TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP)

June 2021

United States Patent and Trademark Office

PREFACE TO THE JUNE 2021 REVISION

The June 2021 revision is an update of the June 2020 edition. Primarily, this update incorporates relevant case law issued between March 1, 2020 and February 28, 2021. In addition, the update includes requirements for new fees in connection with briefs and oral hearings as well as the change in nomenclature from “standing” to file an opposition or cancellation under the Trademark Act to “entitlement to a statutory cause of action.”

The title of the manual is abbreviated as “TBMP.” A citation to a section of the manual may be written as “TBMP § _____ (2021).”

As with previous editions, this edition is available online at the TTAB home page of the USPTO web site in a searchable, printable format as well as in pdf. Archived editions of the TBMP are also available at the TTAB's home page.

Several TTAB judges, attorneys, paralegals, and professional staff contributed to this year’s annual update. Their efforts in ensuring an accurate and timely update are very appreciated. Special thanks are extended to Judge Angela Lykos who took the lead in supervising the work while the TBMP Editor was temporarily assigned to the Office of the Under Secretary and Director.

Cheryl Butler

Senior Counsel and TBMP Editor

Trademark Trial and Appeal Board

INTRODUCTION

INTRODUCTION

The primary purpose of this manual is to provide stakeholders with basic information generally useful for litigating trial cases before the Trademark Trial and Appeal Board. The manual does not modify, amend, or serve as a substitute for any existing statutes, rules, or decisional law and is not binding upon the Board, its reviewing tribunals, the Director, or the USPTO. *Cf.*, *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989). Rather, the manual describes current practice and procedure under the applicable authority and incorporates amendments to the Trademark Rules of Practice, Trademark Act and Federal Rules, and updates in case law, where applicable, as of February 28, 2021. This manual contains links to a USPTO-created compilation of the Trademark Rules of Practice, Trademark Act and Federal Rules that was created for the public's convenience and is not meant to serve as an official legal source. Those using that compilation for legal research should verify their results against the most current official printed editions of the Code of Federal Regulations and United States Code, published Public Laws, and the daily Federal Register, as applicable. The guidelines set forth in the manual do not have the force and effect of law. They have been developed as a matter of internal office management and are not intended to create any right or benefit, substantive or procedural, enforceable by any party against the office.

The manual is devoted primarily to opposition and cancellation proceedings, the two most common types of inter partes proceedings before the Board. Nonetheless, the manual includes a chapter of general information useful for all proceedings and chapters on interference proceedings, concurrent use proceedings, and ex parte appeals to the Board. Updates this year reflect changes in practice as a result of requirements for new fees in connection with appeal briefs and oral hearings and nomenclature. Notably, standing to file an opposition or cancellation under the Trademark Act is now termed "entitlement to a statutory cause of action."

The manual is updated periodically.

The manual is intended for use by all members of the public, including those seeking general information about Board proceedings, those involved in a Board proceeding, and those not represented by legal counsel, as well as by attorneys and legal professionals. In acknowledgement of the wide breath of users, only the most commonly recognized abbreviations are used in case names (e.g., "Co.", "Corp.," "Ltd.") to enhance searching within the manual and to enhance readability. For users who wish to insert case names into a document requiring use of a specific form of citation, please note that case names may need to be modified.

The Board welcomes suggestions for improving the content of the manual. Suggestions and comments should be addressed as follows:

TBMPcomments@uspto.gov, or

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101 Applicable Authority

101.01 Statute and Rules of Practice

All proceedings before the Trademark Trial and Appeal Board ("Board") are governed by the Lanham Trademark Act of 1946, as amended, ("Trademark Act"), 15 U.S.C. § 1051 et seq.; the rules of practice in trademark cases (commonly known as the Trademark Rules of Practice), which may be found in Parts 2 and 7 of Title 37 of the Code of Federal Regulations ("C.F.R."); the rules pertaining to assignments in trademark cases, which may be found in Parts 3 and 7 of 37 C.F.R.; and the rules relating to the conduct of practitioners and the representation of others before the United States Patent and Trademark Office ("USPTO") which may be found in Part 11 of 37 C.F.R. The USPTO rules governing procedure in inter partes proceedings before the Board are adapted, in large part, from the Federal Rules of Civil Procedure, with modifications due primarily to the administrative nature of Board proceedings. [Note 1.]

A copy of Title 37 of the C.F.R. may be obtained at a nominal cost from the U.S. Government Printing Office. An electronic version of Title 37 of the C.F.R. may be found online at the Government Printing Office website through: **https://www.govinfo.gov/app/browse/category/regulatory-info**. A USPTO-created compilation of the Trademark Act and rules can be accessed and downloaded from the USPTO website at: **https://www.uspto.gov/sites/default/files/documents/tmlaw.pdf**. That compilation was created for the public's convenience and is not meant to serve as an official legal source. Those using that compilation for legal research should verify their results against the most current official printed editions of the C.F.R. and United States Code, published Public Laws, and the daily Federal Register, as applicable.

Information regarding proposed and final rule changes to Title 37 is also posted on the USPTO website at **https://www.uspto.gov/trademark/trademark-updates-and-announcements/recent-and-upcoming-statutory-and-regulatory-changes**.

NOTES:

1. *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988).

101.02 Federal Rules

37 C.F.R. § 2.122(a) ***Applicable rules.*** *Unless the parties otherwise stipulate, the rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part. When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

37 C.F.R. § 2.116 ***Federal Rules of Civil Procedure.***

(a) *Except as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure.*

Inter partes proceedings before the Board are also governed by the Federal Rules of Civil Procedure, except as otherwise provided in the Trademark Rules of Practice, and "wherever applicable and appropriate," [Note 1], and by the Federal Rules of Evidence. [Note 2.]

There is no provision in the Trademark Rules of Practice concerning the applicability of the Federal Rules of Evidence to ex parte appeals before the Board. However, certain of the principles embodied in the Federal Rules of Evidence are applied by the Board, in practice, in evaluating the probative value of evidence submitted in ex parte cases. [Note 3.] *See*TBMP § 1208.

NOTES:

1. 37 C.F.R. § 2.116(a). *See Multisorb Technology Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013) (Consistent with 37 C.F.R. § 2.116(a), the Board also generally follows settled federal practice when deciding cases raising procedural issues that fall within the interstices between the provisions in the Federal Rules, the C.F.R., and the Trademark Board Manual of Procedure). *See also Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326 (TTAB 2011) (citing 37 C.F.R. § 2.116(a)).

2. 37 C.F.R. § 2.122(a). *See B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015) (proceedings before the TTAB are largely governed by the Federal Rules of Civil Procedure and Evidence); *Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1311 (Fed. Cir. 1989) (In applying the burden of proof provisions of Fed. R. Evid. 301, the court stated "[t]he Federal Rules of Evidence generally apply to TTAB proceedings."). *See, e.g., Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, at *3, 4 (TTAB 2019) (Fed. R. Evid. 602, 701 and 1006); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 (TTAB 2009) (applying Fed. R. Evid. 201); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1956 (TTAB 2008) (Fed. R. Evid. 801); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1861 (TTAB 2008) (Fed. R. Evid. 701); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104-05 (TTAB 2007) (Fed. R. Evid. 803 and 1004); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1264-65 (TTAB 2003) (Fed. R. Evid. 612); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998) (Fed. R. Evid. 902); *HRL Assoc. Inc. v. Weiss Assoc. Inc.*, 12 USPQ2d 1819, 1822 (TTAB 1989) (Fed. R. Evid. 408); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1448, n.20 (TTAB 1986) (Fed. R. Evid. 401).

3. *See, e.g., In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (articles from general and business publications are not hearsay and are probative of descriptive usage); *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996) (listings from telephone directories and Dun & Bradstreet databases are not inadmissible hearsay); *In re American Olean Tile Co.*, 1 USPQ2d 1823, 1824 n.2 (TTAB 1986) (affidavit consisting of third-hand report by unidentified person is inadmissible hearsay); *In re Foundry Products, Inc.*, 193 USPQ 565, 567 (TTAB 1976) (third-party registrations not considered when copies were not made of record).

101.03 Decisional Law

Proceedings before the Board are also governed, to a large extent, by precedential decisions in prior cases. These decisions include those of the Board itself, as well as the decisions of the Court of Appeals for the Federal Circuit ("Federal Circuit") (which determines appeals from decisions of the Board); the Court of Customs and Patent Appeals (predecessor of the Court of Appeals for the Federal Circuit); and the Director of The United States Patent and Trademark Office (formerly the Commissioner of Patents and Trademarks) ("Director"), who determines petitions seeking review of Board actions on procedural matters.

The Board relies primarily on precedent from the Court of Appeals for the Federal Circuit. The Federal Circuit is the Board's primary reviewing court since by statute, any applicant or party to an inter partes proceeding who is dissatisfied with the Board's decision may seek review of the decision in the Federal Circuit. Also, the Federal Circuit's cases address registration issues more specifically. [Note 1.]

Decisions of the Board, the Director, and the Court of Appeals for the Federal Circuit appear in the United States Patents Quarterly ("USPQ"), Bloomberg Law database, [Note 2], and may also be found in LexisNexis Corporation's LEXIS/NEXIS legal database, and in the Intellectual Property Library of ThomsonReuters Corporation's WESTLAW database. Final Board decisions are also available on a public electronic database by accessing the TTAB Reading Room at **https://ttab-reading-room.uspto.gov/efoia/efoia-ui/#/search/decisions** through the Board home page of the USPTO website. Docket information and full images of Board files may be viewed by accessing TTABVUE at **http://ttabvue.uspto.gov/ttabvue/**.

Decisions that are designated by the Board as "Citable as Precedent," "Precedent of the Board," "Precedent of the TTAB," or "for publication in full" are citable as precedent. Since January 23, 2007, the Board has permitted citation to any Board decision or interlocutory order, although a decision or order designated as not precedential is not binding upon the Board, but may be cited for whatever persuasive value it might have. [Note 3.] In general, however, the Board discourages the citation to non-precedential opinions. [Note 4.]

Decisions of other tribunals may be cited to the extent allowed and for the purposes permitted by the tribunal that issued the decision.

Citation to all TTAB decisions should be to the United States Patent Quarterly, if the decision appears therein; otherwise, to a USPTO public electronic database [e.g. TTABVUE], or Bloomberg Law (BL), WESTLAW, or LEXIS/NEXIS, as well as to any other official reporter, if any, such as the Federal Reporter or Federal Supplement. If a non-precedential decision does not appear in the United States Patents Quarterly or the USPTO's public electronic databases, the citing party should append a copy of the decision to the motion or brief in which the decision is cited. [Note 5.]

Any cited decision of the Board or another court, which appears in the USPQ, should include a citation to the USPQ, in addition to citation to an official reporter (if any), such as the Federal Reporter or Federal Supplement. [Note 6.] *See*TBMP § 801.03 (inter partes briefs); TBMP § 1203.02(f)(ex parte briefs).

NOTES:

1. *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1506 n.2 (TTAB 2008). *See also* 15 U.S.C. § 1071(a); 28 U.S.C. § 1295(a)(4)(B).

2. Bloomberg Law ceased publishing the USPQ in print form in December 2018.

3. Citation of Opinions to the Trademark Trial and Appeal Board, O.G. Notice (Jan. 23, 2007). *See In re tapio GmbH*, 2020 USPQ2d 1138, at *8 n.34 (TTAB 2020) (Board found unpersuasive non-precedential decisions decided on different records); *In re Society of Health and Physical Educators*, 127 USPQ2d 1584, 1587 n.7 (TTAB 2018) ("Board decisions which are not designated as precedent are not binding on the Board, but may be cited and considered for whatever persuasive value they may hold.").

4. *See In re tapio GmbH*, 2020 USPQ2d 1138, at *10 n.30 (TTAB 2020) ("Generally, the practice of citing non-precedential opinions is not encouraged."); *In re Morrison & Foerster LLP*, 110 USPQ2d 1423, 1427 n.6 (TTAB 2014) ("Although parties may cite to non-precedential decisions, the Board does not encourage the practice.); In re Procter & Gamble Co., 105 USPQ2d 1119, 1120-21 (TTAB 2012) (citation to non-precedential opinions permitted but not encouraged; non-precedential decisions not binding on the

Board). *See also 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).

5. *See , e.g. , Citation of Opinions to the Trademark Trial and Appeal Board* , O.G. Notice (Jan. 23, 2007). The final decisions of the Board are posted at **https://ttab-reading-room.uspto.gov/efoia/efoia-ui/#/search/decisions** and files of Board proceedings are available at **http://ttabvue.uspto.gov/ttabvue/**. *See also In re Fiat Group Marketing & Corporate Communications S.p.A.*, 109 USPQ2d 1593, 1596 n.6 (TTAB 2014) (non-precedential decisions are not binding on the Board, but may be cited to and considered for whatever persuasive value they may hold); *In re the Procter & Gamble Co.*, 105 USPQ2d 1119, 1121 (TTAB 2012) (no prohibition against citing to non-precedential opinions, but the Board does not encourage this practice); *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1151 n.7 (TTAB 2011) (parties may cite to non-precedential decisions, but they are not binding on the Board); *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).

6. *See Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1830 (TTAB 2012) (include citation to the *United States Patent Quarterly* (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 (TTAB 2009) (same).

101.04 Director's Orders and Notices

Occasionally, the Director or another USPTO official acting under the Director's authority, publishes in the Official Gazette an order or notice relating to a particular Office policy, practice, procedure, or other such matter of interest to the public. Some of these orders and notices affect practice and procedure before the Board. Such notices are also posted on the Office's website at **https://www.uspto.gov/trademark/trademark-updates-and-announcements/recent-postings**.

101.05 Trademark Trial and Appeal Board Manual of Procedure

The Trademark Trial and Appeal Board Manual of Procedure ("TBMP") (i.e., this Manual) is a compilation of statutory, regulatory, and decisional authority relevant to Board practice and procedure. It is written as a guide for the Board, practitioners and parties before the Board. In addition to compiling applicable authority, the TBMP includes many practical suggestions on practice before the Board. Nonetheless, the TBMP "does not modify, amend, or serve as a substitute for any statutes, rules or decisional law and is not binding upon the [TTAB]." [Note 1.]

The TBMP is revised annually to incorporate changes in applicable statutes, rules, and case law, and to reflect changes in Board practice. [Note 2.] Practitioners and parties before the Board who consult the TBMP should keep the publication date of the current revision in mind, and conduct any research necessary to determine whether there have been any relevant changes in the law since publication.

The TBMP is not – nor is it intended to be – a comprehensive reference on all aspects of the procedural or substantive law applicable to Board proceedings. Parties are urged to conduct appropriate legal research, as needed, or obtain legal counsel. *See* TBMP § 114.

NOTES:

1. *Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises Ltd.*, 511 F.3d 437, 85 USPQ2d 1385, 1393 (4th Cir. 2007) (quoting TBMP Introduction). *See also El Encanto, Inc. v. Hatch Chile Co.*, 825 F.3d 1161, 119 USPQ2d 1139, 1143 (10th Cir. 2016) (quoting in part from TBMP Introduction). *Cf. In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009) ("the TMEP is instructive, but 'is not established law,'") (*citing In re Pennington Seed, Inc.*, 466 F.3d 1053, 80 USPQ2d 1758, 1763 (Fed. Cir. 2006)) ("While the TMEP is not established law, but only provides instructions to examiners, it does represent the PTO's established policy on varietal names that is entitled to our respect.").

2. The Board welcomes suggestions for improving the content of the TBMP. Suggestions and comments should be addressed to:

ATTN: TBMP Editor
U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria,VA 22313-1451

Suggestions may be submitted electronically to: TBMPComments@uspto.gov.

102 Nature of Board Proceedings

102.01 Jurisdiction of Board

The Trademark Trial and Appeal Board is an administrative tribunal of the United States Patent and Trademark Office. The Board is empowered to determine only the right to register. [Note 1.] The Board's determination of registrability does not require in every instance a decision on every pleaded claim, and the Board uses its discretion to decide only those claims necessary to enter judgment and dispose of the case. [Note 2.]

The Board is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition. [Note 3.]

The Board, being an administrative tribunal, has no authority to declare any portion of the Act of 1946, or any other act of Congress, unconstitutional. [Note 4.] But this does not mean that parties who want to raise challenges to an act of Congress or other Constitutional claims should not include them in their pleadings. Like other claims, Constitutional claims should be raised before the Board to consider in the first instance to avoid waiving them. [Note 5.] Where a party raises a constitutional claim, the Board may address the claim or issues raised by the claim, including any factual or statutory premises underlying the claim. [Note 6.]

NOTES:

1. Trademark Act § 17, 15 U.S.C. § 1067, Trademark Act § 18, 15 U.S.C. § 1068, Trademark Act § 20, 15 U.S.C. § 1070, Trademark Act § 24, 15 U.S.C. § 1092. *See Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1309 (TTAB 2014); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1082-83 (TTAB 2014).

2. *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013).

3. *FirstHealth of the Carolinas Inc. v. CareFirst of Md. Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1921 (Fed. Cir. 2007) (quoting TBMP); *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 300 F.3d 1333, 66 USPQ2d 1811, 1819-20 (Fed. Cir. 2003) (no jurisdiction to decide issues arising under state dilution laws), *aff'g* 62 USPQ2d 1857, 1858 (TTAB 2002); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) (Board cannot adjudicate unfair competition issues); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 (TTAB 2011) (no authority to determine the right to use, or the broader questions of infringement, unfair competition, damages or injunctive relief); *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006) ("[T]he Board's jurisdiction is limited to determining whether trademark registrations should issue or whether registrations should be maintained; it does not have authority to determine whether a party has engaged in criminal or civil wrongdoings."), *aff'd unpub'd*, 240 F. App'x 865 (Fed. Cir. July 11, 2007), *cert. denied,*, 552 U.S. 1109 (2008); *Carano v. Vina Concha Y Toro S.A.*, 67 USPQ2d 1149, 1151-52 (TTAB 2003) (no jurisdiction to determine copyright infringement; opposer's claim that applicant neither owns nor is entitled to use mark was not separable from opposer's copyright claim); *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1270 n.2 (TTAB 1999) (no jurisdiction over unfair competition claims); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1771 n.5 (TTAB 1994) (no jurisdiction over claims of trademark infringement and unfair competition), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997); *Kelly Services Inc. v. Greene's Temps. Inc.*, 25 USPQ2d 1460, 1464 (TTAB 1992) (not empowered to render declaratory judgment); *Andersen Corp. v. Therm-O-Shield International, Inc.*, 226 USPQ 431, 432 n.5 (TTAB 1985) (may not entertain any claim based on Trademark Act § 43(a)); *Electronic Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162, 163-64 (TTAB 1984) (unfair competition and Trademark Act § 43(a) claims are outside the Board's jurisdiction); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246, 252 (TTAB 1977) (determination of whether opposer is guilty of unfair business practices is not within the province of the Board); *Yasutomo & Co. v. Commercial Ball Pen Co.*, 184 USPQ 60, 61 (TTAB 1974) (no jurisdiction to address anti-trust issues); *American-International Travel Service, Inc. v. AITS, Inc.*, 174 USPQ 175, 179 (TTAB 1972) (no jurisdiction to determine whether opposer violated criminal statute).

But see Loglan Institute Inc. v. Logical Language Group Inc., 962 F.2d 1038, 22 USPQ2d 1531, 1534 (Fed. Cir. 1992) (Board may have erred in stating that it lacked jurisdiction over equitable defenses which were based on allegations of trademark infringement and unfair competition); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 647 (Fed. Cir. 1983) (regarding Board's authority to consider an agreement, its construction, or its validity if necessary to decide the issues properly before it, including the issue of estoppel); *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417, 423 (CCPA 1972) (Board is not precluded from passing on the validity of a copyright if it is necessary to do so in the course of the exercise of its statutory jurisdiction); *Diaz v. Servicios De Franquicia Pardo's S.A.C.*, 83 USPQ2d 1320, 1326 (TTAB 2007) (Board has jurisdiction over assertion of priority under Article 7 of the Pan American Convention because it pertains expressly to the registrability of marks and priority rights based on use); *M-5 Steel Manufacturing Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1094-95 (TTAB 2001) (contractual estoppel considered); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1702 (TTAB 2000) (noting that by rule change effective August 5, 1999, the 1946 Act was amended to allow parties to bring dilution claims under Trademark Act § 43(c) in opposition and cancellation proceedings); *British-American Tobacco Co. v. Philip Morris Inc.*, 55 USPQ2d 1585, 1589 (TTAB 2000) (a claim under Article 8 of the Pan American Convention is within the jurisdiction of the Board because it pertains expressly to the registrability of marks and provides for the cancellation of registrations).

See also The Scotch Whiskey Association v. United States Distilled Products Co., 13 USPQ2d 1711, 1715 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240, 1243 (TTAB 1990) (Board cannot consider claims of unfair competition standing alone, but can consider such claims in determining the registrability of a mark, that is, in determining a separate, properly pleaded ground for opposition or cancellation), *dismissed*, 18 USPQ2d 1391, 1394 (TTAB 1991) (where petitioner did not plead a separate ground on which to base the petition

to cancel, petitioner's claims under Articles 10 and 10 *bis* of the Paris Convention could not be considered), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

4. *In re District of Columbia*, 101 USPQ2d 1588, 1602 (TTAB 2012) (no authority to declare provisions of the Trademark Act unconstitutional), *aff'd sub nom. In re City of Houston*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1638 (TTAB 2011) (same); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1710 (TTAB 1999) (same), *rev'd on other grounds*, 284 F. Supp.2d 96, 68 USPQ2d 1225 (D.D.C. 2003); *Hawaiian Host, Inc. v. Rowntree MacKintosh PLC*, 225 USPQ 628, 630 (TTAB 1985) (no authority to declare Trademark Act § 44(e) unconstitutional); *Electric Storage Battery Co. v. Mine Safety Appliances Co.*, 143 USPQ 163, 167 (TTAB 1964) (no authority to find Trademark Act § 23 unconstitutional).

5. *Elgin v. Department of Treasury*, 567 U.S. 1, 22-23 (2012) (noting that an agency could "apply its expertise" to the "many threshold questions that may accompany a constitutional claim," and that an agency's "statutory interpretation could alleviate constitutional concerns"); *In re DBC*, 545 F.3d 1373, 1378-80 (Fed. Cir. 2008) (holding that a party forfeited an Appointments Clause challenge that it failed to present to the agency in the first instance).

6. *In re ADCO Industries-Technologies L.P.*, 2020 USPQ2d 53786, at *9-11 (TTAB 2020) (addressing applicant's argument that 15 U.S.C. §§ 1052(a) and (c) are unconstitutional because they violate the First Amendment to the United States Constitution).

102.02 Types of Board Proceedings

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

An opposition is a proceeding in which the plaintiff seeks to prevent the issuance of a registration, in whole or in part, of a mark on the Principal Register. "Any person who believes that he would be damaged by the registration of a mark" may file an opposition thereto, but the opposition may be filed only as a timely response to the publication of the mark, in the Official Gazette of the United States Patent and Trademark Office. [Note 1.] *See*TBMP § 303 (Who May Oppose or Petition to Cancel).

A cancellation proceeding is a proceeding in which the plaintiff seeks to cancel an existing registration, in whole or in part, of a trademark on the Principal Register or the Supplemental Register. A petition for cancellation may only be filed after the issuance of the registration. A petition for cancellation may be filed by "any person who believes that he is or will be damaged by the registration" of the mark. [Note 2.] *See*TBMP § 303 (Who May Oppose or Petition to Cancel).

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 upon 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 (Declaration of Interference). Ordinarily, the availability of an opposition or cancellation proceeding is deemed to prevent any undue prejudice from the unavailability of an interference proceeding. [Note 5.] An interference that has been declared by the Director is not instituted by the Board until after all of the marks that are to be involved in the proceeding have been published in the Official Gazette for opposition. *See*TBMP § 1003. For further information, see TBMP Chapter 1000 (Interferences).

A concurrent use proceeding is a proceeding in which the Board determines whether one or more applicants is entitled to a concurrent registration on the Principal Register, that is, a registration with conditions and limitations, fixed by the Board, as to the mode or place of use of the applicant's mark or the goods and/or services on or in connection with which the mark is used (usually, a concurrent registration is restricted as to the territory which it covers). *See*TBMP § 1101.01. The proceeding may be initiated only through the filing of an application for registration as a lawful concurrent user, and is instituted by the Board only after each of the one or more involved applications has been published for opposition in the Official Gazette, and all oppositions thereto (if any) have been withdrawn or dismissed. *See*TBMP § 1102.01 and TBMP § 1105. For further information, see TBMP Chapter 1100 (Concurrent Use Proceedings).

The Board also has jurisdiction over ex parte appeals, that is, appeals from an examining attorney's final refusal to register a mark in an application. [Note 6.] *See* TBMP Chapter 1200 (Ex Parte Appeals).

NOTES:

1. Trademark Act § 13, 15 U.S.C. § 1063, Trademark Act § 12(a), 15 U.S.C. § 1062 (a), Trademark Act § 18, 15 U.S.C. § 1068.

2. Trademark Act § 14, 15 U.S.C. § 1064, Trademark Act § 18, 15 U.S.C. § 1068, Trademark Act § 24, 15 U.S.C. § 1092.

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

4. Trademark Act § 16, 15 U.S.C. § 1066; 37 C.F.R. § 2.146(a)(4).

5. Removal of Rules Governing Trademark Interferences, 82 Fed. Reg. 48469, 48470 (Oct. 18, 2017).

6. Trademark Act § 12(b), 15 U.S.C. § 1062(b), Trademark Act § 20, 15 U.S.C. § 1070; 37 C.F.R. § 2.141, 37 C.F.R. § 2.142.

102.03 General Description of Board Proceedings

An inter partes proceeding before the Board is similar to a civil action in a federal district court. There are pleadings (at least in an opposition or cancellation proceeding); a wide range of possible motions; conferencing; disclosures; discovery; trial; briefs; and, if requested, an oral hearing, followed by a decision on the case. [Note 1.] However, because the Board is an administrative tribunal, its rules and procedures necessarily differ in some respects from those prevailing in the federal district courts. [Note 2.] *See also* TBMP § 502.01 (Available Motions) and TBMP § 702 (Pretrial Disclosures; Manner of Trial; and Introduction of Evidence). The principal difference is that proceedings before the Board are conducted in writing, and the Board's actions in a particular case are based upon the written record therein. For example, the Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. Indeed, a party to a proceeding before the Board need never come to the offices of the Board at all, unless the Board requests that the parties meet with the Board at its offices for a pretrial conference pursuant to 37 C.F.R. § 2.120(j), or unless the party wishes to argue its case at oral hearing (an oral hearing is held only if requested by a party to the proceeding). Parties may stipulate to expediting the proceeding in whole or in part utilizing Accelerated Case Resolution (ACR). *See*TBMP § 528.0 5 (a)(2), TBMP § 702.04, and TBMP § 705.

An ex parte appeal, being appellate in nature, is a much simpler and shorter procedure, involving only the filing of briefs by the applicant and examining attorney, and, if requested by the applicant, an oral hearing. *See*TBMP Chapter 1200 (Ex Parte Appeals).

"The Trademark Trial and Appeal Board shall include the Director, Deputy Director of the United States Patent and Trademark Office, the Commissioner for Patents, the Commissioner for Trademarks, and [the] administrative trademark judges...." [Note 3.] This Manual refers to these statutory members of the Board collectively as "judges."

Interlocutory motions, requests, conceded matters, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Board judge, or by a single interlocutory attorney ("attorney") or paralegal to whom such authority has been delegated, and certain conceded and non-dispositive matters may be acted on automatically by ESTTA. [Note 4.] Decisions on the merits of a case, and on complex or contested motions that are potentially dispositive of the case, are rendered by a panel of at least three Board judges. [Note 5.] Stipulations or consented (or uncontested) motions to dispose of the proceeding in a certain manner may be decided per curiam by the Board. [Note 6.] Institution orders, stipulated scheduling motions, issuance of notices of default, and other administrative matters may be acted upon by Board paralegals or may be administered through ESTTA. [Note 7.] Motions disposed of by orders entitled ''By the Trademark Trial and Appeal Board'' have the same legal effect as orders by a panel of three Administrative Trademark Judges of the Board. [Note 8.] The parties must enter their changes of address and representation using ESTTA. For further information regarding ESTTA, see TBMP § 110.

NOTES:

1. *See B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) (USPTO rules governing the procedures are designed to approximate the proceedings in a courtroom trial).

2. *See B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S.138, 135 S.Ct. 1293, 113 USPQ2d 2045, 2049 (2015); *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976) ("The procedures followed by the Board are not like the procedures in a courtroom and the applicability of the Federal Rules of Civil Procedure must be judged in that light....").

3. Trademark Act § 17(b), 15 U.S.C. § 1067(b).

4. 37 C.F.R. § 2.127(c).

5. 37 C.F.R. § 2.129(a), 37 C.F.R. § 2.142(e)(1). *See Fifth Generation Inc. v. Titomirov Vodka LLC*, 2019 USPQ2d 418666, at *3 (TTAB 2019) (Board will not decide potentially dispositive motion by telephone; such motions must issue by panel or per curiam).

6. *See Fifth Generation Inc. v. Titomirov Vodka LLC*, 2019 USPQ2d 418666, at *3 (TTAB 2019) (potentially dispositive motions may issue per curiam).

7. 37 C.F.R. § 2.2(g).

8. 37 C.F.R. § 2.127(c).

103 Location and Address of Board

The Board is located at 600 Dulany Street, Alexandria, Virginia 22313-1451. The mailing address of the Board is:

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria,VA 22313-1451.

104 Business to be Conducted in Writing

37 C.F.R. § 2.190(b) ***Electronic trademark documents.*** *… Documents that relate to proceedings before the Trademark Trial and Appeal Board must be filed electronically with the Board through ESTTA.*

37 C.F.R. § 2.191 ***Action of the Office based on the written record.*** *All business with the Office must be transacted in writing. The action of the Office will be based exclusively on the written record. No consideration will be given to any alleged oral promise, stipulation, or understanding when there is disagreement or doubt.*

With the exceptions of discovery conferences with Board participation, see TBMP § 401.01, and telephone conferences, see TBMP § 413.01 and TBMP § 502.06, all business with the Board should be transacted in writing. 37 C.F.R. § 2.191. The personal attendance of parties or their attorneys or other authorized representatives at the offices of the Board is unnecessary, except in the case of a pretrial conference as provided in 37 C.F.R. § 2.120(j), or upon oral argument at final hearing, if a party so desires, as provided in 37 C.F.R. § 2.129. Decisions of the Board will be based exclusively on the written record before it. [Note 1.] Documents filed in proceedings before the Board must be filed through ESTTA. 37 C.F.R. § 2.190(b). *See* TBMP § 110.01(a).

Board proceedings are conducted in English. If a party intends to rely upon any submissions that are in a language other than English, the party should also file a translation of the submissions. If a translation is not filed, the submissions may not be considered. [Note 2.]

NOTES:

1. *Cf. In re Sovran Fin. Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1992) (regarding actions taken by examining attorneys); *In re Merck & Co.*, 24 USPQ2d 1317, 1318 n.2 (Comm'r 1992) (regarding oral representation by Board employee); *In re Investigacion Y Desarrollo de Cosmeticos S.A.*, 19 USPQ2d 1717, 1719 (Comm'r 1991).

2. *See, e.g., Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477 (TTAB 2017) (while translations must be signed by person making translation, they need not be certified to be considered; certification is a suggested better practice); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1734 n.8 (TTAB 2012) (noting that printed publications submitted in a foreign language without translations are of limited probative value); *Johnson & Johnson v. Obschestvo s ogranitchennoy; otvetstvennostiu "WDS"*, 95 USPQ2d 1567, 1570 n.3 (TTAB 2010) (noting that if a party intends to rely at trial on business records in a foreign language, it must provide a translation); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998) (noting that a proffered excerpt from a newspaper or periodical is lacking in foundation and, thus, is not admissible as evidence to the extent that it is unintelligible because it is in a language other than English). *See also Lacteos de Honduras S.A. v. Industrias Sula, S. De R.L. de C.V.*, 2020 USPQ2d 10087, at *6 (TTAB 2020) (for purpose of determining

plausibility of allegations in counterclaim, in connection with motion to dismiss, Board did not consider attached exhibits to complaint because they were in Spanish with no English translation provided); *Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *1 n.1 (TTAB 2019) (Board noted that petitioner provided testimony declarations with translations from Spanish to English).

105 Contact With Board Personnel

37 C.F.R. § 11.305 ***Impartiality and decorum of the tribunal.***

(a) *A practitioner shall not:*

* * * *

(b) *Communicate ex parte with such a person during the proceeding unless authorized to do so by law, rule or court order.*

* * * *

Parties or their attorneys or other authorized representatives may telephone the Board to inquire about the status of a case or to ask for procedural information, but not to discuss the merits of a case or any particular issue. [Note 1.] The telephone number of the Board is (571) 272-8500, or (800) 786-9199 (toll free). If an inquiry involves a particular case, the person making the inquiry should be prepared to give the number of the proceeding or application in question. Inquiries to the Board should not be made by email.

NOTES:

1. 37 C.F.R. § 11.305(b). *See Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1542 n.15 (TTAB 2010) (to inquire as to status of Board proceeding, party may call Board during business hours).

106 Identification, Signature, and Form of Submissions

106.01 Identification of Submissions

A submission filed in a proceeding before the Board should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by the caption identifying the parties' names and the number of the inter partes proceeding (or, in the case of an ex parte appeal, or an extension of time to oppose, the application) to which it relates. [Note 1.] The document should also include a title describing its nature, e.g., "Notice of Opposition," "Answer," "Motion to Compel," "Brief in Opposition to Respondent's Motion for Summary Judgment," or "Notice of Reliance."

Documents filed in an application which is the subject of an inter partes proceeding before the Board should be filed with the Board, not the Trademark Operation, and should bear at the top of the first page both the application serial number, and the inter partes proceeding number and caption. Similarly, requests under Trademark Act § 7, 15 U.S.C. § 1057, to amend, correct, or surrender a registration which is the subject of a Board inter partes proceeding, and any new power of attorney, designation of domestic representative, or change of address submitted in connection with such a registration, should be filed with the Board, not with the Trademark Operation, and should bear at the top of its first page the registration number, and the inter partes proceeding number and the proceeding caption. [Note 2.]

NOTES:

1. 37 C.F.R. § 2.194.

2. 37 C.F.R. § 2.194.

106.02 Signature of Submissions

37 C.F.R. § 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 C.F.R. § 11.14(e) ***Appearance.*** *No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark matters on behalf of a client. Except as specified in § 2.11(a) of this chapter, an individual may appear in a trademark or other non-patent matter in his or her own behalf or on behalf of:*

(1) *A firm of which he or she is a member;*

(2) *A partnership of which he or she is a partner; or*

(3) *A corporation or association of which he or she is an officer and which he or she is authorized to represent.*

37 C.F.R. § 11.18 ***Signature and certificate for correspondence filed in the Office.***

(a) *For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed or inserted by such practitioner, in compliance with § 1.4(d)(1), § 1.4(d)(2), or § 2.193(a) of this chapter.*

(b) *By presenting to the Office or hearing officer in a disciplinary proceeding (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—*

(1) *All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious, or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001 and any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and*

(2) *To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,*

(i) *The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;*

(ii) *The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;*

(iii) *The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and*

(iv) *The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.*

(c) *Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of--*

(1) *Striking the offending paper;*

(2) *Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;*

(3) *Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;*

(4) *Affecting the weight given to the offending paper; or*

(5) *Terminating the proceedings in the Office.*

(d) *Any practitioner violating the provisions of this section may also be subject to disciplinary action.*

37 C.F.R. § 2.193 ***Trademark correspondence and signature requirements.***

(a) ***Signature required.*** *Each piece of correspondence that requires a person's signature, must bear:*

(1) *A handwritten signature personally signed in permanent ink by the person named as the signatory, or a true copy thereof; or*

(2) *An electronic signature that meets the requirements of paragraph (c) of this section, personally entered by the person named as the signatory. The Office will accept an electronic signature that meets the requirements of paragraph (c) of this section on correspondence filed on paper or through TEAS or ESTTA.*

(b) ***Copy of original signature.*** *If a copy of an original signature is filed, the filer should retain the original as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.*

(c) ***Requirements for electronic signature.*** *A person signing a document electronically must:*

(1) *Personally enter any combination of letters, numbers, spaces and/or punctuation marks that the signer has adopted as a signature, placed between two forward slash ("/") symbols in the signature block on the electronic submission; or*

(2) *Sign the verified statement using some other form of electronic signature specified by the Director.*

(d) ***Signatory must be identified.*** *The first and last name, and the title or position, of the person who signs a document in connection with a trademark application, registration, or proceeding before the Trademark Trial and Appeal Board must be set forth immediately below or adjacent to the signature.*

(e) ***Proper person to sign.*** *Documents filed in connection with a trademark application or registration must be signed as specified in paragraphs (e)(1) through (9) of this section.*

(2) ***Responses, amendments to applications, requests for express abandonment, requests for reconsideration of final actions, and requests to divide.*** *Responses to Office actions, amendments to applications, requests for express abandonment, requests for reconsideration of final actions, and requests to divide must be signed by the owner of the application or registration, someone with legal authority to bind the owner (e.g. a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the following guidelines:*

(ii) *If the owner is not represented by a practitioner qualified to practice under § 11.14 of this chapter, the individual owner or someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership) must sign. In the case of joint owners who are not represented by a qualified practitioner, all must sign*

* * * *

(6) ***Requests for correction, amendment or surrender of registrations.*** *A request for correction, amendment or surrender of a registration must be signed by the owner of the registration, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice before the Office under § 11.14 of this chapter. In the case of joint owners who are not represented by a qualified practitioner, all must sign.*

* * * *

(10) ***Cover letters.*** *A person transmitting paper documents to the Office may sign a cover letter or transmittal letter. The Office neither requires cover letters nor questions the authority of a person who signs a communication that merely transmits paper documents.*

(f) ***Signature as certification.*** *The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by any person, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this chapter. Violations of § 11.18(b) of this chapter may jeopardize the validity of the application or registration, and may result in the imposition of sanctions under § 11.18(c) of this chapter. Any practitioner violating § 11.18(b) may also be subject to disciplinary action. See § 11.18(d) and § 11.804 of this chapter.*

* * * *

(i) ***Certified documents required by statute.*** *When a statute requires that a document be certified, a copy or facsimile transmission of the certification is not acceptable.*

Every document filed in an inter partes or ex parte proceeding before the Board, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party's attorney or other authorized representative, as appropriate, and the signatory must be identified. [Note 1.]

Documents filed through ESTTA, the Board's electronic filing system, do not require a conventional signature. Electronic signatures pursuant to 37 C.F.R. § 2.193(c) are required for electronic filings. The party or its representative enters a "symbol" that has been adopted as a signature. The Board will accept any combination of letters, numbers, space and/or punctuation marks as a valid signature if it is placed between two forward slash ("/") symbols. [Note 2.] The electronic signature entered on the ESTTA form is sufficient as the required signature for the entire submission, including in the absence of a signature on any attachment to the filing form. [Note 3.] The electronic filing cover sheet in ESTTA must be signed by the party filing it, the party's attorney or other authorized representative, as appropriate. For further information regarding the filing of submissions using ESTTA, see TBMP § 110.

A party may act in its own behalf in a proceeding before the Board, if the party is domiciled in the United States, or an attorney may represent the party. [Note 4.] *See* TBMP § 114 (Representation of a Party).

When an individual who is a party to a Board proceeding elects to act in his or her own behalf, the individual must sign any documents that he or she files with the Board. If a party which is a partnership elects to act in its own behalf, a partner should sign documents filed by the partnership. If a party which is a corporation or association elects to act in its own behalf, an officer thereof who is authorized to sign for the corporation or association should sign for that corporation or association. If joint applicants elect to act on their own behalf, all joint applicants must sign any documents filed with the Board. [Note 5.]

If a document is filed on behalf of a party by the party's attorney or other authorized representative, it must bear the signature of, and be personally signed or inserted by, that attorney or other representative, unless it is a document required to be signed personally by the party. An attorney or other authorized representative who signs a document, and then files it with the Board on behalf of a party, should remember that his or her signature to the document constitutes a certification of the elements specified in 37 C.F.R. § 11.18(b), and that a knowing violation of the provisions of that rule by an attorney or other authorized representative will leave him or her open to disciplinary action. [Note 6.] *See*TBMP § 114.04 (regarding meaning of the designation "other authorized representative") and TBMP § 527.02 (regarding motions for Fed. R. Civ. P. 11 sanctions). A person transmitting paper documents, when permitted, for filing with the Board may sign a cover letter or transmittal letter, and the Office does not require the party, attorney, or authorized representative to sign a cover or transmittal letter. [Note 7.]

It is not appropriate for one person to sign a document for another person, as, for example, "John Smith, for John Doe" or "John Doe, by John Smith." [Note 8.]

A document filed in a proceeding before the Board should include the first and last name, in typed or printed form, of the person who signed [Note 9]; a description of the capacity in which he or she signed (e.g., as the individual who is a party, if the filing party is an individual; as a corporate officer, if the filing party is a corporation; or as the filing party's attorney); and his or her business address and telephone number. The inclusion of the signing person's address and phone number on the submission itself is vital for any paper or physical submissions permitted under the rules because mail physically sent to the Office is opened in the Mail Room, and ordinarily the envelopes are discarded there before the mail is sent on to its ultimate destination within the Office. Thus, the Board rarely sees the return addresses on the mailing envelopes of papers filed in Board proceedings.

In accordance with 37 C.F.R. § 2.193(b), a legible copy of the signed document is to be filed with the Board because filings are required to be submitted using ESTTA. The original should be retained as evidence of authenticity. If a question as to the authenticity of a filed copy arises, the Office may require submission of the original. [Note 10.]

Notwithstanding the requirement that a document filed before the Board be signed, an unsigned document filed in paper form, when permitted, 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 11.] Similarly, an improperly signed document, whether filed in ESTTA or on paper, when permitted, will not be refused consideration if a properly signed copy is submitted to the Board within the time set in the notification of this defect by the Board. [Note 12.]

NOTES:

1. 37 C.F.R. § 2.193(d); 37 C.F.R. § 2.193(b); 37 C.F.R. § 2.119(e); and 37 C.F.R. § 11.18 (a).

2. 37 C.F.R. § 2.193 (c)(1); 37 C.F.R. § 2.102(a); 37 C.F.R. § 2.111(b); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1039 n.12 (TTAB 2012) (applicant's use of symbols qualified as a signature); *DaimlerChrysler Corp. v. Maydak*, 86 USPQ2d 1945, 1946 (TTAB 2008) (applicant's use of a symbol between the forward slash marks, followed by his name, qualified as a signature); *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1927 (TTAB 2005).

3. 37 C.F.R. § 2.193(c)(1); *DaimlerChrysler Corp. v. Maydak*, 86 USPQ2d 1945, 1946 (TTAB 2008); *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005) (electronically signed ESTTA form made notice of opposition acceptable although attached pleading was not separately signed).

4. 37 C.F.R. § 11.14(a); 37 C.F.R. § 11.14(e).

5. 37 C.F.R. § 11.14(e). *See* 37 C.F.R. § 2.193(e)(2)(ii).

6. 37 C.F.R. § 2.193(f); 37 C.F.R. § 11.18(c). *Cf.* Fed. R. Civ. P. 11. *See also Clorox Co. v. Chemical Bank* , 40 USPQ2d 1098, 1100 n.9 (TTAB 1996) (accuracy in factual representations is expected). Pro se parties are also bound by 37 C.F.R. § 11.18.

7. 37 C.F.R. § 2.193(e)(10).

8. 37 C.F.R. § 2.119(e) and 37 C.F.R. § 11.18 (a); *Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2018 (TTAB 2003) (response to motion signed by person on behalf of practitioner is inappropriate). *Cf. Cerveceria India Inc. v. Cerveceria Centroamericana, S.A.*, 10 USPQ2d 1064, 1067 (TTAB 1989) (Section 8 declaration signed by someone other than named person, while perhaps unacceptable, does not constitute fraud), *aff'd Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989).

9. *See, e.g.*, 37 C.F.R. § 2.193(d).

10. 37 C.F.R. § 2.193(b).

11. 37 C.F.R. § 2.119(e).

12. *Cf.* 37 C.F.R. § 2.119(e); *Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905, 1908 (TTAB 2014) (Board applies opportunity to cure provision in 2.119(e) to improperly signed papers, which defines the time period for cure as "within the time limit set in the notification of this defect by the Office").

106.03 Form of Submissions

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.*

The rules now require that all submissions must be made to the Board via the Internet through ESTTA, subject to certain limited exceptions permitting submissions to be made on paper. Any permitted paper submission must be accompanied by a written explanation showing that ESTTA was unavailable due to technical problems, or that extraordinary circumstances are present, and, where required, a Petition to the Director with the requisite petition fee. [Note 1.] However, because ESTTA currently does not accept multimedia files, the Board will continue its current practice of accepting the submission of physical DVDs or CDs as exhibits in inter partes proceedings for the limited purpose of allowing parties to submit multimedia evidence, such as commercials. [Note 2.]

The requirements for electronic submissions over the Internet can be found in 37 C.F.R. § 2.126(a). Submissions over the Internet are made through ESTTA which is available on the USPTO website. [Note 3.] Using ESTTA, a person can complete and submit forms, with attachments and/or exhibits, to the Board over the Internet, making an official filing online. ESTTA gives step-by-step instructions for properly completing a form. Available forms and instructions can be found at: **https://estta.uspto.gov**. For more information regarding ESTTA, see TBMP § 110.

The Board requires use of ESTTA for the filing of all submissions in Board proceedings. ESTTA permits round-the-clock filing with real-time receipt confirmation, while reducing delay and the possibility of mishandling of submissions within the USPTO. Many ESTTA filings are processed automatically, with an appropriate Board order issuing within minutes of filing. ESTTA users are strongly urged to plan ahead. Because unexpected problems can occur, users should keep filing deadlines in mind and allow plenty of time to resolve any issue which may arise. The Board will provide general assistance to ESTTA filers but cannot guarantee that any problem will be resolved prior to a deadline. If ESTTA filing is not possible prior to a deadline for any reason, parties should timely submit their filings on paper using another accepted filing method (e.g., certificate of mailing and Priority Mail Express® procedures). *See* TBMP § 111.02, *et seq.* (Certificates of Mailing), and TBMP § 111.01, *et seq.* (Priority Mail Express®). Any paper filing must be accompanied by a written explanation showing that ESTTA was unavailable due to technical problems, or that extraordinary circumstances are present, and, where required, a Petition to the Director with the requisite petition fee. Petitions to file on paper are subject to 37 C.F.R. § 2.146, including the requirement for verified facts.

The requirement for use of ESTTA under all circumstances for the filing of either extensions of time to oppose or notices of opposition against Madrid Protocol applications, i.e., applications under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), further enables the USPTO to fulfill its obligation to timely notify the International Bureau of the World Intellectual Property Organization ("WIPO") of oppositions against requests for extension of protection under the Madrid Protocol. A request for an extension of time to oppose a Madrid Protocol application which is not filed through ESTTA will be denied. Similarly, a notice of opposition not filed through ESTTA against such an application will not be instituted. [Note 4.]

Filers may call the Board with questions about filing at (571) 272-8500 or (800) 786-9199 (toll free). Alternatively, filers may send non-urgent email inquiries to ESTTA@uspto.gov, and include a description of the problem, the ESTTA tracking number and Board proceeding number (if any), and a telephone number for contact. The Board will respond to email inquiries within two business days. The email address is for technical ESTTA questions only. **Documents will not be accepted for filing by email.**

The requirements for paper submissions, when permitted, are set out in 37 C.F.R. § 2.126(b). A paper submission must be 8 to 8.5 inches wide and 11 to 11.69 inches long, and printed in at least 11-point type and double-spaced, with the text on one side only of each sheet. If a paper submission contains dividers, the dividers may not contain tabs or any devices that extend beyond the edges of the paper, and must be on the same size and weight paper as the submission.

In addition, a paper submission must not be stapled or bound. This is important because all paper submissions are scanned electronically into the Board's electronic information system and removing staples or binding prior to scanning is difficult and time-consuming, especially where papers have been bound by machine. Moreover, disassembling stapled or bound papers can damage pages, resulting in jammed scanning equipment and increasing the possibility that pages will become lost or disordered during scanning. [Note 5.] These are additional reasons why the Board requires all submissions to be made using ESTTA.

Any paper document filed with the Board must be either the original or a legible copy thereof, on good quality paper. [Note 6.] Extra copies of a document should not be submitted. [Note 7.]

Exhibits pertaining to an electronic submission must be filed electronically through ESTTA as an attachment to the submission and conform to the requirements for electronic submissions, except when a party needs to submit a multimedia exhibit on CD or DVD. [Note 8.] When making a submission of an exhibit on CD or DVD, parties are advised to include in the accompanying ESTTA filing a ''placeholder'' exhibit page to indicate the CD or DVD exhibit, and to mail the CD or DVD to the Board. *See* TBMP § 110.02(c) regarding size limitations. Exhibits to a submission are also subject to the requirements of 37 C.F.R. § 2.126. A best practice for electronic exhibits in PDF form is to use a separator page for each exhibit and to assign a bookmark to that page with an alpha-numeric designation (such as A, B, C or 1, 2, 3) for easy navigation and location of the exhibit.

Exhibits pertaining to a paper submission, where permitted, must be filed on paper and must comply with the requirements for a paper submission. [Note 9.]

As with any paper submission, paper exhibits may not contain tabs, dividers or any such devices that extend beyond the edges of the paper, and moreover, may not be stapled or bound. However, it is acceptable to use binder clips or rubber bands, or similar devices that would allow for easy separation of the papers for scanning.

Exhibits that are large, bulky, valuable, or breakable may be photographed or otherwise reproduced so that an appropriate digitized or paper image of the exhibits can be filed with the Board in lieu of the originals. Exhibits consisting of videotapes or audiotapes of commercials, demonstrations, etc., may not be filed electronically.

The requirements for confidential submissions are specified in 37 C.F.R. § 2.126(c). To be handled as confidential, and kept out of the public record, submissions to the Board that are confidential must be filed under a separate 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 with the confidential portions redacted must also be submitted for the public record. [Note 10.] Confidential materials must be filed through ESTTA using

the "CONFIDENTIAL" option. *See*TBMP § 120.02 and TBMP § 412.04 for information on filing confidential materials.

The Board, in its discretion, may refuse to enter and consider submissions which are not in compliance with 37 C.F.R. § 2.126.

Format of submissions. Apart from the identification, signature, and form requirements referred to above, there is no particular format that submissions to the Board must follow. Nor does the Office have printed forms for any documents filed in Board proceedings. Where possible, parties are encouraged to include a citation to the TTABVUE docket entry and TTABVUE page number, e.g., 1 TTABVUE 2. [Note 11.] For material or testimony that has been designated confidential and which does not appear on TTABVUE, the TTABVUE docket entry number where such material or testimony is located should be included in any citation. [Note 12.]

Although there is no particular format that a submission must follow, in large record cases, the Board may direct the parties on the form of submission for exhibits and may direct the parties to prepare and file an appendix in a specific format. [Note 13.]

NOTES:

1. 37 C.F.R. § 2.126(b); *see also* 37 C.F.R. § 2.101(b)(2), 37 C.F.R. § 2.102(a)(2), 37 C.F.R. § 2.106(b)(1), 37 C.F.R. § 2.111(c)(2), and 37 C.F.R. § 2.114(b)(1).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69966 (October 7, 2016). *See also Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *3 n.4 (TTAB 2020) (a party that wishes to submit audio or video files must record the files on an appropriate medium such as CD-ROM or DVD and physically file it with the Board); *The Pierce-Arrow Society v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at *1 n.8 (TTAB 2019) (Board considered video documentary submitted on CD-ROM); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1654-55 (TTAB 2014) (parties may not, by agreement, override Trademark Rule 2.126 provisions for form of submissions; however, video and audio recordings of evidence such as commercials may be submitted on CD-ROM), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 15, 2016).

3. 37 C.F.R. § 2.2(g); 37 C.F.R. § 2.126(a).

4. *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2021 (TTAB 2005).

5. *See also* RULES OF PRACTICE FOR TRADEMARK-RELATED FILINGS UNDER THE MADRID PROTOCOL IMPLEMENTATION ACT; 68 Fed. Reg. 55748, 55760 (September 26, 2003).

6. *See, e.g.*, 37 C.F.R. § 2.126(a)(2) (must be clear and legible). *See also Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750, 1758 n.16 (TTAB 2013) ("the onus is on the party making the submissions to ensure that, at a minimum, all materials are clearly readable by the adverse party and the Board"), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, at *7 n.23 (TTAB 2019) ("the Board will consider evidence, or a portion of the evidence, only if it is clear and legible.").

7. *DeLorme Publishing Co. v. Eartha's Inc.*, 60 USPQ2d 1222, 1222 n.1 (TTAB 2000) (papers should be filed in single copies only unless otherwise required by rule); *ITC Entertainment Group Ltd. v. Nintendo*

of Am. Inc., 45 USPQ2d 2021, 2022-23 (TTAB 1998) (unnecessary copies and attachments to motions resulted in undue delay and a waste of Board resources); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1708 n.1 (TTAB 1994).

8. 37 C.F.R. § 2.126(a). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69966 (October 7, 2016).

9. 37 C.F.R. § 2.126(b).

10. 37 C.F.R. § 2.126(c).

11. *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

12. *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

13. *AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at *12 (TTAB 2020) (parties directed to file an appendix of all testimony and documentary evidence, identifying page number and relevance, and to bookmark all exhibits submitted in PDF form by alpha-numeric designation).

107 How and Where to File Permitted Paper Filings and Fees

37 C.F.R. § 2.195 ***Filing date of trademark correspondence.*** The filing date of trademark correspondence is determined as follows:

(a) ***Electronic Submissions.*** The filing date of an electronic submission is the date the Office receives the submission, based on Eastern Time, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.

(b) ***Paper Correspondence.*** The filing date of a submission submitted on paper is the date the Office receives the submission, except as follows:

(1) ***Priority Mail Express®.*** The filing date of the submission is the date of deposit with the USPS, if filed pursuant to the requirements of § 2.198.

* * * *

(3) ***Office closed.*** The Office is not open to receive paper correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia.

(c) ***Email and facsimile submissions.*** Email and facsimile submissions are not permitted and, if submitted, will not be accorded a date of receipt.

(d) ***Interruptions in USPS.*** *If the Director designates a postal service interruption or emergency within the meaning of 35 U.S.C. 21(a), any person attempting to file correspondence by Priority Mail Express® Post Office to Addressee service who was unable to deposit the correspondence with the USPS due to the interruption or emergency may petition the Director to consider such correspondence as filed on a particular date in the Office. The petition must:*

(1) *Be filed promptly after the ending of the designated interruption or emergency;*

(2) *Include the original correspondence or a copy of the original correspondence; and*

(3) *Include a statement that the correspondence would have been deposited with the USPS on the requested filing date but for the designated interruption or emergency in Priority Mail Express® service; and that the correspondence attached to the petition is the original correspondence or a true copy of the correspondence originally attempted to be deposited as Priority Mail Express® on the requested filing date.*

The Board requires electronic filing using ESTTA for all submissions in Board proceedings. However, for those submissions that are permitted to be filed on paper due to the unavailability of ESTTA as a result of technical problems, or when extraordinary circumstances are present, the specific requirements for delivery of such submissions to the Office are set out below.

Documents relating to proceedings before the Board may be filed during regular office hours by hand delivery or by courier service to:

Trademark Assistance Center
James Madison Building - East Wing
Concourse Level, Room C55
600 Dulany Street
Alexandria,VA 22314

Such papers may also be filed by depositing them in the mail addressed to:

United States Patent and Trademark Office:
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria,VA 22313-1451

Documents to be filed with the Board, including a notice of ex parte appeal, may not be filed by facsimile transmission ("fax"). [Note 1.] If documents are filed with the Board by fax transmission, they will not receive a filing date. [Note 2.]

The Board does not accept any filings by email. [Note 3.] For information on filing submissions using ESTTA, the Board's electronic filing system, see TBMP § 110.

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

NOTES:

1. 37 C.F.R. § 2.195(c). *See, e.g., Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1283 (TTAB 2008) (facsimile filing of notice of opposition not accepted).

2.37 C.F.R. § 2.195(c). *See, e.g., Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1283 (TTAB 2008) (facsimile filing of notice of opposition not accorded filing date).

3. 37 C.F.R. § 2.195(c).

108 Filing Receipts

When a document intended for the Board is filed in the Office, it is possible to obtain a receipt evidencing the date of such filing.

Documents uploaded to ESTTA, the Board's electronic filing system, are deemed filed upon successful completion of transmission to the Board, including the receipt of any required fee. When documents are successfully filed online using ESTTA, the filer will receive an on-screen acknowledgement of the filing, including an ESTTA tracking number. The filer will also receive an email filing receipt including the ESTTA tracking number and filing information which includes the number of pages transmitted. [Note 1.] If the filer does not receive an on-screen acknowledgement and an email filing receipt, it should not assume that

the paper has been successfully filed. Upon filing, the cover sheet for correspondence transmitted electronically through ESTTA is automatically affixed with the date the Office receives the complete transmission. Eastern Time controls the filing date. [Note 2.] *See*TBMP § 110. Most ESTTA submissions are automatically entered into the TTAB proceeding docket and appear in TTABVUE shortly after transmission, although some require manual processing, which can take up to a week. If your ESTTA submission does not appear in TTABVUE within a week of transmission, please contact the TTAB at 571-272-8500, Mon-Fri. 8:30 am to 5:00 pm, ET for assistance.

In the case of a document permitted to be submitted on paper, if sent by mail, a receipt may be obtained by submitting with the document a stamped, self-addressed postcard with sufficient information to identify clearly the document, the party on whose behalf the paper is being filed, and the proceeding or application in connection with which the document is being filed. When the Office receives the document and the postcard, it will date-stamp both of them and mail the postcard back.

If a document permitted to be submitted on paper is delivered by hand to the Trademark Assistance Center, see TBMP § 107, the receipt may take the form of a postcard bearing appropriate identifying information, or a duplicate copy of the document, or a duplicate copy of the transmittal letter with appropriate identifying information. The receipt and the document will be date-stamped and the receipt will be handed back to the person who delivered the paper.

NOTES:

1. *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351 (TTAB 2014), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014).

2. 37 C.F.R. § 2.195(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 19296, 19296 (to be codified at 37 C.F.R. pt. 2 (proposed April 4, 2016). *See* **https://estta.uspto.gov** for instructions for filing using ESTTA.

109 Filing Date

37 C.F.R. § 2.195. ***Filing date of trademark correspondence.*** *The filing date of trademark correspondence is determined as follows:*

(a) ***Electronic submissions.*** *The filing date of an electronic submission is the date the Office receives the submission, based on Eastern Time, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.*

(b) ***Paper correspondence.*** *The filing date of a submission submitted on paper is the date the Office receives the submission, except as follows:*

(1) ***Priority Mail Express®.*** *The filing date of the submission is the date of deposit with the USPS, if filed pursuant to the requirements of § 2.198.*

* * * *

(3) ***Office closed.*** *The Office is not open to receive paper correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia.*

(c) ***Email and facsimile submissions.*** *Email and facsimile submissions are not permitted and, if submitted, will not be accorded a date of receipt.*

(d) ***Interruptions in USPS.*** *If the Director designates a postal service interruption or emergency within the meaning of 35 U.S.C. 21(a), any person attempting to file correspondence by Priority Mail Express®*

Post Office to Addressee service who was unable to deposit the correspondence with the USPS due to the interruption or emergency may petition the Director to consider such correspondence as filed on a particular date in the Office. The petition must:

(1) *Be filed promptly after the ending of the designated interruption or emergency;*

(2) *Include the original correspondence or a copy of the original correspondence; and*

(3) *Include a statement that the correspondence would have been deposited with the USPS on the requested filing date but for the designated interruption or emergency in Priority Mail Express® service; and that the correspondence attached to the petition is the original correspondence or a true copy of the correspondence originally attempted to be deposited as Priority Mail Express® on the requested filing date.*

The cover sheet for correspondence transmitted electronically through ESTTA is automatically affixed with the date the Office receives the complete transmission, including any required fee. [Note 1.] Eastern Time controls the filing date. [Note 2.] Once a request is transmitted electronically, the system immediately provides the sender with an email acknowledgement of receipt. For more information regarding ESTTA, see TBMP § 110.

Mailed or hand-delivered correspondence, when permitted, is stamped with the date of receipt in the Office (i.e., the “filing” date) unless the correspondence is filed by the Priority Mail Express® procedure provided in 37 C.F.R. § 2.198. [Note 3.]

When correspondence intended for the Board is filed by the “Priority Mail Express® Post Office to Addressee” service of the United States Postal Service, the document's filing date is the date of deposit with the USPS, as shown by the "date accepted" on the Priority Mail Express® label or other official USPS notation. If the date of deposit with the Postal Service cannot be determined, the correspondence will be stamped with the date of its actual receipt in the USPTO. [Note 4.]

The Board does not accept correspondence by facsimile. Any such filings, including a notice of ex parte appeal, will not be accorded a filing date. [Note 5.]

When correspondence intended for the Board is filed by first-class mail with a certificate of mailing, in accordance with the procedure described in 37 C.F.R. § 2.197(a), it is stamped with the date of receipt of the correspondence in the Office. The mailing date specified in the certificate of mailing is used for purposes of determining the timeliness of the correspondence. The date of receipt is used for all other purposes. [Note 6.]

NOTES:

1. 37 C.F.R. § 2.195; *Vibe Records Inc. v. Vibe Media Group LLC* , 88 USPQ2d 1280, 1282 (TTAB 2008) (receipt date of ESTTA submission is automatically affixed to paper). *See* **https://estta.uspto.gov** for instructions for filing using ESTTA.

2. 37 C.F.R, § 2.195. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 19296, 19296 (to be codified at 37 C.F.R. pt. 2 (proposed April 4, 2016)).

3. 37 C.F.R. § 2.195(b).

4. 37 C.F.R . § 2.195(b)(1), 37 C.F.R. § 2.198(a) and 37 C.F.R. § 2.198(b). *See* 37 C.F.R. § 2.198(c) and 37 C.F.R. § 2.198(d), regarding procedures for petitioning the Director to correct a filing date discrepancy

and for procedures for petitioning the Director if the "date accepted" by the Postal Service was incorrectly entered or omitted.

5. 37 C.F.R. § 2.195(c). *See also Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1283 (TTAB 2008) (fax transmission of notice of opposition not acceptable under any circumstances and not accorded a filing date).

6. 37 C.F.R. § 2.195(b)(2) and 37 C.F.R. § 2.197(a). For information concerning the date stamped by the USPTO on correspondence by "Priority Mail Express® Post Office to Addressee" when interruptions or emergencies occur in the United States Postal Service, see 35 U.S.C. § 21 and 37 C.F.R. § 2.195(d).

110 Electronic Filing Using ESTTA

110.01 In General

37 C.F.R. § 2.2

* * * *

(g) *The acronym ESTTA means the Electronic System for Trademark Trials and Appeals and, as used in this part, includes all related electronic systems required to complete an electronic submission through ESTTA.*

* * * *

(r) *Eastern Time means Eastern Standard Time or Eastern Daylight Time, as appropriate.*

(s) *The term electronic submission as used in this part refers to any submission made through an electronic filing system available on the Office's website, but not through email or facsimile transmission.*

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

37 C.F.R. § 2.102(a)(1) *A request to extend the time for filing an opposition to an application must be filed through ESTTA by the opposition due date set forth in § 2.101(c).*

37 C.F.R. § 2.101(b)(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 C.F.R. § 2.102(a)(1) *A request to extend the opposition period for 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 C.F.R. § 2.111(c)(1) *A petition to cancel a registration must be filed through ESTTA.*

37 C.F.R. § 2.190(b) ***Electronic trademark documents.*** *… Documents that relate to proceedings before the Trademark Trial and Appeal Board must be filed electronically with the Board through ESTTA.*

37 C.F.R. § 2.195(a) ***Electronic submissions.*** *The filing date of an electronic submission is the date the Office receives the submission, based on Eastern Time, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.*

ESTTA – the Electronic System for Trademark Trials and Appeals – is the Board's electronic filing system. ESTTA is a web-based application available on the Internet. No special software (apart from a web browser) need be installed on the user's computer in order to use ESTTA. Likewise, users need not open an account or obtain a password, and there is no additional fee for use of ESTTA.

The Board requires use of ESTTA for the filing of all submissions in Board proceedings and for filing of extensions of time to oppose. ESTTA permits round-the-clock filing with real-time receipt confirmation, while reducing delay and the possibility of mishandling of submissions in route to or within the USPTO. Many ESTTA filings are processed automatically, with an appropriate Board order issuing within minutes of filing. Use of ESTTA helps filers avoid common (and sometimes fatal) pitfalls in filing, and allows the Board to efficiently and expeditiously process and act upon filings.

Upon completion of a successful filing, a filer using ESTTA will receive both an on-screen and email acknowledgement of receipt from ESTTA with the ESTTA tracking number and the filing information including the official filing date. The filing date is the date on which the complete ESTTA filing (including any required fee) is received in the USPTO. Although an ESTTA filing can be made from anywhere in the world, Eastern Time controls the filing date, not the local date from where the filing was made. [Note 1.] ESTTA filers should not send hard copies of electronically-filed documents to the Board.

The ESTTA user manual, ESTTA forms, and instructions for their use can be found at https://estta.uspto.gov/. Contextually appropriate help is available throughout ESTTA by clicking on highlighted, hyper-linked terms. These terms usually appear in blue, but may differ depending on your browser settings. Filers should also check "What's New in ESTTA" for important user guidelines.

It is the responsibility of the party making submissions to the Board using ESTTA to ensure that the submissions have been entered into the trial record. [Note 2.] Parties are urged to check not only the ESTTA filing receipts but also TTABVUE, the Board's electronic docket information and file database, to ensure that all documents have been properly transmitted and entered. [Note 3.]

This section is not intended to provide a comprehensive reference for use of ESTTA, but merely to emphasize ESTTA's benefits and availability, and to provide some basic facts about its use.

NOTES:

1. 37 C.F.R. § 2.2; 37 C.F.R. § 2.195(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 19296, 19296 (to be codified at 37 C.F.R. pt. 2 (proposed April 4, 2016)); **https://estta.uspto.gov** (instructions for filing using ESTTA).

2. *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1506 n.195 (TTAB 2017); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351 (TTAB 2014), appeal dismissed per stipulation, No. 2014-1461 (Fed. Cir. Oct. 10, 2014).

3. *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1506 n.195 (TTAB 2017); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351 (TTAB 2014), appeal dismissed per stipulation, No. 2014-1461 (Fed. Cir. Oct. 10, 2014).

110.01(a) ESTTA is Mandatory for All Filings

Use of ESTTA is required for the filing of all submissions in Board proceedings. [Note 1.]

Use of ESTTA previously had been mandatory only for the filing of either (1) extensions of time to oppose Madrid Protocol applications, i.e., applications under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), or (2) notices of opposition against Madrid Protocol applications. [Note 2.] The requirement for use of ESTTA for such filings enables the USPTO to fulfill its obligation to timely notify the International Bureau of the World Intellectual Property Organization of oppositions against requests for extension of protection under the Madrid Protocol. A request for an extension of time to oppose a Madrid Protocol application which is not filed through ESTTA will be denied in all circumstances. [Note 3.] Similarly, a notice of opposition not filed through ESTTA against such an application will not be instituted under any circumstances. [Note 4.] For a further discussion of filing notices of opposition against Madrid Protocol applications using ESTTA, see TBMP § 306.01.

In the rare circumstances the rules permit submissions in paper form, the paper submission must be accompanied by a written explanation showing that ESTTA was unavailable due to technical problems, or that extraordinary circumstances are present, and, where required, a Petition to the Director with the requisite petition fee. [Note 5.] Petitions to file on paper are generally subject to 37 C.F.R. § 2.146, including the requirement for verified facts. [Note 6]. However, a Petition to the Director to accept paper submission of a petition to cancel a registration on the fifth year anniversary of the date of registration is subject to the

requirements of 37 C.F.R. § 2.147(b), including the requirement for a declaration under 37 C.F.R. § 2.20 or 28 U.S.C. § 1746. [Note 7.]

NOTES:

1. *See* 37 C.F.R. § 2.126(a) (submissions must be made through ESTTA); 37 C.F.R. § 2.101(b) (notices of opposition must be filed through ESTTA); 37 C.F.R. § 2.102(a)(1) (extensions of time to oppose must be filed in ESTTA); 37 C.F.R. § 2.102(a)(2) (extensions of time to oppose Trademark Act § 66(a) applications must be filed through ESTTA); 37 C.F.R. § 2.101(b)(2) (notice of opposition against § 66(a) application must be filed through ESTTA); 37 C.F.R. § 2.111(c)(1) (petition to cancel must be filed through ESTTA). 37 C.F.R . § 2.190(b) (electronic trademark documents).

2. *See* 37 C.F.R. § 2.126 (Form of Submissions to the Trademark Trial and Appeal Board); 37 C.F.R. § 2.102(a)(2) (extensions of time to oppose Trademark Act § 66(a), 15 U.S.C. § 1141f(a) applications must be filed through ESTTA); 37 C.F.R. § 2.101(b)(2) (notice of opposition against § 66(a) application must be filed through ESTTA). *See, e.g., CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1960 (TTAB 2011) (opposition to § 66(a) application must be filed via ESTTA); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561 (TTAB 2011) (same); *O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1328 n.2 (TTAB 2010) (same).

3. *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2020-21 (TTAB 2005).

4. *See In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2020-21 (TTAB 2005).

5. 37 C.F.R. § 2.101(b)(2); 37 C.F.R. § 2.102(a)(2); 37 C.F.R. § 2.111(c)(2)(i); 37 C.F.R. § 2.126(b).

6. 37 C.F.R. § 2.101(b)(2); 37 C.F.R. § 2.102(a)(1); 37 C.F.R. § 2.111(c)(2)(i).

7. 37 C.F.R §2.111(c)(2)(ii).

110.01(b) Plan Ahead

ESTTA users are strongly urged to plan ahead. Because unexpected problems can occur, users should keep filing deadlines in mind and allow plenty of time to resolve any issue which may arise. [Note 1.] The Board will provide general assistance to ESTTA filers, see TBMP § 110.04 (Questions about ESTTA Filing), but cannot guarantee that any problem will be resolved prior to a deadline. As discussed above, ESTTA filing is mandatory. *If ESTTA filing is not possible prior to a deadline for any reason, parties should timely submit their filings on paper, using another filing option as appropriate (e.g., certificate of mailing or Priority Mail Express® procedures) . See* TBMP § 111.02 (Certificate of Mailing), and TBMP § 111.01 (Priority Mail Express® procedure). Any paper filing must be accompanied by a written explanation showing that ESTTA is unavailable due to technical problems, or that extraordinary circumstances are present, and, where required, a Petition to the Director with the requisite petition fee. Petitions to file on paper are generally subject to 37 C.F.R. § 2.146, including the requirement for verified facts. [Note 2.] However, a Petition to the Director to accept paper submission of a petition to cancel a registration on the fifth year anniversary of the date of registration is subject to the requirements of 37 C.F.R. § 2.147(b), including the requirement for a declaration under 37 C.F.R. § 2.20 or 28 U.S.C. § 1746. [Note 3.]

Please Note: An extension of time to oppose, or a notice of opposition involving an application under Trademark Act § 66(a) **must** be filed through ESTTA, and may not under any circumstances be filed in paper form. [Note 4.] Users should not anticipate that the Board will extend a deadline because it was not possible to file a submission by ESTTA on the due date.

NOTES:

1. *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1282-83 (TTAB 2008) (ESTTA filer encountered unexpected problem in ESTTA filing; filer transmitted notice of opposition by fax. Held: ESTTA filing not received and fax filing is unacceptable; opposition dismissed as a nullity.).

2. 37 C.F.R. § 2.101(b)(2); 37 C.F.R. § 2.102(a)(1); 37 C.F.R. § 2.111(c)(2)(i).

3. 37 C.F.R. § 2.111(c)(2)(ii).

4. *See* 37 C.F.R. § 2.102(a)(1) (extension of time to oppose) and 37 C.F.R. § 2.101(b)(3) (notice of opposition). *CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1960 (TTAB 2011) (any opposition to a Trademark Act § 66(a), 15 U.S.C. § 1141f(a), application must be filed through ESTTA); *Hunt Control System, Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561 (TTAB 2011) (same); *O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1328 n.2 (TTAB 2010) (same).

110.02 Attachments to ESTTA Filings

110.02(a) In General

Many ESTTA forms permit or require the filer to attach an electronic file to be transmitted to the Board as part of the filing. For instance, an ESTTA user filing a notice of opposition or petition for cancellation must attach to its filing a pleading (*i.e.*, a short and plain statement showing that the filer is entitled to relief). Likewise, a party filing a motion for summary judgment must attach a motion, as well as any affidavits or other evidence in support of it. When such a file can or must be attached, ESTTA will prompt the user to identify the file on the user's computer and attach it to the ESTTA submission. Once a file has been selected and attached, the file may be opened in a separate window so that the user may determine whether all of the relevant pages of the selected file or files have been designated for filing.

110.02(b) Form of ESTTA Attachments

Attachments to ESTTA filings may be in PDF, TIFF or TXT format. [Note 1.] PDF is preferred, and should be used, if possible. Files should be formatted in letter size (8.5" x 11"), and should be rendered at 300 dpi resolution. ESTTA will accept either color or black and white PDF documents for uploading. It is recommended that all documents submitted electronically via ESTTA be "machine readable" to allow the Board and others to search the document using key words, and also mark and copy text from it. Most word processors feature drop-down options to "create .pdf," "save to .pdf," or "print to .pdf."

The filer is responsible for ensuring that all Board submissions – including attachments to ESTTA filings – are legible. Filers should be aware that the quality of ESTTA submissions is often better than those submitted in paper. [Note 2.] Problems with image quality sometimes arise when poor quality documents are scanned or when the quality of legible documents is degraded in the scanning process; these problems typically arise in documents (or parts of documents) featuring graphical material, as opposed to text. Quality can sometimes be significantly degraded when contrast settings used in scanning are not appropriate for

graphical material, or when color materials are scanned or copied in black and white prior to submission. If legibility of material in color or grayscale is important, filers are urged to scan the papers in color and to adjust the scanner's contrast settings to achieve acceptable results prior to ESTTA filing. Users are urged to check the quality of their submission in TTABVUE after filing. TTABVUE contains the same images that the Board will use in considering the submission; if the TTABVUE image is not of acceptable quality, the user should not assume that the Board will be able to view and consider it appropriately. [Note 3.] Original paper documents, when such submissions are permitted, are retained for a period of time, usually less than one year, because, the Board works from the scanned images, rather than the originals.

In addition, electronically submitted pleadings, motions, briefs, and the like must be formatted for at least 11-point type and be double-spaced. [Note 4.] Exhibits to pleadings, motions, and briefs need not be reformatted to meet these requirements, but must be legible.

NOTES:

1. PDF stands for Portable Document Format, a platform-independent, open standard for document exchange. TIFF stands for Tagged Image File Format. TXT is used here to denote a plain-text file format (with .txt extension), with little or no formatting or graphics capability. TIFF and TXT files will be converted to PDF format when they are received by ESTTA. Most word processing programs can directly convert files into one of these formats. Alternatively, papers can usually be scanned in PDF or TIFF format.

2. *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1433 n.5 (TTAB 2016) (filers are responsible for ensuring that all submissions are legible). All paper submissions, when permitted, are scanned by the Board upon receipt. **Please Note:** whether filed in paper form or filed electronically, the quality of papers scanned into TTABVUE appears the same way as when they are submitted. *See, e.g., In re Sela Products., LLC*, 107 USPQ2d 1580, 1585 n.5 (TTAB 2013).

3. *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, at *7 n.23 (TTAB 2019) ("If evidence is not legible, we cannot consider it"; "the Board will only consider evidence or a portion of the evidence if it is clear and legible."); *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1506 n.195 (TTAB 2017) (party has responsibility of ensuring submission entered into record); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1350-51 (TTAB 2014) (duty of party making submissions to ensure they were entered into the trial record), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014) ("the Board primarily uses TTABVUE in reviewing evidence"); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750, 1758 n.16 (TTAB 2013) ("the onus is on the party making the submissions to ensure that, at a minimum, all materials are clearly readable by the adverse party and the Board"), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.).

4. 37 C.F.R. § 2.126(a).

110.02(c) Size Limitations

ESTTA is suited for large filings such as trial testimony and notices of reliance. There is no specific limit to the amount of evidence one may submit in support of a Board proceeding. However, filers should use reason and avoid the submission of irrelevant or merely cumulative evidence. The unnecessary submission of large records is a significant burden upon the Board. [Note 1.] See TBMP § 702.05 for more information about submission of large records in general.

Filers should, however, be aware of certain system limitations. Filers may attach one or more files to any ESTTA form that permits or requires an attachment. The size limit for each file attached is 6 MB, and the aggregate of all attached files for a single ESTTA transmission may not exceed 53 MB. However, because very large files degrade the performance of the Board's electronic file system, *filers should limit each ESTTA submission to no more than an aggregate (all attached files combined) so as not to exceed the limitations*. If a single submission, e.g., a single testimonial transcript or notice of reliance, will exceed the limitations, it should be broken into two or more submissions, in logical segments, filed consecutively.

NOTES:

1. *Corporacion Habanos SA v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1091 (TTAB 2012) (excessive record on a single issue); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 (TTAB 2011) (excessively large record); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1873 (TTAB 2011) (parties' submitted much more evidence than was necessary to support respective positions).

110.03 Service of ESTTA Filings

Except for the notice of opposition, the petition to cancel, or notice of a concurrent use proceeding, every submission filed in a Board inter partes proceeding must be served upon the other parties to the proceeding, and proof of service must be provided before the paper will be considered. [Note 1.] For all other submissions filed in ESTTA, the filer must include a certificate of service as an attachment (or as part of an attachment) to the ESTTA filing as proof of service. However, many of the ESTTA forms, e.g., "consent motion forms," include a certificate of service as part of the ESTTA submission. In that instance only, the filer need not add a certificate of service to the attached document.

In addition to the requirement for a certificate of service, all submissions must actually be served upon the other parties to the proceeding by email, unless otherwise stipulated. [Note 2.] *See*TBMP § 113 (Service of Papers).

The Board effects service only of the notice of opposition or petition to cancel or notice of concurrent use proceeding by providing, in the notice of institution, a web link or web address to access the electronic proceeding record. [Note 3.] For all other filings, ESTTA does not automatically serve papers upon opposing parties. [Note 4.]

For a further discussion regarding the filing of a notice of opposition or a petition for cancellation using ESTTA, and notification, see TBMP § 306.01 (notice of opposition); and TBMP § 307.01-TBMP § 307.02 (petition for cancellation).

NOTES:

1. 37 C.F.R. § 2.119(a); 37 C.F.R. § 2.105(a); 37 C.F.R. § 2.113(a).

2. *See, e.g., Springfield Inc. v. XD* , 86 USPQ2d 1063, 1064 (TTAB 2008) ("The proof of service requirement assumes actual service on applicant, or its attorney or domestic representative of record, if any."). *See also* 37 C.F.R. § 2.119(b).

3. 37 C.F.R. § 2.99(d)(1); 37 C.F.R. § 2.105(a); 37 C.F.R. § 2.113(a).

4. *See, e.g., Coffee Studio LLC v. Reign LLC*, 129 USPQ2d 1480, 1482 (TTAB 2019) (filing notice sent to each party by ESTTA does not constitute service); *Equine Touch Foundation Inc. v. Equinology Inc.*, 91 USPQ2d 1943, 1944 n.5 (TTAB 2009) ("Actual forwarding of the service copy, however, is the responsibility of the filer, as ESTTA does not effect service for the filer."); *Schott AG v. Scott*, 88 USPQ2d 1862, 1863 n.3 (TTAB 2008) (same).

110.04 Questions About ESTTA Filing

Filers may call the Board with questions about filing at (571) 272-8500 or (800) 786-9199 (toll free) from 8:30 a.m. until 5:00 p.m. (Eastern Time). Alternatively, filers may send non-urgent email inquiries to ESTTA@uspto.gov, and include a description of the problem, the ESTTA tracking number and Board proceeding number (if any), and a telephone number for contact. The Board will respond to email inquiries within two business days. The email address is for technical ESTTA questions only. **Submissions will not be accepted for filing by email.** *See*TBMP § 107 ("The Board does not accept any filings by email.").

ESTTA users are encouraged to contact the Board when ESTTA is not working as expected. Whether or not one is able to overcome a problem, others are likely to have similar difficulties. Absent notification by users, the Board may be unaware of the problem, delaying any necessary repair.

111 Priority Mail Express® and Certificate of Mailing Procedures

The procedures described below apply to submissions in paper form.

The Priority Mail Express® procedure discussed below at TBMP § 111.01 applies only to paper submissions that meet an exception to the requirement that submissions be filed electronically using ESTTA. For information regarding the electronic filing of submissions through ESTTA, see TBMP § 110.

The certificate of mailing procedure discussed below at TBMP § 111.02 applies only to paper submissions that meet an exception to the requirement that submissions be filed electronically through ESTTA. For information regarding the electronic filing of submissions via the Internet using ESTTA, see TBMP § 110.

111.01 Priority Mail Express® - In General

37 C.F.R. § 2.198 ***Filing of correspondence by Priority Mail Express®.***

(a) *The filing date of correspondence submitted under this section is the date of deposit with the USPS, as shown by the "date accepted" on the Priority Mail Express® label or other official USPS notation.*

(b) *If the USPS deposit date cannot be determined, the filing date is the date the Office receives the submission.*

(c) *If there is a discrepancy between the filing date accorded by the Office to the correspondence and the "date accepted," the party who submitted the correspondence may file a petition to the Director under § 2.146(a)(2) to accord the correspondence a filing date as of the "date accepted." The petition must:*

(1) *Be filed within two months after the date of deposit;*

(2) *Include a true copy of the Priority Mail Express® mailing label showing the "date accepted," and any other official notation by the USPS relied upon to show the date of deposit; and*

(3) *Include a verified statement attesting to the facts of the original mailing.*

(d) *If the party who submitted the correspondence can show that the "date accepted" was incorrectly entered or omitted by the USPS, the party may file a petition to the Director under § 2.146(a)(2) to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS. The petition must:*

(1) *Be filed within two months after the date of deposit;*

(2) *Include proof that the correspondence was deposited in the Priority Mail Express® Post Office to Addressee service prior to the last scheduled pickup on the requested filing date. Such proof must be corroborated by evidence from the USPS or evidence that came into being within one business day after the date of deposit; and*

(3) *Include a verified statement attesting to the facts of the original mailing.*

(e) *If correspondence is properly addressed to the Office pursuant to § 2.190 and deposited with sufficient postage in the Priority Mail Express® Post Office to Addressee service of the USPS, but not received by the Office, the party who submitted the correspondence may file a petition to the Director under § 2.146(a)(2) to consider such correspondence filed in the Office on the USPS deposit date. The petition must:*

(1) *Be filed within two months after the date of deposit;*

(2) *Include a copy of the previously mailed correspondence showing the number of the Priority Mail Express® mailing label thereon; and*

(3) *Include a verified statement attesting to the facts of the original mailing.*

The Priority Mail Express® Post Office to Addressee service is not applicable to the filing of an extension of time to oppose a Trademark Act § 66(a) application, 15 U.S.C. §1141f(a), or a notice of opposition involving an application under Trademark Act § 66(a). [Note 1.]

Any paper or fee that meets an exception of the requirement to file through ESTTA, can be filed utilizing the Priority Mail Express® Post Office to Addressee service of the United States Postal Service, and be considered as having been filed in the Office on the date of deposit with the USPS. [Note 2.]

In effect, the Priority Mail Express® procedure permits all types of permitted correspondence intended for the Board to be sent by the Priority Mail Express® Post Office to Addressee service even on the due date for the correspondence and still be considered timely, notwithstanding the fact that the mailed correspondence may not be received by the Board until after the due date. This filing procedure applies only to the Priority Mail Express® Post Office to Addressee service of the United States Postal Service, not any third-party carrier that offers overnight delivery. [Note 3.]

Please Note: Priority Mail Express® now substitutes for "Express Mail."

NOTES:

1. 37 C.F.R. § 2.102(a)(1) (extension of time to oppose) and 37 C.F.R. § 2.101(b)(3) (notice of opposition).

2. *See* 37 C.F.R. § 2.198(a). *See also* TMEP § 305.03 for Priority Mail Express® procedures for the Trademark Examining Operation.

3. *See, e.g., In re Pacesetter Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm'r 1994) (correspondence sent by Federal Express not entitled to benefit of Express Mail procedure).

111.01(a) Requirements for Priority Mail Express®

Prior to the original mailing, the Priority Mail Express® mailing label number should be placed on correspondence filed thereunder. The number of the mailing label should be placed on each separate submission and each fee transmitted, either directly on the document or on a separate paper firmly and securely attached to the document.

A party meeting an exception of the requirement to file submissions in Board proceedings through ESTTA who elects to send mail to the Board by the Priority Mail Express® service of the U.S. Postal Service should be careful to use the "Priority Mail Express® Post Office to Addressee" service, rather than the Priority Mail Express® “Hold for Pickup” service which delivers the mail Post Office to Post Office.

111.01(b) Questionable Date of Mailing

If the “date accepted” appearing on the Priority Mail Express® label is illegible, the filing date will be the actual receipt date by the USPTO. 37 C.F.R. § 2.198(b). If there is a discrepancy between the filing date assigned by the Office and the date of deposit, the person who filed the correspondence may petition the Director to accord the “date accepted” date by providing the evidence set forth in 37 C.F.R. § 2.198(c), 37 C.F.R. § 2.198(d), and 37 C.F.R. § 2.198(e). [Note 1.]

NOTES:

1. *See*TMEP § 305.03 for further information on petitions to change the filing date.

111.02 Certificate of Mailing – In General

37 C.F.R. § 2.197 ***Certificate of mailing.***

(a) *The filing date of correspondence submitted under this section is the date of deposit with the USPS if the correspondence:*

(1) *Is addressed as set out in § 2.190 and deposited with the USPS with sufficient postage as first-class mail; and*

(2) *Includes a certificate of mailing for each piece of correspondence that:*

(i) *Attests to the mailing and the address used;*

(ii) *Includes the name of the document and the application serial number or USPTO reference number, if assigned, or registration number to which the document pertains;*

(iii) *Is signed separately from any signature for the correspondence by a person who has a reasonable basis to expect that the correspondence would be mailed on the date indicated; and*

(iv) *Sets forth the date of deposit with the USPS.*

(b) *If correspondence is mailed in accordance with paragraph (a) of this section, but not received by the Office, the party who mailed such correspondence may file a petition to the Director under § 2.146(a)(2) to consider such correspondence filed in the Office on the date of deposit with the USPS. The petition must:*

(1) *Be filed within two months after the date of mailing;*

(2) *Include a copy of the previously mailed correspondence and certificate; and*

(3) *Include a verified statement attesting to the facts of the original mailing.*

(c) *If the certificate of mailing does not meet the requirements of paragraph (a)(2) of this section, the filing date is the date the Office receives the submission.*

A party meeting an exception of the requirement to file submissions in Board proceedings through ESTTA who elects to file correspondence by mail may utilize the certificate of mailing procedure.

Permitted correspondence required to be filed within a set period of time will be considered as being timely filed, even though the correspondence is not received by the Office until after the expiration of the set period, if, prior to the expiration of the set period, (1) the correspondence is mailed to the Office by first-class mail, with the proper address, and (2) includes a certificate of mailing which meets the requirements specified in 37 C.F.R. § 2.197(a). [Note 1.]

In effect, the certificate of mailing procedure permits correspondence to be sent to the Office by first-class mail, even on the due date for the correspondence and still be considered timely, notwithstanding the fact that the mailed correspondence will not be received in the Office until after the due date. [Note 2.]

However, the Board, in its discretion, may require additional evidence to determine if correspondence which bears a certificate of mailing or a certificate of transmission was timely filed, i.e., was mailed or transmitted on the date stated in the certificate. [Note 3.]

The certificate of mailing procedure applies to the filing of many types of correspondence in Board proceedings. However, the certificate of mailing procedure is not available for extensions of time to oppose Trademark Act § 66(a) applications or for the filing of oppositions involving Trademark § 66(a) applications. *See*TBMP § 111.02(f).

The certificate of facsimile transmission procedure is no longer available for any submissions. [Note 4.] *See*TBMP § 107 (How and Where to File Papers and Fees).

NOTES:

1. 37 C.F.R. § 2.197(a); *In re LS Bedding*, 16 USPQ2d 1451, 1452-53 (Comm'r 1990) (certificate of mailing procedure is used to determine timeliness, while the actual receipt date is used for all other purposes, such as an application filing date). *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1734 n.2 (TTAB 2001) (no certificate of mailing).

2. *See Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1759 n.1 (TTAB 1999) (motion to extend filed by a certificate of mailing dated next business day was timely where the period closed on the preceding day, a Sunday).

3. *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1295 (TTAB 1997) (where prima facie proof of certificate of mailing is rebutted by other evidence, person signing certificate must submit an affidavit specifying the date of actual deposit). *Cf. In re Klein*, 6 USPQ2d 1547, 1551-52 (Comm'r 1987), *aff'd sub nom. Klein v. Peterson*, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd* 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989).

4. *See* CHANGES TO THE TRADEMARK RULES OF PRACTICE TO MANDATE ELECTRONIC FILING, 84 Fed. Reg. 37081, 37085 (July 31, 2019). ("[F]acsimile transmissions … are not permitted under this rule for any applications or submissions.").

111.02(a) Requirements for Certificate

37 C.F.R. § 2.190 ***Addresses for trademark correspondence with the United States Patent and Trademark Office.***

(a) ***Paper trademark documents.*** *In general, trademark documents to be delivered by the USPS must be addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451. Trademark-related documents to be delivered by hand, private courier, or other delivery service may be delivered during the hours the Office is open to receive correspondence to the Trademark Assistance Center, James Madison Building--East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia 22314.*

(b) ***Electronic trademark documents.*** *Trademark documents filed electronically must be submitted through TEAS. Documents that relate to proceedings before the Trademark Trial and Appeal Board must be filed electronically with the Board through ESTTA.*

(c) ***Trademark assignment documents.*** *Requests to record documents in the Assignment Recordation Branch may be filed electronically through ETAS. Paper documents and cover sheets to be recorded in the Assignment Recordation Branch should be addressed as designated in § 3.27 of this chapter.*

(d) ***Requests for certified copies of trademark documents.*** *Paper requests for certified copies of trademark documents must be addressed to: Mail Stop Document Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.*

(e) ***Certain documents relating to international applications and registrations.*** *International applications under § 7.11, subsequent designations under § 7.21, responses to notices of irregularity under § 7.14, requests to record changes in the International Register under § 7.23 and § 7.24, requests to note replacements under § 7.28, requests for transformation under §. 7.31 of this chapter, and petitions to the Director to review an action of the Office's Madrid Processing Unit must be addressed to: Madrid Processing Unit, 600 Dulany Street, Alexandria, VA 22314-5796.*

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

(1) Prior to the expiration of the set period, the correspondence must be deposited with the U.S. Postal Service, with sufficient postage as first-class mail, addressed to:

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria,VA 22313-1451

and;

(2) Each piece of correspondence must include a certificate which states the date of deposit with the USPS, attests to the mailing and the address used, includes the name of the document and the application serial number, reference number, or registration to which it pertains, and is signed (separate and apart from any signature for the piece of correspondence itself) by a person who has a reasonable basis to expect that the correspondence will be mailed on or before the date indicated. [Note 1.]

Paper trademark-related documents sent to the Assignment Recordation Branch for recordation should be addressed to: Mail Stop Assignment Recordation Branch Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. If a certificate of mailing is used on such correspondence, it should specify that address. [Note 2.]

Requests for certified copies of trademark documents pertaining to applications and registrations are handled by the USPTO Patent and Trademark Office Certified Copy Center. Requests are submitted online at https://certifiedcopycenter.uspto.gov/. *See*TBMP § 121 for further information on obtaining file copies.

The Assignment Recordation Branch of the Public Records Division also has an electronic trademark assignment recording form on the Office website. The system is called ETAS (Electronic Trademark Assignment System) and allows customers to create and submit a Trademark Assignment Recordation Coversheet by completing online web forms and attaching the supporting legal documentation. The form and additional information can be accessed at **www.uspto.gov/trademarks/process/assign.jsp**. [Note 4.]

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

A certificate of mailing should be clearly labeled as such and should include a reference to the proceeding number to which it pertains, the date of mailing, and the signature of the person attesting that the document is being mailed on a certain date. When possible, the certificate should appear on the paper being mailed, rather than on a separate sheet of paper.

NOTES:

1. 37 C.F.R. § 2.197(a) and 37 C.F.R. § 2.195(b)(3).

2. 37 C.F.R. § 2.190(c); 37 C.F.R. § 3.27.

3. 37 C.F.R. § 2.190(c).

111.02(b) Suggested Format

Shown below is a suggested format for a certificate of mailing, under 37 C.F.R. § 2.197, for trademark-related mail (except for trademark-related documents sent to the Assignment Recordation Branch for recordation and requests for certified copies of trademark application and registration documents):

Certificate of Mailing

I hereby certify that this correspondence

is being deposited with the United States

Postal Service with sufficient postage as

First-class mail in an envelope addressed to:

ATTN: Trademark Trial and Appeal Board

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

on _____ _____

Date Signature

_____

Typed or printed name of

person signing certificate

111.02(c) Location of Certificate

If the simple certificate of mailing format shown in TBMP § 111.02(b) is used, it may appear on the first page of the correspondence, if feasible. Otherwise, it should appear in its entirety on the last page of the correspondence to which it pertains. If the certificate is typed, and there is not enough room on the last page to type the certificate in its entirety, it should at least be started on the last page, so that only part of it continues over to another page. The simple certificate of mailing format should never be used by itself on a separate page at the end of the correspondence. If it is, and the page becomes detached from the rest of the submission, there will be no way of determining the identity of the correspondence to which it relates, and the benefit of the certificate will be lost.

In some cases, there may not be room for a certificate of mailing on a piece of correspondence. In such a case, the certificate may be typed on a separate sheet of paper securely attached to the correspondence. However, if the certificate is typed on a separate sheet of paper, it must include additional information, namely, a description of the nature of the correspondence to which it pertains, as well as the identity of the application, registration, or Office proceeding in connection with which the correspondence is being filed.

If there is any doubt concerning the identity of the correspondence to which a certificate of mailing on a separate sheet pertains, the certificate will not be accepted.

111.02(d) Loss of Certificate of Mailing

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

111.02(e) No Receipt of Correspondence Bearing Certificate

In the event that correspondence intended for the USPTO is timely filed with an appropriate certificate of mailing, pursuant to 37 C.F.R. § 2.197, but is not received in the Office, and there is a resulting Office action, in a proceeding or an application, which is adverse to the submitting party, the correspondence will be considered timely if the party which submitted it (1) informs the Office of the previous mailing of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the

correspondence, (2) supplies an additional copy of the previously mailed correspondence and certificate, and (3) includes a statement attesting, on a personal knowledge basis or to the satisfaction of the Director, to the previous timely mailing. The statement must be verified if it is made by a person other than a practitioner, as that term is defined in 37 C.F.R. § 11.1. *See also*TBMP § 107 (How and Where to File Papers and Fees). [Note 1.] Documents may not be filed with the Board by facsimile transmission, and any document so filed will not be accepted. [Note 2.]

For lost or misplaced correspondence intended for the Board, the evidence required by 37 C.F.R. § 2.197(b) should be submitted to the Board for consideration. If the requirements of 37 C.F.R. § 2.197(b) cannot be met, the only alternative is a Petition to the Director.

NOTES:

1. 37 C.F.R. § 2.197(b).

2. 37 C.F.R. § 2.190 and 37 C.F.R. § 2.195(c).

111.02(f) Excluded Filings

The certificate of mailing procedure is **not** applicable to the filing of an extension of time to oppose a Trademark Act § 66(a) application, 15 U.S.C § 1141f(a)or a notice of opposition involving an application under Trademark Act § 66(a). [Note 1.] The certificate of mailing procedure is applicable to all other types of paper filings in Board proceedings, only to the limited extent paper filings are permitted (see TBMP § 106.03), including a notice of opposition; a petition to cancel; a request for an extension of time to oppose a Trademark Act § 1 or § 44 application, 15 U.S.C § 1051(a)and 15 U.S.C § 1126; a notice of appeal to the Board from a final refusal of registration; a notice of appeal to the Court of Appeals for the Federal Circuit from a decision of the Board; and a notice of election (in an inter partes proceeding) to proceed by civil action under Trademark Act § 21(a)(1), 15 U.S.C. § 1071(a)(1), in response to another party's appeal to the Court of Appeals for the Federal Circuit. Any paper filing must be accompanied by a written statement showing that ESTTA was unavailable due to technical problems, or that extraordinary circumstances are present, and, where required, a Petition to the Director with the requisite petition fee. Petitions to file on paper are generally subject to 37 C.F.R. § 2.146, including the requirement for verified facts. [Note 2.] However, a Petition to the Director to accept paper submissin of a petition to cancel a registration on the fifth year anniversary of the date of registration is subject to the requirements of 37 C.F.R. § 2.20 or 28 U.S.C. § 1746. [Note 3.]

A certificate of mailing is not necessary or appropriate for documents filed using ESTTA. When an ESTTA filing is received by the Board, the filer will be provided with a notice that the document has been successfully filed. *See generally*TBMP § 110.09.

NOTES:

1. 37 C.F.R. § 2.102(a)(1) ("A request to extend the opposition period for 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 C.F.R. § 2.101(b)(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.").

2. 37 C.F.R. § 2.101(b)(2); 37 C.F.R. § 2.111(c)(2)(i).

3. 37 C.F.R. § 2.111(c)(2)(ii).

111.02(g) A Certificate of Mailing is Not ...

As is evident from the requirements for a certificate of mailing, specified in 37 C.F.R. § 2.197(a), the certificate of mailing procedure is not the same as mailing by certified mail. Correspondence sent to the Board by certified mail, and not in compliance with the 37 C.F.R. § 2.197(a) requirements for a certificate of mailing, will be stamped with the date of receipt of the correspondence in the Office, and that date will be used for all purposes, including the timeliness of the filing of the correspondence. [Note 1.]

Further, a certificate of mailing is not the equivalent of a certificate of service. A certificate of mailing indicates when correspondence was sent to the Office pursuant to the provisions of 37 C.F.R. § 2.197(a). The mailing date recited in a certificate of mailing is used for purposes of determining the timeliness of the filing of the correspondence bearing the certificate.

A certificate of service, on the other hand, indicates the date when a copy of the correspondence was served upon another party. A certificate of service cannot be used to prove the timeliness of the filing of the correspondence. *See*TBMP § 113 for information concerning a certificate of service.

NOTES:

1. *See* 37 C.F.R. § 2.195 and 37 C.F.R. § 2.197.

112 Times for Taking Action

37 C.F.R. § 2.196 ***Expiration on Saturday, Sunday or Federal holiday.*** *Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or regulation by or under this part for taking any action or paying any fee in the Office falls on a Saturday, Sunday or Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day that is not a Saturday, Sunday or a Federal holiday.*

For example, if, as set by the Board, an answer to a complaint falls due on a Saturday, Sunday, or federal holiday within the District of Columbia, an answer filed on the next business day will be considered timely. If, as set by the Board, the close of discovery falls on a Saturday, Sunday, or federal holiday within the District of Columbia, and such date is the due date for written responses to discovery requests (i.e., interrogatories, requests for production of documents, and requests for admission), such responses may be served, and discovery depositions may be taken, on the next business day. Similarly, if, as set by the Board, the close of a testimony period falls on a Saturday, Sunday, or federal holiday within the District of Columbia, testimony depositions may be taken, testimony declarations and affidavits may be filed, and other evidence may be offered, on the next business day. [Note 1.]

If, because of some unscheduled event, such as adverse weather conditions, the Office is officially closed by Executive Order of the President or by the Office of Personnel Management for an entire day, that day will be regarded by the Office as a federal holiday within the District of Columbia. Any action due to be taken, or fee due to be paid, on that day, will be considered timely if the action is taken, or the fee paid, on the next succeeding business day on which the Office is open. If, because of an unscheduled event, the Office is closed for part of a business day, but is open for business for some part of the day between 8:30 a.m. and 5:00 p.m. Eastern Time, any action due to be taken, or fee due to be paid, on that day remains due on that day. [Note 2.] Notification of any change in this policy, given the particular circumstances of an

unscheduled event, will be posted on the Office website at **www.uspto.gov**. [Note 3.] Except for maintenance and emergencies, ESTTA remains available for electronic filing of papers at all times despite official closure of the Office.

Please Note:37 C.F.R. § 2.196 is not applicable when the opening of an assigned period (e.g., discovery, testimony) falls on a Saturday, Sunday or Federal holiday.

In addition, 37 C.F.R. § 2.196 does not apply to a motion that must be filed before the day of the deadline for pretrial disclosures for the first testimony period. [Note 4.]

The provisions of 37 C.F.R. § 2.196 do not change the date on which the relevant action must be taken. Instead, the provisions allow an action to be considered timely filed if taken on the next succeeding business day notwithstanding the earlier expiration of the due date on the weekend on or a federal holiday. Thus, when the date for any subsequent action runs from a prior due date or close of a period (e.g., filing a brief after the close of the last testimony period), the due date for the subsequent action is calculated from the actual due date of the prior action or close of the period, not the adjusted date under 37 C.F.R. § 2.196.

NOTES:

1. *See, e.g., Sunrider Corp. v. Raats* , 83 USPQ2d 1648, 1653 n.8 (TTAB 2007) (Board generally does not distinguish business days and calendar days unless last day of period is not a business day); *Strang Corp. v. Stouffer Corp.* , 16 USPQ2d 1309, 1310 (TTAB 1990) (when the five-year anniversary date of a registration falls on a weekend or holiday, petition filed on next business day is considered to have been filed within five years from the issue date). *Cf. National Football League v. DNH Mgmt. LLC* , 85 USPQ2d 1852, 1854 n.6 (TTAB 2008) (where discovery period closed on Saturday, service of written discovery requests the following Monday was not untimely). **Please Note:** Discovery requests now must be served early enough in the discovery period so that responses are due no later than the close of discovery. Similarly, discovery depositions must be properly noticed and taken during the discovery period. 37 C.F.R. § 2.120(a)(3).

2. *See, e.g., "Filing of Papers During Unscheduled Closings of the Patent and Trademark Office"* , 1076 TMOG 6 (March 10, 1987), **www.uspto.gov/web/offices/com/sol/og/con/files/cons032.htm**.

3. *See, e.g., Notice of Shutdown of Certain Electronic Systems of the United States Patent and Trademark Office From Tuesday, December 22, 2015 through Thursday, December 24, 2015* , **http://www.uspto.gov/trademark/trademark-updates-and-announcements/shutdown-certain-electronic-systems-united-states**; and *Notice of USPTO Closure and Designation of September 11, 2001 under 35 U.S.C. § 21(b) for Purpose of Determining Timeliness of Actions or Fees* . **www.uspto.gov/emergencyalerts/emergencyclosure01.htm**.

4. *Asustek Computer Inc. v. Chengdu Westhouse Interactive Entertainment Co., Ltd.*, 128 USPQ2d 1470, 1471 (TTAB 2018) (motion to compel filed Monday, the deadline for first pretrial disclosures, untimely).

113 Service of Papers

37 C.F.R. § 2.119 ***Service and signing of papers.***

(a) *Except for the notice of opposition or the petition to cancel, every submission filed in the Office in inter partes cases, including notices of appeal to the courts, 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. A statement signed by the attorney or other authorized representative, attached to or appearing on the original paper*

when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service.

(b) *Service of 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, or if the serving party can show by written explanation accompanying the submission or paper, or in a subsequent amended certificate of service, that service by email was attempted but could not be made due to technical problems or extraordinary circumstances, then service may be made in any of the following ways:*

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

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

(3) *When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;*

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

(5) *Transmission by overnight courier; or*

(6) *Other forms of electronic transmission.*

(c) *When service is made by first-class mail, Priority Mail Express®, or overnight courier, the date of mailing or of delivery to the overnight courier will be considered the date of service.*

(d) *If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, none of the parties to the proceeding is eligible to use the service option under paragraph (b)(4) of this section. The party not domiciled in the United States may designate by submission filed in the Office the name and address of a person residing in the United States on whom may be served notices or process in the proceeding. If the party has appointed a domestic representative, official communications of the Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under § 11.14(c) of this chapter. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 11.14(a) of this chapter, or qualified under § 11.14(b) of this chapter and authorized under § 2.17(f).*

(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.*

* * * *

Parties are required to use email as the method of service for submissions filed with the Board and any other papers not required to be filed with the Board, unless the parties stipulate to an alternative service method, or unless technical problems or extraordinary circumstances prevent email service. [Note 1.] When email service is not practical, for example, due to the size of the attachment, the Board encourages parties to agree on an effective alternative method of service, such as file hosting services. [Note 2.]

NOTES:

1. 37 C.F.R. § 2.119(b).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69959 (October 7, 2016).

113.01 Requirement for Service of Submissions

Except for the notice of opposition or the petition to cancel, every submission filed in an inter partes proceeding before the Board, including a notice of appeal from a decision of the Board, must be served by the filing party upon every other party to the proceeding. [Note 1.]

The requirement for service also applies to submissions that must be filed with the Board because the Board has jurisdiction over the opposed application or the registration sought to be cancelled. *See*TBMP § 515 and TBMP § 602. [Note 2.] For example, a request to amend or correct an application or registration which is the subject of an inter partes proceeding, an abandonment of that application, or a voluntary surrender of the involved registration, must be filed with the Board and served by the defendant upon every other party to the proceeding.

In addition, the requirement for service applies to documents filed with the Trademark Examining Operation or the Assignment Recordation Branch regarding an application or registration which is the subject of a Board proceeding, if the documents could have an effect on the inter partes proceeding. For example, a change of correspondence address for an applicant/assignee (see TMEP § 609.02(f)), a correction to a registrant/owner's address, separate from its correspondence address (see TMEP § 1609.11), or the submission of an assignment recordation sheet (see TMEP § 503.02), all of which are filed with the Office using TEAS or ETAS, must also be served by the defendant upon every other party to the proceeding.

NOTES:

1. 37 C.F.R. § 2.119(a).

2. 37 C.F.R § 2.133; 37 C.F.R § 2.135.

113.02 Requirement for Proof of Service

When a party to an inter partes proceeding before the Board files a submission required by 37 C.F.R. § 2.119(a) to be served upon every other party to the proceeding, proof that the required service has been made ordinarily must be submitted before the filing will be considered by the Board. Occasionally, in order to expedite matters, and when the interests of the other party or parties would be served thereby, the Board itself will serve, along with an action of the Board relating thereto, a copy of a submission that does not include the required proof of service. For example, if an applicant in an opposition files an abandonment of its involved application without the written consent of the opposer, and the abandonment does not include proof of service upon the opposer, the Board does not send out an action stating that the abandonment will not be considered until proof of service has been submitted. Rather, the Board provides an electronic link to the TTABVUE database for the filed abandonment, along with a copy of an action by the Board entering judgment in opposer's favor pursuant to 37 C.F.R. § 2.135 (which provides, in part, that after the commencement of an opposition, if the applicant files a written abandonment of its application or mark

without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant). [Note 1.]

The notice of filing provided by ESTTA to each party when a submission is made does not substitute for service by the filing party. [Note 2.]

NOTES:

1. *See, e.g., Central Manufacturing Inc. v. Third Millennium Tech. Inc.*, 61 USPQ2d 1210, 1212 n.3 (TTAB 2001) (unserved copy of objection to further extensions of time to oppose filed prior to institution of proceeding forwarded to opposer).

2, *See Coffee Studio LLC v. Reign LLC*, 129 USPQ2d 1480, 1482 (TTAB 2019) (filing notice sent to each party by ESTTA does not constitute service).

113.03 Elements of Certificate of Service

The Board will accept, as prima facie proof that a party filing a document in a Board inter partes proceeding has served a copy of the document upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. The statement should also specify the name of each party or person upon whom service was made, and the address, including the email address. The statement must appear on, or be securely attached to, the document being filed. If the statement is on a separate sheet attached to the filing, it should clearly identify the submission and proceeding to which it relates. [Note 1.]

NOTES:

1. *See* 37 C.F.R. § 2.119(a).

Suggested Format

Shown below is a suggested format for a certificate of service:

I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by forwarding said copy on (insert date of mailing), via email (or insert other appropriate method of delivery) to: (set out name, address, and email address of opposing counsel or party).

_____

Signature

113.04 Manner of Service

Service of submissions filed with the Board and any paper served on a party not required to be filed with the Board, must be made by email, unless otherwise stipulated, or if the serving party can show by written explanation accompanying the submission or paper, or subsequent amended certificate of service, that service by email was attempted but could not be made due to technical problems or extraordinary circumstances.

[Note 1.] The best practice is to reduce such a stipulation to writing, although the agreement should not be filed with the Board unless necessary to resolve a motion.

In the event service by email cannot be made, service of submissions filed in inter partes cases may be made in any of the ways specified in 37 C.F.R. § 2.119(b). They are: (1) by hand delivering a copy of the submission to the person being served; (2) by leaving a copy of the submission at the usual place of business of the person being served, with someone in the person's employment; (3) when the person being served has no usual place of business, by leaving a copy of the submission at the person's address, with some person of suitable age and discretion who resides there; (4) transmission by the "Priority Mail Express® Post Office to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered; (5) transmission by overnight courier; and (6) other forms of electronic transmission. [Note 2.]

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

Service may be made by other forms of electronic transmission, such as fax. [Note 3.]

Incorrect manner of service issues by a party domiciled outside the United States is less likely to arise in view of the requirement that foreign domiciled parties to Board proceedings be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the United States (including the District of Columbia or any Commonwealth or territory of the United States). [Note 4.] Unless a party is domiciled in the United States or its territories, a party cannot represent itself on its own behalf. *See* TBMP §114. A foreign-domiciled party that has appointed a reciprocally-recognized foreign attorney or agent, but has not yet appointed U.S. counsel to represent it before the Board, cannot serve an adverse party by the manners of service specified in 37 C.F.R. § 2.119(b)(1) - 37 C.F.R. § 2.119(b)(3). Moreover, a foreign party may not substitute its national postal service, or omit reference to the nation of the postal service employed, as a means of using 37 C.F.R. § 2.119(b)(4) manner of service; 37 C.F.R. § 2.119(b)(4) requires transmission by the USPS. [Note 5.]

As a practical matter, parties and U.S. counsel that are located outside the United States and are unable to serve submissions by email must meet the service requirement through 37 C.F.R. § 2.119(b)(5) - 37 C.F.R. § 2.119(b)(6).

NOTES:

1. 37 C.F.R. § 2.119(b).

2. 37 C.F.R. § 2.119(b).

3. 37 C.F.R. § 2.119(b)(6).

4. 37 C.F.R. § 2.11, 37 C.F.R. § 2.17(b), 37 C.F.R. § 2.17(c), 37 C.F.R. § 11.1, 37 C.F.R. § 11.14(c)(1), and 37 C.F.R. § 11.14(c)(2). *See* REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31501 (July 2, 2019); *Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 10019, at *1 (TTAB 2020) ("A reciprocally recognized attorney or agent may only appear as an additionally appointed practitioner. A qualified attorney licensed to practice law in the United States, or in any Commonwealth or territory of the United States, must still be appointed as the party's representative who will file documents with the Board and with whom the Board will correspond.").

5. 37 C.F.R. § 2.119(d) ("If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney . . . located in the United States, none of the parties to the proceeding is eligible to use the service option under paragraph (b)(4) of this section.").

6. *See Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 10019, at *1 (TTAB 2020) (Board suspended proceedings pending appointment of United States counsel).

113.05 No Additional Time for Taking Action After Service by Mail

Whenever a party to an inter partes proceeding before the Board is required to take some action within a prescribed period of time after the service of a submission upon that party by another party to the proceeding, and the submission is served by first-class mail, Priority Mail Express®, or overnight courier, the date of mailing or of delivery to the overnight courier will be considered the date of service. The time for taking action is no longer enlarged by 5 days. [Note 1.] Rather, all fifteen-day response dates to submissions served by an adverse party are now amended to twenty days. [Note 2.] In addition, Fed. R. Civ. P. 6(d) is not applicable to Board proceedings. As an alternative to email service, parties may stipulate to accept service by other means but also agree to serve a courtesy copy by email. **Please Note:** a courtesy copy does not substitute for proper service under the applicable Trademark Rules. [Note 3.]

For example, if one party to a proceeding serves, upon another party to the proceeding, a motion to compel discovery by email or other means stipulated to by the parties, the served party's time for filing a response to the motion will be 20 days from the date of service of the motion. "The extra five days provided for in former § 2.119(c) are already built into the response time period." [Note 4.] There is no extra response period built into the 30-day response period for responding to discovery or for responding to a motion for summary judgment. [Note 5.]

NOTES:

1. 37 C.F.R. § 2.119(c). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69960 (October 7, 2016) ("All fifteen-day response dates initiated by a service date are amended to twenty days.").

2. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69960 (October 7, 2016) ("All fifteen-day response dates initiated by a service date are amended to twenty days.").

3. *Jacques Moret Inc. v. Speedo Holdings B.V.*, 102 USPQ2d 1212, 1217 n.7 (TTAB 2012).

4. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69960 (October 7, 2016).

5. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69950-51 (October 7, 2016).

113.06 A Certificate of Service is Not...

A certificate of service is not the equivalent of a certificate of mailing or transmission for any purpose. TBMP § 111.02(g).

114 Representation of a Party

37 C.F.R. § 2.11 ***Requirement for representation.***

(a) *An applicant, registrant, or party to a proceeding whose domicile is not located within the United States or its territories must be represented by an attorney, as defined in § 11.1 of this chapter, who is qualified to practice under § 11.14 of this chapter. The Office cannot aid in the selection of an attorney.*

(b) *The Office may require an applicant, registrant, or party to a proceeding to furnish such information or declarations as may be reasonably necessary to the proper determination of whether the applicant, registrant, or party is subject to the requirement in paragraph (a) of this section.*

(c) *An applicant, registrant, or party to a proceeding may be required to state whether assistance within the scope of § 11.5(b)(2) of this chapter was received in a trademark matter before the Office and, if so, to disclose the name(s) of the person(s) providing such assistance and whether any compensation was given or charged.*

(d) *Failure to respond to requirements issued pursuant to paragraphs (a) through (c) of this section is governed by § 2.65.*

(e) *Providing false, fictitious, or fraudulent information in connection with the requirements of paragraphs (a) through (c) of this section shall be deemed submitting a paper for an improper purpose, in violation of § 11.18(b) of this chapter, and subject to the sanctions and actions provided in § 11.18(c).*

(f) *Notwithstanding § 2.63(b)(2)(ii), if an Office action maintains only requirements under paragraphs (a), (b), and/or (c) of this section, or only requirements under paragraphs (a), (b), and/or (c) of this section and the requirement for a processing fee under § 2.22(c), the requirements may be reviewed only by filing a petition to the Director under § 2.146.*

37 C.F.R. § 2.17 ***Recognition for representation.***

(a) ***Authority to practice in trademark cases.*** *Only an individual qualified to practice under § 11.14 of this chapter may represent an applicant, registrant, or party to a proceeding before the Office in a trademark case.*

(b)(1) ***Recognition of practitioner as representative.*** *To be recognized as a representative in a trademark case, a practitioner qualified under § 11.14 of this chapter may:*

(i) *File a power of attorney that meets the requirements of paragraph (c) of this section;*

(ii) *Sign a document on behalf of an applicant, registrant, or party to a proceeding who is not already represented by a practitioner qualified under § 11.14 of this chapter from a different firm; or*

(iii) *Appear by being identified as the representative in a document submitted to the Office on behalf of an applicant, registrant, or party to a proceeding who is not already represented by a practitioner qualified under § 11.14 of this chapter from a different firm.*

(2) ***Authorization to represent.*** *When a practitioner qualified under § 11.14 of this chapter signs a document or appears pursuant to paragraph (b) of this section, his or her signature or appearance shall*

constitute a representation to the Office that he or she is authorized to represent the person or entity on whose behalf he or she acts. The Office may require further proof of authority to act in a representative capacity.

(3) ***Bar information required.*** *A practitioner qualified under § 11.14(a) of this chapter will be required to provide the name of a State, as defined in § 11.1 of this chapter, in which he or she is an active member in good standing, the date of admission to the bar of the named State, and the bar license number, if one is issued by the named State. The practitioner may be required to provide evidence that he or she is an active member in good standing of the bar of the specified State.*

(c) ***Requirements for power of attorney.*** *A power of attorney must:*

(1) *Designate by name at least one practitioner meeting the requirements of § 11.14 of this chapter; and*

(2) *Be signed by the individual applicant, registrant, or party to a proceeding pending before the Office, or by someone with legal authority to bind the applicant, registrant, or party (e.g., a corporate officer or general partner of a partnership). In the case of joint applicants or joint registrants, all must sign. Once the applicant, registrant, or party has designated a practitioner(s) qualified to practice under § 11.14 of this chapter, that practitioner may sign an associate power of attorney appointing another qualified practitioner(s) as an additional person(s) authorized to represent the applicant, registrant, or party. If the applicant, registrant, or party revokes the original power of attorney (§ 2.19(a)), the revocation discharges any associate power signed by the practitioner whose power has been revoked. If the practitioner who signed an associate power withdraws (§ 2.19(b)), the withdrawal discharges any associate power signed by the withdrawing practitioner upon acceptance of the request for withdrawal by the Office.*

(d) ***Power of attorney relating to multiple applications or registrations.*** *The owner of an application or registration may appoint a practitioner(s) qualified to practice under § 11.14 of this chapter to represent the owner for all existing applications or registrations that have the identical owner name.*

(e) ***Foreign attorneys and agents.*** *Recognition to practice before the Office in trademark matters is governed by § 11.14(c) of this chapter.*

(f) ***Non-lawyers.*** *A non-lawyer may not act as a representative except in the limited circumstances set forth in § 11.14(b) of this chapter. Before any non-lawyer who meets the requirements of § 11.14(b) of this chapter may take action of any kind with respect to an application, registration or proceeding, a written authorization must be filed, signed by the applicant, registrant, or party to the proceeding, or by someone with legal authority to bind the applicant, registrant, or party (e.g., a corporate officer or general partner of a partnership).*

(g) ***Duration of recognition.***

(1) *The Office considers recognition as to a pending application to end when the mark registers, when ownership changes, or when the application is abandoned.*

(2) *The Office considers recognition obtained after registration to end when the mark is cancelled or expired, or when ownership changes. If a practitioner was recognized as the representative in connection with an affidavit under section 8, 12(c), 15, or 71 of the Act, renewal application under section 9 of the Act, or request for amendment or correction under section 7 of the Act, the recognition is deemed to end upon acceptance or final rejection of the filing.*

37 C.F.R. § 11.1 ***Definitions.***

* * * *

Unless otherwise clear from the context, the following definitions apply to this part:

* * * *

Attorney or lawyer means an individual who is an active member in good standing of the bar of the highest court of any State. A non-lawyer means a person who is not an attorney or lawyer.

* * * *

State means any of the 50 states of the United States of America, the District of Columbia, and any Commonwealth or territory of the United States of America.

* * * *

United States means the United States of America, and the territories and possessions the United States of America.

37 C.F.R. § 11.14 ***Individuals who may practice before the Office in trademark and other non-patent matters.***

(a) ***Attorneys.*** *Any individual who is an attorney as defined in § 11.1 may represent others before the Office in trademark and other non-patent matters. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent matters. Registration as a patent practitioner does not itself entitle an individual to practice before the Office in trademark matters.*

(b) ***Non-lawyers.*** *Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent matters, except that individuals not attorneys who were recognized to practice before the Office in trademark matters under this chapter prior to January 1, 1957, will be recognized as agents to continue practice before the Office in trademark matters. Except as provided in the preceding sentence, registration as a patent agent does not itself entitle an individual to practice before the Office in trademark matters.*

(c) ***Foreigners.***

(1) *Any foreign attorney or agent not a resident of the United States who shall file a written application for reciprocal recognition under paragraph (f) of this section and prove to the satisfaction of the OED Director that he or she is a registered and active member in good standing before the trademark office of the country in which he or she resides and practices and possesses good moral character and reputation, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark matters, provided: the trademark office of such country and the USPTO have reached an official understanding to allow substantially reciprocal privileges to those permitted to practice in trademark matters before the Office. Recognition under this paragraph (c) shall continue only during the period that the conditions specified in this (c) paragraph obtain.*

(2) *In any trademark matter where a foreign attorney or agent authorized under paragraph (c)(1) of this section is representing an applicant, registrant, or party to a proceeding, an attorney, as defined in § 11.1 and qualified to practice under paragraph (a) of this section, must also be appointed pursuant to § 2.17(b) and (c) of this chapter as the representative who will file documents with the Office and with whom the Office will correspond.*

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

(e) ***Appearance.*** *No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark matters on behalf of a client. Except as specified*

in § 2.11(a) of this chapter, any individual may appear in a trademark or other non-patent matter in his or her own behalf or on behalf of:

(1) *A firm of which he or she is a member;*

(2) *A partnership of which he or she is a partner; or*

(3) *A corporation or association of which he or she is an officer and which he or she is authorized to represent;*

(f) ***Application for reciprocal recognition.*** *An individual seeking reciprocal recognition under paragraph (c) of this section, in addition to providing evidence satisfying the provisions of paragraph (c) of this section, shall apply in writing to the OED Director for reciprocal recognition, and shall pay the application fee required by § 1.21(a)(1)(i) of this subchapter.*

114.01 Party May Represent Itself

A party, if domiciled in the United States or its territories, may represent itself in an ex parte or inter partes proceeding before the Board, or the party may be represented by an attorney who is licensed to practice law in the United States. [Note 1.]

If a partnership which is a party to a Board proceeding elects to represent itself, the partnership may act through an individual who is a partner. If a party electing to represent itself is a corporation or an association, the party may act through any individual who is (1) an officer of the party and who is (2) in fact authorized to represent it. [Note 2.] Joint owners who elect to represent themselves must act together. [Note 3.]

However, because the governing practices and procedures in proceedings before the Board are quite technical and highly specialized, it is strongly recommended that an attorney knowledgeable about trademark law represent a party. [Note 4.]

Please Note: Effective August 3, 2019, under 37 C.F.R. § 2.11, a foreign-domiciled party to a Board proceeding must be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the United States (including the District of Columbia or any Commonwealth or territory of the United States). [Note 5.] Domicile for purposes of 37 C.F.R. § 2.11 means “permanent legal place of residence” of a natural person or the “principal place of business” of a juristic entity. [Note 6.] A foreign attorney may only appear on a foreign domiciled party’s behalf if the attorney has been reciprocally recognized by the USPTO’s Office of Enrollment and Discipline. [Note 7.] However, even if a foreign applicant has appointed a reciprocally recognized foreign attorney, a qualified attorney who is licensed to practice law in the United States still must be appointed for filing papers and corresponding with the Office. [Note 8.] Generally, if a foreign-domiciled party appears and is not represented by U.S. counsel, the Board will suspend the proceedings and inform the party of the time frame within which it must appoint U.S. counsel to represent it before the Board. [Note 9.]

NOTES:

1. *See* 37 C.F.R. § 2.11; 37 C.F.R. § 11.14(e).

2. *See* 37 C.F.R. § 11.14(e).

3. TMEP § 803.03(d). *Cf.* 37 C.F.R. § 2.193(e)(2)(ii)("in the case of joint owners who are not represented by a qualified practitioner, all must sign.").

4. *Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *1 (TTAB 2020) (quoting TBMP Section 114.01, and noting that compliance with the Trademark Rules of Practice, and where applicable, the Federal Rules of Civil Procedure and the Federal Rules of Evidence, is required of all parties even those who assume the responsibility and risk of representing themselves).

5. 37 C.F.R. § 2.11. *See* REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31498-31501 (July 2, 2019).

6. 37 C.F.R. § 2.2(o). *See also* Trademark Examination Guide 4-19 (Revised) ("Under this rule, a person's 'permanent legal place of residence' is the place the person resides and intends to be the person's principal home. The 'principal place of business' is the location of a juristic entity's headquarters where the entity's senior executives or officers ordinarily direct and control the entity's activities and is usually the center from where other locations are controlled. 37 C.F.R. § 2.2(p)."), available at www.uspto.gov.

7. 37 C.F.R. § 11.14(c)(1).

8. 37 C.F.R. § 11.14(c)(2); 37 C.F.R. § 2.17(b) and 37 C.F.R. § 2.17(c). *See* REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31501 (July 2, 2019); *Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 10019, at *1 (TTAB 2020) ("A reciprocally recognized attorney or agent may only appear as an additionally appointed practitioner. A qualified attorney licensed to practice law in the United States, or in any Commonwealth or territory of the United States, must still be appointed as the party's representative who will file documents with the Board and with whom the Board will correspond.").

9. *See Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC* , 2020 USPQ2d 10019, at *1 (TTAB 2020) (Board suspended proceedings pending appointment of United States counsel). See also Trademark Examination Guide 4-19 (Revised) at 8 (September 2019), available at www.uspto.gov.

114.02 Selection of Attorney

The Board cannot aid a party in the selection of an attorney, nor does the Office maintain a register or list of trademark attorneys. [Note 1.]

NOTES:

1. 37 C.F.R. § 2.11(a).

114.03 Representation by Attorney

The term "attorney" (or "lawyer") is defined in 37 C.F.R. § 11.1 as "an individual who is an active member in good standing of the bar of the highest court of any State." An attorney is eligible to represent others before the Office in trademark matters, including proceedings before the Board, and in other non-patent matters. [Note 1.] Such an attorney is not required to apply to the Office for registration or recognition to practice before the Office in trademark and other non-patent matters. An attorney appearing in a Board proceeding will be required to provide his or her bar membership information to show that he or she is an active member in good standing. [Note 2.]

Please Note: Practice before the Board constitutes practice before the Office, subjecting any such attorney to the USPTO RULES OF PROFESSIONAL CONDUCT. [Note 3.] Attorneys practicing before the Board are encouraged to familiarize themselves with the provisions of Part 11 of 37 C.F.R.

An attorney, as defined in 37 C.F.R. § 11.1, will be accepted as a representative of a party in a proceeding before the Board if the attorney (1) signs a document that is filed with the Office on behalf of the party and satisfactorily identifies himself or herself as an attorney or lawyer, or is identified as the representative in a document submitted to the Office on behalf of a party to a proceeding, [Note 4] (2) appears in person, or (3) files a written power of attorney signed by the party the attorney represents. [Note 5.]

When representation has been established by the filing of a document a new notice of appearance is sufficient to change the attorney of record. However, if representation has been established by the filing of a power of attorney, and thereafter another attorney or other authorized representative appears on behalf of the party, a new power of attorney is required to change the attorney of record. *See*TBMP § 116 (Termination of Representation), TBMP § 513 (Motion to Withdraw as Representative).

When an attorney, as defined in 37 C.F.R. § 11.1, acting in a representative capacity signs a document or appears in person in a proceeding before the Board, his or her personal signature or appearance constitutes a representation to the Office that, under the provisions of 37 C.F.R. § 11.14 (which specifies the types of individuals who may practice before the Office in trademark and other non-patent matters) and the laws of the jurisdiction where the attorney is licensed to practice, that he or she is authorized to represent the particular party in whose behalf he or she acts. If there is some question as to whether an individual who makes such an appearance is authorized to act in a representative capacity, further proof of his or her authority may be required. [Note 6.]

If a formal power of attorney is filed in a proceeding before the Board, it should state the name and address of the individual or individuals to whom the power is granted, identify the party granting the power, indicate the power being granted (e.g., "to represent Opposer in this proceeding, with full power of substitution and revocation, and to transact all business in the United States Patent and Trademark Office in connection therewith"), and be signed by the party granting the power. The Office requires that a power of attorney specify the names of one or more individuals to whom the power is granted. A power that specifies both the names of one or more individuals and the name of a firm will be regarded as a power to the individual(s). [Note 7.] A power that specifies only the name of a firm will be regarded not as a power to the firm but rather simply as a designation of an address to which correspondence is to be sent. [Note 8.] *See* TBMP § 117 (Correspondence – With Whom Held).

Please Note: Effective August 3, 2019, the Office amended 37 C.F.R § 2.11(a) to require foreign-domiciled applicants, registrants, or parties to a trademark proceeding to be represented by an attorney who is licensed to practice law in the United States. The term "domicile" means the "permanent legal place of residence" of a natural person or the "principal place of business" of a juristic entity. 37 C.F.R § 2.2(o).

For representation by a foreign attorney, or agent, including a Canadian trademark attorney or agent, seeTBMP § 114.05.

NOTES:

1. *See* 37 C.F.R. § 11.1, 37 C.F.R. § 11.14(a); *Weiffenbach v. Klempay*, 29 USPQ2d 2027, 2030 (Dep't of Comm. 1993) (only individuals who are not attorneys and were recognized to practice before the Office in trademark cases prior to January 1, 1957, and attorneys may represent clients before the Office in trademark cases).

2. 37 C.F.R. § 2.17(b)(3).

3. *See* 37 C.F.R. § 11.5(b) and 37 C.F.R. § 11.19(a).

4. 37 C.F.R. § 2.17(b)(1)(ii) and 37 C.F.R. § 2 .17(b)(1)(iii). *See Jacques Moret Inc. v. Speedo Holdings B.V.*, 102 USPQ2d 1212, 1216 (TTAB 2012) (law firm that filed motion to dismiss recognized as counsel of record for respondent); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1613 n.1 (TTAB 1991) (appearance made by filing motion on behalf of respondent).

5. 37 C.F.R. § 2.17(b)(1)(i) and 37 C.F.R. § 2.17(c).

6. 37 C.F.R. § 2.17(b)(2).

7. *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998) (other named attorneys appointed by petitioner were authorized to represent petitioner and assume responsibility for the case).

8. TMEP § 605.01 (Requirements for Power of Attorney).

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

The only non-lawyers permitted to represent others in trademark cases before the Office, including proceedings before the Board, are those who were recognized to practice before the Office in trademark cases prior to January 1, 1957. [Note 1.] Before such a representative may take any action of any kind in a proceeding before the Board, however, the representative must file in the proceeding a written authorization from the party that he or she represents, or from another person entitled to prosecute the case (e.g., the party's appointed attorney of record). [Note 2.]

NOTES:

1. 37 C.F.R. § 11.14 (b); *Weiffenbach v. Klempay* , 29 USPQ2d 2027, 2031 (Dep't of Comm. 1993) (patent agent, admitted to practice before the Office in patent cases after January 1, 1957, was excluded from trademark practice before the Office); *Weiffenbach v. Frank* , 18 USPQ2d 1397, 1400 (consent order) (Comm'r 1991) (patent agent who engaged in unauthorized representation in trademark matters reprimanded and barred from such practice). *But see* 37 C.F.R. § 11.18(c) and 37 C.F.R. § 11.14(e).

2. 37 C.F.R. § 2.17(f).

114.05 Representation by Foreign Attorney or Agent

(c) ***Foreigners***

(1) *Any foreign attorney or agent not a resident of the United States who shall file a written application for reciprocal recognition under paragraph (f) of this section and prove to the satisfaction of the OED Director that he or she is a registered and active member in good standing before the trademark office of the country in which he or she resides and practices and possesses good moral character and reputation, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark matters, provided: the trademark office of such country and the USPTO have reached an official understanding to allow substantially reciprocal privileges to those permitted to practice in trademark matters before the Office. Recognition under this paragraph (c) shall continue only during the period that the conditions specified in this paragraph (c) obtain.*

(2) *In any trademark matter where a foreign attorney or agent authorized under paragraph (c)(1) of this section is representing an applicant, registrant, or party to a proceeding, an attorney, as defined in § 11.1 and qualified to practice under paragraph (a) of this section, must also be appointed pursuant to § 2.17(b) and (c) of this chapter as the representative who will file documents with the Office and with whom the Office will correspond.*

37 C.F.R. § 11.14(f) ***Application for Reciprocal Recognition.*** *An individual seeking reciprocal recognition under paragraph (c) of this section, in addition to providing evidence satisfying the provisions of paragraph (c) of this section, shall apply in writing to the OED Director for reciprocal recognition, and shall pay the application fee required by § 1.21(a)(1)(i) of this subchapter.*

Under certain conditions specified in 37 C.F.R. § 11.14(c), a foreign attorney or agent who is not a resident of the United States may be recognized for the limited purpose of representing in trademark cases before the Office, parties located in the country in which the attorney or agent resides or practices. An individual seeking recognition to practice under 37 C.F.R. § 11.14(c) must apply in writing to the Director of the Office of Enrollment and Discipline, and pay the appropriate fee. [Note 1.]

Currently, the USPTO's Office of Enrollment and Discipline recognizes only Canada as qualifying for the limited exception provided in 37 C.F.R. § 11.14(c), permitting Canadian trademark attorneys and agents to represent a Canadian party before the Office as additionally appointed practitioners, so long as they remain registered and in good standing in Canada and are formally reciprocally recognized by the USPTO's Office of Enrollment and Discipline. 37 C.F.R § 11.14(c)(2). [Note 2.]

Please Note: While a reciprocally recognized Canadian trademark attorney or agent may appear as an additionally appointed practitioner for a Canadian party, [Note 3], that party is also required to appoint a U.S.-licensed attorney, as defined in 37 C.F.R § 11.1 and qualified to practice under 37 C.F.R § 11.14(a), as the representative who will file documents with the Board and with whom the Board will correspond. [Note 4.] As an additionally appointed practitioner, the Canadian trademark attorney or agent remains authorized to prepare and sign Board filings and to communicate with Board personnel by telephone or email. [Note 5.]

The Office of Enrollment and Discipline maintains a list of trademark attorneys and agents who are registered or in good standing with the Canadian Intellectual Property Office. [Note 6.]

Canadian patent agents are no longer authorized to practice before the USPTO in trademark matters. [Note 7.] However, for inter partes matters and ex parte appeals pending before August 3, 2019, currently reciprocally recognized Canadian patent attorneys and agents may complete their representation on behalf of a party, but may not handle new trademark matters. [Note 8.]

The certificate of mailing procedure is not available for use on mail that originates in Canada, as it is not deposited in the United States mail as required by the certification.

NOTES:

1. 37 C.F.R. § 11.14(f).

2. 37 C.F.R § 11.14(c)(1). See REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31501 (July 2, 2019) ("Recognized Canadian trademark attorneys and agents continue to be authorized to represent Canadian parties in U.S. trademark matters."); *Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC,*

2020 USPQ2d 10019, at *1 (TTAB 2020) ("A reciprocally recognized attorney or agent may only appear as an additionally appointed practitioner.") (emphasis original).

3. 37 C.F.R § 2.11(a); 37 C.F.R. § 11.14(c)(1); 37 C.F.R § 11.14(c)(2). *See Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 10019, at *1 (TTAB 2020).

4. 37 C.F.R § 11.14(c)(2). *See* REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31501 (July 2, 2019); *Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 10019, at *1 (TTAB 2020).

5. *See Cloudworks Consulting Services Inc. v. Ongoing Operations*, LLC, 2020 USPQ2d 10019, at *1 n.5 (TTAB 2020).

6. *See*TMEP § 602.03 (Foreign Attorneys and Agents); REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31501 (July 2, 2019) ("Currently, only Canadian attorneys and agents [who are registered, active, and in good standing] are reciprocally recognized under § 11.14(c)."); *Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 10019, at *1 n.4 (TTAB 2020) ("Currently, only Canadian attorneys and agents are reciprocally recognized under this rule and, in accordance therewith, any representation must be limited to parties located in Canada.").

7. 37 C.F.R § 11.14(c)(1). *See* REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31501 (July 2, 2019) (amended rule 37 C.F.R. § 11.14(c)(1) "removes from the regulations … the authorization for reciprocally recognized Canadian patent agents to practice before the USPTO in trademark matters.").

8. REQUIREMENT OF U.S. LICENSED ATTORNEY FOR FOREIGN TRADEMARK APPLICANTS AND REGISTRANTS, 84 Fed. Reg. 31498, 31501 (July 2, 2019) (Canadian patent agents are authorized to practice in trademark matters pending before the Office prior to August 3, 2019, the effective date of 37 C.F.R. § 11.14(c)(1), as amended, where they are listed as the representative).

114.06 Individual Not Recognized to Represent Others

An individual who is not recognized, under 37 C.F.R. § 11.14(a), 37 C.F.R. § 11.14(b), 37 C.F.R. § 11.14(c), or 37 C.F.R. § 11.14(e) to practice before the Office in trademark cases, will not be permitted to represent a party in a proceeding before the Board. *See*TBMP § 114.03-TBMP § 114.05 regarding recognition of who may practice before the USPTO in trademark matters.

If it comes to the attention of the Board that an individual who is not recognized, under 37 C.F.R. § 11.14(a), 37 C.F.R. § 11.14(b), 37 C.F.R. § 11.14(c) or 37 C.F.R. § 11.14(e), to practice before the Office in trademark cases, is attempting to represent a client in a Board proceeding, the Board will notify the individual that he or she is not entitled to do so. If the individual signs and files a submission on behalf of a client to a Board proceeding, the submission will not be considered unless a new copy thereof, signed by the party or by an authorized representative who is entitled to practice before the Office in trademark cases, is filed. If an individual not authorized to practice before the Office signs an extension of time to oppose and/or a notice of opposition or a petition for cancellation and it comes to the Board's attention, the Board will notify the individual that he or she is not entitled to do so and allow the party time in which to cure the defect. [Note 1.]

However, no Board correspondence intended for the party will be sent to that individual. Rather, the Board will send such correspondence to the party itself, or to the party's attorney or to the party's domestic representative if appropriate. [Note 2.] *See* TBMP § 117 (Correspondence – With Whom Held).

NOTES:

1. *Birlinn Ltd. v. Stewart* , 111 USPQ2d 1905, 1908 (TTAB 2014) (Board applies opportunity to cure provision in 2.119(e) to improperly signed papers, which defines the time period for cure as "within the time limit set in the notification of this defect by the Office"); 37 C.F.R. § 2.119(e).

2. 37 C.F.R. § 2.18(a).

114.07 Designation of Domestic Representative

37 C.F.R. § 2.24 ***Designation and revocation of domestic representative by foreign applicant.***

(a) *An applicant or registrant that is not domiciled in the United States may designate a domestic representative (i.e., a person residing in the United States on whom notices or process in proceedings affecting the mark may be served).*

(b) *The designation, or a request to change or revoke a designation, must set forth the name, email address, and postal address of the domestic representative and be signed pursuant to § 2.193(e)(8).*

(c) *The mere designation of a domestic representative does not authorize the person designated to represent the applicant or registrant.*

37 C.F.R. § 2.119(d) *If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, none of the parties to the proceeding is eligible to use the service option under paragraph (b)(4) of this section. The party not domiciled in the United States may designate by submission filed in the Office the name and address of a person resident in the United States on whom may be served notices or process in the proceeding. If the party has appointed a domestic representative, official communications of the Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under § 11.14(c) of this chapter. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 11.14(a), or qualified under § 11.14(b) and authorized under § 2.17(f).*

Generally, foreign-domiciled applicants and parties to a Board proceeding will not need to designate a domestic representative because such applicant and parties are required to be represented by an attorney who is licensed to practice law in the United States. Where records need to be updated during the pendency of a Board proceeding, shown below is a suggested format for the designation of a domestic representative:

Designation of Domestic Representative

(Name of Domestic Representative), whose postal

address is _____

and whose email address is _____,

is hereby designated (Name of Designating Party's)

representative upon whom notice or process in this

proceeding may be served.

_____

(Signature of Designating Party)

_____

(Identification of Person Signing)

_____

(Date of Signature)

The designation of a domestic representative is not the equivalent of a power of attorney. [Note 1.] In other words, a domestic representative cannot represent a party in Board proceedings. The appointment of a domestic representative serves a different purpose; that is to provide a contact and address for service of process. [Note 2.]

Effective August 3, 2019, all foreign-domiciled applicants, registrants, or parties to a Board proceeding must be represented by an attorney licensed to practice law in the United States. [Note 3.] Even if a party has appointed a domestic representative, once a U.S. licensed attorney is appointed, the Board will send correspondence only to the appointed attorney.

If the foreign-domiciled party has not appointed a domestic representative and a U.S. licensed attorney has not yet been appointed to represent the party in the proceeding, the Board will send correspondence directly to the party at the address of record for the party, unless the party requests in writing to change its address. [Note 4.]

NOTES:

1. *See*TMEP § 610; *Jacques Moret Inc. v. Speedo Holdings B.V.*, 102 USPQ2d 1212, 1214 n.4 (TTAB 2012) (discussing difference between an attorney designated solely as domestic representative and an attorney appointed as counsel of record).

2. *See*TMEP § 610.

3. 37 C.F.R. § 2.11.

4. 37 C.F.R. § 2.119(d); 37 C.F.R. § 2.18(a)(1).

114.08 Adverse Parties Represented by Same Practitioner

37 C.F.R. § 11.107 ***Conflict of interest; Current clients.***

(a) *Except as provided in paragraph (b) of this section, a practitioner shall not represent a client if the representation involves a concurrent conflict of interest. A concurrent conflict of interest exists if:*

(1) *The representation of one client will be directly adverse to another client; or*

(2) *There is a significant risk that the representation of one or more clients will be materially limited by the practitioner's responsibilities to another client, a former client or a third person or by a personal interest of the practitioner.*

(b) *Notwithstanding the existence of a concurrent conflict of interest under paragraph (a) of this section, a practitioner may represent a client if:*

(1) *The practitioner reasonably believes that the practitioner will be able to provide competent and diligent representation to each affected client;*

(2) *The representation is not prohibited by law;*

(3) *The representation does not involve the assertion of a claim by one client against another client represented by the practitioner in the same litigation or other proceeding before a tribunal; and*

(4) *Each affected client gives informed consent, confirmed in writing.*

As a general rule, a practitioner (i.e., attorney or other authorized representative) may not represent parties with conflicting interests in proceedings before the Office. That is, a practitioner normally may not accept proffered employment, or continue multiple employment, if the exercise of the practitioner's independent professional judgment on behalf of one client is likely to be adversely affected by the practitioner's representation of another client, or if the employment would be likely to involve the practitioner in representing differing interests. [Note 1.]

However, a practitioner may represent multiple clients under the particular circumstances specified in 37 C.F.R. § 11.107(b).

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

It is the responsibility of a practitioner to ensure that there is no violation of the rules cited above. If an impermissible conflict exists, a practitioner should take appropriate action immediately. A practitioner who fails to do so may be subject to disciplinary action.

Please Note: Effective May 3, 2013, the United States Patent and Trademark Office adopted new USPTO RULES OF PROFESSIONAL CONDUCT which are based on the American Bar Association's MODEL RULES OF PROFESSIONAL CONDUCT. Cases decided prior to May 3, 2013 refer to the USPTO CODE OF PROFESSIONAL CONDUCT that was in effect at that time. These earlier cases continue to be instructive.

NOTES:

1. 37 C.F.R. § 11.107; *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 221 USPQ 1077, 1082 (Comm'r 1984) (attorney was disqualified, but law firm was not); *Plus Products v. Con-Stan Industries, Inc.*, 221 USPQ 1071, 1075 (Comm'r 1984) (attorney representing respondent in an opposition disqualified in view

of his previous representation of petitioner in USPTO proceedings and in infringement litigation concerning the same trademark issues). *But see Gilman Corp. v. Gilman Brothers Co.*, 20 USPQ2d 1238, 1240 (Comm'r 1991) (petitioner's former attorney in patent matter not disqualified from representing respondent in trademark cancellation proceeding; no "substantial relationship" between prior and present matters); *Unico American Corp. v. Unico Banking Group*, 223 USPQ 684, 685 (Comm'r 1984) (opposer has no right to seek disqualification of applicant's counsel based on any possible conflict between applicant and third parties).

115 Conduct of Practitioner

115.01 Applicable Rules

The conduct of an attorney or other authorized representative in proceedings before the Board is governed by Part 11 of 37 C.F.R., Subpart D – **USPTO Rules of Professional Conduct** (37 C.F.R. § 11.101 - 37 C.F.R. § 11.901).

Part 11 of 37 C.F.R., Subpart B – **Recognition to Practice Before the USPTO**, addresses the representation of others before the Office, including who is authorized to practice before the United States Patent and Trademark Office (set out in 37 C.F.R. § 11.4 - 37 C.F.R. § 11.18). Part 11 of 37 C.F.R., Subpart C – **Investigations and Disciplinary Proceedings; Jurisdiction, Sanctions, Investigations, and Proceedings**, addresses investigations and disciplinary proceedings (37 C.F.R. § 11.19 - 37 C.F.R. § 11.60).

In addition to the requirements specifically applicable to the conduct of practitioners, all parties in matters before the Board, whether represented by counsel or not, are expected to conduct their business with decorum and courtesy. [Note 1.]

NOTES:

1. 37 C.F.R. § 2.192; *MySpace Inc. v. Mitchell*, 91 USPQ2d 1060, 1062 n.4 (TTAB 2009) (referencing 37 C.F.R. § 2.192).

115.02 Disciplinary Proceedings

37 C.F.R. § 2.193 ***Trademark correspondence and signature requirements.***

* * * *

(f) ***Signature as certification.*** *The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by any person, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this chapter. Violations of § 11.18(b) of this chapter may jeopardize the validity of the application or registration, and may result in the imposition of sanctions under § 11.18(c) of this chapter. Any practitioner violating § 11.18(b) may also be subject to disciplinary action. See §§ 11.18(d) and 11.804 of this chapter.*

37 C.F.R. § 11.18 ***Signature and certificate for correspondence filed in the Office.***

* * * *

(b) *By presenting to the Office or hearing officer in a disciplinary proceeding (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-*

(1) *All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. § 1001 and any other applicable criminal statute, and violations of this section may jeopardize the probative value of the paper; and*

(2) *To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,*

(i) *The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;*

(ii) *The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;*

(iii) *The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and*

(iv) *The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.*

37 C.F.R. § 11.20 ***Disciplinary sanctions; Transfer to disability inactive status.***

(a) ***Types of discipline.*** *The USPTO Director, after notice and opportunity for a hearing, and where grounds for discipline exist, may impose on a practitioner the following types of discipline:*

(1) *Exclusion from practice before the Office;*

(2) *Suspension from practice before the Office for an appropriate period of time;*

(3) *Reprimand or censure; or*

(4) ***Probation.*** *Probation may be imposed in lieu of or in addition to any other disciplinary sanction. Any conditions of probation shall be stated in writing in the order imposing probation. The order shall also state whether, and to what extent, the practitioner shall be required to notify clients of the probation. Violation of any condition of probation shall be cause for imposition of the disciplinary sanction. Imposition of the disciplinary sanction predicated upon violation of probation shall occur only after an order to show cause why the disciplinary sanction should not be imposed is resolved adversely to the practitioner.*

(b) ***Conditions imposed with discipline.*** *When imposing discipline, the USPTO Director may condition reinstatement upon the practitioner making restitution, successfully completing a professional responsibility course or examination, or any other condition deemed appropriate under the circumstances.*

(c) ***Transfer to disability inactive status.*** *The USPTO Director, after notice and opportunity for a hearing may, and where grounds exist to believe a practitioner has been transferred to disability inactive status in another jurisdiction, or has been judicially declared incompetent; judicially ordered to be involuntarily committed after a hearing on the grounds of incompetency or disability, or placed by court order under guardianship or conservatorship, transfer the practitioner to disability inactive status.*

By presenting a submission to the Office, the signer makes the certifications set forth in 37 C.F.R. § 11.18(b), and is subject to sanctions under 37 C.F.R. § 11.18(c) for violation of 37 C.F.R. § 11.18(b)(2), regardless of whether the party is a practitioner or non-practitioner. [Note 1.]

The rules governing disciplinary proceedings are set out in 37 C.F.R. § 11.19-37 C.F.R. § 11.60. Such a proceeding is instituted only under the circumstances specified in 37 C.F.R. § 11.19.

NOTES:

1. For examples of cases involving disciplined practitioners, see *Bender v. Dudas*, 490 F.3d 1361, 83 USPQ2d 1065, 1072-73 (Fed. Cir. 2007) (decision to exclude patent attorney from practicing before the USPTO was not "arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law" in light of attorney's failure to disclose to clients his financial relationship with invention promotion company); *Sheinbein v. Dudas*, 465 F.3d 493, 80 USPQ2d 1537, 1539 (Fed. Cir. 2006) (decision to exclude patent attorney from practicing before the USPTO was proper based on attorney's disbarment in Maryland and the District of Columbia for assisting son to flee the United States to avoid murder investigation); *Klein v. Peterson*, 866 F.2d 412, 9 USPQ2d 1558, 1560 (Fed. Cir. 1989) (patent attorney excluded from practice for certificate of mailing violations); *Moatz v. Colitz*, 68 USPQ2d 1079 (Dir. USPTO 2003) (practitioner suspended for, *inter alia*, aiding others in the unauthorized practice of law, sharing fees with non-practitioners, and handling matter without adequate preparation); *In re Rivera*, 67 USPQ2d 1952, 1954-55 (Dir. USPTO 2003) (reciprocal discipline); *In re Ryznic*, 67 USPQ2d 1115, 1122-23 (Dir. USPTO 2003) (agent suspended for, *inter alia*, prosecuting patent application while employed by USPTO); *In re Cohen*, 66 USPQ2d 1782, 1785 (Dir. USPTO 2003) (practitioner suspended for neglecting client matter and other sanctionable conduct); *Moatz v. Kersey*, 67 USPQ2d 1291, 1294-96 (Dir. USPTO 2002) (practitioner represented private clients while employed by U.S. government and failed to notify USPTO of suspension in other jurisdictions); *Weiffenbach v. Logan*, 27 USPQ2d 1870, 1875 (Comm'r 1993) (patent attorney suspended from practice before USPTO for five years for altering an office action in a patent application and engaging in other unethical conduct); *McCandlish v. Doe*, 22 USPQ2d 1223, 1227 (Comm'r 1992) (patent attorney reprimanded by Commissioner for misrepresenting facts and knowingly allowing documents to remain of record which had been withdrawn).

115.03 Petitions to Disqualify

37 C.F.R. § 11.19(c) *Petitions to disqualify a practitioner in ex parte or inter partes matters in the Office are not governed by §§ 11.19 through 11.60 and will be handled on a case-by-case basis under such conditions as the USPTO Director deems appropriate.*

Petitions to disqualify practitioners representing parties in ex parte or inter partes matters before the Board are not disciplinary proceedings and hence are not governed by 37 C.F.R. § 11.19-37 C.F.R. § 11.60. Rather, petitions to disqualify are handled on a case-by-case basis. *See*TBMP § 114.08 (Adverse Parties Represented by Same Practitioner).

When a petition to disqualify is filed in connection with a proceeding pending before the Board, the Board immediately issues an action suspending proceedings in the case and advising the parties that no additional papers should be filed by the parties until further notice, pending briefing and consideration of the petition.

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

116 Termination of Representation

116.01 Revocation of Authority

37 C.F.R. § 2.19 ***Revocation or withdrawal of power of attorney.***

(a) ***Revocation.***

(1) *Authority to represent an applicant, registrant or party to a proceeding before the Office may be revoked at any stage in the proceedings of a trademark case, upon written notification signed by the applicant, registrant, or party to the proceeding, or by someone with legal authority to bind the applicant, registrant, or party (e.g., a corporate officer or general partner of a partnership). In the case of joint applicants or joint registrants, all must sign.*

(2) *When a power of attorney is revoked, the Office will communicate directly with the applicant, registrant, or party to the proceeding, or with the new attorney or domestic representative if appropriate.*

(3) *A request to change the correspondence address does not revoke a power of attorney.*

(4) *A new power of attorney that meets the requirements of § 2.17(c) will be treated as a revocation of the previous power.*

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

116.02 Withdrawal as Representative--In General

37 C.F.R. § 2.19(b) ***Withdrawal of attorney.*** *If the requirements of § 11.116 of this chapter are met, a practitioner authorized to represent an applicant, registrant, or party to a proceeding in a trademark case may withdraw upon application to and approval by the Director or, when applicable, upon motion granted by the Trademark Trial and Appeal Board. The practitioner should file the request to withdraw soon after the practitioner notifies the client of his/her intent to withdraw. The request must include the following:*

(1) *The application serial number, registration number, or proceeding number;*

(2) *A statement of the reason(s) for the request to withdraw; and*

(3) *Either*

(i) *A statement that the practitioner has given notice to the client that the practitioner is withdrawing from employment and will be filing the necessary documents with the Office; that the client was given notice of the withdrawal at least two months before the expiration of the response period, if applicable; that the practitioner has delivered to the client all documents and property in the practitioner's file concerning the application, registration or proceeding to which the client is entitled; and that the practitioner has notified the client of any responses that may be due, and of the deadline for response; or*

(ii) *If more than one qualified practitioner is of record, a statement that representation by co-counsel is ongoing.*

37 C.F.R. § 11.116 ***Declining or terminating representation.***

(a) *Except as stated in paragraph (c) of this section, a practitioner shall not represent a client, or where representation has commenced, shall withdraw from the representation of a client if:*

(1) *The representation will result in violation of the USPTO Rules of Professional Conduct or other law;*

(2) *The practitioner's physical or mental condition materially impairs the practitioner's ability to represent the client; or*

(3) *The practitioner is discharged.*

(b) *Except as stated in paragraph (c) of this section, a practitioner may withdraw from representing a client if:*

(1) *Withdrawal can be accomplished without material adverse effect on the interests of the client;*

(2) *The client persists in a course of action involving the practitioner's services that the practitioner reasonably believes is criminal or fraudulent;*

(3) *The client has used the practitioner's services to perpetrate a crime or fraud;*

(4) *A client insists upon taking action that the practitioner considers repugnant or with which the practitioner has a fundamental disagreement;*

(5) *The client fails substantially to fulfill an obligation to the practitioner regarding the practitioner's services and has been given reasonable warning that the practitioner will withdraw unless the obligation is fulfilled;*

(6) *The representation will result in an unreasonable financial burden on the practitioner or has been rendered unreasonably difficult by the client; or*

(7) *Other good cause for withdrawal exists.*

(c) *A practitioner must comply with applicable law requiring notice to or permission of a tribunal when terminating a representation. When ordered to do so by a tribunal, a practitioner shall continue representation notwithstanding good cause for terminating the representation.*

(d) *Upon termination of representation, a practitioner shall take steps to the extent reasonably practicable to protect a client's interests, such as giving reasonable notice to the client, allowing time for employment of other counsel, surrendering papers and property to which the client is entitled and refunding any advance payment of fee or expense that has not been earned or incurred. The practitioner may retain papers relating to the client to the extent permitted by other law.*

Under certain circumstances, a practitioner may withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board. A practitioner who wishes to withdraw must file a written request with the Board for permission to do so. The practitioner may not be able to withdraw until he or she has complied with the conditions specified in 37 C.F.R. § 11.116(c)- 37 C.F.R. § 11.116(d).

116.03 When Withdrawal is Mandatory

Withdrawal from employment as the attorney or other representative of a party to a Board proceeding is mandatory under the circumstances specified in 37 C.F.R. § 11.116(a).

116.04 When Withdrawal is Permissive

Withdrawal from employment as the attorney or other authorized representative of a party to a Board proceeding is permissive under the circumstances specified in 37 C.F.R. § 11.116(b).

116.05 Request to Withdraw

A practitioner who wishes to withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board must file a written request with the Board for permission to do so. The request to withdraw must be based upon one of the grounds for mandatory or permissive withdrawal listed in 37 C.F.R. § 11.116(a) and 37 C.F.R. § 11.116(b). Moreover, the practitioner must comply with the requirements of 37 C.F.R. § 11.116(c) and 37 C.F.R. § 11.116(d). [Note 1.]

The propriety of a request for permission to withdraw as counsel in an application that is the subject of a potential opposition is determined by the Board, and not the Trademark Examining Operation. *See*TBMP § 212.01.

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

Please Note: Effective May 3, 2013, the United States Patent and Trademark Office adopted new USPTO RULES OF PROFESSIONAL CONDUCT which are based on the American Bar Association's MODEL RULES OF PROFESSIONAL CONDUCT. Cases decided prior to May 3, 2013 refer to the USPTO RULES CODE OF PROFESSIONAL CONDUCT that was in effect at that time. These earlier cases continue to be instructive.

NOTES:

1. *See* 37 C.F.R. § 2.19(b) and 37 C.F.R. § 11.116; *In re Slack*, 54 USPQ2d 1504, 1505 (Comm'r 2000) (standards and procedure for withdrawal); *In re Legendary Inc.*, 26 USPQ2d 1478, 1479 (Comm'r 1992) (same). *See also SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372, 1374 (TTAB 2001) (request to withdraw may not be used as a subterfuge for an extension of time; request to withdraw and motion to extend filed on last day of testimony period denied).

117 Correspondence - With Whom Held

37 C.F.R. § 2.18 ***Correspondence, with whom held.***

(a) ***Establishing the correspondent.*** *The Office will send correspondence as follows:*

(1) *If the applicant, registrant, or party to a proceeding is not represented by an attorney qualified to practice before the Office under § 11.14(a) of this chapter, the Office will send correspondence to the applicant, registrant, or party to the proceeding.*

(2) *If an attorney is recognized as a representative pursuant to § 2.17(b)(1), the Office will correspond only with that attorney. A request to change the correspondence address does not revoke a power of attorney. Except for service of a cancellation petition, the Office will not correspond directly with the applicant, registrant, or a party to a proceeding, or with another attorney from a different firm, unless:*

(i) *The applicant or registrant files a revocation of the power of attorney under § 2.19(a) and/or a new power of attorney that meets the requirements of § 2.17(c);*

(ii) *The attorney has been suspended or excluded from practicing in trademark matters before the USPTO; or*

(iii) *Recognition of the attorney has ended pursuant to § 2.17(g).*

(b) ***Ex parte matters.*** *Only one correspondence address may be designated in an ex parte matter.*

(c) ***Maintaining and changing the correspondence addresses.*** *The applicant, registrant, or party to a proceeding must maintain current and accurate correspondence addresses, as required by § 2.23, for itself and its attorney, if one is designated. If any of these addresses change, a request to change the address, signed in accordance with § 2.193(e)(9), must be promptly filed.*

(d) ***Post registration filings under sections 7, 8, 9, 12(c), 15, and 71 of the Act.*** *Even if there is no new power of attorney or written request to change the correspondence address, the Office will change the correspondence address upon the examination of an affidavit under section 8, 12(c), 15, or 71 of the Act,*

renewal application under section 9 of the Act, or request for amendment or correction under section 7 of the Act, if a new address is provided, in accordance with paragraph (a) of this section.

37 C.F.R. § 2.24 ***Designation and revocation of domestic of representative by foreign applicant.***

(a) *An applicant or registrant that is not domiciled in the United States may designate a domestic representative (i.e., a person residing in the United States on whom notices or process in proceedings affecting the mark may be served).*

(b) *The designation, or a request to change or revoke a designation, must set forth the name, email address, and postal address of the domestic representative and be signed pursuant to § 2.193(e)(8).*

(c) *The mere designation of a domestic representative does not authorize the person designated to represent the applicant or registrant.*

37 C.F.R. § 2.119(d) *If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, none of the parties to the proceeding is eligible to use the service option under paragraph (b)(4) of this section. The party not domiciled in the United States may designate by submission filed in the Office the name and address of a person resident in the United States on whom may be served notices or process in the proceeding. If the party has appointed a domestic representative, official communications of the Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under § 11.14(c) of this chapter. If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney at law or other qualified person, the Office will send correspondence directly to the party, unless the party designates in writing another address to which correspondence is to be sent. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 11.14(a) of this chapter, or qualified under § 11.14(b) of this chapter and authorized under § 2.17(f).*

117.01 In General

Whenever the Board takes an action in a proceeding before it, the Board sends a copy of the action to each party or to the party's attorney. For an unrepresented party, such correspondence will be sent to the party at the party's address of record in the proceeding, which may be updated by the party by designating in writing another address to which correspondence is to be sent. If an appearance is made on behalf of the party by an attorney (as defined in 37 C.F.R. § 11.1), or a written power of attorney is filed, the Board will send correspondence to the attorney who makes the appearance, or to the attorney designated in the power of attorney. [Note 1.] If there is no attorney of record for a foreign-domiciled party, but a domestic representative has been appointed, correspondence will be sent to the domestic representative until an attorney is appointed. [Note 2.]

If the Board has an email address for Board correspondence with a party, notice of all Board actions will be sent by email. [Note 3.] A "hard copy" may not be sent by postal mail. For applications filed prior to February 15, 2020, an email address for Board correspondence will be obtained in the case of an applicant in an ex parte appeal or in an opposition if the applicant had previously supplied an email address in connection with the prosecution of the subject application and had authorized the Office to communicate with applicant by email. For applications filed on or after February 15, 2020, the Board will obtain and use the valid email address required to be provided by all applicants and registrants that are not exempted by treaty or by any appointed attorney for receipt of correspondence from the USPTO. [Note 4.] In all other cases, the Board will obtain an email address for a party when that party files correspondence with the Board using ESTTA, or files a change of correspondence address specifying an email address.

The Board considers the submission of filings using ESTTA as consent to the Board's sending notice of Board actions by email. Unlike the case with paper correspondence, a party may designate more than one email address (separated by commas, up to a limit of 800 characters) for receipt of notice of Board actions. Because notice of Board actions will not always be sent by both electronic and postal mail, it is essential that parties filing electronically with the Board adjust their email "spam" filters to always accept messages from the USPTO domain (uspto.gov). The USPTO webpage entitled "Don't Miss Important E-mails from the USPTO: Add the USPTO to your 'Safe Senders' list" at https://www.uspto.gov/trademark/trademark-updates-and-announcements/dont-miss-important-e-mails-uspto includes instructions to ensure that USPTO emails reach the recipient.

If the Board does not have an email address for Board correspondence with a party, a copy of any Board action taken in the case will be sent to that party by postal mail at the party's address of record.

The mailing of correspondence in accordance with standard Office mailing procedures creates a presumption of receipt of correspondence. [Note 5.]

NOTES:

1. *See Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1079-1080 (TTAB 1992) (new power of attorney filed); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1614 n.1 (TTAB 1991) (appearance made by filing motion in the proceeding).

2. *See* 37 C.F.R. § 2.18(b) (changing the correspondence address). *See, e.g.*, *Equine Touch Foundation Inc. v. Equinology Inc.*, 91 USPQ2d 1943, 1944 n.3 (TTAB 2009) (noting that although counsel filed an answer for respondent, the ESTTA cover sheet generated in filing the answer still listed the correspondence address as respondent rather than counsel and that "[i]f counsel intends to represent respondent throughout the remainder of this proceeding, counsel should file a change of correspondence address to list himself and his address as the address for correspondence from the Board and future service copies from petitioner.").

3. CHANGES TO THE TRADEMARK RULES OF PRACTICE TO MANDATE ELECTRONIC FILING, 84 Fed. Reg. 37081, 37082 (July 31, 2019) ("This rule requires applicants and registrants, and parties to a proceeding before the TTAB, to provide and maintain an email address for correspondence.").

4. CHANGES TO THE TRADEMARK RULES OF PRACTICE TO MANDATE ELECTRONIC FILING, 84 Fed. Reg. 37081, 37082-84 (July 31, 2019); CHANGES TO THE TRADEMARK RULES OF PRACTICE TO MANDATE ELECTRONIC FILING, 84 Fed. Reg. 69330, 69330 (Dec. 18, 2019) (delay of effective date to February 15, 2020).

5. *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1953 (TTAB 1997).

117.02 When There is More Than One Attorney or Other Appointed Practitioner

If a party has supplied a list of email addresses for correspondence with the Board, notice of any Board action will be sent as a courtesy to each of the email addresses supplied. The email address for the party, if the party is not represented, or for the party's attorney if the party is represented, is the official correspondence email for purposes of the Board proceeding. *See*TBMP § 117.01.

With respect to postal mail, the Board ordinarily will not undertake double correspondence, that is, the sending of paper correspondence to two addresses on behalf of a single party. If more than one attorney or

other appointed practitioner makes an appearance on behalf of a party, the papers filed by the additional attorney(s) or other practitioner(s) will be accepted, but the Board will send paper correspondence to only one of them, to be determined according to the circumstances in the case. [Note 1.]

If a power of attorney names more than one individual, and does not specify which of them is to have primary responsibility for the case and receive correspondence, the name(s) of the individual attorney(s) in the signature block of the covering transmittal letter will be used by the Board on the proceeding file, on correspondence for the party, and on the final decision of the Board, to identify counsel for the party, unless the party or one of the named attorneys requests otherwise in writing. If there is no transmittal letter, and no other indication as to which of the named attorneys is to have primary responsibility for the case and receive correspondence, the name of the first listed attorney will be used by the Board on the proceeding file, in the Board's electronic databases (e.g., TTABVUE), on correspondence for the party, and on the Board's final decision, unless the party or one of the named attorneys requests otherwise in writing.

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

For example, if one attorney ("A") makes an appearance on behalf of a party, and his or her address is thus established in the proceeding file as the correspondence address, following which a second attorney ("B") makes an appearance on behalf of the party, and files a written request that correspondence be sent to him or her, the correspondence address in the proceeding file will be changed, and future correspondence will be sent to B, rather than A. No requirement will be made that B submit authorization, from the party or from A, for the change of correspondence address, nor will B be required to serve a copy of the request upon A. If B does not file a written request that correspondence be sent to him or her, correspondence will continue to be sent to A.

If a power of attorney from a party to one attorney ("A") has been filed, and thereafter a power of attorney from the party to another attorney ("B") is filed, the second power of attorney will be construed, even if there is no revocation of the first power, as a written request to change the correspondence address from A to B, unless the party or A directs otherwise. [Note 2.] Likewise, if an attorney makes an appearance on behalf of a party, and thereafter the party files a written power of attorney to another attorney, the Board will send subsequent correspondence to the appointed attorney.

If a power of attorney from a party to one attorney ("A") has been filed, and thereafter A files an "associate power of attorney" to another attorney ("B"), the correspondence address will remain unchanged, and the Board will continue to send correspondence to A, unless A or the party directs otherwise. [Note 3.]

If a power of attorney from a party to several attorneys ("A," "B," and "C") in the same firm ("XYZ") has been filed, and thereafter A leaves the firm but does not file a request that all future correspondence be sent to him or her, rather than to B and/or C, the Board will continue to send correspondence to B and/or C. If A, after leaving firm XYZ, does file a request that all future correspondence be sent to him or her, rather than to B and/or C, the correspondence address will be changed as requested. If, however, B and C object, and maintain that it is they, rather than A, who continue to represent the party and are entitled to receive correspondence, proceedings in the case will be suspended until a designation of correspondence address by the party has been submitted.

If oppositions or petitions for cancellation filed by different opposers or petitioners against the same application or registration are consolidated, or if an opposition or petition for cancellation is filed by joint opposers or petitioners, and the different plaintiffs are represented by different attorneys or other authorized representatives, rather than by the same one(s), the plaintiffs must appoint one lead counsel, to whom the Board may send postal correspondence intended for the plaintiffs. [Note 4.] After the lead counsel has been appointed for postal correspondence, the Board will send a copy of any Board order, decision, or other communication to plaintiff's lead counsel and to the applicant or its attorney. Lead counsel in turn will be responsible for making and distributing postal copies of such Board correspondence to each plaintiff or its attorney. In these cases, the lead counsel is not substituted for the separate counsel of each plaintiff, but rather is responsible for coordinating the conduct of the plaintiffs' cases. However, by designating more than one email address (separated by commas, up to a limit of 800 characters) for receipt of notice of Board actions, all representatives may receive electronic correspondence from the Board.

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

NOTES:

1. *See* 37 C.F.R. § 2.18.

2. *See*TMEP § 604.03.

3. *See*TMEP § 605.03.

4. *Cf. Internet Inc. v. Corp. for National Research Initiatives*, 38 USPQ2d 1435, 1436 n.2 (TTAB 1996) (in three proceedings where defendant in one case was one of two plaintiffs in the two other cases, and where each plaintiff retained separate counsel, Board indicated that it would send correspondence to attorneys for the plaintiff which was a party to all three cases unless otherwise advised).

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

In the case of a party whose application is the subject of a Board proceeding, any appearance or power of attorney (or designation of other appointed practitioner) of record in the application file at the time of the commencement of the Board proceeding is considered to be effective for purposes of the proceeding, and correspondence will be sent initially to that address, [Note 1] including applicant's email address, if electronic communication with the Office has been authorized or if designation of an email address for correspondence is now required by the Office. Thereafter, the correspondence address may be changed in appropriate circumstances.

However, in the case of a party whose registration is the subject of a proceeding before the Board, any representation which may be of record in the registration file at the time of the commencement of the Board proceeding is not considered to be effective for purposes of the Board proceeding. Rather, correspondence is sent to the registrant itself or its domestic representative unless and until an attorney makes an appearance in the Board proceeding in the registrant's behalf, or a written power of attorney is filed in the proceeding by the registrant, or the registrant requests in writing to change its address. [Note 2.]

Changes of attorney addresses or powers of attorney in registration files are accepted by the Office when submitted with post-registration filings, such as those under Trademark Act § 7, Trademark Act § 8, Trademark Act § 9 or Trademark Act § 15, 15 U.S.C. § 1057, 15 U.S.C. § 1058, 15 U.S.C. § 1059 or 15 U.S.C. § 1065, as well as in a cancellation or concurrent use proceeding before the Board. The attorney representing the registrant is responsible for insuring that registrant's correspondence addresses are updated. The Office accepts separate written address changes for registrants and domestic representatives, but global changes of address (when one paper is filed listing all involved registrations) will not be effective in changing the address in each file. However, a single TEAS form for recording a change of address, found at **www.uspto.gov/teas/e-TEAS/index.html**, can be used to notice a change of address for more than one application or registration. The TEAS form can be used to change the correspondence address only on applications or registrations that are currently active. [Note 3.]

NOTES:

1. 37 C.F.R. § 2.105(c). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69954 (October 7, 2016). ("For opposition proceedings, the terminology 'email or correspondence address of record' in the rule refers to 'correspondence address' as it is used throughout the Rules of Practice in Trademark Cases (e.g., §§ 2.18, 2.21, 2.22, 2.23) and the addition of 'email' merely highlights that an email correspondence address may be used when authorized.").

2. 37 C.F.R. § 2.113(c), 37 C.F.R. § 2.18. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69954 (October 7, 2016). ("The Office plans to effect service using the 'Current Owner Information' field or, if one has been appointed, the 'Domestic Representative Information' field in the USPTO's TSDR database.").

3. TMEP § 609.02(b).

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

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

117.05 Correspondence After Revocation or Withdrawal

If the authority of an attorney or other authorized representative to represent a party in a proceeding before the Board is revoked, or the practitioner is granted permission to withdraw upon request therefor to the Board, and the party is not represented by any other practitioner, correspondence will be sent to the party at its address of record unless another practitioner puts in an appearance, or a written appointment of another practitioner is filed, or the party designates in writing another address to which correspondence is to be sent.

117.06 Correspondence With Foreign Party

If a party to a Board proceeding is not domiciled in the United States and is not represented by an attorney who is licensed to practice law in the United States, correspondence will be sent to the party's domestic representative, if one has been appointed. However, a domestic representative cannot represent a party in Board proceedings. [Note 1.] If the party has not appointed a domestic representative and a U.S. licensed attorney has not yet been appointed in the proceeding, the Office will send correspondence directly to the party at the address of record for the party, which the party may request in writing to change. [Note 2.]

Please Note: Effective August 3, 2019, the Office amended 37 C.F.R § 2.11(a) to require foreign-domiciled applicants, registrants, or parties to a trademark proceeding to be represented by an attorney who is licensed to practice law in the United States. If a foreign-domiciled party appears without an attorney, generally, the Board will suspend the proceedings and inform the party of the time frame within which it must appoint a U.S. licensed attorney. [Note 3.]

NOTES:

1. *See*TMEP § 610.

2. *See* 37 C.F.R. § 2.119(d).

3. *See Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC* , 2020 USPQ2d 10019, at *1 (TTAB 2020) (Board suspended proceedings pending appointment of United States counsel). *See also* Requirement of U.S.-Licensed Attorney for Foreign-Domiciled Trademark Applicants and Registrants, Trademark Examination Guide 4-19 (Revised) at 8 (September 2019), available at www.uspto.gov.

117.07 Change of Address

If a party to a Board proceeding or its attorney or other authorized representative moves or changes its postal address or email address, a separate notice of the change of address or email address should be filed with the Board using ESTTA, and should reference the proceeding number. [Note 1.] It is the responsibility of a party to a proceeding before the Board to ensure that the Board has the party's current correspondence address, including an email address. If a party fails to notify the Board of a change of address, with the result that the Board is unable to serve correspondence on the party, default judgment may be entered against the party.

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

The best practice is to promptly file a separate change of address with the Board when the correspondence address, including an email address, for any party to a Board proceeding changes. [Note 2.]

NOTES:

1. *See* 37 C.F.R. § 2.126(a).

2. *See* 37 C.F.R. § 2.18(c).

117.08 Individual Not Entitled to Represent Others

An individual who is not entitled, under 37 C.F.R. § 11.14(a), 37 C.F.R. § 11.14(b), 37 C.F.R. § 11.14(c) or 37 C.F.R. § 11.14(e), to practice before the Office in trademark cases, will not be permitted to represent a party in a proceeding before the Board, and may not file submissions on behalf of the party. [Note 1.] If it comes to the attention of a Board attorney that such an individual is attempting to represent a party in a Board proceeding, the Board attorney will bring the matter to the attention of the Chief Administrative Trademark Judge, who will coordinate appropriate action with the Office of Enrollment and Discipline. Moreover, no Board correspondence intended for the party will be sent to the individual. Rather, the Board will send such correspondence to the party itself, or to the party's attorney . [Note 2.] However, under certain circumstances, where a submission is signed by an individual not authorized to practice before the Office, the Board may allow time to cure the signature defect. [Note 3.] *See also*TBMP § 114.06.

NOTES:

1. *See*TMEP § 602 (Person Authorized to Practice Before USPTO in Trademark Matters).

2. *See* 37 C.F.R. § 2.18.

3. *See, e.g., Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905 (TTAB 2014) (Board applies opportunity to cure provision in 2.119(e) to improperly signed papers, which defines the time period for cure as "within the time limit set in the notification of this defect by the Office").

118 Payment of Fees

118.01 Lists of Fees and Charges

A list of the fees and charges established by the USPTO for trademark cases may be found in 37 C.F.R. § 2.6, and online at the USPTO's website, **www.uspto.gov**. A list of fees and charges established by the USPTO for miscellaneous services may be found in 37 C.F.R. § 1.21, as well as on the USPTO website.

A list of fees and charges for processing correspondence relating to international applications and registrations under the Madrid Protocol may be found in 37 C.F.R. § 7.6 as well as on the USPTO website. International fees that may be paid to the International Bureau of the World Intellectual Property Organization through the Office in connection with international applications and registrations may be found in 37 C.F.R. § 7.7 as well as on the WIPO website, www.wipo.int.

118.02 Fees Payable in Advance

37 C.F.R. § 2.206 ***Trademark Fees payable in advance.***

(a) *Trademark fees and charges payable to the Office are required to be paid in advance; that is, at the time of requesting any action by the Office for which a fee or charge is payable.*

(b) *All fees paid to the Office must be itemized in each individual trademark application, or registration file, or trademark proceeding, so the purpose for which the fees are paid is clear. The Office may return fees that are not itemized as required by this paragraph.*

118.02(a) Fees for Extensions of Time for Filing an Opposition

37 C.F.R. § 2.102 ***Extension of time for filing an opposition.***

(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. The request need not be verified, but must be signed by the potential opposer or by the potential opposer's attorney, as specified in § 11.1 of this chapter, or authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for electronically filed extension requests.*

(1) *A request to extend the time for filing an opposition to an application must be filed through ESTTA by the opposition due date set forth in § 2.101(c). In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a request to extend the opposition period for an application based on Section 1 or 44 of the Act may be filed in paper form by the opposition due date set forth in § 2.101(c). A request to extend the opposition period for 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.*

(2) *A paper request to extend the opposition period for an application based on Section 1 or 44 of the Act must be filed by the due date set forth in § 2.101(c) and be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under paragraph (a)(1) of this section. Timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.*

(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.*

(c) * * *

(1) *A person may file a first request for:*

(i) *Either a thirty-day extension of time, which will be granted upon request; or*

(ii) *A ninety-day extension of time, which will be granted only for good cause shown. A sixty-day extension is not available as a first extension of time to oppose.*

(2) *If a person was granted an initial thirty-day extension of time, that person may file a request for an additional sixty-day extension of time, which will be granted only for good cause shown.*

(3) * * * No other time period will be allowed for a final extension of the opposition period.

* * *

(d) *The filing date of a request to extend the time for filing an opposition is the date of electronic receipt in the Office of the request. In the rare instance that filing by paper is permitted under these rules, the filing date will be determined in accordance with §§ 2.195 through 2.198*

Certain extensions of time to oppose an application for registration require payment of a fee. All required fees for extensions of time to oppose are per application fees, not per class fees, and must be tendered with the extension request.

There is no fee for an initial thirty-day extension request. There is a per application fee for filing a second request of sixty days or for an initial request of ninety-days for an extension of time to oppose. [Note 1.] There also is a per application fee for filing a final sixty-day request for extension of time to oppose after one or two requests totaling 120 days from the date of publication. [Note 2.]

The fees for an extension of time to oppose are higher for paper submissions. Petition fees are applicable to all requests for extensions of time to oppose filed on paper. [Note 3.]

When a request for extension of time to oppose is filed using ESTTA, as required, the correct fee will be calculated and payment must be made before the filing will be transmitted to the USPTO. Note that in order for fees to be properly calculated, each potential opposer must be entered separately. [Note 4.]

NOTES:

1. 37 C.F.R. § 2.6(a)(22)(ii).

2. 37 C.F.R. § 2.6(a)(23)(ii).

3. 37 C.F.R. § 2.102(a)(2); 37 C.F.R. § 2.6(a)(22)(i); 37 C.F.R. § 2.6(a)(23)(i); 37 C.F.R. § 2.6(a)(15).

4. *Cf. Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (multiple opposers not entered separately in ESTTA, resulting in improper fee being calculated and paid).

118.02(b) Fees for Opposition and Cancellation Proceedings

37 C.F.R. § 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) *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. The opposition need not be verified, but must be signed by the opposer or the opposer'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 oppositions filed through ESTTA under paragraph (b)(1) or (2) of this section.*

(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. 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.*

(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 C.F.R. § 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.*

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

(2)(i) *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.*

(ii) *For a petition to cancel a registration on the fifth year anniversary of the date of registration of the mark, a petitioner for cancellation who meets the requirements of § 2.147(b) may submit a petition to the Director to accept a timely filed paper petition to cancel.*

(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 filing fee for an opposition or cancellation proceeding must be tendered with the notice of opposition or petition for cancellation. A notice of opposition or petition for cancellation filed without a filing fee will not be accorded a filing date. [Note 1.]

When a notice of opposition or petition for cancellation is filed using ESTTA, the correct fee will be calculated and payment must be made before the filing will be uploaded to the USPTO for processing. Note that in order for fees to be properly calculated, each opposer or petitioner must be entered separately. [Note 2.]

If an otherwise timely notice of opposition or petition for cancellation is submitted on paper with less than the full fee due for each party opposer or party petitioner and for each class opposed or sought to be cancelled, the proceeding may not be instituted. [Note 3.] A paper filing of a notice of opposition or petition to cancel must be accompanied by a Petition to the Director, with required fee, and a showing that ESTTA is unavailable due to technical problems, or extraordinary circumstances are present. [Note 4.] Petitions to file on paper generally are subject to 37 C.F.R. § 2.146, including the requirement for verified facts. [Note 5.] However, a Petition to the Director to accept paper submission of a petition to cancel a registration on the fifth year anniversary of the date of registration is subject to the requirements of 37 C.F.R. § 2.147(b), including the requirement for a declaration under 37 C.F.R. § 2.20 or 28 U.S.C. § 1746. [Note 6.]

Please Note: Effective January 2, 2021, the USPTO revised 37 C.F.R § 2.114(a) to provide that a partial refund of the fee for a petition to cancel may be made in cases based solely on abandonment or nonuse where default judgment is entered because there is no appearance by a defendant and no filings are made other than the petition to cancel. [Note 7.]

For information regarding the fees for filing a notice of appeal, an appeal brief, or a request for an extension of time to file an appeal brief in an ex parte appeal, see TBMP § 1202.04and TBMP § 203.02(a).

NOTES:

1. 37 C.F.R. § 2.101(d) and 37 C.F.R. § 2.111(d).

2. *See Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (multiple opposers not entered separately in ESTTA, resulting in improper fee being calculated and paid; opposition considered to be properly filed by first-named opposer only).

3. 37 C.F.R. § 2.101(d) and 37 C.F.R. § 2.111(d).

4. 37 C.F.R. § 2.101(b)(2) and 37 C.F.R. § 2.111(c)(2).

5. 37 C.F.R. § 2.101(b)(2); 37 C.F.R. § 2.111(c)(2)(i).

6. 37 C.F.R. § 2.111(c)(2)(ii).

7. 37 C.F.R § 2.114(a)(2). *See* TRADEMARK FEE ADJUSTMENT, 85 Fed. Reg. 73197, 73210-11 (Nov. 17, 2020), effective January 2, 2021.

118.02(c) Fee for Filing a Request for an Oral Hearing before the Board

A party that wishes to have an oral hearing in a Board inter partes proceeding or ex parte appeal must submit a request, by separate submission via ESTTA, along with the filing fee, not later than 10 days after the due date for filing the last reply brief. [Note 1.] *See*TBMP § 802.02.

NOTES:

37 C.F.R § 2.6(a)(24). *See* TRADEMARK FEE ADJUSTMENT, 85 Fed. Reg. 73197, 73210 (Nov. 17, 2020), effective January 2, 2021.

118.03 Method of Payment--In General

37 C.F.R. § 2.207 ***Method of payment.***

(a) *All payments of money required in trademark cases, including fees for the processing of international trademark applications and registrations that are paid through the Office, shall be made in U.S. dollars and in the form of a cashier's or certified check, Treasury note, national bank note, or United States Postal Service money order. If sent in any other form, the Office may delay or cancel the credit until collection is made. Checks and money orders must be made payable to the Director of the United States Patent and Trademark Office. (Checks made payable to the Commissioner of Patents and Trademarks will continue to be accepted.) Payments from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent to the Office by mail will be at the risk of the sender, and letters containing money should be registered with the United States Postal Service.*

(b) *Payments of money required for trademark fees may also be made by credit card except for replenishing a deposit account. Payment of a fee by credit card must specify the amount to be charged to the credit card and such other information as is necessary to process the charge, and is subject to collection of the fee. The Office will not accept a general authorization to charge fees to a credit card. If credit card information is provided on a form or document other than a form provided by the Office for the payment of fees by credit card, the Office will not be liable if the credit card number becomes public knowledge.*

Filers using ESTTA to file submissions with the Board online will be prompted to pay any necessary fees as a part of the ESTTA filing process. When paying a fee through ESTTA, filers may utilize a credit card, electronic funds transfer, or a USPTO deposit account.

In the rare instances that the rules permit filing by paper, it is also the practice of the Office to accept, as "conditional" payment of a fee, a signed uncertified check. If such a check is returned for insufficient funds, the fee remains unpaid, and the filing date of the fee will be the filing date of any resubmitted adequate payment. [Note 1.] An unsigned check will be returned to its sender, but the Director has the discretion to accept such a check, as "conditional" payment, upon petition showing sufficient cause therefor. [Note 2.]

The Office cannot accept U.S. Treasury checks that have been issued to the applicant or to another party as payment of Office fees. This is true for all refund checks whether issued from the Office or any other government agency. Office rules require that money orders and checks be made payable to the Director of Patents and Trademarks and do not permit the acceptance of U.S. Treasury checks endorsed by the applicant in payment of fees.

NOTES:

1. *See In re Cantatore*, 231 USPQ 742, 744 (Comm'r 1986) (petition to revive was denied because filing fee check was returned for insufficient funds).

2. *See Dubost v. U.S. Patent and Trademark Office*, 777 F.2d 1561, 227 USPQ 977, 980 (Fed. Cir. 1985) (Office has discretion), *on remand*, *In re Dubost*, 231 USPQ 887, 889 (Comm'r 1986) (sufficient cause not shown).

118.04 Method of Payment--Deposit Accounts

For the convenience of attorneys and the general public in paying fees and charges to the Office, deposit accounts may be established in the Office. [Note 1.] The Office has an automated financial system, USPTO Financial Manager, allowing transactions to occur over the Internet through the Office website at **www.uspto.gov**. Deposit accounts can be maintained through the Internet and funds replenished by check or electronic funds transfer. [Note 2.] A deposit account may be used for payment of any necessary fee when filing online using ESTTA, or when necessary to file paper documents.

The fees for filing an ex parte appeal to the Board, certain extensions of time to oppose an application, an opposition, and a petition for cancellation, may all be charged to a deposit account, provided that the requirements of 37 C.F.R. § 2.208 are met. However, the charging of a fee against an account that does not contain sufficient funds to cover it cannot be regarded as payment of the fee. [Note 3.] Thus, the overdrawing of a deposit account may result in the loss of a vital date.

The Office will not accept ex parte appeals if the notice of appeal is not accompanied by at least the minimum fee for one class or specific authorization to charge the deposit account for that fee, as opposed to a general authorization which may have been provided when the application was filed. A general authorization to charge a deposit account will only be effective upon petition to the Director. [Note 4.] Because the general authorization can only be invoked on petition, the Board itself cannot accept the general authorization as a basis for treating the appeal fee as timely submitted.

NOTES:

1. *See* 37 C.F.R. § 2.208 (Deposit accounts).

2. 37 C.F.R. § 2.208(c).

3. *See* 37 C.F.R. § 2.208(b).

4. *In re Sky is the Ltd.*, 42 USPQ2d 1799, 1800 (Comm'r 1996) ("Requiring the Office mailroom and the ITU/Divisional Unit of the Office to check each application file for a general authorization to charge a deposit account would place an undue and unmanageable burden on those sections of the Office.").

119 Papers and Fees Generally Not Returnable

119.01 Fee Refunds--General Rule

37 C.F.R. § 2.209 ***Refunds.***

(a) *The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a trademark application, appeal or other trademark filing for which the fee was paid, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. § 3332 and 31 C.F.R. part 208), or instruct the Office that refunds are to be credited to a deposit account, the Director may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.*

(b) *Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph. If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 2.208(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.*

119.02 Submissions and Fees--Ex Parte Cases

After an application has received a filing date, submissions filed in connection therewith, including ex parte appeal papers, will not be returned. [Note 1.] Use of ESTTA for filing with the Board is required. ESTTA will not accept untimely filings or filings with insufficient fees.

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

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

NOTES:

1. *See* 37 C.F.R. § 2.25 (Documents not returnable).

119.03 Submissions and Fees--Inter Partes Cases

In the rare instances that filings by paper are permitted under the rules, after an inter partes proceeding before the Board has been filed, paper submissions and other materials filed in connection therewith, normally will not be returned. Paper submissions filed by mail or hand delivery are scanned. After a short period of

retention following filing and scanning, the Board disposes of the paper submissions. Following the conclusion of a proceeding, including any appeal period, any physical materials submitted will be disposed of by the Board in an appropriate manner. *See*TBMP § 806 (Termination of Proceeding). The Board will retain electronic versions of all submissions pursuant to USPTO document retention policies. Confidential submissions will remain sealed after termination of the proceeding. If, because of a defect in an opposition or a petition for cancellation filed with the Board, a proceeding is not instituted, any submitted fee will be refunded.

Use of ESTTA for filing with the Board is required. ESTTA will not accept untimely filings, filings with insufficient fees, or filings where any of the conditions identified below exist. 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 C.F.R. § 2.146 and the required fee. [Note 1.] A Petition to the Director to accept paper submission of a petition to cancel a registration on the fifth year anniversary of the date of registration is subject to the requirements of 37 C.F.R. § 2.102(b), including the requirement for a declaration under 37 C.F.R. § 2.20 or 28 U.S.C. § 1746. [Note 2.]

In the rare circumstances where filing by paper is permitted under the rules, no proceeding will be instituted, and any submitted filing fee 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 C.F.R. § 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.

(2) If an opposition or a petition for cancellation is filed prematurely (i.e., prior to publication of the subject mark in the Official Gazette for purposes of opposition, or prior to issuance of a registration of the subject mark, respectively, even if the registration has issued by the time of the Board's action).

(3) If an opposition is filed after the time for opposing has expired; or, is filed unsigned, and a signed copy is not submitted within the time limit set in the notification of this defect by the Board; or is filed without the required fee; or if the opposed application was abandoned before the opposition was filed. *See*TBMP § 218 (Abandonment of Application).

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 under 37 C.F.R. § 2.146, or where applicable, 37 C.F.R. § 2.147 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 for a permitted filing in paper form in the following circumstances:

(1) If a petition to cancel a Principal Register registration that is more than five years old does not allege any ground upon which such a registration can be cancelled (*see* Trademark Act § 14, 15 U.S.C. § 1064), the cancellation will be instituted and the Board will issue an order to show cause why the petition should not be dismissed for failure to state a claim. Note that when filing a petition for cancellation online using ESTTA, time-barred grounds for cancellation are not presented as an option.

(2) If a petition for cancellation is filed with respect to a registration which, at the time of the filing of the petition, was not a "live" registration (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.

(3) If a party files an opposition or a petition for cancellation, and immediately thereafter changes its mind, and requests that the opposition or petition for cancellation not be instituted and that the papers be returned, the request ordinarily will be denied, and the proceeding will be instituted, unless there is a defect in the opposition or petition for cancellation which precludes institution, in which case no proceeding will be instituted, and any submitted fee will be refunded.

When the Board finds that it erroneously instituted a proceeding, the proceeding will be dismissed as a nullity. A refund will be issued in most circumstances involving dismissal as a nullity (e.g., institution of duplicate proceedings). All submissions will be retained by the Board under the assigned proceeding number, pursuant to the applicable retention policy.

NOTES:

1. 37 C.F.R. § 2.101(b)(1); 37 C.F.R. § 2.101(b)(3); 37 C.F.R. § 2.101(b)(2); 37 C.F.R. §2.101(d); 37 C.F.R. §2.113(c)(1); 37 C.F.R. §2.111(c)(2).

2. 37 C.F.R. § 2.111(c)(2)(ii).

120 Access to Files

37 C.F.R. § 2.27(d) *Except as provided in paragraph (e) of this section, the official records of applications and all proceedings relating thereto are available for public inspection and copies of the documents may be furnished upon payment of the fee required by § 2.6.*

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

120.01 Non - confidential Files

Except for materials filed under seal pursuant to a protective order or agreement, all pending Board proceeding files and exhibits thereto are available for public inspection and copying. [Note 1.] Most Board records since 2001 are electronic. The electronic records of the Board are accessible via TTABVUE on the Board's home page of the USPTO website at http://ttabvue.uspto.gov /. The electronic record of applications and registrations, which are the subject matter of pending proceedings before the Board, and extensions of time to oppose are accessible via the Internet at http://tsdr.uspto.gov/.

Board records submitted prior to approximately 2001 are kept in paper. An individual who wishes to inspect or copy one of the paper files is directed to the National Archives and Records Administration, www.archives.gov/research.

NOTES:

1. *See* 37 C.F.R. § 2.27.

120.02 Confidential Materials

Materials filed with the Board under seal pursuant to the Board's standard protective order, or a protective agreement signed by the parties, or a protective order entered by the Board or any court and filed in compliance with TBMP § 412.04, will be kept confidential and will not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. [Note 1.] These materials may be inspected only by those individuals who are entitled, under the terms of the protective order, to have access to the protected information. [Note 2.] *See* TBMP § 412. (Protective Orders), TBMP § 526 (Motion for Protective Order), TBMP § 703.01(p) (Confidential or Trade Secret Material). To be handled as confidential, and kept out of the public record, confidential materials must be so designated at the time of filing. Regardless of submission method, all submissions in Board proceedings which are not properly designated as confidential will be placed in the Board's public records, available on the Internet in TTABVUE.

When using ESTTA, the filer should select "CONFIDENTIAL Opposition, Cancellation or Concurrent Use" under "File Documents in a Board Proceeding." [Note 3.] Filings made using this option will not be made available for public viewing, although an entry will be made on the publicly-available docket sheet in TTABVUE.

If a paper submission contains confidential material, it must be submitted under separate cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. Paper submissions are scanned into TTABVUE and designated "confidential." After scanning and designating as "confidential," the Board retains the confidential paper submissions for a short period of time before disposing of the confidential paper submissions in an appropriate manner.

The parties are strongly discouraged from submitting materials which contain the personally identifiable information of an individual (e.g., account numbers, social security number, home addresses, and home phone numbers). The parties are also discouraged from submitting unnecessary information (e.g., payroll) that may lead to identity theft or other fraudulent use of such information, even where such information concerns a business but may not be addressed in either the Board's standard protective order or a stipulated protective agreement between the parties. If such information is embedded in the materials being submitted, such privacy information is to be redacted. [Note 4.]

Except for materials filed under seal pursuant to a protective order or agreement, all Board proceeding files and exhibits thereto are available for public inspection and copying. Therefore, only the particular discovery responses, exhibits, deposition transcript pages, or those portions of a brief, pleading or motion that disclose confidential information should be filed under seal pursuant to a protective order. [Note 5.] A good practice would be to clearly mark as "confidential" each page of a submission that contains such matter.

However filed, if a party submits any brief, pleading, motion or other such filing containing confidential information under seal, the party must also submit for the public record a redacted version of said submissions. [Note 6.]

NOTES:

1. *See* 37 C.F.R. § 2.116(g) ("The Trademark Trial and Appeal Board's standard protective order is automatically imposed in all inter partes proceedings, unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. The standard protective order is available at the Office's Web site."); 37 C.F.R. § 2.27(e). *See also AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at *4 (TTAB 2020) ("Confidential filings are accessible only by the Board.")

2. *See* 37 C.F.R. § 2.27(e); 37 C.F.R. § 2.120(f); 37 C.F.R. § 2.125(f).

3. *See* http://estta.uspto.gov/filing-type.jsp. This option is only available for filing documents in an existing opposition, cancellation, or concurrent use proceeding. Since a notice of opposition or petition for cancellation provides only notice of a claim and general facts in support of it, there should rarely, if ever, be occasion to file confidential material with a notice or petition. The existence of the proceeding itself will not be treated as confidential.

4. *See United States Polo Association v. David McLane Enterprises, Inc.*, 2019 USPQ2d 108442, at *5, 9-10 (TTAB 2019) (names, addresses, phone numbers, and email addresses of third parties is personally identifying information that may be designated as confidential under the Board's standard protective order).

5. *See* 37 C.F.R. § 2.126(c); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000). *See also ProMark Brands, Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1238 n.24 (TTAB 2015) (party allowed time to resubmit deposition transcript separating the confidential testimony from nonconfidential testimony).

6. *See* 37 C.F.R. § 2.126(c).

120.03 Files of Terminated Proceedings

When an inter partes proceeding has been finally determined, i.e., when the proceeding is over (including the resolution of any direct court review), the Office takes certain further steps based on the final decision, including those steps necessary to give effect to the decision. This process is referred to as the "termination" of the proceeding. *See*TBMP § 806 (Termination of Proceeding).

The official records for all Board proceedings are now kept electronically. The electronic files of all Board proceedings continue to remain available online through TTABVUE after termination.

Pursuant to the National Archives retention schedule, terminated inter partes proceeding file records are transferred to the National Archives after 5 years for permanent retention.

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

An individual who wishes to inspect or copy a paper file is directed to the National Archives and Records Administration, www.archives.gov/research.

121 Copying of Files

Most records filed in Board proceedings since 2001 are kept electronically. An individual who wishes to inspect or copy one of the paper files is directed to the National Archives and Records Administration, www.archives.gov/research. Paper submissions are scanned into TTABVUE. After scanning, the Board retains the paper submissions for a short period of time before disposing of the paper submissions in an appropriate manner. *See* TBMP § 120.02.

The electronic files of the Board are accessible on the Internet via TTABVUE. [Note 1.] The electronic files of applications and registrations which are the subject matter of pending proceedings before the Board are accessible online via TSDR. [Note 2.] Both TTABVUE and TSDR permit users to view, download, and print non-confidential portions of applications, registrations, and Board proceedings.

The U.S. Patent and Trademark Office Certified Copy Center will furnish certified copies of trademark application and registration files, or of one or more papers therefrom, or of papers from the files of Board proceedings, upon written request and payment of the fee prescribed in 37 C.F.R. § 2.6. The Office will also furnish, upon written request and payment of the fee prescribed in 37 C.F.R. § 2.6, printed copies of trademark registrations, certified copies of registrations with information as to the current status and title of the registration, and abstracts of title to trademark applications and registrations.

All requests for certified copies of trademark documents relating to applications or registrations, including copies of papers from the files of Board proceedings, and abstracts of title, are handled by the USPTO Certified Copy Center. Copies can be ordered online at http://certifiedcopycenter.uspto.gov/. Customer service is available by telephone at (571) 272-3150 or (toll free) (800) 972-6382, Monday through Friday between 8:30 a.m. and 5 p.m. ET, and by email at dsd@uspto.gov.

NOTES:

1. **https://ttabvue.uspto.gov/**.

2. **https://tsdr.uspto.gov/**.

122 Certification

122.01 Court Requirements

If a copy of a Board proceeding file, or a portion thereof, is needed for use before a court, the court may require a certified copy (which bears a seal). This may be obtained from the Patent and Trademark Copy Fulfillment Branch, Public Records Division. *See* TBMP § 121 for information on ordering certified copies.

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

122.02 Certified Copies

Certified copies, bearing a seal, of Office proceeding files, including Board proceeding files, or portions thereof, may be ordered online from the U.S. Patent and Trademark Office Certified Copy Center at

https://certifiedcopycenter.uspto.gov/. *See*TBMP § 121 for additional information on ordering certified copies.

123 Status Information for Applications, Registrations and Board Proceedings

Detailed current information about the status and prosecution history of trademark applications and registrations can be obtained online through the TSDR database at **http://tsdr.uspto.gov/**. Information on any recorded documents affecting the title to applications or registrations can be obtained from the Trademark Assignments database at **https://assignment.uspto.gov/trademark/index.html#/trademark/search**.

The Trademark Assistance Center provides general information about the registration process and can also answer status questions. The Center can be reached at (571) 272-9250 or (800) 786-9199 (toll free). [Note 1.]

The status of Board proceedings and of requests for extensions of time to oppose can be obtained online using TTABVUE at **http://ttabvue.uspto.gov**. [Note 2.] General information about Board proceedings (including status information) can be obtained by calling the Trademark Trial and Appeal Board at (571) 272-8500 or (800) 786-9199 (toll free) during business hours.

NOTES:

1. *See generally*TMEP § 108, *et seq.* (Status Inquiries).

2. *Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1542 n.17 (TTAB 2010).

124 Action by Assignee

When a mark which is the subject of a federal application or registration has been assigned, together with the application or registration, in accordance with Trademark Act § 10, 15 U.S.C. § 1060, any action with respect to the application or registration which may or must be taken by the applicant or registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded or that proof of the assignment has been submitted. [Note 1.] Similarly, when a mark which is not the subject of a federal application or registration, but which is owned and pleaded by a plaintiff in a Board inter partes proceeding, has been assigned, the assignee may act in the proceeding in place of the assignor, provided that proof of the assignment has been submitted in the proceeding. *See*TBMP § 512.01 (Assignment of Mark).

Please Note: Trademark Act § 10, 15 U.S.C. § 1060, and part 3 of 37 C.F.R. are not applicable to Trademark Act § 66(a), 15 U.S.C. § 1141f(a) applications and registrations. [Note 2.] Except in limited circumstances, [Note 3] requests to record assignments of § 66(a) applications and registrations must be filed directly with the International Bureau of the World Intellectual Property Organization. [Note 4.] The International Bureau will notify the USPTO of any changes in ownership recorded in the International Register. The USPTO will record only those assignments, or other documents of title, that have been recorded in the International Register. [Note 5.]

NOTES:

1. 37 C.F.R. § 3.71(d) (Prosecution by assignee), 37 C.F.R. § 3.73(b) (Establishing right of assignee to take action). *See* Trademark Act § 72, 15 U.S.C. § 1141l, 37 C.F.R. § 7.22–37 C.F.R. § 7.24 regarding assignment of Trademark Act § 66(a), 15 U.S.C. § 1141f(a) applications and registrations.

2. TMEP § 503.05. *See* 37 C.F.R. § 7.22–37 C.F.R. § 7.24(a) for information on recording changes to applications and registrations under Trademark Act § 66(a).

3. *See*TMEP § 1906.01(a)(i).

4. 37 C.F.R. § 7.22. *See also*TMEP § 1906, *et seq.* (Recording Changes in International Register).

5. *See*TMEP § 1906.01(a).

Chapter 200 EXTENSIONS OF TIME TO OPPOSE

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201 In General

Trademark Act § 13(a),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, 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. An opposition may be amended under such conditions as may be prescribed by the Director.*

37 C.F.R. § 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) *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. The opposition need not be verified, but must be signed by the opposer or the opposer'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 oppositions filed through ESTTA under paragraphs (b)(1) or (2) of this section.*

(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. 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.*

(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 C.F.R. § 2.102 ***Extension of time for filing an opposition.***

(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. The request need not be verified, but must be signed by the potential opposer or by the potential opposer's attorney, as specified in § 11.1 of this chapter, or authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for electronically filed extension requests.*

(1) *A request to extend the time for filing an opposition to an application must be filed through ESTTA by the opposition due date set forth in § 2.101(c). In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a request to extend the opposition period for an application based on Section 1 or 44 of the Act may be filed in paper form by the opposition due date set forth in § 2.101(c). A request to extend the opposition period for 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.*

(2) *A paper request to extend the opposition period for an application based on Section 1 or 44 of the Act must be filed by the due date set forth in § 2.101(c) and be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under paragraph (a)(1) of this section. Timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.*

(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.*

(c) *The time for filing an opposition shall not be extended beyond 180 days from the date of publication. Any request to extend the time for filing an opposition must be filed before thirty days have expired from the date of publication or before the expiration of a previously granted extension of time, as appropriate. Requests to extend the time for filing an opposition must be filed as follows:*

(1) *A person may file a first request for:*

(i) *Either a thirty-day extension of time, which will be granted upon request; or*

(ii) *A ninety-day extension of time, which will be granted only for good cause shown. A sixty-day extension is not available as a first extension of time to oppose.*

(2) *If a person was granted an initial thirty-day extension of time, that person may file a request for an additional sixty-day extension of time, which will be granted only for good cause shown.*

(3) *After receiving one or two extensions of time totaling ninety days, a person may file one final request for an extension of time for an additional sixty days. No other time period will be allowed for a final extension of the opposition period. The Board will grant this request only upon written consent or stipulation signed by the applicant or its authorized representative, or a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, or a showing of extraordinary circumstances. No further extensions of time to file an opposition will be granted under any circumstances.*

(d) *The filing date of a request to extend the time for filing an opposition is the date of electronic receipt in the Office of the request. In the rare instance that filing by paper is permitted under these rules, the filing date will be determined in accordance with §§ 2.195 through 2.198.*

Any person, whether natural or juristic, who believes that he, she, or it would be damaged by the registration of a mark on the Principal Register may, upon payment of the prescribed fee, file an opposition in the Office, stating the grounds therefor, within 30 days after the publication of the mark in the Official Gazette for purposes of opposition. [Note 1.] *See* TBMP § 303.02 ("Meaning of the term 'person'").

For further information concerning the filing of an opposition, see TBMP Chapter 300.

Similarly, any person who believes that he, she, or it would be damaged by the registration of a mark on the Principal Register may file a request to extend the time for filing an opposition. [Note 2.] Requests for extensions of time to oppose are filed with and determined by the Board. [Note 3.] Requests for extension of time to oppose an application based on Trademark Act §§ 1 or 44 of the Act must be filed through ESTTA unless ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present. [Note 4.] However, requests for extensions of time to oppose a Trademark Act § 66(a) application must always be filed electronically in ESTTA, and may not under any circumstances be filed in paper form. [Note 5.]

The time for filing a request for an extension of time to oppose is governed by Trademark Act § 13(a), 15 U.S.C. § 1063(a), and 37 C.F.R. § 2.102(c). Other requirements for a request for an extension of time to oppose are set forth in 37 C.F.R. § 2.102(a), 37 C.F.R. § 2.102(b), and 37 C.F.R. § 2.102(d). Moreover, an extension of time to oppose must also meet the general requirements for submissions to the Board specified in 37 C.F.R. § 2.126. *See*TBMP § 106.03. Each of these requirements is discussed in the sections that follow.

The Board lacks jurisdiction to decide an untimely filed opposition. [Note 6.]

NOTES:

1. Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 C.F.R. § 2.101. *See also* 37 C.F.R. §2.80 (mark entitled to registration will be published in the Official Gazette for opposition).

2. Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 C.F.R. § 2.102.

3. *See* 37 C.F.R. § 2.102(a); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1075 n.2 (TTAB 1993) (37 C.F.R. § 2.102 delegates the authority to the Board to grant ex parte extensions of time to oppose). *See*TMEP § 1503.04.

4. 37 C.F.R. § 2.102(a)(1). *See also* 37 C.F.R. § 2.126(a) ("Submissions must be made to the Trademark Trial and Appeal Board via ESTTA.").

5. 37 C.F.R. § 2.102(a)(1). *See In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2020-21 (TTAB 2005) (requests for extension of time to oppose a Trademark Act § 66(a) (Madrid Protocol) application must be filed via ESTTA; paper requests for extensions will be denied).

6. *Renaissance Rialto Inc. v. Ky Boyd*, 107 USPQ2d 1083, 1084 (TTAB 2013) (whether an opposition was timely filed is "an issue of jurisdictional significance"; untimely filed opposition dismissed withough prejudice to file a cancellation for lack of jurisdiction). *See generally Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993).

202 Time for Filing Request

202.01 In General

Trademark Act § 13(a),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, 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. An opposition may be amended under such conditions as may be prescribed by the Director.

37 C.F.R. § 2.102(c) *The time for filing an opposition shall not be extended beyond 180 days from the date of publication. Any request to extend the time for filing an opposition must be filed before thirty days have expired from the date of publication or before the expiration of a previously granted extension of time, as appropriate. Requests to extend the time for filing an opposition must be filed as follows:*

(1) *A person may file a first request for:*

(i) *Either a thirty-day extension of time, which will be granted upon request; or*

(ii) *A ninety-day extension of time, which will be granted only for good cause shown. A sixty-day extension is not available as a first extension of time to oppose.*

(2) *If a person was granted an initial thirty-day extension of time, that person may file a request for an additional sixty-day extension of time, which will be granted only for good cause shown.*

(3) *After receiving one or two extensions of time totaling ninety days, a person may file one final request for an extension of time for an additional sixty days. No other time period will be allowed for a final extension of the opposition period. The Board will grant this request only upon written consent or stipulation signed by the applicant or its authorized representative, or a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, or a showing of extraordinary circumstances. No further extensions of time to file an opposition will be granted under any circumstances.*

(d) *The filing date of a request to extend the time for filing an opposition is the date of electronic receipt in the Office of the request. In the rare instance that filing by paper is permitted under these rules, the filing date will be determined in accordance with §§ 2.195 through 2.198.*

A first request for an extension of time to oppose an application for registration of a mark must be filed prior to the expiration of the thirty-day period after publication of the mark in the Official Gazette, pursuant to Trademark Act § 12(a), 15 U.S.C. § 1062(a). [Note 1.] Any request for a further extension of time to oppose must be filed by the initial requesting party, or its privy, prior to the expiration of an extension granted to the requesting party or its privy. [Note 2.]

All requests to extend the time for filing an opposition must be filed through ESTTA. [Note 3.] For an application based on Trademark Act §§ 1 or 44, a request to extend the opposition period may be filed in paper form only if ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present. [Note 4.] Requests for extension of time to oppose a Trademark Act § 66(a) application may not under any circumstances be filed in paper form. [Note 5.]

Any paper request must be timely, [Note 6], and must be accompanied by a Petition to the Director with the requisite fees and a showing that ESTTA was unavailable because of technical problems or that extraordinary circumstances are present. [Note 7.] The timeliness of any paper submission will be determined in accordance with 37 C.F.R. § 2.195 through 37 C.F.R. § 2.198. [Note 8.] *See* TBMP § 111.02 (certificate of mailing procedure) and TBMP § 111.01 (Priority Mail Express®) for further information about submissions filed in paper form and procedures providing for the timeliness of any paper submissions. Paper filings must also

meet the general requirements for submissions to the Board specified in 37 C.F.R. § 2.126. *See* TBMP § 106.03 and TBMP § 107

No more than three requests to extend the time for filing an opposition, totaling 180 days from the date of publication, may be filed. [Note 9.] During the initial 30-day period following publication of the mark, a potential opposer may file a request for a thirty-day extension without a showing of cause, *see*TBMP § 207.02 (Extensions Up to 120 Days from Date of Publication), followed by a request for a sixty-day extension for good cause. [Note 10.] If granted, the potential opposer will have until 120 days from the date of publication within which to oppose. Alternatively, the potential opposer may file a single first request for a ninety-day extension of time for good cause, thereby obtaining, if granted, an extension up to 120 days from the date of publication. [Note 11.] A sixty-day extension is not available as a first extension of time to oppose. [Note 12.] After one or two granted requests totaling 120 days from the date of publication, the potential opposer may request one final extension of time for an additional sixty days, but only with the consent of the applicant or a showing of extraordinary circumstances. [Note 13.]

The final request (for the 120-180 day period after publication) can only be granted for sixty days and not any other period of time. [Note 14.] For example, within the 90-120 day period from publication, the potential opposer cannot request a thirty-day extension of time, even with the consent of the applicant. If an extension of less than sixty days is requested, even if based on consent, the request will be denied unless the reasons stated for the granting of the request are determined to be extraordinary, in which case the request will be granted for sixty days. In other words, although a thirty-day extension of time is not permissible under 37 C.F.R. § 2.102(c)(3), the presence of extraordinary circumstances would allow the granting of a sixty-day extension of time. No further extensions of time to oppose will be permitted.

The following chart illustrates the initial publication period and extensions of time to oppose which may be granted:

<table>
<tr><td rowspan="2">Publication
30 days
37 C.F.R. § 2.102(c)</td><td>First 30 days – no reason necessary
37 C.F.R. § 2.102(c)(1)(i)</td><td>Next 60 days – for good cause or consent
37 C.F.R. § 2.102(c)(2)</td><td rowspan="2">Final 60 days – with consent or under extraordinary circumstances
37 C.F.R. § 2.102(c)(3)</td></tr>
<tr><td colspan="2">First 90 Days – for good cause or consent
37 C.F.R. § 2.102(c)(1)(ii)</td></tr>
</table>

NOTES:

1. Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 C.F.R. § 2.102(c). *See In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477, 1478 (Comm'r Pats. 1994) (citing *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (timeliness of extension requests is statutory and cannot be waived)). *Cf. Yahoo! Inc. v. Loufrani*, 70 USPQ2d 1735, 1736 (TTAB 2004) (because requirements of Section 13(a) of the Act for the filing of an opposition are statutory, they cannot be waived by stipulation of the parties, nor can they be waived by the Director on petition).

2. 37 C.F.R. § 2.102(b).

3. 37 C.F.R. § 2.102(a)(1). *See also* 37 C.F.R. § 2.126(a) ("Submissions must be made to the Trademark Trial and Appeal Board via ESTTA.").

4. 37 C.F.R. § 2.102(a)(1) and 37 C.F.R. § 2.126(a).

5. 37 C.F.R. § 2.102(a)(1). *See NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1039 n.19 (TTAB 2014) (Use of ESTTA is mandatory for the filing of extensions of time to oppose applications filed under the Madrid Protocol).

6. 37 C.F.R. § 2.102(a)(2).

7. 37 C.F.R. §2.120(a)(2). *Cf. DFC Expo LLC v. Coyle*, 121 USPQ2d 1903 (TTAB 2017) (untimely paper submission of notice of opposition without certificate of mailing, fees, or petition to Director denied).

8. 37 C.F.R. § 2.102(a)(2) and 37 C.F.R. §2.102(d).

9. 37 C.F.R. § 2.102(c)(1)(i) and 37 C.F.R. §2.102(c)(2).

10. 37 C.F.R. § 2.102(c)(1)(i) and 37 C.F.R. § 2.102(c)(2).

11. 37 C.F.R. § 2.102(c)(1)(ii).

12. 37 C.F.R. § 2.102(c)(1)(ii).

13. 37 C.F.R. § 2.102(c)(3).

14. 37 C.F.R. § 2.102(c)(3).

202.02 Date of Publication of Mark

The date of publication of a mark is the issue date 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.

202.03 Premature Request

Trademark Act § 13(a), 15 U.S.C. § 1063(a), provides that an opposition to the registration of a mark upon the Principal Register may be filed "within thirty days after" the publication of the mark in the Official Gazette under Trademark Act § 12(a), 15 U.S.C. § 1062(a). Trademark Act § 13(a), 15 U.S.C. § 1063(a) also provides for extensions of the time for filing an opposition under certain conditions. ESTTA does not permit a party to file a premature notice of opposition or premature request for an extension of time to oppose. Any paper-filed opposition, and any paper-filed request for an extension of time to oppose, filed before the date of publication of the mark sought to be opposed, is premature, and the Board will reject the opposition even if the mark has been published by the time of the Board's action. *Cf.*TBMP § 306.03 (Premature Opposition).

202.04 Late Request

A request for an extension of time to oppose must be filed prior to the expiration of the thirty-day period after publication for opposition of the mark which is the subject of the request, in the case of a first request, or prior to the expiration of an extension granted to the requesting party or its privy, in the case of a request for a further extension. [Note 1.] See TBMP § 206.02 for information regarding further extension requests filed by a party in privity with the person who requested and was granted the extension of time. Because these timeliness requirements are statutory, they cannot be waived by stipulation of the parties, nor can the Director upon petition waive them. [Note 2.] The ESTTA filing system does not permit a party to file a late

request for extension of time to oppose. [Note 3.] Likewise, later paper submissions will be denied. A first request filed in paper after the expiration of the thirty-day period following publication of the subject mark, or a request for a further extension filed in paper after the expiration of the previous extension granted to the requesting party or its privy, will be denied by the Board as late, even if the applicant has consented to the granting of the late-filed request.

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

Potential opposers are reminded that parties may not rely on information obtained by telephone with the Board. 37 C.F.R. § 2.191 provides in pertinent part: "The action of the Office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulations, or understanding in relation to which there is disagreement or doubt." [Note 4.] *See*TBMP § 104 (Business to be Conducted in Writing).

NOTES:

1. Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 C.F.R. § 2.102(c). *See, e.g., Renaissance Rialto Inc. v. Ky Boyd*, 107 USPQ2d 1083, 1084 (TTAB 2013) (whether an opposition was timely filed is "an issue of jurisdictional significance"; untimely filed opposition dismissed without prejudice to file a cancellation for lack of jurisdiction).

2. *See In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477, 1478 (Comm'r Pats. 1994) (citing *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (timeliness of extension requests is statutory and cannot be waived)). *Cf. Yahoo! Inc. v. Loufrani*, 70 USPQ2d 1735, 1736 (TTAB 2004) (because requirements of Section 13(a) of the Act for the filing of an opposition are statutory, they cannot be waived by stipulation of the parties, nor can they be waived by the Director on petition).

3. *Cf. PPG Industries, Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1927 (TTAB 2005) ("… when a paper is filed via ESTTA, it must be signed in conformance with Rule 2.193(c)(1)(iii). As a practical matter, ESTTA will allow the filing party to complete the submission process only after the required electronic signature has been entered.").

4. *See In re Merck & Co.*, 24 USPQ2d 1317, 1318 n.2 (Comm'r 1992).

203 Form of Request

203.01 General Considerations

203.01(a) Required Electronic Filings; Paper Filings

37 C.F.R. § 2.102 ***Extension of time for filing an opposition.***

(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. The request need not be verified, but must be signed by the potential opposer or by the potential opposer's attorney, as specified in § 11.1 of this chapter, or authorized representative, as specified*

in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for electronically filed extension requests.

(1) *A request to extend the time for filing an opposition to an application must be filed through ESTTA by the opposition due date set forth in § 2.101(c). In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a request to extend the opposition period for an application based on Section 1 or 44 of the Act may be filed in paper form by the opposition due date set forth in § 2.101(c). A request to extend the opposition period for 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.*

(2) *A paper request to extend the opposition period for an application based on Section 1 or 44 of the Act must be filed by the due date set forth in § 2.101(c) and be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under paragraph (a)(1) of this section. Timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.*

(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.*

(c) *The time for filing an opposition shall not be extended beyond 180 days from the date of publication. Any request to extend the time for filing an opposition must be filed before thirty days have expired from the date of publication or before the expiration of a previously granted extension of time, as appropriate. Requests to extend the time for filing an opposition must be filed as follows:*

(1) *A person may file a first request for:*

(i) *Either a thirty-day extension of time, which will be granted upon request; or*

(ii) *A ninety-day extension of time, which will be granted only for good cause shown. A sixty-day extension is not available as a first extension of time to oppose.*

(2) *If a person was granted an initial thirty-day extension of time, that person may file a request for an additional sixty-day extension of time, which will be granted only for good cause shown.*

(3) *After receiving one or two extensions of time totaling ninety days, a person may file one final request for an extension of time for an additional sixty days. No other time period will be allowed for a final extension of the opposition period. The Board will grant this request only upon written consent or stipulation signed by the applicant or its authorized representative, or a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, or a showing of extraordinary circumstances. No further extensions of time to file an opposition will be granted under any circumstances.*

(d) *The filing date of a request to extend the time for filing an opposition is the date of electronic receipt in the Office of the request. In the rare instance that filing by paper is permitted under these rules, the filing date will be determined in accordance with §§ 2.195 through 2.198.*

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.*

A request for an extension of time to oppose must be submitted through ESTTA and must specify the period of extension desired. [Note 1.] Available forms and instructions for electronic filing can be found at http://estta.uspto.gov.

If ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a request to extend time to oppose an application based on Trademark Act §§ 1 or 44, 15 U.S.C. § 1051 or 15 U.S.C. § 1126, may be filed in paper form. [Note 2.] See TBMP § 106.03 and TBMP § 107 for general information about paper filings. The requirements for formatting electronic and paper submissions to the Board are specified in 37 C.F.R. § 2.126(a) and 37 C.F.R. § 2.126(b), respectively.

Under no circumstances may a request to extend the opposition period for a Madrid Protocol application, i.e., an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), be filed in paper form. [Note 3.] The requirement to use ESTTA for such filings enables the USPTO to fulfill its obligation to timely notify the International Bureau of the World Intellectual Property Organization of oppositions filed against applications requesting extension of protection under the Madrid Protocol. A request for an extension of time to oppose a Madrid Protocol application that is not filed through ESTTA will be denied.

No more than three requests to extend the time for filing an opposition, totaling 180 days from the date of publication, may be filed. [Note 4.] During the initial 30-day period following publication of the mark, a potential opposer may file a request for a thirty-day extension without a showing of cause, *see* TBMP § 207.02, followed by a request for a sixty-day extension for good cause, if the first request was granted. [Note 5.] If granted, the potential opposer will have until 120 days from the date of publication within which to oppose. A sixty-day extension of time to oppose is not available as a first extension of time to oppose. [Note 6.] Alternatively, the potential opposer may file a single first request for a ninety-day extension of time for good cause, thereby obtaining, if granted, an extension up to 120 days from the date of publication. [Note 7.] After one or two granted requests totaling 120 days from the date of publication, the potential opposer

may request one final extension of time for an additional sixty days, but only with the consent of the applicant or a showing of extraordinary circumstances. [Note 8.]

The final request (for the 120–180 day period after publication) can only be granted for sixty days and not any other period of time. [Note 9.] For example, within the 90-120 day period from publication, the potential opposer cannot request a thirty day extension of time, even with the consent of the applicant. If an extension of less than sixty days is requested, even if based on consent, the request will be denied unless the reasons stated for the granting of the request are determined to be extraordinary, in which case the request will be granted for sixty days instead. In other words, although a thirty day extension of time is not permissible under 37 C.F.R. § 2.102(c)(3), the presence of extraordinary circumstances would allow the grant of a sixty day extension of time. No further extensions of time to oppose will be permitted.

The following chart illustrates the initial publication period and extensions of time to oppose which may be granted:

<table>
<tr><td rowspan="2">Publication
30 days
37 C.F.R. § 2.102(c)</td><td>First 30 days – no reason necessary
37 C.F.R. § 2.102(c)(1)(i)</td><td>Next 60 days – for good cause or consent
37 C.F.R. § 2.102(c)(2)</td><td rowspan="2">Final 60 days – with consent or under extraordinary circumstances
37 C.F.R. § 2.102(c)(3)</td></tr>
<tr><td colspan="2">First 90 Days – for good cause or consent
37 C.F.R. § 2.102(c)(1)(ii)</td></tr>
</table>

NOTES:

1. 37 C.F.R. § 2.102(a)(1); 37 C.F.R. § 2.102(c). *See also* 37 C.F.R. § 2.126(a) ("Submissions must be made to the Trademark Trial and Appeal Board via ESTTA.").

2. 37 C.F.R. § 2.102(a)(1) and 37 C.F.R. § 2.102(a)(2).

3. 37 C.F.R. § 2.102(a)(1). *See NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1039 n.19 (TTAB 2014) (Use of ESTTA is mandatory for the filing of extensions of time to oppose applications filed under the Madrid Protocol).

4. 37 C.F.R. § 2.102(c)(1)(i) and 37 C.F.R § 2.102(c)(2).

5. 37 C.F.R. § 2.102(c)(1)(i)and 37 C.F.R. § 2.102(c)(2).

6. 37 C.F.R. § 2.102(c)(1)(ii).

7. 37 C.F.R. § 2.102(c)(1)(ii).

8. 37 C.F.R. § 2.102(c)(3).

9. 37 C.F.R. § 2.102(c)(3).

203.01(b) Note on Electronic Filing With ESTTA

Electronic filing of extensions of time to oppose using ESTTA is required in all instances. In the rare occasion that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a

request to extend the time to oppose an application based on Trademark Act §§ 1 or 44, 15 U.S.C. § 1051 or 15 U.S.C. § 1126 may be filed in paper form. [Note 1.] A potential opposer is encouraged to plan ahead. "System status" for current and planned outages may be checked on the USPTO website. At times, a system may be down for a short period. A potential opposer, if unsuccessful at electronic filing on a first attempt, should try again later in the day before resorting to paper filing. Under no circumstances may a request to extend the opposition period for an application based on Trademark Act § 66(a), 15 U.S.C. § 1141f(a), be filed on paper. [Note 2.]

To assist the user, ESTTA provides prompts to supply and verify all required information. Most extensions of time to oppose filed via ESTTA are automatically processed, providing a nearly instantaneous Board order (with an email notification providing a link to the filing in TTABVUE) granting the requested extension (if appropriate).

ESTTA forms, including a request for extension of time to oppose, and filing instructions can be found at https://estta.uspto.gov. Filers with questions about electronic filing may call (571) 272-8500 or (800) 786-9199 (toll free) (8:30 am – 5:00 pm Eastern Time) for assistance, or send an email to TTABISInfo@uspto.gov. [Note 3.] For technical questions that arise during filing via ESTTA, the filer may send an email to ESTTA@uspto.gov. Questions of a general nature regarding Board proceedings should be directed to the phone numbers listed above.

See TBMP § 106.03 and TBMP § 110 for general information on ESTTA filing.

NOTES:

1. 37 C.F.R. § 2.102(a)(1) and 37 C.F.R. § 2.102(a)(2).

2. 37 C.F.R. § 2.102(a)(1). *See also In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2020-21 (TTAB 2005) (requests for extension of time to oppose a Trademark Act § 66(a) (Madrid Protocol) application must be filed via ESTTA; paper requests for extensions will be denied).

3. When sending an email inquiry, include a description of the problem or question, the ESTTA tracking number (if any), the Board proceeding (or application) number (if any), and a name and telephone number for contact. The Board will respond to email inquiries within two business days. Email should not be used for more urgent inquiries.

203.02 Identifying Information

203.02(a) In General

ESTTA contains the necessary forms for filing extensions of time to oppose. Selecting the correct form will appropriately identify the filing, and once the required fields for identifying the application and potential opposer are completed, the filing can be electronically transmitted to the Office. Any attachments to ESTTA forms should be separately captioned and identified for clarity. An email notification of the Office's receipt of the transmission will be sent and most extension requests will be automatically processed. Multiple claimants seeking to proceed as co-opposers should use a separate form for each potential opposer. *See* TBMP § 203.02(b).

In the rare instances where the rules permit an extension request against a Trademark Act §§ 1 or 44 application to be filed on paper, it should bear at its top the heading "IN THE UNITED STATES PATENT

AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by information identifying the application to which the request pertains, namely, the name of the applicant, and the application serial number, filing date, mark, and date of publication in the Official Gazette. [Note 1.] The request should also bear an appropriate title describing its nature, such as "Request for Extension of Time to Oppose" or "Request for Further Extension of Time to Oppose." For ESTTA users, once the correct form is selected, the filing will be appropriately identified.

NOTES:

1. *See In re Merck & Co.* , 24 USPQ2d 1317, 1318 (Comm'r 1992) (Board's refusal to institute opposition as untimely was proper where potential opposer had misidentified applicant and serial number in its extension request). *Cf.* 37 C.F.R. § 2.194(b)(1) ("A letter about a trademark application should identify the serial number, the name of the applicant, and the mark."); *Yahoo! Inc. v. Loufrani*, 70 USPQ2d 1735, 1736 n.4 (TTAB 2004) (opposition dismissed as nullity where notice of opposition misidentified the application sought to be opposed).

203.02(b) Requirement for Identification of Potential Opposer

A request for an extension of time to oppose must identify the potential opposer with reasonable certainty. [Note 1.] An extension request filed through ESTTA cannot be electronically transmitted to the Office unless all required fields, including the field for identification of the potential opposer, are completed. If a paper-filed request for extension of time to oppose fails to identify the potential opposer with reasonable certainty, and assuming all other requirements for the paper filing are satisfied, the defect regarding the identity of the potential opposer may be corrected only if the correction can be made prior to the expiration of the time for filing the request, that is, before the expiration of the thirty-day opposition period following publication of the subject mark in the case of a first request, or before the expiration of the previous extension in the case of a request for a further extension. Any requests for extensions of time to oppose in which the potential opposer is not identified with reasonable certainty cannot be remedied after the opposition period, including any extensions, has expired. [Note 2.]

If a paper-filed request for a further extension of time to oppose does not specifically name the potential opposer, but it is clear from the circumstances that the request is being submitted on behalf of the same potential opposer which obtained an earlier extension, the request may be construed by the Board as identifying the potential opposer with reasonable certainty. However, the better, and safer, practice is to specifically name the potential opposer in each request for an extension of time to oppose.

ESTTA Tip: When filing electronic requests for extensions of time to oppose on behalf of more than one potential opposer, *file a separate request for each potential opposer*. Do not file a joint request (i.e., on behalf of "ABC, Co. and XYZ Inc."), as this will make it more difficult to include both potential opposers as parties to an opposition, if one is filed. When filing the opposition, both (separate) potential opposers can be easily added as parties to the same opposition proceeding, and all fees will be calculated correctly. [Note 3.]

NOTES:

1. 37 C.F.R. § 2.102(b).

2. *See In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm'r 1985) (since extension request failed to identify any party except attorney filing request, and since privity does not include attorney/client relationship,

subsequent notice of opposition was untimely). *Cf. In re Su Wung Chong*, 20 USPQ2d 1399, 1400 (Comm'r 1991) (inadvertence is not extraordinary circumstance to waive rule requiring that statement indicating consent or showing extraordinary circumstances for extension over 120 days must be submitted at time extension request is filed, not after the fact); *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (subsequently obtained consent is not sufficient to allow Board to entertain request for reconsideration, and omission, in itself, is not extraordinary circumstance to waive requirement that consent accompany extension request).

3. *Cf. Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (electronically-filed opposition in which opposers were not separately named did not include correct fees; consequently one potential opposer was not considered to be a party); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994) (Multiple claimants may initiate opposition together and proceed as co-opposers, if opposition is filed within statutory opposition period or during extension of time, and if each of joint opposers submits opposition fee and establishes standing and grounds for opposition.).

203.03 Signature

37 C.F.R. § 2.120(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. The request need not be verified, but must be signed by the potential opposer or by the potential opposer's attorney, as specified in § 11.1 of this chapter, or authorized representative, as specified in § 11.1 4(b) of this chapter. Electronic signatures pursuant to 2.193(c) are required for electronically filed extension requests.*

A request for an extension of time to oppose must be signed either by the potential opposer or by its attorney, as specified in 37 C.F.R. § 11.1 or other authorized representative, as specified in 37 C.F.R. § 11.14(b). [Note 1.] *See also*TBMP § 114.06. The required signature information fields include the signature; the name of the person signing; a description of the capacity in which he or she signs (e.g., as the individual who is the potential opposer, if the potential opposer is an individual; as a corporate officer, specifying the particular office held, if the potential opposer is a corporation; as potential opposer's attorney; etc.); his or her email and business address (to which correspondence relating to the request will be sent); and telephone number. An extension request filed through ESTTA cannot be electronically transmitted to the Office unless all required fields, including the signature field, are completed.

An extension request filed electronically through ESTTA does not require a conventional signature. Instead the party or its representative enters a "symbol" that has been adopted as a signature. The Board will accept any combination of letters, numbers, space and/or punctuation marks as a valid signature if it is placed between two forward slash ("/") symbols. [Note 2.] *See*TBMP § 106.02.

In the rare instance where an extension request against a Trademark Act §§ 1 or 44 application is filed in paper form, the request should bear, under the written signature, the name, in typed or printed form, of the person signing; a description of the capacity in which he or she signs (e.g., as the individual who is the potential opposer, if the potential opposer is an individual; as a corporate officer, specifying the particular office held, if the potential opposer is a corporation; as potential opposer's attorney; etc.); his or her email and business address (to which correspondence relating to the request will be sent); and telephone number.

If all other requirements for a paper-filed request are met, an unsigned paper-filed request will not be refused consideration if a signed copy is submitted to the Office within the time limit set in the written notification of this defect by the Board. [Note 3.] TBMP § 106.02.

A potential opposer that has submitted an unsigned paper request should not wait until it has submitted a signed copy of the request (in response to the Board's written notification of the defect), and the Board has acted on the request, before filing an opposition or a request for a further extension of time to oppose. If the extension request is ultimately granted, the length of the granted extension may be less than that sought in the extension request, and it will run from the expiration of the thirty-day opposition period after publication, in the case of a first request, or from the date of expiration of the previously granted extension, in the case of a subsequent request. If no opposition or request for further extension of time to oppose is filed prior to the expiration of any extension ultimately granted to the potential opposer, the time for opposing will be deemed to have expired, and the application that was the subject of the request will be sent for issuance of a registration or a notice of allowance, as appropriate. *See* TBMP § 202.01 (Time for Filing Request).

NOTES:

1. 37 C.F.R. § 2.102(a); *La Maur, Inc. v. Andis Clipper Co.*, 181 USPQ 783, 784 (Comm'r 1974) (extension requests signed and filed on behalf of potential opposer by its attorney acceptable).

2. 37 C.F.R. § 2.193(c). *See*TMEP § 611.01(b) (Requirements for Signature) and TMEP § 611.01(c) (Signature of Documents Filed Electronically).

3. 37 C.F.R. § 2.119(e). *See also Birlinn Ltd. v. Stewart* , 111 USPQ2d 1905 (TTAB 2014) (Board applies opportunity to cure provision in 2.119(e) to improperly signed papers, which defines the time period for cure as "within the time limit set in the notification of this defect by the Office"); 37 C.F.R. § 2.119(e).

203.04 Service

Except for the notice of opposition and petition to cancel, every paper filed in the USPTO in inter partes cases must be served upon the other parties to the proceeding, and proof of such service must be made before the Board will consider the paper. [Note 1.] Because a request for an extension of time to oppose is filed prior to the commencement of the opposition, it is ex parte, rather than inter partes, in nature. Accordingly, the request need not be served (or include proof of service) upon the applicant. [Note 2.] Once the Board has acted upon a request for an extension of time to oppose, the Board will send the applicant a copy of the Board's action thereon. [Note 3.]

NOTES:

1. 37 C.F.R. § 2.119(a).

2. *La Maur, Inc. v. Andis Clipper Co.*, 181 USPQ 783, 784 (Comm'r 1974) (request for extension of time is an ex parte matter; requests need not be served on applicant).

3. Trademark Act § 13, 15 U.S.C. § 1063.

203.05 Duplicate Requests

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

Most requests for extension of time filed via ESTTA are automatically processed. Because they are not examined by Board staff, duplicate requests may be granted. Whether filed through ESTTA or on paper, counsel should avoid duplicate filings by checking the application status in TTABVUE prior to filing an extension request.

204 Fees

There is a tiered fee structure for filing extensions of time to oppose that is calculated per application rather than per class. There is no fee for filing a first thirty-day request for an extension of time to oppose. There is a per application fee for filing either a second sixty-day request or the first ninety-day request for extension of time to oppose (combining the no-fee 30 day extension of time to oppose and the fee required for a subsequent 60-day extension of time to oppose). [Note 1.] There is a per application fee for filing a final sixty-day request for extension of time to oppose after one or two requests totaling 120 days from the date of publication. [Note 2.] The fees are higher for paper submissions. [Note 3.] Petition fees are applicable to all requests for extensions of time to oppose filed in paper form, in addition to the per application filing fees. [Note 4.]

When a request for extension of time to oppose is filed using ESTTA, as required, the correct fee will be calculated and payment must be made before the filing will be transmitted to the USPTO. Note that in order for fees to be properly calculated, each potential opposer must be entered separately.

NOTES:

1. 37 C.F.R. § 2.6(a)(22)(i) and37 C.F.R. § 2.6(a)(22)(ii).

2. 37 C.F.R. § 2.6(a)(23)(i) and 37 C.F.R. §2.6(a)(23)(ii).

3. 37 C.F.R. § 2.6(a)(22)(i) and 37 C.F.R. § 2.6(a)(23)(i).

4. 37 C.F.R. § 2.102(a)(2); 37 C.F.R. § 2.6(a)(15)(i) and 37 C.F.R. § 2.6(a)(15)(ii).

205 Mark on Supplemental Register Not Subject to Opposition

Although the mark in an application for registration on the Principal Register is published for, and subject to, opposition, the mark in an application for registration on the Supplemental Register is not. [Note 1.] If it appears after examination of an application to register a mark on the Supplemental Register, that applicant is entitled to the registration, a certificate of registration is issued without publication for opposition. [Note 2.] Upon issuance of the registration, the mark appears in the Official Gazette, not for opposition, but rather to give notice of the issuance of a registration. [Note 3.]

Because applications for registration on the Supplemental Register are not subject to opposition, but only to cancellation, requests for extensions of time to oppose are not permitted. ESTTA does not permit the filing of a request for an extension of time to oppose against an application for registration on the Supplemental Register, and if such a request were to be filed in paper form, the Board must deny it. The remedy of the would-be opposer lies in the filing of a petition to cancel the registration of the mark, once the registration has issued. [Note 4.]

NOTES:

1. Trademark Act § 24, 15 U.S.C. § 1092; 37 C.F.R. § 2.82.

2. Trademark Act § 23(b) and Trademark Act § 24; 15 U.S.C. § 1091(b) and 15 U.S.C. § 1092; 37 C.F.R. § 2.82.

3. Trademark Act § 24, 15 U.S.C. § 1092; 37 C.F.R. § 2.82; TMEP § 1502.

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

206 Who May File an Extension of Time to Oppose

37 C.F.R. § 2.102 ***Extension of time for filing an opposition.***

(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. …*

(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.*

206.01 General Rule

Any person, whether natural or juristic who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may, upon payment of the prescribed fee, file an opposition in the Office, stating the grounds therefor, within 30 days after the publication of the mark in the Official Gazette for purposes of opposition. [Note 1.] *See also* TBMP § 303.02.

Similarly, any person, whether natural or juristic, who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may file a request to extend the time for filing an opposition. [Note 2.] *See* TBMP § 203. A request for an extension of time to oppose must identify the potential opposer with reasonable certainty. [Note 3.] *See*TBMP § 203.02(b).

The potential opposer's belief in its prospective damage arising from registration (i.e., its standing, now referred to as an entitlement to bring a statutory cause of action, see TBMP § 309.03(b)) need not be explicitly stated in an extension request, and is rarely an issue. Nonetheless, a request for extension of time to oppose may not be filed for improper purposes, such as harassment or delay. Although the Board may question a potential opposer's entitlement to bring a statutory cause of action in appropriate cases, either upon motion or sua sponte, the question will rarely be before the Board because, most of the time, an order automatically granting the requested extension is issued by ESTTA. Moreover, because extensions are limited in time, and potential opposers are not required to state potential grounds for an opposition, it will almost always be more appropriate to defer the issue of entitlement to bring a staturoty cause of action until an opposition (if any) is filed, setting out the grounds for the opposition and the opposer's belief in damage. *See, e.g.,*TBMP § 503 (Motion to Dismiss for Failure to State a Claim).

An extension of time to oppose is a personal privilege which inures only to the benefit of the party to which it was granted and those in privity with that party. [Note 4.] For this reason, a request for a further extension of time to oppose, or an opposition filed during an extension of time, ordinarily must be filed in the name of the party to which the previous extension was granted. [Note 5.] TBMP § 206.02 (Request by Privy). A request for a further extension, or an opposition, filed in a different name will be accepted if a person in privity with the person granted the previous extension files it, or if the person that requested the extension was misidentified through mistake. [Note 6.]

NOTES:

1. Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 C.F.R. § 2.101.

2. Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 C.F.R. § 2.102.

3. 37 C.F.R. § 2.102(b).

4. *See* 37 C.F.R. §2.102(b); *Renaissance Rialto Inc. v. Ky Boyd*, 107 USPQ2d 1083, 1087 (TTAB 2013) (acquisition of another's right to oppose, independent of a transfer of rights to a trademark and its associated goodwill, is an insufficient basis upon which to claim the benefit of the transferor's personal privilege in an extension of time to oppose an application; opposition dismissed for lack of jurisdiction); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994) ("[A]n extension of time to oppose inures to the benefit of the potential opposer and its privies, so that 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."; "Typically, the right to go forward with an opposition may be transferred when the opposer, or its pleaded mark and the goodwill associated therewith, has been acquired by another party."); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993) ("An extension of time to oppose is a personal privilege, inuring only to the benefit of the party to which it was granted or a party shown to be in privity therewith. A party cannot claim the benefit of an extension granted to another (unrelated) party."); *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (unrelated entities).

5. *Renaissance Rialto Inc. v. Boyd*, 107 USPQ2d 1083, 1087 (TTAB 2013) (acquisition of another's right to oppose, independent of a transfer of rights to a trademark and its associated goodwill, is an insufficient basis upon which to claim the benefit of the transferor's personal privilege in an extension of time to oppose); *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.").

6. *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"); *Warren Distribution, Inc. v. Royal Purple, LLC*, 115 USPQ2d 1667, 1669-70 (TTAB 2015) (company that filed notice of opposition not in privity with individual who filed extension request in her own name; and such individual was not "misidentified" as entity seeking extension "by mistake.").

206.02 Request for Further Extension Filed by Privy

A request for a further extension, or an opposition, filed by a different party will not be rejected on that ground if it is shown to the satisfaction of the Board that the different party is in privity with the party granted the previous extension. [Note 1.] The "showing" should be in the form of a recitation of the facts upon which the claim of privity is based. The showing must be submitted with the request or opposition. ESTTA will

prompt the filer to provide an explanation. In the rare instance that the rules permit the filing to be made in paper form, the Board will issue an order requesting an explanation of the discrepancy. If the request for a further extension, or the opposition, is filed both in the name of the party granted the previous extension and in the name of one or more different parties, an explanation will be requested as to each different party, and the request will not be granted, or the opposition accepted, as to any different party which fails to make a satisfactory showing of privity.

In the field of trademarks, the concept of privity generally includes, *inter alia*, the relationship of successive ownership of a mark (e.g., assignor, assignee) and the relationship of "related companies" within the meaning of Trademark Act § 5 and Trademark Act § 45, 15 U.S.C. § 1055 and 15 U.S.C. § 1127. [Note 2.] It does not, however, include the attorney/client relationship. [Note 3.]

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

ESTTA Tip: When filing electronic requests for extensions of time to oppose on behalf of more than one potential opposer, *file a separate request for each potential opposer*. Do not file a joint request (*i.e.*, on behalf of "ABC, Co. and XYZ Inc."), as this will make it more difficult to include both potential opposers as parties to an opposition, if one is filed. When filing the opposition, both (separate) potential opposers can be easily added as parties to the same opposition proceeding, and all fees will be calculated correctly. [Note 4.]

NOTES:

1. 37 C.F.R. § 2.102(b); *In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm'r 1985) ("parties in privity must have the same right or interest"); *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); *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (two unrelated entities that merely share same objection to registration are not in privity).

2. *See International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1495 (Fed. Cir. 2000) (discussion of various 'privity' relationships); *Warren Distribution, Inc. v. Royal Purple, LLC*, 115 USPQ2d 1667, 1670-71 (TTAB 2015) (notice of opposition untimely where opposer was not in privity with employee who filed extension request in individual name); *Renaissance Rialto Inc. v. Boyd*, 107 USPQ2d 1083, 1086-87 (TTAB 2013) (notice of opposition untimely where opposer, as purported assignee, could not succeed to any proprietary interest in the mark because transferor had no rights to transfer; case dismissed for lack of jurisdiction); *Rolex Watch U.S.A., Inc. v. Madison Watch Co., Inc.*, 211 USPQ 352, 358 (TTAB 1981) (regarding right of owner, or one in privity with owner, to maintain opposition or cancellation based on Trademark Act § 2(d)); *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (two unrelated entities that merely share same objection to registration are not in privity despite having both been named as defendants in civil actions brought by owner of mark). *Cf. John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1946-47 (TTAB 2010) (res judicata; privity with parties to previous action); *Argo & Co. v. Carpetsheen Manufacturing., Inc.*, 187 USPQ 366, 367 (TTAB 1975) (motion to suspend granted in view of privity of applicant with parties in civil action); *F. Jacobson & Sons, Inc. v. Excelled Sheepskin & Leather Coat Co.*, 140 USPQ 281, 282 (Comm'r 1963) (parent in privity). *But see Tokaido v. Honda Associates Inc.*, 179 USPQ 861, 862 (TTAB 1973) (respondent's motion to suspend for civil action between respondent and third party denied where petitioner as nonexclusive licensee of third party was not in privity with third party).

3. *In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm'r 1985) ("An attorney/client relationship does not invest the attorney with the same right or interest as his client ....").

4. *Cf. Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (electronically-filed opposition in which opposers were not separately named did not include correct fees; one potential opposer was accordingly not considered to be a party).

206.03 Misidentification of Potential Opposer

A request for a further extension, or an opposition, filed in a different name will not be rejected on that ground if it is shown to the satisfaction of the Board that the party in whose name the extension was requested was misidentified through mistake. [Note 1.] The phrase "misidentified through mistake," as used in 37 C.F.R. § 2.102(b), means a mistake in the form of the potential opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named. [Note 2.]

The "showing" submitted in support of a claim of misidentification through mistake should be in the form of a recitation of the facts upon which the claim of misidentification through mistake is based. The showing must be submitted with the request or opposition. ESTTA will prompt the filer to provide an explanation. In the rare instance that the rules permit the filing to be made in paper form, the Board will issue an order requesting an explanation of the discrepancy.

NOTES:

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

2. *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) (no misidentification through mistake between employee who filed extension request as individual and employer who filed notice of opposition); *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); TMEP § 803.06 (Applicant May Not be Changed).

Cf. Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap, 184 USPQ 505, 506 (TTAB 1974) (motion to substitute granted where opposition was mistakenly filed in name of original owner and original owner assigned mark to opposer nunc pro tunc); *Davidson v. Instantype, Inc.*, 165 USPQ 269, 271 (TTAB 1970) (leave to amend to substitute proper party granted where opposition was filed in name of the individual rather than in the name of the corporation); *Pyco, Inc. v. Pico Corp.*, 165 USPQ 221, 222 (TTAB 1969) (where succession occurred prior to filing of opposition, erroneous identification of opposer as a partner in a firm which no longer existed was not fatal); *Raker Paint Factory v. United Lacquer Manufacturing Corp.*, 141 USPQ 407, 409 (TTAB 1964) (sole owner substituted for partnership where original plaintiff identified as partnership composed of that individual, since originally named plaintiff was not actually in existence when opposition was filed and even if it were, as a partner, he is a successor to the partnership).

Cf. also In re Tong Yang Cement Corp., 19 USPQ2d 1689, 1690 (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); *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078, 1079 (Comm'r 1990) (permitted to amend name of registrant in Trademark Act §§ 8 and 15, 15 U.S.C. §§ 1058 and 1065, declaration where

trade name was inadvertently substituted for corporate name); *In re Techsonic Industries, Inc.*, 216 USPQ 619, 620 (TTAB 1982) (allowed to correct application where applicant was identified by only a portion of its earlier used name and earlier name had already been supplanted by new name at time application was filed, but at all times was one single entity); *Argo & Co. v. Springer*, 198 USPQ 626, 634 (TTAB 1978) (Board granted applicant's motion to change its name from corporation which was defectively incorporated to individuals who were true owners of mark at time of filing); *In re Eucryl, Ltd.*, 193 USPQ 377, 378 (TTAB 1976) (exclusive U.S. distributor is owner only if it has agreement with manufacturer providing for right to apply; since distributor had no right to apply, despite its being a sister company and thus related to manufacturer, subsequent assignment to manufacturer did not cure defect); *Argo & Co. v. Springer*, 189 USPQ 581, 582 (TTAB 1976) (defendant can be substituted when originally named party was not in existence at time of filing complaint); *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613, 614 (Comm'r 1974) (deletion of "company" permissible).

207 Requirements for Showing of Cause; Extraordinary Circumstances

37 C.F.R. § 2.102(c) *The time for filing an opposition shall not be extended beyond 180 days from the date of publication. Any request to extend the time for filing an opposition must be filed before thirty days have expired from the date of publication or before the expiration of a previously granted extension of time, as appropriate. Requests to extend the time for filing an opposition must be filed as follows:*

(1) *A person may file a first request for:*

(i) *Either a thirty-day extension of time, which will be granted upon request; or*

(ii) *A ninety-day extension of time, which will be granted only for good cause shown. A sixty-day extension is not available as a first extension of time to oppose.*

(2) *If a person was granted an initial thirty-day extension of time, that person may file a request for an additional sixty-day extension of time, which will be granted only for good cause shown.*

(3) *After receiving one or two extensions of time totaling ninety days, a person may file one final request for an extension of time for an additional sixty days. No other time period will be allowed for a final extension of the opposition period. The Board will grant this request only upon written consent or stipulation signed by the applicant or its authorized representative, or a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, or a showing of extraordinary circumstances. No further extensions of time to file an opposition will be granted under any circumstances.*

207.01 In General

The time for filing an opposition will not be extended beyond 180 days from the date of publication. [Note 1.] No more than three requests to extend the time to oppose may be filed. [Note 2.] During the initial 30-day period following publication of the mark, a potential opposer may file a first request for a thirty-day extension without a showing of cause, *see* TBMP § 207.02, followed by a request for a sixty-day extension for good cause. [Note 3.] If granted, the potential opposer will have until 120 days from the date of publication within which to oppose. Alternatively, the potential opposer may file a single first request for a ninety-day extension of time for good cause thereby obtaining, if granted, an extension up to 120 days from the date of publication. [Note 4.] A sixty-day extension if not available as a first extension of time to oppose. [Note 5.] After one or two granted requests totaling 120 days from the date of publication, *see* TBMP § 207.02, the potential opposer may request one final extension of time for an additional sixty days, but only with the consent of applicant or a showing of extraordinary circumstances. [Note 6.]

The final request (for the 120-180 day period after publication) can only be granted for sixty days and not any other period of time. [Note 7.] For example, within the 90-120 day period from publication, the potential opposer cannot request a thirty day extension of time, even with the consent of the applicant. If an extension of less than sixty days is requested, even if based on consent, the request will be denied unless the reasons stated for the granting of the request are determined to be extraordinary, in which case the request will be granted for sixty days. In other words, although a thirty day extension of time is not permissible under 37 C.F.R. § 2.102(c)(3), the presence of extraordinary circumstances would allow the granting of a sixty-day extension of time. No further extensions of time to oppose will be permitted.

The following chart illustrates the initial publication period and extensions of time to oppose which may be granted:

<table>
<tr><td rowspan="2">Publication
30 days
37 C.F.R. § 2.102(c)</td><td>First 30 days – no reason necessary
37 C.F.R. § 2.102(c)(1)(i)</td><td>Next 60 days – for good cause or consent
37 C.F.R. § 2.102(c)(2)</td><td rowspan="2">Final 60 days – with consent or under extraordinary circumstances
37 C.F.R. § 2.102(c)(3)</td></tr>
<tr><td colspan="2">First 90 Days – for good cause or consent
37 C.F.R. § 2.102(c)(1)(ii)</td></tr>
</table>

NOTES:

1. 37 C.F.R. § 2.102(c)(3).

2. 37 C.F.R. § 2.102(c)(1)(i) - 37 C.F.R. § 2.102(c)(2).

3. 37 C.F.R. § 2.102(c)(1)(i) and 37 C.F.R. §2.102(c)(2).

4. 37 C.F.R. § 2.102(c)(1)(ii).

5. 37 C.F.R. § 2.102(c)(1)(ii).

6. 37 C.F.R. § 2.102(c)(3).

7. 37 C.F.R. § 2.102(c)(3).

207.02 Extensions Up to 120 Days From the Date of Publication

A first extension of time to oppose for not more than thirty days will be granted upon written request, if the request is otherwise appropriate (e.g., is timely filed by a party who believes it would be damaged by registration, and identifies the potential opposer with reasonable certainty). *See* TBMP § 202 (Time for Filing Request), TBMP § 206 (Who May File an Extension of Time to Oppose). No showing of cause is required for the first thirty-day extension. [Note 1.]

Following the first thirty-day extension of time to oppose, the Board may grant a further extension of time for sixty days, provided good cause is shown for the further extension and the request is otherwise appropriate (e.g., is timely filed before the first thirty-day extension expires, and includes a showing of privity, if necessary). [Note 2.] *See*TBMP § 202 (Time for Filing Request), TBMP § 206 (Who May File an Extension of Time to Oppose).

Alternatively, a potential opposer may request a ninety-day extension of time in the first request, provided good cause for the extension is shown. [Note 3.] If an otherwise proper first extension request seeks an extension of ninety days, but does not include a showing of good cause for the time in excess of thirty days, the potential opposer will be granted an extension of only thirty days. [Note 4.]

See TBMP § 209.02 for information on calculating extension expiration dates.

A showing of good cause for an extension of time to oppose over thirty days must set forth the reasons why additional time is needed for filing an opposition. Circumstances that may constitute good cause include the potential opposer's need to investigate the claim, the potential opposer's need to confer with or obtain counsel, applicant's consent to the extension, settlement negotiations between the parties, the filing of a letter of protest by the potential opposer, an amendment of the subject application, the filing of a petition to the Director from the grant or denial of a previous extension, and civil litigation between the parties. The merits of the potential opposition are not relevant to the issue of whether good cause exists for the requested extension. *See*TBMP § 215 (Effect of Letter of Protest), TBMP § 212 (Amendment of Application During or After Extension), TBMP § 211.03 (Petition to the Director).

NOTES:

1. *See* Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 C.F.R. § 2.102(c)(1)(i).

2. 37 C.F.R. § 2.102(c)(2).

3. 37 C.F.R. § 2.102(c)(1)(ii).

4. *See Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (under previous rule, potential opposer only entitled to extension of 30 days where initial request exceeded thirty days by two days and potential opposer did not assert good cause for additional days).

207.03 Extensions Beyond 120 Days From the Date of Publication

The time for filing an opposition will not be extended beyond 180 days from the date of publication. After one or two granted requests totaling 120 days from the date of publication, *see*TBMP § 207.02, and prior to the expiration of the previous request, the potential opposer may request one final extension of time for an additional sixty days. [Note 1.]

The final request (for the 120-180 day period after publication) can only be granted for sixty days and not any other period of time. [Note 2.] For example, within the 90-120 day period from publication, the potential opposer cannot request a thirty day extension of time, even with the consent of the applicant. If an extension of less than sixty days is requested, even if based on consent, the request will be denied unless the reasons stated for the granting of the request are determined to be extraordinary, in which case the request will be granted for sixty days. In other words, although a thirty day extension of time is not permissible under 37 C.F.R. § 2.102(c)(3), the presence of extraordinary circumstances would allow the granting of a sixty day extension of time. No further extensions of time to file an opposition will be granted under any circumstances. [Note 3.]

The Board will grant this request if the potential opposer submits one of the following: (1) a written consent or stipulation signed by the applicant or its attorney, or (2) a request by the potential opposer or its attorney

stating that the applicant has consented to the request, or (3) a showing of extraordinary circumstances. [Note 4.]

Extraordinary circumstances are those which are beyond what is usual or ordinary, for example fire, extreme weather, or death. Settlement negotiations between the parties, the filing of a letter of protest by the potential opposer, the pendency of a post-publication amendment, or civil litigation between the parties do not constitute extraordinary circumstances. [Note 5.]

Applicant's consent to an extension of time to oppose must be express, though it may be provided orally, and the extension request must state that such consent has been provided. It is not sufficient to indicate in the extension request that the parties are discussing settlement; the request must expressly state that applicant has consented to the extension. [Note 6.] In the rare circumstances where the rules permit the request to be filed in paper form, the statement of applicant's consent should appear in the body of the request, not merely in the title (e.g. "Consented Request to Extend") of the filing.

ESTTA provides prompts for either of these elements (extraordinary circumstances or applicant's consent) and a request will not be electronically transmitted to the Office until one of these fields is selected and completed. As a result, extension requests successfully filed using ESTTA will rarely, if ever, be deficient for failure to supply the statement of extraordinary circumstances, or the statement that applicant has consented.

In the case of a permitted paper filing, if one of these elements (i.e., the showing of extraordinary circumstances, or applicant's written consent, or the statement that applicant has consented) is omitted from an extension request based in whole or in part upon the omitted element, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the previous extension. [Note 7.]

See TBMP § 209.02 for information on calculating extension expiration dates.

NOTES:

1. 37 C.F.R. § 2.102(c)(3).

2. 37 C.F.R. § 2.102(c)(3).

3. 37 C.F.R. § 2.102(c)(3).

4. 37 C.F.R. § 2.102(c)(3).

5. *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (mere existence of settlement discussions does not constitute extraordinary circumstances).

6. *See In re Su Wung Chong*, 20 USPQ2d 1399, 1400 (Comm'r 1991) (inadvertent omission of showing of extraordinary circumstances, or consent, at the time extension request was filed does not constitute reason to accept extension; whether applicant's silence in response to potential opposer's inquiries about extension requests amounted to consent was "not the question on petition.").

7. *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (extraordinary circumstances not shown for extension; subsequently obtained consent insufficient). *Cf. In re Spang*

Industries, Inc. 225 USPQ 888, 888 (Comm'r 1985) (potential opposer not identified with reasonable certainty; defect not curable after time for filing extension expired).

208 Essential Element Omitted

Extension requests filed through ESTTA cannot be electronically transmitted to the Office unless all required fields, including the signature field, are completed, and therefore, ESTTA will not process a request that is missing an essential element (e.g., allegation of consent, extraordinary circumstance). As a result, extension requests successfully filed using ESTTA will rarely, if ever, be deficient for failure to supply an essential element of the request.

Where filing in paper form is undertaken and permitted, if any element (e.g., identification of potential opposer, showing of good cause, showing of extraordinary circumstances, applicant's written consent, statement that applicant has consented) essential to a particular request for extension of time to oppose is omitted from the request, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the thirty-day opposition period following publication of the subject mark, in the case of a first request, or prior to the expiration of the previous extension, in the case of a request for a further extension. [Note 1.]

In the circumstance where a permitted paper filing of an extension of time to oppose is missing the required signature, the unsigned paper request will not be refused consideration if a signed copy is submitted to the Office within the time limit set in the written notification of this defect by the Board. [Note 2.] *See*TBMP § 106.02. *See also*TBMP § 114;TBMP § 203.03.

NOTES:

1. *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (extraordinary circumstances not shown for extension; subsequently obtained consent insufficient); *In re Spang Industries, Inc.*, 225 USPQ 888 (Comm'r 1985) (potential opposer not identified with reasonable certainty; defect not curable after time for filing extension expired).

2. *See* 37 C.F.R. § 2.119(e).

209 Action by Board on Request

209.01 Suspension Policy

The Board will not suspend the running of an extension of time to oppose for any reason. A potential opposer must either continue to file timely requests for extensions of time, if it wishes to preserve its right to oppose, or file the notice of opposition. Once the notice of opposition is filed, however, the Board will suspend the opposition under appropriate circumstances. *See, e.g.,*TBMP § 211.03 (no suspension pending decision on petition to the Director), TBMP § 212.05 (no suspension pending consideration of amendment), TBMP § 215 (no suspension pending determination regarding letter of protest), TBMP § 216 (no suspension pending cancellation of an inadvertently issued registration). For information on the suspension of an opposition proceeding *after* commencement, see TBMP § 510.

209.02 Determination of Extension Expiration Date

ESTTA automatically calculates extension dates, in the permissible intervals, with the appropriate fee, where applicable.

The extension expiration date stated in an action granting an extension is the date upon which the extension actually expires, even if that date is a Saturday, Sunday, or a federal holiday within the District of Columbia. If the expiration date falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, an opposition, or a request for a further extension, filed by the potential opposer on the next succeeding day which is not a Saturday, Sunday, or a federal holiday will be considered timely. [Note 1.] *See*TBMP § 112. However, the beginning date for calculating any subsequent extension is the actual expiration date of the previous extension, regardless of whether the expiration date fell on a weekend or federal holiday. [Note 2.]

A potential opposer may file a first request for a thirty-day extension without a showing of cause, [Note 3] followed by a request for a sixty-day extension for good cause that is filed prior to the expiration of the first thirty-day period. [Note 4.] *See*TBMP § 207.02. Alternatively, the potential opposer may file a single request for a ninety-day extension of time for good cause. [Note 5.] After one or two granted requests totaling 120 days from the date of publication, *see*TBMP § 207.02, and prior to the expiration of the previous extension, the potential opposer may file one final extension request for an additional sixty days with the consent of applicant or a showing of extraordinary circumstances. [Note 6.]

Extensions of time to oppose will only be granted in the increments set out in 37 C.F.R. § 2.102(c).

ESTTA automatically calculates the appropriate extension periods, and filers will be prompted to select a time period which complies with 37 C.F.R. § 2.102(c).

For permitted paper filings, incorrectly requested time periods are addressed as follows:

If a paper filing of a potential opposer seeks a *first* request for an extension of time to oppose which is longer than thirty days (or seeks an extension of "thirty days," but specifies an extension expiration date which is later than the expiration date of the requested "thirty days"), and good cause is shown and the required fee submitted, the extension, if granted, will be set to expire in ninety days. [Note 7.] *See*TBMP § 207.02.

If a permitted paper filing of a potential opposer seeks a *further* request for extension of time to oppose (that is, beyond a first thirty-day request) and asks for a time which is longer or shorter than sixty days (or asks for certain number of days, but specifies an extension expiration date which is longer or shorter than the expiration date of the requested number of days), shows good cause and submits the required fee, the additional extension, if granted, will be set to expire in sixty days. [Note 8.]

If a permitted paper filing of a potential opposer requests an extension of time for any other period other than a sixty-day request after receiving a first thirty-day and an additional sixty-day extension of time, or a first ninety-day extension of time, the request will be denied unless the party has shown extraordinary circumstances and submitted the required fee. [Note 9.] *See*TBMP § 207.03.

See TBMP § 204 for information on the required fees for certain extensions of time to oppose.

NOTES:

1. *See* 37 C.F.R. § 2.195 (Receipt of trademark correspondence); 37 C.F.R. § 2.196 (Times for taking action: Expiration on Saturday, Sunday or federal holiday); *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (30-day extension expired on Saturday; rule allowing filing of opposition or subsequent extension on following Monday does not extend opposition period; subsequent extension period ran from Saturday, not the next Monday).

2. *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991).

3. *See* 37 C.F.R. § 2.102(c)(1)(i).

4. *See* 37 C.F.R. § 2.102(c)(2).

5. *See* 37 C.F.R. § 2.102(c)(1)(ii).

6. *See* 37 C.F.R. § 2.102(c)(3).

7. *See* 37 C.F.R. § 2.102(c)(1)(i) and 37 C.F.R. § 2.102(c)(2) ("A sixty-day extension is not available as a first extension of time to oppose."). *Cf. Kimberly-Clark Corp. v. Paper Converting Industries, Inc.*, 21 USPQ2d 1875, 1877 (Comm'r 1991) (under former rules, initial request extending beyond thirty days with required showing of good cause granted).

8. *See* 37 C.F.R. § 2.102(c)(2).

9. *See* 37 C.F.R. § 2.102(c)(3).

210 Objection to Request

Since a request for an extension of time to oppose is ex parte in nature, there is no requirement that a copy has to be served upon the applicant. *See* TBMP § 203.04. For the same reason, an applicant is not notified of the filing of an extension request before the Board has acted on it. The Board's action on the extension request constitutes notice to the applicant of the extension request, a copy of which may be viewed at **http://ttabvue.uspto.gov**.

An applicant may learn of the filing of an extension request, and file an objection thereto, before applicant receives notice from the Board of the request. This may happen, for example, when a potential opposer serves a courtesy copy of the request upon applicant. If the Board receives an objection before it acts upon the request, the Board will consider the objection. If the objection is received after action on the request, and the request has been granted, the objection will be treated as a request for reconsideration.

However, ESTTA automatically processes requests for extension of time to oppose within minutes of filing. Consequently, it is rare for an applicant to learn of an extension request in time to file an objection prior to Board action on it. Accordingly, an applicant that receives notification from the Board that an extension request has been filed and granted may submit objections in the form of a request for reconsideration. *See*TBMP § 211.01 (Request for Reconsideration).

An applicant who receives notification from the Board that a request for extension of time to oppose has been granted may submit an objection to the granting of any further extensions of time to the potential

opposer. In such a case, the objection will be considered by the Board in determining any subsequent request for an extension of time to oppose filed by the potential opposer. If the Board does not receive an objection until after the Board has granted a subsequent extension request, the objection will be treated as a request for reconsideration of the Board's action.

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

An ESTTA form for electronically filing an objection is now available. Consequently, the filing must be made through ESTTA.

211 Relief From Action of Board

211.01 Request for Reconsideration

If an applicant or potential opposer is dissatisfied with an order of the Board on a request for an extension of time to oppose, it may file a request for reconsideration of the action, stating the reasons. The request should be filed promptly after the filing party learns of or receives the Board's order, whichever is first.

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

There is no requirement that a request for reconsideration be served upon the non-filing party. If there is no indication that service has been made, the Board will send the non-filing party a copy of the request, usually in the nature of a link to the TTABVUE database, together with that party's copy of the Board's order granting or denying the request.

The filing of a request for reconsideration of the denial, or the granting, of a request for an extension of time to oppose does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, before the expiration of the relevant extension. [Note 1.] The Board will not suspend the time for filing an opposition or a subsequent extension of time pending consideration of a request for reconsideration. *See* TBMP § 209.01.

An ESTTA form for electronically filing a request for reconsideration is now available. Consequently, the filing must be made through ESTTA.

NOTES:

1. *Cf.* 37 C.F.R. § 2.89(g).

211.02 Relief after Institution of Opposition

If an applicant is dissatisfied with an order of the Board on a request for an extension of time to oppose and the opposition has been filed and instituted, the applicant may raise the issue by means of a motion to dismiss the opposition for lack of jurisdiction. [Note 1.]

NOTES:

1. *Central Manufacturing Inc. v. Third Millennium Tech. Inc.*, 61 USPQ2d 1210, 1215 (TTAB 2001) (motion to dismiss granted where it was found that opposer's allegations of consent and good cause for extension request were untrue); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1075 n.2 (TTAB 1993) (applicant may question propriety of extensions of time in a motion to dismiss).

211.03 Petition to the Director

If an applicant or potential opposer is dissatisfied with an order of the Board on a request for an extension of time to oppose, it may file a petition to the Director for review of the order in question. [Note 1.]

The petition to the Director must include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the requisite fee, as specified in 37 C.F.R. § 2.6. Any brief in support of the petition must be embodied in or accompany the petition. If facts are to be proved, the proof must be in the form of verified statements which, with any exhibits thereto, must accompany the petition. [Note 2.]

A petition from the grant or denial of a request for an extension of time to oppose must be filed not later than 15 days after the issue date of the grant or denial of the request. [Note 3.] A petition from the denial of a request must be served on the attorney, if any, or on the applicant. [Note 4.] A petition from the grant of a request must be served on the attorney, if any, or on the opposer. [Note 5.] Proof of service of the petition must be made as provided in 37 C.F.R. § 2.119 . [Note 6.] *See* TBMP § 113.03 (Elements of Certificate), and TBMP § 113.04 (Manner of Service). The potential opposer or the applicant, as the case may be, may file a response not later than 15 days after the date of service of the petition. [Note 7.] A copy of the response must be served upon the petitioner, with proof of service as provided by 37 C.F.R. § 2.119. No further document relating to the petition may be filed. [Note 8.]

The filing of a petition by the potential opposer from the denial, or by the applicant from the granting, of a request for an extension of time to oppose, does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, prior to the expiration of the extension which is the subject of the petition. [Note 9.] The filing of a petition will constitute good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication. The Board will not suspend the time for filing an opposition or subsequent extension pending consideration of a petition to the Director. *See*TBMP § 209.01.

If the petition is resolved unfavorably to opposer during the running of an extension of time, any opposition or request for further extension of time to oppose filed during or after the extension period in question will be rejected as untimely.

If a potential opposer files a timely opposition during the pendency of its petition to the Director, the Board will institute the opposition. At the same time, the Board will normally suspend the opposition pending

resolution of the petition. If, along with the notice of opposition, the opposer files a motion to suspend the opposition, citing the pending petition as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and state that the opposition is suspended pending resolution of the petition to the Director. A copy of the Board's order will be sent to both parties.

If the decision on the petition is ultimately unfavorable to opposer, the opposition will be dismissed.

NOTES:

1. 37 C.F.R. § 2.146 (Petitions to the Director). *See* TMEP § 1704 (Petitionable Subject Matter).

2. 37 C.F.R. § 2.146(c).

3. 37 C.F.R. § 2.146(e)(1).

4. 37 C.F.R. § 2.146(e)(1).

5. 37 C.F.R. § 2.146(e)(1).

6. 37 C.F.R. § 2.146(e)(1).

7. 37 C.F.R. § 2.146(e)(1).

8. 37 C.F.R. § 2.146(e)(1).

9. *See* 37 C.F.R. § 2.146(g); *In re Docrite Inc.*, 40 USPQ2d 1636, 1637 n.1 (Comm'r 1996) (citing 37 C.F.R. § 2.146(g) and stating that filing petition to review denial of request to extend time to oppose does not stay time to file opposition or further extensions of time to oppose).

212 Amendment of Application During or After Extension

212.01 Jurisdiction to Consider Amendment

The Board has no jurisdiction over an application unless and until the application becomes involved in a Board inter partes proceeding. [Note 1.] That is, although the Board administers requests for extensions of time to oppose, and has jurisdiction over matters relating to any requested extensions of time to oppose an application, the Board does not have jurisdiction over the subject application until a notice of opposition is filed. In the absence of an inter partes proceeding, the Board has jurisdiction only over matters relating to any requested extensions of time to oppose.

Thus, if, in an application which is the subject of a request for an extension of time to oppose, an amendment or other submission (such as a request for republication, a request for reconsideration of a refusal to approve an amendment) relating to the application is filed by the applicant, unless the application is involved in any Board inter partes proceeding, it is the Trademark Examining Operation (and not the Board) which must determine the propriety of the amendment or other submission. [Note 2.] That is, unless an inter partes proceeding (i.e., an opposition or concurrent use proceeding) is pending, all post-publication amendments concerning an application which is the subject of a request for an extension of time to oppose must be filed with the Trademark Examining Operation. [Note 3.]

However, the Board does determine the propriety of a request filed by an attorney to withdraw as applicant's representative, in an application which is the subject of a request for an extension of time to oppose. The Board has jurisdiction to consider the request to withdraw as representative in such a case, because applicant's representative of record acts on applicant's behalf in matters relating to the requested extensions of time to oppose. *See*TBMP § 114-TBMP § 116 for information on representation of parties before the Board. *See also*TBMP § 203.03.

Any amendment to an application which is the subject of a request for an extension of time to oppose that is proposed by an applicant prior to the commencement of an inter partes proceeding, whether of its own volition or to accommodate a concern of a potential opposer, must be filed electronically through TEAS. Inquiries regarding the procedure for submitting a post-publication amendment, or questions regarding the status of a pending post-publication amendment, can be made by calling the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199.

Because the Board does not have jurisdiction over an application until the commencement of an inter partes proceeding, parties should take care to direct amendments filed during the opposition period (as extended) to the Trademark Examining Operation as noted above, and not the Board. Filing such submissions with the Board will only delay consideration of the amendment. Moreover, the Board will not suspend the time for filing an opposition or subsequent extension pending consideration of an amendment. *See* TBMP § 209.01. While the pendency of an amendment to an application will normally constitute good cause for an extension of time to oppose under 37 C.F.R. § 2.102(c)(1)(ii) or 37 C.F.R. § 2.102(c)(2) (extensions up until 120 days from the date of publication), it will not be considered an extraordinary circumstance justifying an extension of time to oppose under 37 C.F.R. § 2.102(c)(3) (extension 120-180 days from publication). TBMP § 207.03. Parties seeking amendment of a published application as a means to avoid the filing of an opposition are thus advised to do so as early in the opposition period as possible.

NOTES:

1. *Compare* 37 C.F.R. § 2.84 (examining attorney may exercise jurisdiction over application prior to publication, and with the permission of the Director, after publication) *with* 37 C.F.R. § 2.133 (application subject to an opposition may not be amended in substance without Board approval). *See generally*TMEP § 1504 (Jurisdiction over Application).

2. *See* 37 C.F.R. § 2.84; *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1535 (Comm'r 1991). *Cf. Groening v. Missouri Botanical Garden*, 59 USPQ2d 1601, 1603 (Comm'r 1999) (mark originally published in wrong class may be amended by examining attorney to the correct class and republished in the correct class without either applicant's approval or a restoration of jurisdiction).

3. For information on the procedures for filing and processing post-publication amendments with the Trademark Examining Operation, see TMEP § 1505 (Amendments Filed by Applicants After Publication).

212.02 Conditions for Approval of Post-Publication Amendment

During the time between the publication of a mark in the Official Gazette for opposition, and the issuance of a certificate of registration or notice of allowance, an application not involved in an inter partes proceeding before the Board may be amended upon request by the applicant with the Trademark Examining Operation, provided that the amendment meets the requirements of 37 C.F.R. § 2.71, 37 C.F.R. § 2.72 and 37 C.F.R. § 2.74. [Note 1.] Otherwise, an amendment to such an application may be submitted only upon petition to the Director to restore jurisdiction over the application to the examining attorney for consideration of the

amendment and further examination. [Note 2]. If a proposed amendment would necessitate issuance of a refusal or requirement by the examining attorney, the amendment cannot be made unless applicant (1) successfully petitions the Director to restore jurisdiction over the application to the examining attorney for consideration of the amendment and further examination, and (2) is able to satisfy any requirement or overcome any refusal asserted in any Office action issued after the restoration of jurisdiction. [Note 3.]

Examples of the types of amendments which may be made under the conditions described above include acceptable amendments to the identification of goods or services, to the drawing, to add a disclaimer, and (in the case of an application under Trademark Act § 1(a), 15 U.S.C. § 1051(a), or an application under Trademark Act § 1(b), 15 U.S.C. § 1051(b), in which an acceptable amendment to allege use has been filed), to convert an application for an unrestricted registration to one for concurrent use registration. [Note 4.]

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

NOTES:

1. 37 C.F.R. § 2.84(b).

2. 37 C.F.R. § 2.84(b).

3. *See, e.g.,* 37 C.F.R. § 2.84(b); TMEP § 1504 (Jurisdiction over Application); TMEP § 1505 *et seq.* (Amendments filed by Applicants After Publication).

4. *See In re MCI Communications Corp.*, 21 USPQ2d 1534, 1539 (Comm'r 1991) (disclaimer). *Cf. In re Little Caesar Enterprises, Inc.*, 48 USPQ2d 1222, 1223 (Comm'r 1998) (regarding request to divide certain items out of a class of goods during extension of time to oppose, and petition to waive rule requiring that request to divide be filed before application is approved for publication). *See generally* TMEP § 1505.01 regarding procedures for processing amendments filed after publication.

212.03 Form of Amendment

An amendment or other submission relating to an application which is the subject of a request for an extension of time to oppose should be in the normal form for an amendment or other submission relating to an application. Such amendments should be filed with the Trademark Examining Operation electronically through TEAS. Inquiries regarding the procedure for submitting a post-publication amendment, or questions regarding the status of a pending post-publication amendment, can be made by calling the Trademark Assistance Center at (571) 272-9250 or (800) 786-9199.

212.04 Action by Board - Upon Receipt of Amendment

Amendments filed in applications which are the subject of an extension of time to oppose are acted on by the Trademark Examining Operation and not by the Board, and must be filed electronically through TEAS, with limited exceptions. [Note 1.] Filing such amendments with the Board serves only to delay their consideration. If an amendment is received by the Board, the amendment will be forwarded to the Trademark Examining Operation.

NOTES:

1. *See* 37 C.F.R. § 2.23(c) and 37 C.F.R. § 2.56(d); Examination Guide 1-20 (Revised): Mandatory Electronic Filing and Specimen Requirements (February 2020).

212.05 Action by Board - During Consideration of Amendment by TMEO

The filing and pendency of an amendment will be considered good cause for extensions of time to oppose under 37 C.F.R. § 2.102(c)(1)(ii) or 37 C.F.R. § 2.102(c)(2) (extensions up to 120 days from the date of publication), but it will not constitute extraordinary circumstances justifying an extension of time under 37 C.F.R. § 2.102(c)(3) (extension 120-180 days from publication). *See* TBMP § 207.03. The Board will not suspend the time for filing an opposition or subsequent extension pending consideration of an amendment. *See*TBMP § 209.01.

If a timely opposition is filed while an amendment is still pending before the Trademark Examining Operation, the Board will institute the opposition. Upon the motion of either party, the Board will usually grant a motion to suspend the opposition pending consideration of the amendment by the Trademark Examining Operation. Such a motion to suspend should be promptly filed through ESTTA by either party to an opposition proceeding once that party becomes aware of the filing of the amendment with the Trademark Examining Operation.

212.06 Action by Board - After Consideration of Amendment by TMEO

If an opposition was instituted and suspended prior to the action by the Trademark Examining Operation on a post-publication amendment, and the amendment is subsequently approved, the Board will notify the parties that the amendment was approved, advise the parties that the opposition will go forward on the basis of the application as amended, allow opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have the opposition dismissed. The Board will also suspend the opposition (or continue suspension) pending opposer's response. If opposer chooses to go forward, proceedings in the opposition will be resumed and appropriate dates will be set or reset. If the amendment is not approved, the parties will be so advised, and proceedings will be resumed with appropriate dates set or reset.

212.07 Amendment During Opposition

If an amendment is filed in an application that is the subject of an opposition, the Board has jurisdiction over the application and will determine the propriety of the amendment. Once an opposition has commenced, the application that is the subject of the opposition may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or upon motion granted by the Board. [Note 1.] *See*TBMP § 514 (Motion to Amend Application or Registration).

NOTES:

1. *See* 37 C.F.R. § 2.133.

213 Effect of Restoration of Jurisdiction

If the examining attorney wishes to issue a new refusal or make a requirement in an application that is the subject of a request for an extension of time to oppose, the examining attorney must make a request to the Director to restore jurisdiction over the application to the examining attorney for that purpose. [Note 1.] If the application is the subject of an opposition, the examining attorney's request for jurisdiction must be

directed to the Board. [Note 2.] It should be noted that with respect to an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), if an opposition has commenced, the examining attorney may not request remand, [Note 3], and that before an opposition commences, a request to restore jurisdiction must be directed to the Director, who will take into consideration the time constraints established by treaty regarding notification of the International Bureau of the World Intellectual Property Organization of any refusal. Thus, because an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), is time-sensitive, the granting of a request to return such application to the examination process is unlikely. [Note 4.]

A request for jurisdiction that is granted by the Director during an unexpired extension of time to oppose does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, before the expiration of the previous request. After the Board learns that the examining attorney's jurisdiction has been restored during the running of an extension of time to oppose, a Board administrative staff member will prepare an order advising potential opposer and applicant.

As appropriate, the order will approve the extension of time (or, if already approved, note that potential opposer has been granted an extension of time to oppose until a specified date); instruct the examining attorney that if the application is subsequently approved, and the mark is not republished, the application remains subject to any current extensions of time to oppose or oppositions which may have been timely filed; and advise potential opposer that the restoration of jurisdiction does not relieve the potential opposer of the responsibility of filing an opposition, or a further request for extension of time to oppose, prior to the expiration of the previous request.

The restoration of jurisdiction (or the filing of a request for jurisdiction) will constitute good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication. The Board will not suspend the time for filing an opposition or subsequent extension of time to oppose during restoration of jurisdiction to the examining attorney. *See* TBMP § 209.01.

If, after jurisdiction has been restored, and during the running of an extension of time, the examining attorney approves the application, and the mark is not republished, the Board administrative staff member will issue an order so advising the potential opposer and applicant. The order will also approve the extension of time, if appropriate (or, if already approved, note that potential opposer has been granted an extension of time to oppose until a specified date).

If, after consideration before the examining attorney, the mark is republished, or if registration is ultimately denied, any time remaining in the opposition period, as extended (and any further request for extension) will be moot. No further extension of the original opposition period will be granted. Rather, a potential opposer's time for opposing will recommence on the date of republication.

If a timely opposition is filed while the question of registrability is still before the examining attorney, the Board will institute the opposition. At the same time, the Board will normally suspend proceedings until the registrability of the mark has been finally determined. If, at the time the notice of opposition is filed, the opposer files a motion to suspend the opposition, citing the restoration of jurisdiction as the reason for suspension, the Board will institute the opposition, grant the motion to suspend, and indicate that the opposition is suspended pending final determination of the registrability of the mark. To ensure suspension under such circumstances, the opposer should concurrently, but in a filing separate from the notice of opposition, move to suspend the opposition.

If the examining attorney subsequently approves the application, and the mark is republished, and if the change reflected in the republication is one that might have an effect upon an opposition which was timely

filed, the Board will issue an order notifying opposer and applicant of the republication, and of the reason therefor; explain that the opposition will be determined on the basis of applicant's correct (or amended) mark, goods or services, disclaimer status, etc.; and allow opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have the opposition dismissed as a nullity. If opposer chooses to go forward, proceedings in the opposition will be resumed and appropriate dates will be set or reset.

If registration is ultimately denied by the examining attorney, any timely filed opposition will be dismissed as a nullity.

NOTES:

1. *See* 37 C.F.R. § 2.84(a); TMEP § 1504.01 (Jurisdiction of Examining Attorney), TMEP § 1504.02 (Jurisdiction of Trademark Trial and Appeal Board); *In re Hershey*, 6 USPQ2d 1470, 1471 n.2 (TTAB 1988) (restoration of jurisdiction to examining attorney by Director is not subject to review by the Board).

2. *See* 37 C.F.R. § 2.130 (new matter suggested by the trademark examining attorney); TMEP § 1504.02.

3. *See* TMEP § 1504.05.

4. *See* TMEP § 1902.02(l).

214 Effect of Republication

The examining attorney may determine that an application filed under Trademark Act § 1 or Trademark Act § 44, 15 U.S.C. § 1051 or 15 U.S.C. § 1126, that is the subject of a request for an extension of time to oppose must be republished. This may happen, for example, when the goods or services, although properly identified in the application itself, were published incorrectly; when a disclaimer was mistakenly included in the original publication; or when the application has been amended after publication (but before the filing of an opposition), and the amendment is of such nature as to require republication. [Note 1.] Republication may not be available to applications filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), due to the time requirements of the Madrid Protocol. [Note 2.]

If a mark is republished by order of the examining attorney, any opposition filed during the original thirty-day opposition period, or within a granted extension thereof, is considered by the Board to be timely. If the change reflected in the republication is one that might have an effect upon the opposition, the Board will issue an order notifying opposer and applicant of the republication, and of the reason therefor; explain that the opposition will be determined on the basis of the application as amended; and allow opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have its opposition dismissed.

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

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

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

NOTES:

1. *See*TMEP § 1505.03 and TMEP § 1505.03(a) listing examples of amendments for which republication is necessary and TMEP § 1505.03(b) listing those for which republication is not necessary.

2. *See* Trademark Act § 68(c) and Trademark Act § 69(a), 15 U.S.C. § 1141h(c) and 15 U.S.C. § 1141i(a); *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2020 (TTAB 2005) (discussing time constraints applicable to Trademark Act § 66(a), 15 U.S.C. § 1141f(a) (Madrid Protocol) applications).

215 Effect of Letter of Protest

A third party that has objective evidence bearing upon the registrability of a mark in a pending application may bring such evidence to the attention of the Office by filing, with the Office of the Deputy Commissioner for Trademark Examination Policy ("Deputy Commissioner"), a "letter of protest" that complies with the requirements of 37 C.F.R. § 2.149. [Note 1.] The Deputy Commissioner will determine if the letter of protest complies with the requirements of Trademark Rule 2.149 and whether any submitted evidence should be included in the application record for consideration by the examining attorney. [Note 2.]

A letter of protest may be filed either before or after publication of the subject mark for opposition. However, a letter of protest filed after publication must be filed within thirty days after publication in order to be considered timely. [Note 3.] In the case of a published application that is not the subject of an opposition, if the Deputy Commissioner determines that the submission complies with the requirements of Trademark Rule 2.149 and submitted evidence will be included in the application record, jurisdiction over the application will be restored to the examining attorney to take appropriate action. This procedure applies regardless of whether a request for an extension of time to oppose the application is pending. If an opposition has been instituted, the Board has jurisdiction over the application and will restore jurisdiction to the examining attorney upon request. [Note 4.]

The filing of a letter of protest, whether before or after publication of the mark, does not stay the time for filing an opposition or an extension of time to oppose the subject mark. [Note 5.] If a party files a letter of protest before publication but the subject mark still publishes for opposition, then the party must timely file a request for extension of time to oppose, if it wishes to preserve its right to oppose. Similarly, if a party that files a letter of protest after publication wishes to preserve its right to oppose, it too must file a timely

request for an extension of time to oppose. [Note 6.] Regardless of when the letter of protest was filed, if the subject mark has been published for opposition, the party may choose to file a notice of opposition instead of a request for extension of time to oppose.

If a potential opposer indicates, in a first or a subsequent request for an extension of time to oppose, that it has filed a letter of protest (not yet determined by the Deputy Commissioner) with respect to the subject mark, such filing will constitute good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark. However, the filing will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication. The Board will not suspend the time for filing an opposition or subsequent extension of time to oppose pending consideration of a letter of protest. *See*TBMP § 209.01.

If a potential opposer indicates, in a first or a subsequent request for an extension of time to oppose, that a different party has filed a letter of protest (not yet determined by the Deputy Commissioner), with respect to a mark that is the subject of the potential opposer's request for an extension of time to oppose, the filing of the letter of protest will not be considered by the Board to constitute good cause for the granting of an extension to the potential opposer. In other words, a potential opposer may not rely on the filing of a letter of protest by a different party to establish good cause for its own extension of time to oppose.

Typically, a letter of protest is filed and a determination whether submitted evidence should be included in the applicaiton record is made before the mark is published. In such case, the examining attorney retains jurisdiction over the application and decides whether to issue a refusal based on the evidence included in the record. [Note 7.] Sometimes, a letter of protest is filed *before* the mark has been published for opposition but the Deputy Commissioner does not review the submission until after the mark has been published. In such case, if the mark has not been opposed, and the examining attorney determines that a refusal or requirement must be made based on the evidence included in the application record jurisdiction will be restored to the examining attorney to take action on the application. [Note 8.] In any case where an opposition has already been instituted when the Deputy Commissioner makes a determination to include evidence submitted with a letter of protest in the application record, jurisdiction rests with the Board, and therefore a request must be made to the Board to remand the application to the examining attorney to take a specific action. [Note 9.]

If the Deputy Commissioner includes evidence submitted with a letter of protest in the record of an application that is the subject of a first or subsequent request for an extension of time to oppose, the Board may address the consequences of the determination in any order on any further request to extend, or when instituting an opposition.

Examples are described below:

Determination Made on Letter of Protest During Extension of Time:

Sometimes, when an extension of time to oppose is granted, a determination also has been made to include evidence submitted with a letter of protest in the application record. If jurisdiction has been restored and the examining attorney has issued an Office action asserting a refusal or a requirement, and if a well-taken first or subsequent request for an extension of time to oppose is reviewed during this time, a Board administrative staff member may prepare an order notifying the potential opposer and applicant that jurisdiction over the application was restored to the examining attorney who has issued an Office action as a result of evidence submitted with a letter of protest being included in the record; and that neither the issuance of an action by the examining attorney nor the filing of a response and/or amendment by the applicant relieves the potential opposer of the responsibility of filing an opposition, or a further request for

extension of time to oppose, prior to the expiration of the previous request. While the Board attempts to provide such information to the applicant and potential opposer in every instance in which the letter of protest procedure results in jurisdiction being restored to the examining attorney and issuance of an Office action, if the Board fails to do so, the potential opposer is not excused from the noted responsibilities.

Determination Made on Letter of Protest During Opposition:

If a party files a timely opposition while a letter of protest is pending review by the Deputy Commissioner, the Board will institute the opposition as it normally would. If the Deputy Commissioner subsequently determines that the letter of protest (filed before or after publication of the subject mark) is compliant and includes evidence in the application record, a request to remand the application to the examining attorney will be made to the Board. [Note 10.] If the Board remands the application back to the examining attorney, the opposition will be suspended for as long as the question of registrability of the subject mark is before the examining attorney.

Please Note: A Trademark Act § 66(a) application may not be remanded under 37 C.F.R. § 2.130.

If a party files a timely opposition after a determination has been made to include evidence submitted with a letter of protest in the application record and after jurisdiction has been restored to the examining attorney, the Board will normally institute and suspend the opposition until the registrability of the mark has been finally determined by the examining attorney. To ensure suspension under such circumstances, the opposer should concurrently, but in a filing separate from the notice of opposition, move to suspend the opposition, citing the restoration of jurisdiction as the reason for suspension, when filing the notice of opposition.

If an opposed application is abandoned by the applicant for non-response to an Office action issued after jurisdiction has been restored to the examining attorney, or if a refusal made by the examining attorney is upheld on appeal, judgment will not be entered against the applicant under 37 C.F.R. § 2.135. Instead, the Board may resume the suspended opposition, giving opposer time to indicate whether it wishes to go forward to obtain a determination on the merits or to have the opposition dismissed as moot. If, however, applicant files a written abandonment without the written consent of every adverse party, judgment will be entered against applicant under 37 C.F.R. § 2.135. *See*TBMP § 602.01.

If the examining attorney subsequently withdraws any refusal or requirement issued in regard to an opposed application in which jurisdiction had been restored to the examining attorney, or if any refusal of registration is reversed on appeal, the Board should be notified for resumption of the suspended opposition. Republication of a mark following restoration of jurisdiction should be very rare, but if the mark is republished, and if the change reflected in the republication is one that might have an effect upon the opposition, the Board will resume the opposition and issue an order notifying opposer and applicant of the republication. The Board will note the reason for republication; explain that the opposition will be determined on the basis of the application as amended; and allow the opposer time to indicate whether it wishes to proceed with the opposition against the amended application, or have the opposition dismissed as moot. If opposer chooses to go forward, appropriate dates will be reset.

NOTES:

1. TMEP § 1715.

2. *See* TMEP § 1715. For information concerning the standard applied by the Deputy Commissioner in determining whether evidence submitted with a letter of protest should be entered into the record, see TMEP

§ 1705.03 (Letter of Protest Filed Before Publication), and TMEP § 1705.04 (Letter of Protest Filed on the Date of Publication or After Publication).

3. 37 C.F.R. § 2.149(c)TMEP §1715.02("Letters of protest filed more than 30 days after publication are untimely."). *Cf. National Cable Television Association Inc. v. American Cinema Editors Inc.*, 19 USPQ2d 1424 (Fed. Cir. 1991) (letter of protest filed after registration issued deemed "an ineffectual gesture").

4. TMEP § 1715.03(c)and TMEP § 1715.04(b) . *See also* 37 C.F.R. § 2.130; TMEP § 1504.02.

5. TMEP § 1715.03(e); *In re Pohn*, 3 USPQ2d 1700, 1703 (Comm'r 1987).

6. *See In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375, 1377 (Comm'r 1988).

7. *See* TMEP § 1504.01. *Accord Sheetz of Delaware, Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341 (TTAB 2013) (letter of protest submitted during prosecution of the application and later submitted under notice of reliance as evidence by opposer during trial).

8. TMEP §1715.03(b).

9. TMEP §1715.04(b)and TMEP §1715.04(b).

10. *See* 37 C.F.R. § 2.130; TMEP § 1715.03(c). *See also* TMEP § 1504.02.

216 Inadvertently Issued Registration

Sometimes a registration is issued, mistakenly, from an application that, at the time of such issuance, is the subject of an unexpired extension of time to oppose, or a timely opposition. These circumstances are examples of where a registration is referred to as "inadvertently issued."

The Board is without authority, within the context of either an extension of time to oppose, or an opposition proceeding, to cancel an inadvertently issued registration and restore it to application status. Rather, it is the Director who has such authority, and the Director exercises this authority with caution. [Note 1.] A registration will ordinarily be deemed to have been issued inadvertently if a notice of opposition or a request for extension of time to oppose was timely and properly filed but the registration nonetheless issued. [Note 2.] The Director will not find that a registration issued inadvertently if (1) the notice of opposition was defective in some manner, and (2) that defect prevented the Office from identifying the application in question, and from withholding the issuance of a registration. [Note 3.]

Accordingly, when it comes to the attention of the Board that a registration has issued inadvertently from an application that is the subject of an unexpired extension of time to oppose, the Board will issue an order approving the extension of time, if appropriate, or, if already approved, noting that potential opposer has been granted an extension of time to oppose until a specified date, and advising potential opposer that if it wishes to preserve its right to oppose should the registration be cancelled as inadvertently issued, potential opposer must continue to file further timely requests for extensions of time to oppose, or it must file the notice of opposition. The Board will then notify the Director. The Director, in turn, may either cancel the registration as inadvertently issued, and restore it to application status, or decline to do so.

The inadvertent issuance of the registration will be considered good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but it will not constitute extraordinary

circumstances justifying an extension of time beyond 120 days from publication. The Board will not suspend the time for filing an opposition or subsequent extension of time to oppose pending cancellation of an inadvertently-issued registration. *See*TBMP § 209.01.

If a registration that issued inadvertently during an extension of time to oppose is not cancelled by the Director and restored to application status, any opposition that may have been filed by the potential opposer will not be instituted, and any submitted opposition fee will be refunded. The potential opposer's substantive remedy, under the statute, will be through a petition to cancel the registration.

If a timely opposition is filed while the matter of the registration is pending before the Director, the Board will acknowledge the filing of the notice or opposition and inform the parties that the opposition will be instituted if and when the inadvertently issued registration has been cancelled. A copy of the Board's action will be sent to both parties.

If the Director cancels and restores the registration to application status, the opposition will be instituted and appropriate dates will be set. If the Director declines to cancel the registration, the opposition will not be instituted and the fee will be refunded.

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

NOTES:

1. *In re Siemens Aktiengesellschaft*, 34 USPQ2d 1862, 1863 (Comm'r Pat. 1995) (inherent authority to cancel an inadvertently issued registration "is to be exercised with caution.") (citing *Mc Lachlan Touch Inc.*, 6 USPQ2d 1395, 1396 (Comm'r 1987)).

2. *Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent, Inc.*, 60 USPQ2d 1703, 1704 (Comm'r 2000).

3. *Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent, Inc.*, 60 USPQ2d 1703, 1704 (Comm'r 2000) (where notice of opposition misidentified the serial number of opposed application, Director declined to cancel registration, finding that error which caused the registration to issue was made by opposer, not as result of inadvertent act by the Office).

217 Relinquishment of Extension

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

If a potential opposer that has requested or obtained an extension of time to oppose has agreed unconditionally in writing not to oppose, applicant may submit a copy of the agreement to the Board, with an appropriate cover letter bearing proof of service upon potential opposer, and the Board will immediately forward the

subject application for issuance of a registration certificate or notice of allowance, as appropriate. *Cf.* TBMP § 212.06 (Action by Board-After Consideration of Amendment by TMEO).

An ESTTA form for either situation described above involving relinquishment of an extension of time to oppose is now available. Consequently, the filing must be made through ESTTA.

218 Abandonment of Application

If an applicant files an express abandonment of an application that is the subject of a pending or granted request for extension of time to oppose, or if a Trademark Act § 66(a), 15 U.S.C. § 1141f(a), application that is the subject of a pending or granted request for extension of time to oppose is abandoned by the Office as the result of cancellation of the underlying international registration, [Note 1] the application stands abandoned and any pending request for an extension of time to oppose is moot. An application that has been abandoned is no longer subject to the filing of a new opposition. Any opposition filed on or after the filing date of the abandonment will not be considered, and the filing fee will be refunded. If the opposition was instituted prior to the Board's knowledge of the filing of an express abandonment, the opposition will be dismissed as a nullity and the opposition fee will be refunded. [Note 2.] *Cf.*TBMP § 602.01 (Withdrawal by Applicant) for information concerning abandonment of an application after the commencement of an opposition.

The abandonment of an application that is not the subject of an inter partes proceeding before the Board (i.e., an opposition, interference, or concurrent use proceeding) is without prejudice to the applicant. It is not necessary that applicant obtain a potential opposer's consent thereto. [Note 3.] Therefore, abandonment of an application during an extension of time to oppose is without prejudice (regardless of whether the potential opposer consents).

In contrast, after the commencement of an opposition, interference, or concurrent use proceeding, if an applicant files an express abandonment of its application (or if a Trademark Act § 66(a), 15 U.S.C. § 1141f(a), application is abandoned by the Office as the result of cancellation of the underlying international registration) without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. [Note 4.] However, if an application is abandoned after the commencement of an opposition, interference, or concurrent use proceeding, but before applicant has been notified thereof by the Board, the applicant will be given an opportunity to obtain the written consent of every adverse party, or to withdraw the abandonment and litigate the proceeding, failing which judgment shall be entered against applicant. [Note 5.]

An applicant may expressly abandon its application by filing with the Office a written statement of abandonment or withdrawal of the application, signed by the applicant or by the applicant's attorney. [Note 6.] An express abandonment (filed prior to commencement of an opposition) must be filed using TEAS, with limited exceptions. [Note 7.] Express abandonments filed prior to the commencement of an opposition should not be directed to the Board.

When an applicant files an express abandonment of an application that is the subject of a pending or a granted request for extension of time to oppose, or a Trademark Act § 66(a), 15 U.S.C. § 1141f(a), application is abandoned by the Office as the result of cancellation of the underlying international registration, the status of the application in USPTO databases reflects the abandonment. A further extension of time to oppose or a notice of opposition cannot be filed against an abandoned application via ESTTA. That is, ESTTA will not allow the processing of either a further extension of time to oppose or a notice of opposition. A potential opposer also may check the status of an application using USPTO databases, including TSDR, before pursuing a further extension of time to oppose or a notice of opposition.

NOTES:

1. If an international registration is cancelled by the International Bureau (IB) for any reason, the IB will notify the USPTO and the USPTO will abandon the corresponding Trademark Act § 66(a), 15 U.S.C. § 1141f(a), application. *See* 37 C.F.R. § 7.30. If the international registration is cancelled under Article 6(4) of the Madrid Protocol, the applicant may "transform" its abandoned Trademark Act § 66(a) application into one under Trademark Act § 1 or Trademark Act § 44, 15 U.S.C. § 1051 or 15 U.S.C. § 1126. *See* 37 C.F.R. § 7.31. Although the transformed application retains the filing and priority date of the abandoned Trademark Act § 66(a) application, 37 C.F.R. § 7.31(b), it is reexamined under 37 C.F.R. § Part 2, and will be published for opposition, even if it had been published prior to transformation. 37 C.F.R. § 7.31(c). *See*TMEP § 1904.09, *et seq.*, for information on transformation.

2. *See 3PMC, LLC v. Huggins*, 115 USPQ2d 1488, 1489 (TTAB 2015) (application abandoned on same day that notice of opposition was filed was not subject to opposition); *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1081 n.1 (TTAB 1992); *In re First National Bank of Boston*, 199 USPQ 296, 297 (TTAB 1978) (notice of opposition and abandonment both filed on same day; no opposition).

3. *See* 37 C.F.R. § 2.68.

4. *See* 37 C.F.R. § 2.135.

5. *See In re First National Bank of Boston*, 199 USPQ 296, 301 (TTAB 1978). *Cf.*TBMP § 602.01 (abandonment of application during inter partes proceeding).

6. *See* 37 C.F.R. § 2.68.

7. *See* 37 C.F.R. § 2.23(c) and 37 C.F.R. § 2.56(d); Examination Guide 1-20 (Revised): Mandatory Electronic Filing and Specimen Requirements February 2020.

219 Amendment to Allege Use; Statement of Use

An amendment to allege use under Trademark Act § 1(c), 15 U.S.C. § 1051(c), filed in an intent-to-use application (i.e., an application under Trademark Act 1(b), 15 U.S.C. § 1051(b)) after approval for publication, is late-filed. [Note 1.] Thus, an amendment to allege use filed during an extension of time to oppose or during an opposition is late-filed.

A statement of use under Trademark Act § 1(d), 15 U.S.C. § 1051(d), is premature if it is filed in an intent-to-use application prior to the issuance of a notice of allowance under Trademark Act § 13(b)(2), 15 U.S.C. § 1063(b)(2). [Note 2.] A notice of allowance is issued in an intent-to-use application (for which no amendment to allege use has been timely filed and accepted) only after the opposition period (as extended) has expired and all oppositions filed have been dismissed. [Note 3.] Thus, a statement of use filed during an extension of time to oppose or during an opposition is premature.

Any late-filed amendment to allege use or premature statement of use will not be considered, and any fee submitted therewith will be refunded. [Note 4.]

If an intent-to-use application has been published and is under a well-taken request for an extension of time to oppose when a timely filed amendment to allege use (i.e., an amendment to allege use filed prior to approval for publication) is associated with the application, the Board will issue an action approving the

extension of time (or, if already approved, noting that potential opposer has been granted an extension of time to oppose until a specified date) and advise the potential opposer that if it wishes to preserve its right to oppose should the amendment to allege use be ultimately withdrawn by the applicant or approved by the examining attorney, the potential opposer must continue to file further timely requests for extensions of time to oppose, or it must file the notice of opposition.

The examining attorney will process the amendment to allege use in the same manner as any other timely filed amendment to allege use that is not associated with the application file until after publication. [Note 5.] In the event that the amendment to allege use is ultimately withdrawn by the applicant, or approved by the examining attorney, the examining attorney should notify the Board (before any scheduled republication of applicant's mark) for further appropriate action with respect to the extension of time to oppose. [Note 6.] If the application is abandoned while it is before the examining attorney, the Board should be notified.

The filing of the amendment to allege use will be considered good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but it will not constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication. In such a situation, the Board will not suspend the time for filing an opposition or a subsequent extension of time to oppose pending consideration of the amendment to allege use. *See*TBMP § 209.01.

If an intent-to-use application has already been published, and is the subject of an opposition, when a timely filed amendment to allege use (i.e., an amendment to allege use filed prior to approval for publication) is associated with the application, the Board normally will suspend the opposition and return the application to the trademark examining attorney for appropriate action with respect to the amendment to allege use. [Note 7.] In the event that the amendment to allege use is ultimately withdrawn by the applicant, or approved by the examining attorney, the examining attorney should so notify the Board and the Board will take further appropriate action with respect to the opposition. [Note 8.] If the application is abandoned while it is before the examining attorney, the examining attorney should likewise notify the Board.

NOTES:

1. 37 C.F.R. § 2.76(a); *In re Sovran Financial Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1992) (amendment to allege use filed during blackout period denied as untimely).

2. Trademark Act § 1(d)(1) and Trademark Act § 13(b)(2), 15 U.S.C. § 1051(d)(1) and 15 U.S.C. § 1063(b)(2); 37 C.F.R. § 2.81(b).

3. Trademark Act § 13(b)(2),15 U.S.C. § 1063(b)(2); 37 C.F.R. § 2.81(b).

4. 37 C.F.R. § 2.76(a); 37 C.F.R. § 2.88(a). *See*TMEP § 1104.03(c) (Processing Amendment to Allege Use Filed During the Blackout Period).

5. *See* TMEP § 1104.04 (Processing Timely Amendment to Allege Use Located After Publication).

6. *See* TMEP § 1104.04.

7. *See* TMEP § 1104.04.

8. *See*TMEP § 1104.04.

220 Inadvertent Issuance of a Notice of Allowance

On a rare occasion, a notice of allowance is issued mistakenly in an intent-to-use application that, at the time of such issuance, is the subject of an unexpired extension of time to oppose or a timely opposition. If a notice of allowance is inadvertently issued in an intent-to-use application which is the subject of an unexpired extension of time to oppose or a timely opposition, and a statement of use is filed, the notice of allowance will be cancelled by the ITU/Divisional Unit as inadvertently issued. The statement of use will be returned, and the fee submitted therewith will be refunded. [Note 1.]

Sometimes a notice of allowance issues after a request for an extension of time to oppose has been submitted but before the request is approved. If, by the time the Board learns of the issuance of the notice of allowance, the extension requested has expired, and no opposition or further extension requests have been filed, the Board will issue an action acknowledging the extension request, and indicating that it was well-taken but that time has since expired and no opposition or further request has been filed. The Board will also indicate that a notice of allowance was inadvertently issued during the requested extension period, but since the requested time period has run without subsequent action by the potential opposer, the notice of allowance will not be withdrawn.

NOTES:

1. *See* TMEP § 1106.03 (Cancellation of Notice of Allowance).

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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.

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 C.F.R. § 2.42, 37 C.F.R. § 2.73, 37 C.F.R. § 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 C.F.R. § 2.101(a) *An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee.*

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

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

37 C.F.R. § 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. 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 C.F.R. § 2.99(c) and 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.111(a).

3. 37 C.F.R. § 2.116(c).

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

5. 37 C.F.R. § 2.101(b)(1); 37 C.F.R. § 2.101(b)(3); 37 C.F.R. § 2.111(c)(1).

302.01 Mandatory Electronic Filing

37 C.F.R § 2.101 ***Filing an opposition.***

(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.*

37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 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.* * * *

(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.* * * *

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.] 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.] 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 C.F.R. § 2.146, including the requirement for verified facts under 37 C.F.R. § 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. Fees for a paper-filed notice of opposition or petition to cancel may be paid by check, money order, credit card (using the credit card payment form) or a USPTO deposit account. See "Methods of Payment," available at **https://www.uspto.gov/trademark/view-fee-schedule-trademark-fee-information**. If paying by check or money order or credit card, separate checks, or money orders, or credit card forms 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. While all paper-filed notices of opposition and petitions to cancel and answers must be accompanied by a petition and the requisite fee, when the filing is the result of technical difficulties with ESTTA, the filer may concurrently request that the fee be waived and reimbursed.

In addition, general submissions to the Board must be filed via ESTTA. [Note 10.] Eastern Time controls 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 situation, 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 C.F.R. § 2.101(b)(3). *Cf. In re Börlind Gesellschaft für Kosmetische Erzeugnisse GmbH*, 73 USPQ2d 2019, 2020 (TTAB 2005) (former 37 C.F.R. § 2.102(a)(2) (now 37 C.F.R. § 2.102(a)(1)) requires ESTTA filing of extensions of time to oppose Trademark Act § 66(a) applications).

2. 37 C.F.R. § 2.101(b)(1).

3. 37 C.F.R. § 2.111(c)(1).

4. 37 C.F.R. § 2.101(b)(3); 37 C.F.R. § 2.101(b)(2); and 37 C.F.R. § 2.111(c)(2).

5. *See* 37 C.F.R. § 2.106(b)(1) and 37 C.F.R. § 2.114(b)(1).

6. *See* 37 C.F.R. § 2.106(b)(1) and 37 C.F.R. § 2.114(b)(1).

7. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69966 (October 7, 2016). *DFC Expo LLC v. Coyle*, 121 USPQ2d 1903, 1905 (TTAB 2017) (among the deficiencies, filing was not accompanied by a Petition to the Director or by the required fee).

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). *See DFC Expo LLC v. Coyle*, 121 USPQ2d 1903, 1905 (TTAB 2017) ("A Petition to the Director requires a petition fee, the necessary showing, and verification of statements supporting the petition.").

10. *See* 37 C.F.R. § 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 C.F.R. § 2.126(b).

13. *See* 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.2(b) *Entity as used in this part includes both natural and juristic persons.*

37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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. § 1127, and 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 entitlement to a statutory cause of action (previously referred to as "standing") to file an opposition or a petition to cancel, respectively. [Note 1.] A party may establish its entitlement to oppose or to petition to cancel by showing (1) that it is within the zone of interests protected by the statute (i.e., has a "real interest" in the outcome of the proceeding) and (2) damage proximately caused by registration (i.e., a reasonable basis for its belief in damage). [Note 2.] *See*TBMP § 309.03(b).To plead an interest within the "zone of interests" a 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 its entitlement to a statutory cause of action. [Note 4.] There is also no requirement that actual damage be pleaded or proved in order to establish an entitlement to a statutory cause of action 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 Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4-8 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020); *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); *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *5 n.34 (TTAB 2020); *Major League Soccer, LLC v. F.C. International Milano S.p.A.*, 2020 USPQ2d 11488, at *5 n.18 (TTAB 2020); *Spanishtown Enterprises., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at * 1-2 (TTAB 2020).

2. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4-8 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020); *Empresa Cubana del Tabaco v. General Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999).

3. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4-8 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020); *Empresa Cubana del Tabaco v. General Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999).

4. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4-8 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020); *Empresa Cubana del Tabaco v. General Cigar Co.*, 753 F.3d 1270, 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) (no requirement that any " actual 'damage '" be pled or proved to establish standing); *Enbridge, Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009) (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 C.F.R. § 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 C.F.R. § 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 inures 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 C.F.R. § 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 with the opposition. When a party filing an opposition differs from the name of the party identified in the extension of time to oppose, ESTTA will prompt the filer to provide an explanation.

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. ESTTA will prompt the filer to provide an explanation.

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 C.F.R. § 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 C.F.R. § 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). *See 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 C.F.R. § 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 with the opposition. ESTTA will prompt the filer to provide an explanation.

For information concerning the misidentification of a potential opposer during an extension of time to oppose, *see*TBMP § 206.03.

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

NOTES:

1. 37 C.F.R. § 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.

For information regarding applicant's ability to correct a defect in the name or legal entity in the application, *see*TBMP § 512.04 and TMEP § 1201.02(c).

NOTES:

1. *See* Fed. R. Civ. P. 17(a); 37 C.F.R. § 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. Great Seats Ltd. v. Great Seats Inc.*, 84 USPQ2d 1235, 1244 (TTAB 2007) (application void ab initio where two separate commercial entities were in existence on application filing date and application was filed in name of wrong entity); *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.

Please note: In ESTTA, all parties must be identified during the filing process in order for the proper fees to be charged for each party opposer or petitioner.

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 entitlement to a statutory cause of action (previously referred to as "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 entitlement to a statutory cause of action 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 entitlement to a statutory cause of action 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 C.F.R. § 2.101(d) and 37 C.F.R. § 2.111(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); *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); *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). 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.").

2. *See General Mills, Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1594 n.12 (TTAB 2011) ("Where there are multiple plaintiffs, each plaintiff must prove its standing and, in the case of likelihood of confusion and dilution claims, prior use."), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *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 C.F.R. § 2.86.

2. *See* 37 C.F.R. § 2.101(d) and 37 C.F.R. § 2.111(d).

3. *See* 37 C.F.R. § 2.101(d) and 37 C.F.R. § 2.111(d).

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

305 Consolidated and Combined Complaints

37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.104(b).

2. *See* 37 C.F.R. § 2.112(b).

3. *See* Fed. R. Civ. P. 42(a); *One Jeanswear Group Inc. v. YogaGlo, Inc.*, 127 USPQ2d 1793, 1795 (TTAB 2018) (motion to consolidate granted; oppositions involved the same parties, similar marks and likelihood of confusion claims); *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); *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).

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 move for consolidation after the proceedings have been instituted 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.").

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 C.F.R. § 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 C.F.R. § 2.197 and the Priority Mail Express® procedure described in 37 C.F.R. § 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. Facsimile transmission 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 C.F.R. § 2.195, 37 C.F.R. § 2.196, and 37 C.F.R. § 2.197 unless the notice is filed in accordance with 37 C.F.R. § 2.198 (Filing of correspondence by Priority Mail Express®). [Note 6.] If the notice is filed in accordance with 37 C.F.R. § 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 very rare instances that the opposition has not yet been instituted and time remains in the opposition period. Generally, 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 C.F.R. § 2.102(b) and 37 C.F.R. § 2.102(c); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994).

2. *See* 37 C.F.R. § 2.101(b)(1).

3. *See* 37 C.F.R § 2.195(c). *See also Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1283 (TTAB 2008) (opposition improperly filed by facsimile not entitled to a filing date).

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

5. *See* 37 C.F.R. § 2.101(e).

6. 37 C.F.R. § 2.101(e). *See DFC Expo LLC v. Coyle*, 121 USPQ2d 1903 (TTAB 2017) (among the deficiencies, filing, received after the deadline, was not accompanied a certificate of mailing); *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1283 (TTAB 2008) (untimely opposition dismissed as a nullity).

7. *See* 37 C.F.R § 2.198(b).

8. *See* 37 C.F.R. § 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 C.F.R. § 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.

The ESTTA system will not permit a would-be opposer to file an opposition against an application that has not yet been published.

In the rare instance that a party files an opposition on paper and it has been permitted by the Director, on petition, but the filing date is prior to the publication of the mark sought to be opposed, the opposition 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 Director 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 1.8 regarding certificates of mailing would effectively waive Trademark Act § 13, 15 U.S.C. § 1063 and, in any event, the 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 C.F.R. § 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 C.F.R. § 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], the mark 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 C.F.R. § 2.195, 37 C.F.R. § 2.196, and 37 C.F.R. § 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 C.F.R. § 2.198. [Note 9.] If the petition is filed in accordance with 37 C.F.R. § 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 C.F.R. § 2.111(b).

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

3. *See, e.g., K-Swiss Inc. v. Swiss Army Brands Inc.*, 58 USPQ2d 1540 (TTAB 2001) (geographic deceptiveness ground available for registration over five years old); *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894, 1898 (TTAB 1992) ("[I]f the registrant fails to perform actions which are within his control, e.g., he abandons his mark or uses his mark so as to misrepresent the source of the goods or allows the mark to become, or promotes it as, the generic name for the goods, his registration can be cancelled because he has, in effect, participated in its destruction."). *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); *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318, 1320 (TTAB 1990) (ownership of mark not available ground for registration over 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). *See also Sentry Chemical Company v. Pennwalt Corp.*, 212 USPQ 25 (TTAB 1980) (Section 2(a) claims available for registration over five years old).

Section 2(a)'s clause concerning marks that may disparage or bring into contempt or disrepute was held to be unconstitutional by the U.S. Supreme Court in *Matal v. Tam*, 137 S. Ct. 1744, 122 USPQ2d 1757 (2017), and no longer provides a basis to petition to cancel a registration.

Section 2(a)'s clause concerning immoral or scandalous matter was held to be unconstitutional by the U.S. Supreme Court in *Iancu v. Brunetti*, 139 S. Ct. 782, 2019 USPQ2d 232043 (2019), and no longer provides a basis to petition to cancel a registration.

5. *See* Trademark Act § 2(e)(5), 15 U.S.C. § 1052(e)(5) *See, e.g., In re MK Diamond Products, Inc.*, 2020 USPQ2d 10882 (TTAB 2020) (applicant's configuration mark comprised of a saw blade design found functional)..

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 C.F.R. § 2.111(e).

9. *See* 37 C.F.R. § 2.111(e).

10. *See* 37 C.F.R § 2.198(b).

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, 15 U.S.C § 1052(e)(1), that respondent's mark is geographically descriptive, 15 U.S.C § 1052(e)(2), or geographically deceptively misdescriptive, 15 U.S.C § 1052(e)(3), or that respondent's mark is primarily merely a surname, 15 U.S.C § 1052(e)(4)), [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 C.F.R. § 2.197 and the "Priority Mail Express®" procedure described in 37 C.F.R. § 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 C.F.R. § 2.195, 37 C.F.R. § 2.196, and 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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.

To further the USPTO's goal of maintaining the accuracy and integrity of the U.S. Trademark Register, the Board recently undertook a two-year pilot program to explore procedures for expediting certain cancellation proceedings that are limited to claims of abandonment or nonuse (or both) where the parties voluntary stipulate to one or more of the TTAB's Accelerated Case Resolution (ACR) options. *See*TBMP § 528.05(a)(2) and TBMP § 702.04. Under the pilot, the Board, on an ongoing basis, identified eligible newly-filed cancellation proceedings that may benefit by some form of the Board's existing ACR procedures. [Note 14.] The Board identified cases that commenced between March 2, 2018 and February 28, 2020.

Information about how the pilot was conducted can be found at **https://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board/expedited-cancellation-pilot-program**. Information about results and trends identified will be made available once pilot program cases that are ongoing have concluded.

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 C.F.R. § 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); *Stromgren Supports Inc. v. Bike Athletic Co.*, 43 USPQ2d 1100, 1108-07 (TTAB 1997) (descriptiveness ground considered because petition to cancel filed before five year anniversary 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 Montecash LLC v. Anzar Enterprises Inc.*, 95 USPQ2d 1060, 1063 (TTAB 2010) (petitioner cannot seek to cancel a mark more than five years old on the ground that a portion of the mark is a generic name, and the purportedly generic term has not been disclaimed); *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 C.F.R. § 2.111(e).

11. *See* 37 C.F.R. § 2.111(e), 37 C.F.R. § 2.197(a) and 37 C.F.R. § 2.198(a).

12. *See* 37 C.F.R. § 2.111(e).

13. *See* 37 C.F.R §2.198(b).

14. *Wirecard AG v. Striatum Ventures B.V.*, 2020 U.S.P.Q.2d 10086 (TTAB 2020) (case decided under expedited cancellation pilot using ACR procedures); *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1787 (TTAB 2018) (same).

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 (2020). *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 only any submitted filing fee for the petition to cancel 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 C.F.R. § 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 C.F.R. § 2.101(c)-37 C.F.R. § 2.101(d). The amount of the required filing fee is specified in 37 C.F.R. § 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 C.F.R. § 2.195, 37 C.F.R. § 2.196, 37 C.F.R. § 2.197 and 37 C.F.R. § 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 C.F.R. § 2.206-37 C.F.R. § 2.208, and TBMP § 118. For information on fee refunds, *see* 37 C.F.R. § 2.209, and TBMP § 119.

NOTES:

1. *See* 37 C.F.R. § 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 C.F.R. § 2.101(e).

3. *See* 37 C.F.R. § 2.101(c) and 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.101(b)(3).

3. *See* 37 C.F.R. § 2.101(b)(1).

4. *See* 37 C.F.R. § 2.101(b)(2).

5. *See* 37 C.F.R. § 2.101(d). *See also DFC Expo LLC v. Coyle*, 121 USPQ2d 1903, 1904-05 (TTAB 2017) (among the deficiencies, filing was not accompanied by the required fee).

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 C.F.R. § 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 C.F.R. § 2.111(d). The amount of the required fee is specified in 37 C.F.R. § 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 C.F.R. § 2.195, 37 C.F.R. § 2.196, 37 C.F.R. § 2.197 and 37 C.F.R. § 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 C.F.R. § 2.206-37 C.F.R. § 2.208, and TBMP § 118. For information on fee refunds, *see* 37 C.F.R. § 2.209, and TBMP § 119.

NOTES:

1. *See* 37 C.F.R. § 2.111(a), 37 C.F.R. § 2.111(d), and 37 C.F.R. § 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 C.F.R. § 2.111(e).

3. *See* 37 C.F.R. § 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 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 4.]

The responsibility for filing proper fees rests with the party filing the fees. [Note 5.]

NOTES:

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

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

2. *See* 37 C.F.R. § 2.101(d) and 37 C.F.R. § 2.111(d).

3. *See* 37 C.F.R. § 2.101(d) and 37 C.F.R. § 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 C.F.R. § 2.101(d) and 37 C.F.R. § 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 C.F.R. § 2.101(d) and 37 C.F.R. § 2.111(d).

2. *See* 37 C.F.R. § 2.101(d) and 37 C.F.R. § 2.111(d).

3. *See* 37 C.F.R. § 2.101(d) and 37 C.F.R. § 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 C.F.R. § 2.104(b).

2. *See* 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.111(c)(1) *A petition to cancel a registration must be filed through ESTTA.*

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

37 C.F.R. § 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 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.*

* * * *

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 C.F.R. § 2.126(a); 37 C.F.R. § 2.101(b)(1); 37 C.F.R. § 2.101(b)(3); 37 C.F.R. § 2.111(c)(1).

2. *See* 37 C.F.R. § 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 C.F.R. § 2.101(b)(2).

4. 37 C.F.R. § 2.111(c)(2).

5. *See* 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.126(b).

NOTES:

1. *See* 37 C.F.R. § 2.126(a)(1) and 37 C.F.R. § 2.126(a)(2).

2. *See* 37 C.F.R. § 2.101(b)(1); 37 C.F.R. § 2.101(b)(3).

3. 37 C.F.R. § 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 C.F.R. § 2.101(b)(2) and 37 C.F.R. § 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 C.F.R. § 2.197 and the Priority Mail Express® procedure described in 37 C.F.R. § 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; 3) the application or registration number(s) for any mark owned and relied upon by opposer; and 4) any prior common law rights in a mark(s) relied upon by opposer and associated goods or services. [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 C.F.R. § 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., entitlement to a statutory cause of action 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 C.F.R. § 2.101(b)(1); 37 C.F.R. § 2.111(c)(1); 37 C.F.R. § 2.126(a).

2. 37 C.F.R. § 2.101(b)(2) and 37 C.F.R. § 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) (ESTTA cover sheet is considered part of the complete opposition pleading).

4. 37 C.F.R. § 2.101(b)(3).

5. *See Destileria Serralles, Inc. v. Kabushiki Kaisha Donq*, 125 USPQ2d 1463, 1466-67 (TTAB 2017) (ESTTA filing system permits a plaintiff relying on common law marks to identify them); *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 C.F.R. § 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 C.F.R. § 11.1, or other authorized representative, as specified in 37 C.F.R. § 11.14(b). [Note 1.] *See* TBMP § 106.02 and TBMP § 114.06. Electronic signatures pursuant to 37 C.F.R. § 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 C.F.R. § 2.101(b) and 37 C.F.R. § 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 C.F.R. § 2.101(b) and 37 C.F.R. § 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) (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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.101(a) and 37 C.F.R. § 2.111(a).

2. *See* 37 C.F.R. § 2.105(a) and 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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. [Note 3.]

As a reminder, 37 C.F.R § 2.18(c) 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 C.F.R. § 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 C.F.R. § 2.197 and the "Priority Mail Express® procedure described in 37 C.F.R. § 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 C.F.R. § 2.101(a).

2. 37 C.F.R. § 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. *See, e.g.,* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69953 (October 7, 2016) ("notice of the opposition will be sent to the ''email or correspondence address'' of the appropriate recipient").

4. *See* 37 C.F.R. § 2.101(e).

5. *See* 37 C.F.R § 2.198(a).

6. *See* 37 C.F.R § 2.198(b).

7. *See* 37 C.F.R. § 2.197(a) and 37 C.F.R. § 2.198(a).

8. 37 C.F.R §2.195 (c); *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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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.] In view of system enhancements to facilitate email service, the Board now serves defendants by email unless there is no email address of record for the defendant, in which case service is by U.S. mail. [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 C.F.R. § 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 C.F.R § 2.18(c) 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 in accordance with 37 C.F.R. § 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 C.F.R. § 2.197 and the "Priority Mail Express®" procedure described in 37 C.F.R. § 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 C.F.R. § 2.111(a).

2. *See* 37 C.F.R. § 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. *See, e.g.*, MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69954 (October 7, 2016) ("[I]n cancellation proceedings, the Board intends to serve by U.S. mail, pending system enhancements to facilitate email service at a later date.").

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

5. 37 C.F.R. § 2.111 (e).

6. *See* 37 C.F.R § 2.198(a).

7. *See* 37 C.F.R § 2.198(b).

8. *See* 37 C.F.R. § 2.197(a) and 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.99(h) and 37 C.F.R. § 2.133(c).

3. 37 C.F.R. § 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 C.F.R. § 2.104(c); *CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1962-63 (TTAB 2011). *See also Destileria Serralles, Inc. v. Kabushiki Kaisha Donq*, 125 USPQ2d 1463, 1466-67 (TTAB 2017) (opposer could not amend notice of opposition against § 66(a) application to add common law trademark rights not previously identified on the ESTTA cover sheet; ESTTA filing system permits an opposer relying on common law marks to identify them); *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 entitlement to a statutory cause of actions -- *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 entitlement to a statutory cause of action -- *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. (2020), 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. (2020).

NOTES:

1. *See* 37 C.F.R. § 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 C.F.R. § 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. 10, 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. 544, 570 (2007). *See also Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1349 (TTAB 2017) (likelihood of confusion claim based on the claimant's use of two marks conjointly must be pleaded clearly enough to provide fair notice of the claim to the defendant); *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. 10, 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. 544, 570 (2007); Fed. R. Civ. P. 8(a). *See also Lewis Silkin LLP v. Firebrand LLC*, 129 USPQ2d 1015, 1016 (TTAB 2018) (Board follows federal notice pleading standard which includes the requirement that the complaint "state a claim to relief that is plausible on its face"); 5 C. WRIGHT, A. MILLER & M. KANE, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1219 (3d ed. 2020) ("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 C.F.R. § 2.122(d)(1)).

12. *See* 37 C.F.R. § 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) Entitlement to a Statutory Cause of Action

Any person who believes it is or will be damaged by registration of a mark has an entitlement to bring a statutory cause of action (previously referred to as "standing") to file a complaint. [Note 1.] *See*TBMP § 303 In 2020, the U.S. Court of Appeals for the Federal Circuit adopted the framework set forth by the U.S. Supreme Court in *Lexmark International, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061 (2014). *Lexmark* established two requirements for determining whether a party is entitled to bring or maintain a statutory cause of action: a party must demonstrate (i) an interest falling within the zone of interests protected by the statute, and (ii) proximate causation. Despite the change in nomenclature, prior Federal Circuit and Board decisions interpreting Sections 13 and 14 of the Trademark Act, 15 U.S.C. § 1063and 15 U.S.C § 1064, remain equally applicable. [Note 2.] There is no meaningful, substantive difference between the analytical frameworks in the Board's prior "standing" case law, under which a plaintiff must show a real interest in the proceeding and a reasonable basis for its belief in damage [Note 3], and the current "entitlement" case law, under which a plaintiff must show an interest falling within the zone of interests protected by statute and damage proximately caused by registration. [Note 4.] In other words, demonstrating a real interest in opposing or cancelling a registration of a mark satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark demonstrates damage proximately caused by registration of the mark. [Note 5.].

PLEASE NOTE: Although there has been a change in nomenclature, use of the term "standing" may appear interchangeably with the wording "an entitlement to a statutory cause of action" in parentheticals to case citations throughout the manual. Notwithstanding, parties should refer to the issue in submissions filed in Board proceedings as "entitlement to a statutory cause of action."

At the pleading stage, all that is required is that a plaintiff allege facts sufficient to show it has an interest within the zone of interests protected by statute, i.e., a "real interest" and damage proximately caused by registration, i.e., a "reasonable basis" for its belief that it would suffer some kind of damage if the mark is registered. [Note 6.] *See also*TBMP § 303.06 regarding pleading of an entitlement to a statutory cause of action by joint plaintiffs. To plead a zone of interest protected by statute, referred to in prior case law as a "real interest," plaintiff must allege a "direct and personal stake" in the outcome of the proceeding. [Note 7.] The allegations in support of plaintiff's belief of damage proximately caused by registration must have a reasonable basis "in fact." [Note 8.]

Allegations in support of an entitlement to a statutory cause of action which may be sufficient for pleading purposes must later be affirmatively proved by the plaintiff at trial (or on summary judgment). [Note 9.] 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 10], in order to establish an entitlement to a statutory cause of action or to prevail in an opposition or cancellation proceeding. *See* TBMP § 303.03.

An interest falling within the zone of interests protected by statute and damage proximately caused by the registration of a mark may be found, for example, where plaintiff pleads (and later proves):

A claim of likelihood of confusion that is not wholly without merit [Note 11], including claims based upon current ownership of a valid and subsisting registration [Note 12] or prior use of a confusingly similar mark. [Note 13.] A registration on the Supplemental Register may be sufficient to establish an entitlement to a statutory cause of action [Note 14];

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 15];

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 16];

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 17.]

A counterclaimant's entitlement to a statutory cause of action to cancel a pleaded registration is inherent in its position as defendant in the original proceeding. [Note 18.] *See also*TBMP § 313.03.

A plaintiff need not assert proprietary rights in a term in order to have an entitlement to a statutory cause of action. [Note 19.] For example, when descriptiveness or genericness of the mark is in issue, plaintiff may plead (and later prove) its entitlement to a statutory cause of action 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 20.] Allegations that plaintiff is a competitor may be made in connection with other claims as well. [Note 21.]

If a plaintiff can show an entitlement to a statutory cause of action on one ground, it has the right to assert any other grounds in an opposition or cancellation proceeding. [Note 22.]

NOTES:

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

2. *See, e.g., Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4-8 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020); *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *5 n.34 (TTAB 2020); *Major League Soccer, LLC v. F.C. International Milano S.p.A.*, 2020 USPQ2d 11488, at *5 n.18 (TTAB 2020); *Spanishtown Enterprises, Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *1-2 (TTAB 2020).

3. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014).

4. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4-8 (Fed. Cir. 2020).

5. *Spanishtown Enterprises, Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020) (citing *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *7 (Fed. Cir. 2020)).

6. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020) ("we discern no meaningful, substantive difference between the analytical frameworks expressed in Lexmark and Empresa Cubana."). *See also Empresa Cubana del Tabaco v. General Cigar Co.*, 753 F.3d 1270, 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); *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).

Shael Norris v. PAVE: Promoting Awareness, Victim Empowerment, 2019 USPQ2d 370880, at *3-4 (TTAB 2019) (plaintiff's endeavors and the relationship between the parties establish plaintiff's reals interest and reasonable basis for belief of damage); *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 (TTAB 2009) (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).

7. *Empresa Cubana del Tabaco v. General Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999). *See also Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Schiedmayer Celesta GmbH v. Piano Factory Group, Inc.*, 2019 USPQ2d 341894, at *5-6 (TTAB 2019) (personal stake where plaintiff is named after family and owned by a family member using the mark for keyboard instruments), appeal filed, No. 20-1196 (Fed. Cir. Dec. 3, 2019); *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).

8. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 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).

9. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 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., Spanishtown Enterprises, Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388 (TTAB 2020) (summary judgment denied because of the existence of a genuine dispute of material fact as to plaintiff's entitlement to a statutory cause of action); *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).

10. *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).

11. *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).

12. *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); *Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, at *4 (TTAB 2019) (pleaded registration made of record); *Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016) (same); *Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1190 (TTAB 2012) (same); *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) (same); *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1754 (TTAB 2009) (same); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1849 (TTAB 2008) (same); *Corporacion Habanos S.A. v. Anncas Inc.*, 88 USPQ2d 1785, 1790 (TTAB 2008) (same); *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).

13. *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); *AT&T Mobility LLC v. Mark Thomann*, 2020 USPQ2d 53785, at *11 (TTAB 2020) (opposer's standing confirmed by proof of its corporate relationship to entity using the mark as part of its trade name); *Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, at *4 (TTAB 2019) (standing also established by testimony with exhibits of earlier use of confusingly similar mark); *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).

14. *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).

15. *See Empresa Cubana del Tabaco v. General Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (plaintiff's application refused based on defendant's registrations); *Hole In 1 Drinks, Inc. v. Michael Lajtay*, 2020 USPQ2d 10020, at *3 (TTAB 2020) (evidence of record showing petitioner's pending application refused registration based on respondent's registration); *Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1039-40 (TTAB 2018) (opposer's standing established through applicant's concessions and admissions that opposer's pending application would be refused registration should applicant's application register); *Saddlesprings Inc. v Mad Croc Brands Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012) (same); *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's application was suspended, and opposer, a Cuban entity, submitted a letter confirming permission from the U.S. Dept. of Treasury to file an opposition); *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).

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

17. *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).

18. *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).

19. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3-4 (Fed. Cir. 2020); *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").

20. *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).

Milwaukee Electric Tool Corp. v. Freud America, Inc., 2019 USPQ2d 460354, at *4-5 (TTAB 2019) (standing established because parties are competitors in the power saw blade industry), appeal filed, No. 1:20-cv-00109-WO-JEP (M.D.N.C. Feb. 3, 2020); *Performance Open Wheel Racing, Inc. v. United States Auto Club Inc.*, 2019 USPQ2d 208901, at *2 (TTAB 2019) (standing established because parties are competitors in arranging automobile racing events); *Grote Industries, Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1201 (TTAB 2018) (standing established because parties are competitors in the light truck industry); *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (standing established by plaintiff showing that it is engaged in the manufacture or sale of the same or related goods and that the product in question is one which could be produced in the normal expansion of plaintiff's business); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1487 (TTAB 2017) (opposer's status as competitor establishes standing to oppose registration of product configuration); *Apollo Medical*

Extrusion Technologies, Inc. v. Medical Extrusion Technologies, Inc., 123 USPQ2d 1844, 1848 (TTAB 2017) (opposer established that it is a competitor of Applicant and that it received a cease and desist letter from applicant); *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 as a competitor and based on cease and desist letter showing business interests affected); *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).

21. *See, e.g., M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd.*, 2019 U.S.P.Q.2d 149090, at *4 (TTAB 2019) (standing to assert a § 2(c) claim may be established by facts that plaintiff is a competitor and has a present or prospective right to use the name).

22. *See Hole In 1 Drinks, Inc. v. Michael Lajtay*, 2020 USPQ2d 10020, at *3 (TTAB 2020) (once standing shown on one ground, plaintiff has right to assert any other ground in proceeding); *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (if petitioner can show standing on the ground of functionality, it can assert any other grounds, including abandonment); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1479 (TTAB 2017) (standing established based on surname claim sufficient to establish standing for any other ground); *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1481 (TTAB 2017) (opposer established its standing as to genericness ground of certification mark and was entitled to assert any other ground); *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

309.03(c)(1) In General

In addition to an entitlement to a statutory cause of action, 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 C.F.R. § 2.104(a) and 37 C.F.R. § 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 falsely suggests a connection with plaintiff's name or identity [Note 13], 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 14.]

(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), or for a Trademark Act § 1(b), 15 U.S.C. § 1051(b)application, within the expiration of the time for filing a statement of use. [Note 15.]

(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 17.] 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 17.]

(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 18.]

(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 19.]

(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 20.]

(9) That defendant's mark, consisting of a particular sound applied to its goods, is not inherently distinctive and has not acquired distinctiveness. [Note 21.]

(10) That defendant's mark, consisting of trade dress, product design or packaging, is not inherently distinctive and has not acquired distinctiveness. [Note 22.]

(11) 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 23.]

(12) That defendant's mark represents multiple marks in a single application (or registration) ("phantom mark"). [Note 24.]

(13) 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 25]; or due to a course of conduct that has caused the mark to lose significance as an indication of source. [Note 26.]

(14) 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 27.]

(15) That defendant's product design is generic. [Note 28.]

(16) That defendant's mark would dilute the distinctive quality of plaintiff's famous mark. [Note 29.]

(17) That defendant has used its mark so as to misrepresent the source of its goods or services. [Note 30.]

(18) 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 31.]

(19) That defendant committed fraud in the procurement of its registration or during the prosecution of its application for registration. [Note 32.]

(20) 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 33.]

(21) That defendant's application is barred from registration by claim or issue preclusion. [Note 34.] *See also* TBMP § 311.02(b).

(22) That defendant's mark is the title of a single creative work and not considered a trademark. [Note 35.]

(23) 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 36.]

(24) 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 37.]

(25) That the intent-to-use application was assigned or transferred in contravention of Trademark Act § 10; 15 U.S.C. § 1060. [Note 38.]

(26) That the mark is generic. [Note 39.] A mark registered on the Supplemental Register is subject to cancellation on the basis that it is generic. [Note 40.]

(27) 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 41.]

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), *cert denied*, 137 S. Ct. 1202 (2017), *aff'd on remand*, 338 F. Supp.3d 1477 (E.D. Va. 2018), *appeal filed*, No. 18-2232 (4th Cir. Oct. 19, 2018); *UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1244(TTAB 2015) (laches and acquiescence are affirmative defenses that may be raised by a defendant, not claims asserted by the plaintiff); *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 Omaha Steaks International, Inc. v. Greater Omaha Packing Co., 908 F.3d 1315, 128 USPQ2d 1686, 1691-95 (Fed. Cir. 2018) (Board improperly broadened analysis of third-party use to encompass third-party marks on clearly dissimilar goods and improperly discounted certain evidence of fame); *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); *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914 (TTAB 2020) (likelihood of confusion claim sustained, in part, dismissed, in part); *Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611 (TTAB 2020) (likelihood of confusion claim dismissed); *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596 (TTAB 2020) (likelihood of confusion claim sustained as to identified goods notwithstanding that plaintiff did not demonstrate family of marks); *Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400 (TTAB 2020) (likelihood of confusion claim dismissed for failure to prove priority of use); *Shannon DeVivo v. Celeste Ortiz*, 2020 USPQ2d 10153 (TTAB 2020) (likelihood of confusion claim sustained); *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *8-9 (TTAB 2019) (Board declined to apply doctrine of foreign equivalents to given names and found marks dissimilar); *Primrose Retirement Communities, 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 Insurance 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); *City of London Distillery, Ltd. v. Hayman Group Ltd.*, 2020 USPQ2d 11487 (TTAB 2020) (mere descriptiveness); *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914

(TTAB 2020) (mere descriptiveness claim dismissed); *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 *Converse, Inc. v. ITC*, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018) (clarifying and identifying six factors for determining whether a mark has acquired secondary meaning); *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1377-79 (Fed. Cir. 2018) (explaining burdens of opposer and applicant in connection with Trademark Act § 2(f) claim; substantial evidence supports finding marks lack acquired distinctiveness); *Schlafly v. Saint Louis Brewery, LLC*, 909 F.3d 420, 128 USPQ.2d 1739, 1743 (Fed. Cir. 2018) (whether the surname had acquired distinctiveness); *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., Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, *12-13 (TTAB 2020) (applicant did not meet burden of showing acquired distinctiveness, and term is primarily geographically descriptive); *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 tapio GmbH*, 2020 USPQ2d 11387 (TTAB 2020); *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*, 120 USPQ2d 1717, 1725 (TTAB 2016); *In re Piano Factory Group Inc.*, 85 USPQ2d 1522, 1526-27 (TTAB 2007) (surname plus "& SONS" refused as "primarily a surname"). *See also Schlafly v. Saint Louis Brewery, LLC*, 909 F.3d 420, 128 USPQ.2d 1739, 1743 (Fed. Cir. 2018) (whether the surname had acquired distinctiveness).

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); *Grote Industries, Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1210-11 (TTAB 2018) (product design, pattern for truck lights, not functional; prima facie case of aesthetic functionality not established); *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, 1791-92 (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., University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co. Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir.1983); *U.S. Olympic Committee v. Tempting Brands Netherlands B.V.*, 2021 USPQ2d 164, at *33 (TTAB 2021 (claim of false suggestion of a connection fails as plaintiff cannot show the mark points uniquely and unmistakably to it); *The Pierce-Arrow Society v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at *7 (TTAB 2019) (same), *appeal dismissed*, No. 20-1068 (Fed. Cir. Nov. 13, 2019); *Schiedmayer Celesta GmbH v. Piano Factory Group, Inc.*, 2019 USPQ2d 341894, at *12 (TTAB 2019) (false suggestion of a connection found), appeal filed, No. 20-1196 (Fed. Cir. Dec. 3, 2019); *Boston Red Sox Baseball Club L.P. v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008) (same); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1436-37 (TTAB 1996) (motion to dismiss false suggestion of a connection claim granted); *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639-40 (TTAB 1988) (disparagement of opposer found under 2(a)); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428, 429-30 (TTAB 1985) (denying motion for summary judgment on false suggestion of connection claim). *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).

14. *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).

15. *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); *Aycock Engineering Inc. v. Airflite Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1305 (Fed. Cir. 2009) (registration of a mark that does not meet the use requirement is void ab initio); *International Mobile Machines Corp. v. International Telephone and Telegraph Corp.*, 800 F.2d 1118, 231 USPQ 142, 143 (Fed. Cir. 1986) ("An initial commercial transaction is sufficient to support the validity of a registration so long as the initial transaction is not a sham transaction and is followed by a continuing effort or intent to engage in commercial use."); *Avakoff v. Southern Pacific Co.*, 765 F.2d 1097, 226 USPQ 435, 436 (Fed. Cir. 1985) (shipment to owner of mark by manufacturer, advertising in the nature of form letter solicitation to retailers, and subsequent sales insufficient to constitute use in commerce for applicant); *Toys, Inc. v. McDonald's Corp.*, 585 F.2d 1067, 199 USPQ 722, 723 (CCPA 1978) (because applicant did not use the mark in commerce in association with the goods at the time it filed the application, its application was void); *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); *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1051-1055 (TTAB 2017) (claim of nonuse at time of filing statement of use); *Ashland Licensing & Intellectual Property LLC v. Sunpoint International Group USA Corp.*, 119 USPQ2d 1125, 1131 (TTAB 2016) (any legally sufficient nonuse claim must plead that Respondent failed to use its mark in commerce by the expiration of the time for filing a statement of use in each application); *Embarcadero Technologies, Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1524 (TTAB 2016) (where applicant filed an "insurance extension," sufficient pleading of nonuse is that Respondent did not use the mark with the goods in the registration within the time for filing its statement of use as extended); *United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1044-46 (TTAB 2014) (application void ab initio for nonuse in connection with services); *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); *City National Bank v. OPGI*

Management GP Inc./Gestion OPGI Inc., 106 USPQ2d 1668, 1676-78 (TTAB 2013) (internal use of mark by applicant did not constitute use in commerce); *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, 1045 (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, 1966 (TTAB 1987) (single shipment of the product from one corporate officer to another was an intracompany transaction done solely for the purpose of qualifying for registration, and was a sham; no use in commerce prior to filing date of application found); *Pennwalt Corp. v. Sentry Chemical Co.*, 219 USPQ 542, 550 (TTAB 1983) (nonuse in commerce based on experimental shipment not available ground for registration over five years old); *Bonaventure Associates v. Westin Hotel Co.*, 218 USPQ 537, 543-45 (TTAB 1983) (opposer's construction and golf club services for a vacation home residential community not inherently incapable of use in commerce). *See also Grand Canyon West Ranch LLC v. Hualapai Tribe*, 78 USPQ2d 1696, 1697-98 (TTAB 2006) (explaining the distinction between nonuse on some or all of the goods or services; application not treated as void in connection with a claim asserting nonuse as to some of the goods or services).

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).

16. *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); *Hole In 1 Drinks, Inc. v. Michael Lajtay*, 2020 USPQ2d 10020, at *10 (TTAB 2020) (underlying application void ab initio where individual registrant, at the time application was filed, lacked a bona fide intent to use the mark alone); *A&H Sportswear Co. v. William W. Yedor*, 2019 USPQ2d 111513, at *6 (TTAB 2019) (lack of a bona fide intent to use found where only document not sufficiently contemporaneous with filing of application); *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-known 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).

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

18. *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).

19. *See, e.g., Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611 (TTAB 2020) (nonownership claim dismissed; oral intra-family license with informal control sufficient to qualify licensee as related company); *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); *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).

See also Shael Norris v. PAVE: Promoting Awareness, Victim Empowerment, 2019 USPQ2d 370880, at *5 (TTAB 2019) (lack of ownership not an available claim against an intent to use application); *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318, 1320 (TTAB 1990) (ownership claim not available ground for registration over five years old).

20. *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).

21. *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).

22. 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 1829, 1839 (TTAB 2013) (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). *Cf. In re MK Diamond Products, Inc.*, 2020 USPQ2d 10882 (TTAB 2020) (product configuration of a saw blade found non-distinctive and not having acquired distinctiveness).

For product packaging *see 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).

23. *See, e.g., D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (I DC fails to function as a mark). *Cf. In re Team Jesus LLC*, 2020 USPQ2d 11489 (TTAB 2020) (TEAM JESUS fails to function as a mark); *In re Greenwood*, 2020 USPQ2d 11439 (TTAB 2020) (GOD BLESS THE USA fails to function as a mark); *In re Vox Populi Registry Ltd.*, 2020 USPQ2d 11289 (TTAB 2020) (designation . *SUCKS* fails to function as a mark; found to be merely a generic top-level domain ("gTLD")), *appeal docketed*, No. 21-1496 (Fed. Cir. Jan. 6, 2021); *In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298 (TTAB 2020) (proposed mark TEXAS LOVE fails to function as a mark because it constitutes a widely used concept or sentiment); *In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048 (TTAB 2020) (the proposed mark .CAM incapable of functioning as a mark for some of the identified services).

See aiso 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).

24. *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).

25. 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); *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *16-17 (TTAB 2020) (plaintiff failed to prove abandonment of defendant's mark because defendant was able to demonstrate that it maintained an intent to resume use of its mark throughout the period of nonuse); *Lewis Silkin LLP v. Firebrand LLC*, 129 USPQ2d 1015, 1020 (TTAB 2018) (discussing pleading requirements for a legally sufficient claim of abandonment); *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. Wirecard AG v. Striatum Ventures B.V., 2020 USPQ2d 10086, at *9 (TTAB 2020) (prima facie showing of abandonment rebutted by fact showing registrant's intent to commence use); *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)).

26. 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).

27. *See* Trademark Act § 2(c), 15 U.S.C. § 1052(c). *See also M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd.*, 2019 U.S.P.Q.2d 149090, at *7 (TTAB 2019) (right to preclude registration expired upon death of "particular living individual" who was no longer living at the time of trial); *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).

28. *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).

29. *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); *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097 (TTAB 2018) (full analysis of factors of dilution by blurring); *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).

30. *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), *cert denied*, 137 S. Ct. 1202 (2017), *aff'd on remand*, 338 F. Supp.3d 1477 (E.D. Va. 2018), *appeal filed*, No. 18-2232 (4th Cir. Oct. 19, 2018); *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).

31. *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).

32. *See* Fed. R. Civ. P. 9(b); *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009); *Freki Corp. v. Pinnacle Entertainment, Inc.*, 126 USPQ2d 1697, 1703 (TTAB 2018) (fraud claim insufficiently pleaded); *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); *Meckatzer Löwenbräu Benedikt Weiß KG v. White Gold LLC*, 95 USPQ2d 1185, 1187 (TTAB 2010) (motion to dismiss denied where fraud claim sufficiently pleaded); *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); *Bart Schwartz International Textiles, Ltd. v. The Federal Trade Commission*, 289 F.2d 665, 129 USPQ 258, 260 (CCPA 1961) ("[T]he obligation which the Lanham Act imposes on an applicant is that he will not make knowingly inaccurate or knowingly misleading statements in the verified declaration forming a part of the application for registration."); *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).

33. *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).

34. *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).

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

36. *Cf. In re Alabama Tourism Department*, 2020 USPQ2d 10485 (TTAB 2020); *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).

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

38. *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).

39. *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 Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018) (explaining determinations to be made under second *Marvin Ginn* factor); *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1379 (Fed. Cir. 2018) (incorrect application of first *Marvin Ginn* factor); *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).

See also International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère, 2020 USPQ2d 10892 (TTAB 2020) (proposed mark GRUYERE found generic for identified goods); *Milwaukee Electric Tool Corp. v. Freud America, Inc.*, 2019 USPQ2d 460354, at *17-18 (TTAB

2020) (color red is generic as used on saw blades), *appeal filed*, No. 1:20-cv-00109-WO-JEP (M.D.N.C. Feb. 3, 2020).

But see USPTO v. Booking.com B.V., 591 U.S. ___, 140 S.Ct. 2298, 2020 USPQ2d 10729 (2020) (BOOKING.COM not generic for online hotel reservation services); *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 as a certification mark for spirits distilled from agave plant).

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

41. *See, e.g.*, *Stawski v. Lawson*, 129 USPQ2d 1036, 1048-1053 (TTAB 2018) (whether concurrent use applicant had lawful use in commerce within the meaning of the concurrent use proviso of Section 2(d)), *appeal filed*, No. 19-1617 (Fed. Cir. March 4, 2019). *Cf.* I *n re Stanley Brothers Social Enterprises LLC*, 2020 USPQ2d 10658, at *15 (TTAB 2020) (finding applicant's proposed mark's use in commerce for the goods identified a per se violation of the Food, Drug & Cosmetics Act (FDCA) because Applicant's goods contain cannabidiol (CBD), an extract of the cannabis plant, regulated under the FDCA as a drug); *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).

309.03(c)(2) Priority and Likelihood of Confusion

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.

A. Priority

A plaintiff must plead (and later prove) priority of use. [Note 1.] 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 2.] 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 3] prior trademark or service mark use; [Note 4] or prior use analogous to trademark or service mark use. [Note 5.]

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 6] 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 7.]

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 8.]

NOTES:

1. 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); *Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400 (TTAB 2020) (failed to prove priority of use); *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1607 (TTAB 2018) (continuous use not required for priority, the question is "whether the mark or trade name has been 'previously used in the United States by another and not abandoned"); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1483 (TTAB 2017) (failure to prove priority due to abandonment); *Executive Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180 & 1199 (TTAB 2017) (same); *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); *Giersch v. Scripps*, 90 USPQ2d 1020, 1023 (TTAB 2009) (petitioner established common law rights of distinctive mark); *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).

2. *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); *Milano S.p.A.*, 2020 USPQ2d 11488, at *7 (TTAB 2020) (no allegations of prior proprietary rights in a mark owned by opposer); *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. Stawski v. Lawson, 129 USPQ2d 1036, 1039 & 1052-1053 (TTAB 2018) (concurrent use applicant could not meet the jurisdictional requirement of lawful use in commerce prior to defendant's application filing date), *appeal filed*, No. 19-1617 (Fed. Cir. March 4, 2019); *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).

3. *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).

4. *See Sun Hee Jung v. Magic Snow, LLC*, 124 USPQ2d 1041, 1044 (TTAB 2017) (insufficient pleading of priority based on recognition, rather than use, in the United States as well as United States-Korea Free Trade Agreement); *Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028, 1036 (TTAB 2017) (licensee cannot rely on her licensor's use to prove priority); *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, 1284-85 (TTAB 2008) (opposer's use, while not large, was sufficient to constitute more than token use; applicant cannot establish priority in the United States based on the fact that applicant's mark is well-known in other countries); *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).

5. *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); *Central Garden & Pet Co. v. Doskocil Manufacturing Co.*, 108 USPQ2d 1134, 1142 (TTAB 2013) (reliance on priority through analogous use must be pleaded); *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).

6. *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).

7. *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 C.F.R. § 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 may be decided before the issues in the underlying opposition, at the discretion of the Board. *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); *but see Delaware Quarries, Inc. v. PlayCore IP Sub, Inc.*, 108 USPQ2d 1331, 1332 (TTAB 2013) (Board properly retained jurisdiction to decide applicant's counterclaim after finding no likelihood of confusion since "[s]tanding is assessed at the time the counterclaim is filed").

8. *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 1.] 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 2.]

Direct or Hypothetical Pleading of Likelihood of Confusion: A plaintiff may plead likelihood of confusion directly or hypothetically. [Note 3.] 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 4.] 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 5.]

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 6.]

NOTES:

1. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See, e.g., Omaha Steaks International, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1690-91 (Fed. Cir. 2018) (Board erred in consideration of the fifth and sixth *du Pont* factors which affected analysis of the first *du Pont* factor); *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 Zheng Cai v. Diamond Hong, Inc., 901 F.3d 1367, 127 USPQ2d 1797, 1800-01 (Fed. Cir. 2018) (substantial evidence supported likelihood of confusion finding based on the similarity of the marks, the goods and the trade channels which were the only relevant factors); *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).

2. *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).

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

4. *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).

5. *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).

6. *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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.111(b) and 37 C.F.R. § 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 C.F.R. § 2.99(h) and 37 C.F.R. § 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 DAK Industries 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); *DAK Industries 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 Piano Wellness, LLC v. Williams*, 126 USPQ2d 1739, 1741 (TTAB 2018) (under Trademark Act § 18, the Board may, upon motion of any party before it, amend the ownership of an application in order to give effect to a district court judgment ordering transfer of a trademark application); *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) (Section 18 is broad enough to authorize the Board to amend ownership of the registration upon request of the parties).

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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 under 37 C.F.R. § 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 of all physical papers because the papers are scanned shortly after filing and appear in the electronic 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 C.F.R. § 2.101(b)(1); 37 C.F.R. § 2.101(b)(3); 37 C.F.R. § 2.101(b)(2); 37 C.F.R. § 2.101(d); 37 C.F.R. § 2.111(c)(1); 37 C.F.R. § 2.111(c)(2).

2. *See* 37 C.F.R. § 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 C.F.R. § 2.111(d).

4. 37 C.F.R. § 2.104(a) and 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.101(b)(1)). When a timely opposition in proper form (*See* 37 C.F.R. § 2.101 and 37 C.F.R. § 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 C.F.R. § 2.111(a) and 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 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 C.F.R. § 2.105(a), for an opposition, or in 37 C.F.R. § 2.113(a), for a cancellation; states that proceedings in the case will be conducted in accordance with the Trademark Rules of Practice, 37 C.F.R. 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, assigning each party's time for pretrial disclosures and for taking testimony, and the briefing periods. [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, the Board will send notification to defendants by email where an email address is of record for registrant and by U.S. mail where there is no email address of record for registrant. [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 C.F.R § 2.18(c) 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.

A foreign-domiciled party, whether plaintiff or defendant, is required to obtain U.S. counsel. [Note 21.]

In a cancellation proceeding, if the party identified by the petitioner pursuant to 37 C.F.R. § 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 22.] *See* TBMP § 512.

NOTES:

1. *See* 37 C.F.R. § 2.105(a).

2. *Cf.* 37 C.F.R. § 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 C.F.R. § 2.113(a).

4. *See* 37 C.F.R. § 2.113(c)(1) and 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.105(b) and 37 C.F.R. § 2.105(c); and 37 C.F.R. § 2.113(b) and 37 C.F.R. § 2 .113(c); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69953 (October 7, 2016).

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

13. 37 C.F.R. § 2.105(a) and 37 C.F.R. § 2.113(a).

14. *See* 37 C.F.R. § 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 C.F.R. § 2.105(b)(1); 37 C.F.R. § 2.113(b)(1).

16. 37 C.F.R. § 2.105(b)(3); 37 C.F.R. § 2.113(b)(3).

17. 37 C.F.R. § 2.105(b)(2) and 37 C.F.R. § 2.113(b)(2). *See* 37 C.F.R. § 2.119(d).

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

19. *See* 37 C.F.R. § 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 C.F.R. 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. 37 C.F.R. § 2.11(a).

22. *See* 37 C.F.R. § 2.113(d).

310.02 Defendant's Copy of Institution Order Returned as Undeliverable

37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.118.

310.03 Setting Time for Filing Answer

310.03(a) In General

37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.105(a) and 37 C.F.R. § 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 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.*

(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 C.F.R. § 2.126(a) and 37 C.F.R. § 2.126(b).

311 Form and Content of Answer

311.01 Form of Answer

37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.106(b)(1) and 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.116(c).

2. *See* 37 C.F.R. § 2.126(a)(1) and 37 C.F.R. § 2.126(a)(2).

3. *See* 37 C.F.R. § 2.126(a) and 37 C.F.R. § 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), *dismissed with prejudice*, No. 0:14-cv-4463 (D. Minn. Jan. 20, 2016).

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 C.F.R. § 2.126(a) for electronic filings through ESTTA and 37 C.F.R. § 2.106(b)(1), 37 C.F.R. § 2.145(b)(1), and 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.106(b)(1) and 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.119(e).

311.01(c) Filing and Service of Answer

37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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: The notice automatically generated by ESTTA upon filing the answer does not constitute service and does not relieve a party of its obligation to serve a copy of the answer under the Trademark Rules; the filing notice and actual service of the submission are independent of one another. [Note 8.]

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 C.F.R. § 2.146(g), and parties should adhere to the trial schedule. [Note 9.]

NOTES:

1. *See* 37 C.F.R. § 2.106(b)(1) and 37 C.F.R. § 2.114(b)(1).

2. *See* 37 C.F.R. § 2.106(b)(1) and 37 C.F.R. § 2.114(b)(1).

3. *See* 37 C.F.R. § 2.119(a) and 37 C.F.R. § 2.119(b). *See also Coffee Studio LLC v. Reign LLC*, 129 USPQ2d 1480, 1482 n.5 (TTAB 2019) (Under Trademark Rule 2.119(a), every submission filed in an inter partes proceeding, except for the petition to cancel or notice of opposition, must be served upon the other party together with a certificate of service).

4. *See* 37 C.F.R. § 2.119(a) and 37 C.F.R. § 2.119(b).

5. *See* 37 C.F.R. § 2.119(b).

6. *See* 37 C.F.R. § 2.119(b). *Cf. Coffee Studio LLC v. Reign LLC*, 129 USPQ2d 1480, 1482 n.5 (TTAB 2019) (discussing service of a motion).

7. *See* 37 C.F.R. § 2.119(b).

8. *Coffee Studio LLC v. Reign LLC*, 129 USPQ2d 1480, 1482 (TTAB 2019).

9. 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.106(b)(2) and 37 C.F.R. § 2.114(b)(2).

2. *See* 37 C.F.R. § 2.106(b)(3)(i); 37 C.F.R. § 2.106(b)(3)(ii); 37 C.F.R. § 2.114(b)(3)(i); and 37 C.F.R. § 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 knowledge or iinformation 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. [Note 2.] 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 3.] 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 4.]

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 C.F.R. § 2.106(b)(2) and 37 C.F.R. § 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* Fed. R. Civ. P. 8(b)(5).

3. *See* 37 C.F.R. § 2.106(b)(2) and 37 C.F.R. § 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

311.02(b)(1) In General

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. 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 1.] 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 2], except that geographic restrictions will be considered and determined by the Board only in the context of a concurrent use registration proceeding. [Note 3.] *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 C.F.R § 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 4.] *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. Affirmative defenses may be deemed waived if not pursued at trial or argued in briefs. [Note 5.]

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 for a Principal Register registration start to run from the date of registration, in the absence of actual knowledge before the close of the opposition period, but for a Supplemental Register registration, the defenses start to run from the time of knowledge that the registration issued. [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 C.F.R. § 2.106(b)(3)(ii) and 37 C.F.R. § 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 C.F.R. § 2.106(b)(2) and 37 C.F.R. § 2.114(b)(2); Fed. R. Civ. P. 8(b) and (c); *Morehouse Manufacturing Corp. v. J. Strickland and Co.*, 407 F.2d 881, 160 USPQ 715, 717 (CCPA 1969) (no added injury to the plaintiff where defendant owns a substantially similar registered mark for substantially similar goods and/or services). *See also 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).

2. *See* 37 C.F.R. § 2.133(a). *Cf.* 37 C.F.R. § 2.133(b) and 37 C.F.R. § 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).

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

4. *See* 37 C.F.R. § 2.133(a) and 37 C.F.R. § 2.133(b). *See also 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); *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); *Montecash LLC v. Anzar Enterprises, Inc.*, 95 USPQ2d 1060, 1062 (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 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. § 1068 restriction 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).

5. *See TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1100-01 (TTAB 2018) (affirmative defenses waived because not pursued at trial or argued in brief); *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1602 n.5 (TTAB 2018) (affirmative defenses waived because not argued in ACR brief); *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).

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); *TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1414 (TTAB 2018) (where laches defense involves a Supplemental registration, period of delay begins on the date when the petitioner first had knowledge that the registration issued); *Ava Ruha Corp. v. Mother's Nutritional Center, Inc.*, 113 USPQ2d 1575, 1580 (TTAB 2015) ("[I]n a cancellation proceeding, laches begins to run no earlier than the date the involved mark was published for opposition (if there was actual knowledge), and no later than the issue date of the registration (when Plaintiff is put on constructive notice.")); *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).

See also Pinkette Clothing, Inc. v. Cosmetic Warriors Ltd., 894 F.3d 1015, 127 USPQ2d 1315, 1322 (9th Cir. 2018) (laches defense in cancellation available within the first five years of registration). *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 TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1413 (TTAB 2018) (laches not a bar to cancellation if confusion inevitable); *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)); *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.*, 86 USPQ2d 1283, 1285 n.4 (TTAB 2008) (comparison of marks for purpose of determining whether the marks are essentially the same under the Morehouse doctrine).

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 USPQ2d 1311, 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) (applicant's "fair use" defense given no consideration); *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 C.F.R. § 2.106(b)(2) and 37 C.F.R. § 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 (TTAB 2009).

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 C.F.R. § 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 C.F.R. § 2.106(b)(3)(i), 37 C.F.R. § 2.106(b)(3)(ii), 37 C.F.R. § 2.114(b)(3)(i) and 37 C.F.R. § 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 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). *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 C.F.R. § 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 C.F.R. § 2.99(h) and 37 C.F.R. § 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(b)(2) Specific Affirmative Defenses

Additional cases are provided as a reference addressing the following affirmative defenses: estoppel, [Note 1.]; "Morehouse" defense, [Note 2.]; prior judgment, [Note 3.]; and laches, [Note 4.]. Cases referencing select other defenses are also provided. [Note 5.]

NOTES:

1. *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 Associaton 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 Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001) (contractual estoppel). *Cf.* T *extron, Inc. v. 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).

2. *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. U. S. Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995) (*Morehouse* defense). *Cf. Performance Open Wheel Racing, Inc. v. United States Auto Club Inc.*, 2019 USPQ2d 208901, at *11 (TTAB 2019) (*Morehouse* defense does not apply where the issue is whether the mark is generic); *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*, 208 F. App'x 886, 887 (Fed. Cir. 2006).

3. *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); *Sharp Kabushiki Kaisha v. ThinkSharp Inc.*, 448 F.3d 1368, 79 USPQ2d 1376, 1379-80 (Fed. Cir. 2006) (res judicata, claim preclusion); *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); *Freki Corp. v. Pinnacle Entertainment, Inc.*, 126 USPQ2d 1697, 1701 (TTAB 2018) (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, 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. Empresa Cubana Del Tabaco v. General Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1063-65 (Fed. Cir. 2014) (neither issue nor claim preclusion barred Board cancellation action); *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); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1467-68 (TTAB 2016) (no

claim or issue preclusion; judicial estoppel inapplicable); *Be Sport, Inc. v. Al-Jazeera Satellite Channel*, 115 USPQ2d 1765, 1769 (TTAB 2015) (proposed defense of claim preclusion futile); *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).

4. *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); *Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, *9-12 (TTAB 2019) (eight-month delay not unreasonable, material prejudice not shown); *Schiedmayer Celesta GmbH v. Piano Factory Group, Inc. and Sweet 16 Musical Properties, Inc.*, 2019 USPQ2d 341894, at *9-11 (TTAB 2019) (although delay of over seven years unreasonable, petition to cancel not barred by laches because defendant unable to show material prejudice), *appeal filed*, No. 20-1196 (Fed. Cir. Dec. 3, 2019); *TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1414 (TTAB 2018) (where laches defense involves a Supplemental registration, period of delay begins on the date when the petitioner first had knowledge that the registration issued); *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1609-13 (TTAB 2018) (addressing merits of laches defense in cancellation); *Ava Ruha Corp. v. Mother's Nutritional Center, Inc.*, 113 USPQ2d 1575, 1579-83 (TTAB 2015) (laches available for dilution claim in opposition and cancellation; laches applied to dilution claim); *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*, 208 F. App'x 886, 887 (Fed. Cir. 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).

5. *Spanishtown Enterprises, Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *4 (TTAB 2020) (lack of capacity to sue); *Hu v. TJ Food Services, LLC*, 123 USPQ2d 1777, 1779 (TTAB 2017) (lack of board jurisdiction due to contractual agreement containing arbitration clause); *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.*, *Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1338 (TTAB 2006) (applicant's "fair use" defense given no consideration); *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, 1737 (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).

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 Spanishtown Enterprises, Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *4 (TTAB 2020) (applicant cannot obtain summary judgment on unpleaded lack of capacity defense); *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* 188 F. Supp. 3d 22 (D.D.C. 2016), *aff'd*, 743 F. App'x 457, 128 USPQ2d 1172 (D.C. Cir. 2018); *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); *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.*, 86 USPQ2d 1283, 1285 n.4 (TTAB 2008) (applicant neither pleaded nor established the defense that its mark is well-known in the United States within the meaning of Article 6bis of the Paris Convention); *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 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) (denying motion to strike portions of petition to cancel that were not prejudicial and gave respondent more complete notice of petitioner's claim).

311.03 Reply to Answer Should Not be Filed

Although 37 C.F.R. § 2.106(b) and 37 C.F.R. § 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 C.F.R. § 2.106(b)(2), 37 C.F.R. § 2.106(b)(3)(iii), 37 C.F.R. § 2.114(b)(2) and 37 C.F.R. § 2.114(b)(3)(iii).

312 Default

312.01 In General

37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.106(a) and 37 C.F.R. § 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 C.F.R. § 2.106(a) and 37 C.F.R. § 2.114(a); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69952 (October 7, 2016).

8. 37 C.F.R. § 2.106(b)(3)(iv); 37 C.F.R. § 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). *See also* 10A WRIGHT, A. MILLER& M. KANE, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2693 (4th ed. 2020) (setting aside entry of default is addressed to the sound discretion of the court).

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). *See also* 10A WRIGHT, A. MILLER& M. KANE, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2693 (4th ed. 2020) (default judgments viewed with disfavor).

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. 2020); *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. 2020).

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. 2020).

313 Counterclaims

313.01 In General

37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.106(b)(3)(ii) and 37 C.F.R. § 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 C.F.R. § 2.111 - 37 C.F.R. § 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 C.F.R. § 2.106(b)(3)(ii) and 37 C.F.R. § 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 C.F.R. § 2.111(b) and 37 C.F.R. § 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 C.F.R. § 2.99(h) and 37 C.F.R. § 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 C.F.R. § 2.106(b)(3)(iii) and 37 C.F.R. § 2.114(b)(3)(iii); 37 C.F.R. § 2.111(c).

12. *See* 37 C.F.R. § 2.106(b)(3)(iii) and 37 C.F.R. § 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 C.F.R. § 2.106(b)(3)(iv) and 37 C.F.R. § 2.114(b)(3)(iv).

313.02 Fee For Counterclaim

37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.106(b)(3)(iii); 37 C.F.R. § 2.114(b)(3)(iii); and 37 C.F.R. § 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, 94

USPQ2d 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 C.F.R. § 2.111(d) and 37 C.F.R. § 2.112(b) .

3. *See* 37 C.F.R. § 2.111(d) and 37 C.F.R. § 2.112(b) .

4. *See* 37 C.F.R. § 2.111(d) and 37 C.F.R. § 2.112(b) .

313.03 Form and Substance of Counterclaim; Service of Counterclaim

37 C.F.R. § 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 entitlement to a statutory cause of action (previously referred to as "standing") to assert a counterclaim to cancel a registration pleaded by the plaintiff in its complaint. The counterclaimant's entitlement to a statutory cause of action 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 C.F.R. § 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 (2020). *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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.106(b)(3)(i) and 37 C.F.R. § 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 C.F.R. § 2.106(b)(3)(i) and 37 C.F.R. § 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 C.F.R. § 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); *Freki Corp. v. Pinnacle Entertainment, Inc.*, 126 USPQ2d 1697, 1701 (TTAB 2018) (petitioner barred from asserting one of its claims in cancellation proceeding because it was aware of ground in earlier cancellation proceeding but failed to assert a compulsory counterclaim); *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 Jive Software, Inc. v. Jive Communications, Inc., 125 USPQ2d 1175 (TTAB 2017) (finding leave to add a counterclaim is governed by Rule 15 and is to be "freely given when justice so requires," Board allowed applicant to amend opposition to assert counterclaim for cancellation of opposer's pleaded registrations since case was suspended by parties and actual delay was minimal); *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 C.F.R. § 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 C.F.R. § 2.106(b)(3)(i) and 37 C.F.R. § 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 C.F.R. § 2.106(b)(3)(i) and 37 C.F.R. § 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 C.F.R. § 2.195 – 37 C.F.R. § 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 C.F.R. § 2.106(b)(3)(i) and 37 C.F.R. § 2.114(b)(3)(i).

2. *See* 37 C.F.R. § 2.111(e).

3. *See* 37 C.F.R. § 2.111(c)(1) and 37 C.F.R. § 2.114(b)(1).

4. *See* 37 C.F.R. § 2.111(e).

5. *See* 37 C.F.R. § 2.119(a).

313.06 Answer to Counterclaim

37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.6(a)(16) and TBMP § 313.02. For information on the form for a counterclaim, *see*TBMP § 313.03.

NOTES:

1. *See* 37 C.F.R. § 2.106(b)(3)(iii) and 37 C.F.R. § 2.114(b)(3)(iii).

2. *See* 37 C.F.R. § 2.106(b)(3)(iv) and 37 C.F.R. § 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 C.F.R. § 2.106(a)and 37 C.F.R. § 2.114(a).

4. *Cf.* 37 C.F.R. § 2.106(b)(3)(i) and 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 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); *Freki Corp. v. Pinnacle Entertainment, Inc.*, 126 USPQ2d 1697, 1702 (TTAB 2018) (lack of fair notice of a claim of nonuse on some of the identified services when not pled as a separate ground); *UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1244 (TTAB 2015) (unpleaded allegations relating to fraud, acquiescence and laches will not be heard); *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 C.F.R. § 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*, 188 F. Supp. 3d 222 (D.D.C. 2016), *aff'd*, 743 F. App'x 457, 128 USPQ2d 1172 (D.C. Cir. 2018); *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 C.F.R. § 2.107(a) and 37 C.F.R. § 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 C.F.R. § 2.106(b)(2)(i) and 37 C.F.R. § 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 Corp. 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 2.107 and 37 C.F.R. § 2.115 .

2. *See* Trademark Act § 68(c)(3), 15 U.S.C. § 1141h; 37 C.F.R. § 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 C.F.R. § 2.107(a) and 37 C.F.R. § 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 C.F.R.. §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 C.F.R. § 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 C.F.R. § 2.107(b); *Destileria Serralles, Inc. v. Kabushiki Kaisha Donq*, 125 USPQ2d 1463, 1466-67 (TTAB 2017) (for opposition involving § 66(a) application, the scope or basis of Section 2(d) claim was limited to ESTTA opposition form; opposer could not amend notice of opposition to rely on its common law rights in a mark); *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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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), and TBMP § 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 C.F.R. § 2.126. *See, generally,*TBMP § 106.03.

NOTES:

1. 37 C.F.R. § 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 International (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 C.F.R. § 2.122(d)(1)).

3. *See* 37 C.F.R. § 2.122(e) and 37 C.F.R. § 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 C.F.R. § 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"); *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005) (signer of the ESTTA form is responsible for the content of the attachments for purposes of Fed. R. Civ. P. 11). *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.

Chapter 400 DISCOVERY

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401 Introduction to Disclosures and Discovery

37 C.F.R. § 2.120(a)(1) ***[Discovery.] In general.*** *Except as otherwise provided in this section, and wherever appropriate, the provisions of the Federal Rules of Civil Procedure relating to disclosure and discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings. The provisions of Rule 26 of the Federal Rules of Civil Procedure relating to required disclosures, the conference of the parties to discuss settlement and to develop a disclosure and discovery plan, the scope, proportionality, timing and sequence of discovery, protective orders, signing of disclosures and discovery responses, and supplementation of disclosures and discovery responses, are applicable to Board proceedings in modified form, as noted in these rules and as may be detailed in any order instituting an inter partes proceeding or subsequent scheduling order. The Board will specify the deadline for a discovery conference, the opening and closing dates for the taking of discovery, and the deadlines within the discovery period for making initial*

disclosures and expert disclosure. The trial order setting these deadlines and dates will be included within the notice of institution of the proceeding.

Through the use of the various disclosures (i.e., initial and expert) and discovery devices (i.e., discovery depositions, interrogatories, requests for production of documents and things, and requests for admission) available to litigants in inter partes proceedings before the Board, a party may ascertain the facts underlying its adversary's case. Discovery of these facts may lead to a settlement of the case, may simplify the issues, or may reveal a basis for a motion for summary judgment, an additional claim (in the case of a plaintiff), or an additional defense or counterclaim (in the case of a defendant). At the very least, taking discovery enables the propounding party to propose to the responding party stipulations of fact, stipulations as to procedures for introducing into the record evidence produced in response to discovery requests, and to otherwise prepare for trial. Propounding and responding to discovery may further lead parties to stipulate to narrowing the issues for trial, or to stipulate to expedited determination of their case under the Board's Accelerated Case Resolution (ACR) process. [Note 1.] *See*TBMP § 528.05(a)(2), TBMP § 702.04 and TBMP § 705 for information regarding ACR and stipulations.

The conduct of discovery in Board inter partes proceedings is governed by 37 C.F.R. § 2.120. Discovery before the Board under 37 C.F.R. § 2.120 is similar in many respects to discovery before the federal district courts under the Federal Rules of Civil Procedure. Ordinarily, the discovery provisions of the Federal Rules of Civil Procedure are applicable in Board inter partes proceedings, except as otherwise provided in 37 C.F.R. § 2.120. The provisions of the Federal Rules of Civil Procedure relating to automatic disclosure and discovery conferences are applicable to inter partes proceedings. However, the Board has adopted a modified disclosure and conferencing regime. [Note 2.] All parties to Board proceedings are obliged to (1) conduct a discovery conference to discuss, inter alia, disclosure and discovery plans, and (2) make initial, expert, and pretrial disclosures. The Board adopted the disclosure regime of the Federal Rules of Civil Procedure in order to promote the early exchange of information and earlier settlement of cases and, for cases that do not settle, "more efficient discovery and trial, [reduction of] incidents of unfair surprise, and [to] increase the likelihood of fair disposition of the parties' claims and defenses." [Note 3.] In addition, the utilization of initial and expert disclosures is intended to "obviate the need to use traditional discovery to obtain 'basic information' about a party's claims or defenses." [Note 4.] In the absence of any express written statement from the parties filed with the Board that they waive their reciprocal rights to obtain disclosures or agree to restrictions on the use of particular discovery devices, the Board will presume the parties will comply with their obligation to make all required disclosures and will utilize traditional discovery devices, as permitted by the Trademark Rules and Federal Rules of Civil Procedure. [Note 5.]

For more information regarding discovery conferences, see TBMP § 401.01 and TBMP § 408.01(a).

For a discussion of when discovery requests, discovery responses, and disclosures should be filed with the Board, see TBMP § 409 and 37 C.F.R. § 2.120(k)(8).

For information regarding pretrial disclosures, see TBMP § 702.01.

For information regarding Accelerated Case Resolution (ACR), see TBMP § 528.05(a)(2), TBMP § 702.04, and TBMP § 705.

NOTES:

1. For a discussion of the purposes served by discovery, see *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 865 (TTAB 1979). *See also Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 250 (TTAB 1978). For a discussion

of ACR, see, for example, *Eveready Battery Co., Inc. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244-47 (August 1, 2007); 37 C.F.R. § 2.120(a); Fed. R. Civ. P. 26(a)(1)(A); Fed. R. Civ. P. 26(a)(2); Fed. R. Civ. P. 26(a)(3); Fed. R. Civ. P. 26(f).

3. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244 and 42246 (August 1, 2007). *See also Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1879-80 n.5 (TTAB 2012) (citing August 1, 2007 final rule); *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012) (disclosures, from initial through pretrial, and discovery responses should be viewed as a continuum of communication designed to avoid unfair surprise and to facilitate a fair adjudication of the case on the merits); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (adoption of disclosure model intended to provide an orderly administration of the proceeding as it moves to trial).

4. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244 and 42246 (August 1, 2007).

5. *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767-68 (TTAB 2008).

401.01 Discovery Conferences

37 C.F.R. § 2.120(a)(1) ***[Discovery]*** *. . . The provisions of Rule 26 of the Federal Rules of Civil Procedure relating to . . . the conference of the parties to discuss settlement and to develop a disclosure and discovery plan . . . are applicable to Board proceedings in modified form . . . . The Board will specify the deadline for a discovery conference . . . .* * * * *

37 C.F.R. § 2.120(a)(2)(i) *The discovery conference shall occur no later than the opening of the discovery period, and the parties must discuss the subjects set forth in Rule 26(f) of the Federal Rule of Civil Procedure and any subjects set forth in the Board's institution order. A Board Interlocutory Attorney or Administrative Trademark Judge will participate in the conference upon request of any party made after answer but no later than ten days prior to the deadline for the conference, or when the Board deems it useful for the parties to have Board involvement. The participating attorney or judge may expand or reduce the number or nature of subjects to be discussed in the conference as may be deemed appropriate.*

* * * *

(v) The parties are not required to prepare or transmit to the Board a written report outlining their discovery conference discussions, unless the parties have agreed to alter disclosure or discovery obligations set forth by these rules or applicable Federal Rules of Civil Procedure, or unless directed to file such a report by a participating Board Interlocutory Attorney or Administrative Trademark Judge.

Fed. R. Civ. P. 26(f)(2) Conference Content; Parties' Responsibilities. *In conferring, the parties must consider the nature and basis of their claims and defenses and the possibilities for promptly settling or resolving the case; . . . discuss any issues about preserving discoverable information, and develop a proposed discovery plan.*

For all inter partes proceedings, the parties are required to hold a discovery conference to discuss the subjects set forth in Fed. R. Civ. P. 26(f) and in the institution order for the case. [Note 1.] As specified in the Board's institution order:

"The parties are required to schedule and hold a discovery conference by the deadline in the schedule in this order, or as reset by the Board. In the conference, the parties are required to discuss, at a minimum, 1) the nature and basis of their claims and defenses, 2) the possibility of promptly settling, or at least narrowing the scope of claims or defenses, and 3) arrangements for disclosures, discovery, preserving discoverable information and introduction of evidence at trial. For guidance, see Fed. R. Civ. P. 26(f), Trademark Rule 2.120(a)(2)(i), and TBMP §§ 401.01 and 408.01(a)."

The conference is not limited to the subjects listed in Fed. R. Civ. P. 26(f) or in the Board's institution order, and "the parties are free to discuss any additional topics that could promote settlement or efficient adjudication of the Board proceeding," including alternative means for adjudication such as the Board's Accelerated Case Resolution (ACR) procedure. [Note 2.] See TBMP § 528.05(a)(2) and TBMP § 702.04 for further information on ACR. Because the parties may enter into stipulations altering disclosure obligations, they should continue to discuss their reciprocal obligations and progress made in satisfying such obligations even after the discovery conference has been held.

The conference should take place once the pleadings have closed and by the deadline set forth in the Board's institution order (or by any extended deadline approved by the Board), and must take place no later than the opening of the discovery period. [Note 3.] In instances, however, where the defendant is in default, or a pleading motion under Fed. R. Civ. P. 12 has been filed, or a counterclaim has been filed, the parties' obligation to have a discovery conference is tolled or effectively stayed. [Note 4.] The rationale is that an answer must be filed to all claims and counterclaims, and issues related to the pleadings resolved, before the parties can have a meaningful discovery conference. [Note 5.] In such cases, the Board will reset the deadline for the discovery conference, as well as all subsequent dates, upon resolution of the default or Fed. R. Civ. P. 12 motion, or acknowledgement of the counterclaim, which may include setting or resetting the deadline for filing an answer. [Note 6.] Generally after an answer is filed, the Board is unlikely to find good cause to extend the deadline for the discovery conference for settlement negotiations, even upon stipulation or consent. [Note 7.] There is no Fed. R. Civ. P. 16(b) scheduling/conference order.

The parties' discovery conference may be in person or by other means (e.g. telephone). [Note 8.] If any party wants a Board professional to participate in the required discovery conference, the party must submit such request through ESTTA, the Board's electronic filing system, or call the Board attorney assigned to the case no later than ten (10) days prior to the deadline for conducting the discovery conference, so as to facilitate completion of the conference by the deadline. [Note 9.] A party requesting the Board's participation in the discovery conference should also inform the Board, either in their filing or in the phone call to the Board, of any other proceedings between the parties involving the mark(s) at issue.

Submitting a request using ESTTA is preferred; however, parties are encouraged to follow up a few days later with a phone call to the Board attorney assigned to the case if they have not yet been contacted by a Board attorney. Board participation is encouraged where pro se litigants are involved. [Note 10.] The Board, on its own initiative, may elect to participate in the discovery conference when the Board deems it useful for the parties to have Board involvement. [Note 11.] The participating attorney or judge has discretion to expand or reduce the number or nature of subjects to be discussed during the conference. [Note 12.] For instance, the Board professional may ascertain whether the parties have previously engaged in settlement discussions, explain to the parties the Board's ACR option, and may inquire whether the parties need additional time after the conference to discuss settlement. [Note 13.] Participation by a Board professional

will be by telephone. [Note 14.] The conference will not be recorded by the Board and shall not be recorded by the parties. [Note 15.]

If a party desires the appearance of more than one counsel on behalf of a party in a discovery conference with Board participation, that party is to designate a lead counsel to represent the party in the conference. With respect to pro se parties, the person who appears on behalf of the party, must be authorized under 37 C.F.R. § 11.14(e). *See*TBMP §114.01 (Party May Represent Itself). If a pro se litigant desires to have counsel appear on its behalf strictly for purposes of the discovery conference with Board participation, such counsel shall file a notice of appearance prior to the conduct of the discovery conference for this limited purpose. Subsequently, counsel will file a notice of withdrawal, unless counsel has been retained by the party to take further action on behalf of the party in the case. See TBMP § 116.01 for information regarding termination of representation.

In discovery conferences with Board participation, parties must conduct themselves with appropriate decorum and interruptions are to be avoided. [Note 16.] The Board professional participating in the conference generally will signal that a party may make a presentation by inviting the party to do so or by inviting a response to a presentation made by another. The Board professional may make other requirements for the orderly conduct of the discovery conference.

If neither party requests Board participation in the discovery conference and the Board does not elect to participate in the conference on its own initiative, the parties still must conference no later than the prescribed deadline, and the Board will operate on the assumption that the conference was held by the deadline. The mere discussion of settlement among the parties does not substitute for a full discovery conference of subjects set forth in Fed. R. Civ. P. 26(f) and the Board's institution order. [Note 17.]

The parties do not have to file a disclosure/discovery plan with the Board following their discovery conference, unless they are seeking leave by motion or stipulation to alter standard deadlines or obligations, or unless they were directed to do so by the Board. [Note 18.]

The Board has the authority to order parties to hold a discovery conference, either sua sponte or upon motion. [Note 19.]

For a discussion regarding the duty to cooperate in scheduling and conducting a discovery conference, and the imposition of sanctions for the failure to participate in a discovery conference, see TBMP § 408.01(a).

For general information on the conduct of telephone conferences, participation in telephone conferences, and issuance of rulings resulting from telephone conferences, see TBMP § 502.06(a).

NOTES:

1. 37 C.F.R. § 2.120(a)(1); 37 C.F.R. § 2.120(a)(2)(i); Fed. R. Civ. P. 26(f). *See, e.g., Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761-62 (TTAB 2009) (mere discussion of settlement does not substitute for full discovery conference of subjects set forth in Fed. R. Civ. P. 26 and Board's institution order). See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 and 42252 (August 1, 2007) for information about the adoption of a discovery conference in Board proceedings.

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 and 42252 (August 1, 2007). *See Weatherford/Lamb Inc. v. C&J*

Energy Servs., Inc., 96 USPQ2d 1834, 1836 n.4 (TTAB 2010) (parties encouraged to discuss ACR during discovery conference). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69959 and 69961 (October 7, 2016) (if voluminous production is anticipated, method of service is worthwhile issue to discuss at Board discovery conference; production of ESI is a subject for discussion at discovery).

3. 37 C.F.R. § 2.120(a)(2)(i). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

4. 37 C.F.R. § 2.106(a), 37 C.F.R. § 2.114(a) and 37 C.F.R. § 2.127(d). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69957, 69959 and 69967 (October 7, 2016). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007) (filing of a counterclaim results in proceeding effectively being stayed).

5. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

6. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

7. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007). *See Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767 n.1 (TTAB 2008) ("The Board is unlikely to find good cause when such a request is based on the parties' desire to engage in settlement discussions.").

8. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

9. *See* 37 C.F.R. § 2.120(a)(2)(i); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007). *But see Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1762 (TTAB 2009) (Board professional can participate in discovery conference with less than ten days' notice in instances where parties are at an impasse; conference may take place after deadline in those circumstances).

10. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42252 (August 1, 2007) ("... Board professionals involved in conferences will fill the educator's role [that] would have to be filled by experienced counsel.").

11. 37 C.F.R. § 2.120(a)(2)(i); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016).

12. 37 C.F.R. § 2.120(a)(2)(i).

13. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42252 (August 1, 2007).

14. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

15. 37 C.F.R. § 2.120(j)(3).

16. 37 C.F.R. § 2.192; 37 C.F.R. § 11.305(d).

17. *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761-62 (TTAB 2009).

18. 37 C.F.R. § 2.120(a)(2)(v); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

19. *See, e.g., Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1763 (TTAB 2009).

401.02 Initial Disclosures

37 C.F.R. § 2.120(a)(2)(ii) *Initial disclosures must be made no later than thirty days after the opening of the discovery period.*

37 C.F.R. § 2.120(a)(3) *A party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board, or by order of the Board.* * * * *

Fed. R. Civ. P. 26(a)(1) Initial Disclosure.

(A) ***In General.*** *Except as exempted by Rule 26(a)(1)(B) or as otherwise stipulated or ordered by the court, a party must, without awaiting a discovery request, provide to the other parties:*

(i) *the name and, if known, the address and telephone number of each individual likely to have discoverable information — along with the subjects of that information — that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment;*

(ii) *a copy — or a description by category and location — of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment . . . .*

Each party involved in an inter partes proceeding is obligated to make initial disclosures to every other party, by the deadline set in the Board's institution order, or as may be reset by stipulation of the parties approved by the Board, or by motion granted by the Board, or by order of the Board. [Note 1.] A party may not seek discovery through traditional devices until after it has made its initial disclosures, absent modification of this requirement by a stipulation or motion of the parties approved by the Board, or upon Board order. [Note 2.] Generally, each party will meet this obligation by complying with the disclosure requirements set forth in Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii); subsections (iii) and (iv) of Rule 26(a)(1)(A) do not apply to Board proceedings. [Note 3.] "Initial disclosures are not intended to substitute for all discovery but, rather, to prompt routine disclosure of names of potential witnesses and basic information about documents and things that a party may use to support a claim or defense." [Note 4.]

Pursuant to Fed. R. Civ. P. 26(a)(1), a party is not obligated to disclose the name of every witness, document or thing that may have or contain discoverable information about its claim or defense, but merely the witnesses, documents and things having or containing discoverable "information that the disclosing party may use to support its claims or defenses." [Note 5.] If, however, a party does identify a trial witness in its initial disclosures, the party must provide the subject matter(s) about which each identified witness is likely to have discoverable information, as well as any known addresses and/or phone numbers for the identified

witness. [Note 6.] In addition, a party must either provide the location of all identified documents in its initial disclosures or, in the alternative, produce them. [Note 7.]

Initial disclosures are not a substitute for taking comprehensive discovery. [Note 8.] Nonetheless, discovery in Board proceedings should be more limited in scope than in district court cases since Board jurisdiction is limited to determining a party's right to obtain or retain a registration. [Note 9.] However, in the spirit of cooperation, parties can, subject to Board approval, stipulate to rely on more expansive use of reciprocal disclosures in lieu of formal discovery, as a more efficient and less costly means of litigating a Board proceeding. [Note 10.]

There is no concept of priority in regard to initial disclosures, and a party is not relieved of its obligation to make or supplement initial disclosures merely because it may not have received such disclosures or supplementation from an adverse party or parties. [Note 11.] For information regarding the duty to supplement initial disclosures, see TBMP § 408.03.

A party making initial disclosures has the option of disclosing information about the existence and location of documents instead of producing copies of documents. [Note 12.] However, the Board encourages parties to actually exchange copies of disclosed documents rather than to merely identify their location. [Note 13.]

Initial written disclosures and initial disclosures of documents are treated like responses to discovery requests insofar as they may be used in support of or in opposition to a motion for summary judgment and, at trial, may be introduced by notice of reliance. [Note 14.] For more information on motions for summary judgment and introduction of disclosures at trial by notice of reliance, see TBMP § 528 and TBMP § 704.14.

Pertinent information under Fed. R. Civ. P. 26(a)(1) stored in digital or electronic form must also be identified in initial disclosures. For further information regarding the discovery of electronically stored information, see TBMP § 402.02.

A party failing to make initial disclosures may be subject to a motion to compel, and ultimately, a motion for discovery sanctions. [Note 15.] A motion to compel initial disclosures must be filed within thirty days after the disclosure deadline. [Note 16.] For further information regarding motions to compel initial disclosures, see TBMP § 523.

In addition, a party may not file a motion for summary judgment until the party has made its initial disclosures, except for a motion asserting claim or issue preclusion or lack of jurisdiction by the Board. [Note 17.]

For further information regarding the duty to cooperate and remedies for failure to make initial disclosures, see TBMP § 408.01(b) and TBMP § 411.01.

NOTES:

1. 37 C.F.R. § 2.120(a)(1), 37 C.F.R. § 2.120(a)(2)(ii), 37 C.F.R. § 2.120(a)(2)(iv), and 37 C.F.R. § 2.120(a)(3).

2. 37 C.F.R. § 2.120(a)(3). *See Amazon Technologies, Inc. v. Wax*, 93 USPQ2d 1702, 1704-06 (TTAB 2009) (party objecting to discovery due to proponent's alleged failure to make initial disclosures must specifically articulate that objection); *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1768 (TTAB 2008) (parties' notice of waiver of initial disclosures approved).

3. *See* 37 C.F.R. § 2.120(a)(1). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007); *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008) (initial disclosures must be signed by party or party's attorney to comply with Fed. R. Civ. P. 26(g)).

4. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

5. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326 (TTAB 2011) (because an exhaustive search for all information or potential witnesses is not required, Board did not exclude the testimony of certain witnesses named for the first time in pretrial disclosures based on the failure to name them in initial disclosures, though the testimony for most witnesses was excluded for other reasons); *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 n.1 (TTAB 2009) ("A party need not, through its mandatory initial disclosures, identify particular individuals as prospective trial witnesses, per se, but must identify 'each individual likely to have discoverable information that the disclosing party may use to support its claims or defenses.' . . . Individuals identified through initial disclosures therefore could reasonably be viewed as possible witnesses.").

See also Kate Spade LLC v. Thatch, LLC, 126 USPQ2d 1098, 1103-04 (TTAB 2018) (where applicant's initial disclosures provided notice that applicant would submit documentary evidence of third-party use at trial, and its supplemental initial disclosures described unnamed witnesses who would testify regarding third-party use, applicant's failure to make pretrial disclosure of certain witnesses was substantially justified and harmless). *But see Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1179 (TTAB 2010) (where opposer identified trial witness in pretrial disclosures who was not identified in initial disclosures, opposer ordered to serve revised pretrial disclosures limiting testimony of the previously undisclosed witness to subjects other than those on which a previously disclosed witness who was identified in initial disclosures could testify).

6. *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008).

7. *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008).

8. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

9. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245-46 (August 1, 2007). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951 (October 7, 2016) ("The Board continues to view the universe of [electronically stored information] within the context of its narrower scope of jurisdiction, as compared to that of the federal district courts.").

10. 37 C.F.R. § 2.120(a)(2)(iv). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016) ("parties may stipulate … that reciprocal disclosures be used in place of discovery").

11. Fed. R. Civ. P. 26(a)(1)(E).

12. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42254 (August 1, 2007).

13. *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 n.4 (TTAB 2008).

14. 37 C.F.R. § 2.127(e)(2); 37 C.F.R. § 2.122(g); 37 C.F.R. § 2.120(k)(3)(i) - 37 C.F.R. § 2.120(k)(3)(ii). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69962 (October 7, 2016); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

15. 37 C.F.R. § 2.120(f)(1); 37 C.F.R. § 2.120(h); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42256 (August 1, 2007). *See also Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1878-79 (TTAB 2012) (motion to compel is available remedy for failure to serve, or insufficient, initial disclosures).

16. 37 C.F.R. § 2.120(f)(1); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69961 (October 7, 2016).

17. 37 C.F.R. § 2.127(e)(1). *See, e.g., Qualcomm, Inc. v. FLO Corp.*, 93USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment denied as premature where movant had yet to serve initial disclosures). *See also Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009) ("Because the Board does not allow a party to file a motion for summary judgment prior to the moving party's service of initial disclosures on the adverse party, the Board generally will no longer exercise its discretion to convert motions to dismiss that refer to matters outside the pleadings into motions for summary judgment, if such motions are filed before the moving party serves its initial disclosures.").

401.03 Expert Disclosures

37 C.F.R. § 2.120(a)(2)(iii) . . . *Disclosure of expert testimony must occur in the manner and sequence provided in Rule 26(a)(2) of the Federal Rule of Civil Procedure, unless alternate directions have been provided by the Board in an institution order or any subsequent order resetting disclosure, discovery or trial dates. If the expert is retained after the deadline for disclosure of expert testimony, the party must promptly file a motion for leave to use expert testimony. Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the Board, either on its own initiative or on notice from either party of the disclosure of expert testimony, may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert.*

Fed. R. Civ. P. 26(a)(2) Disclosure of Expert Testimony.

(A) ***In General.*** *In addition to the disclosures required by Rule 26(a)(1), a party must disclose to the other parties the identity of any witness it may use at trial to present evidence under Federal Rule of Evidence 702, 703, or 705.*

(B) ***Witnesses Who Must Provide a Written Report.*** *Unless otherwise stipulated or ordered by the court, this disclosure must be accompanied by a written report — prepared and signed by the witness — if the witness is one retained or specially employed to provide expert testimony in the case or one whose duties as the party's employee regularly involve giving expert testimony. The report must contain:*

(i) *a complete statement of all opinions the witness will express and the basis and reasons for them;*

(ii) *the facts or data considered by the witness in forming them;*

(iii) *any exhibits that will be used to summarize or support them;*

(iv) *the witness's qualifications, including a list of all publications authored in the previous 10 years;*

(v) *a list of all other cases in which, during the previous 4 years, the witness testified as an expert at trial or by deposition; and*

(vi) *a statement of the compensation to be paid for the study and testimony in the case.*

(C) ***Witnesses Who Do Not Provide a Written Report.*** *Unless otherwise stipulated or ordered by the court, if the witness is not required to provide a written report, this disclosure must state:*

(i) *the subject matter on which the witness is expected to present evidence under Federal Rule of Evidence 702, 703, or 705; and*

(ii) *a summary of the facts and opinions to which the witness is expected to testify.*

(D) ***Time to Disclose Expert Testimony.*** *A party must make these disclosures at the times and in the sequence that the court orders. Absent a stipulation or a court order, the disclosures must be made:*

(i) *at least 90 days before the date set for trial or for the case to be ready for trial; or*

(ii) *if the evidence is intended solely to contradict or rebut evidence on the same subject matter identified by another party under Rule 26(a)(2)(B) or (C), within 30 days after the other party's disclosure.*

(E) ***Supplementing the Disclosure.*** *The parties must supplement these disclosures when required under Rule 26(e).*

Although not frequently utilized in Board proceedings, experts in Board inter partes proceedings are typically recruited on the basis of experience in the relevant trade or industry and not on the basis of personal knowledge of or on-the-scene involvement in any sequence of events that gave rise to the Board proceedings. [Note 1.] As set forth in Federal Rule of Evidence 702, made applicable to Board proceedings by 37 C.F.R. § 2.122(a), "[a] witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise if: (a) the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue; (b) the testimony is based on sufficient facts or data; (c) the testimony is the product of reliable principles and methods; and (d) the expert has reliably applied the principles and methods to the facts of the case." [Note 2.] A party generally must decide within the discovery period whether it plans to use an expert to testify at trial since expert disclosure is due 30 days prior to the close of discovery, or by any deadline that may be reset by any order of the Board issued after the initial institution order, but the expert disclosure deadline must always be scheduled prior to the close of discovery whenever disclosure and discovery deadlines are modified. [Note 3.]

The extent of the expert disclosure obligation is governed by Fed. R. Civ. P. 26(a)(2). [Note 4.] Parties are not required to disclose consulting experts. [Note 5.] On the other hand, both retained, specially employed experts, and unretained experts must be disclosed. [Note 6.] Only retained experts are required to provide a report, unless otherwise stipulated. [Note 7.] For unretained experts, a party must provide the subject matter on which the witness is expected to present evidence under Fed. R. Evid. 702, 703, or 705; and a summary of the facts and opinions to which the witness is expected to testify. [Note 8.]

The disclosure of planned or possible expert testimony by any party must be made by the expert disclosure deadline, regardless of whether any other party has made such disclosure. Thus, for example, if a defendant has plans to present, or may present, expert testimony to support an affirmative defense, regardless of whether a plaintiff may use expert testimony in support of a main claim, then the defendant must disclose the planned or possible presentation of such testimony by the deadline set by the Board. [Note 9.] If a party decides after the deadline for expert disclosure that it would like to, or may need to, rely on expert testimony at trial, the

party must file a motion for leave to use the expert at trial. [Note 10.] The provisions regarding the timing of expert disclosure are intended to facilitate the taking of any necessary discovery by any party or parties adverse to the disclosing party, in regard to the proposed expert witness, and to allow the adverse party or parties to determine whether it will be necessary to rely on a rebutting expert. Parties are expected to cooperate in the process of exchanging information about any testifying experts, and should at least discuss, during the discovery conference, the possibility of entering into stipulations that will facilitate the exchange of such information and/or the presentation of expert testimony. The parties should revisit these discussions whenever it appears that a testifying expert witness may become involved in the case. [Note 11.]

Any party disclosing plans to use an expert must notify the Board that it has made the required disclosure (but should not file with the Board copies of the materials provided to adverse parties) to comply with Fed. R. Civ. P. 26(a)(2). [Note 12.] The Board may then suspend proceedings to allow for discovery limited to experts. [Note 13.] The suspension order may leave unchanged the deadline specified in the Federal Rule for disclosure of plans to use a rebuttal expert, or may reset the deadline, depending upon the circumstances at the time the Board issues the suspension order. Suspension is as to activities unrelated to the exchange of information about, and reports by, expected expert witnesses, and the parties should continue with the expert disclosure procedures specified in the Federal Rule pending issuance of any suspension order by the Board that will specify any actions of the parties required by the Board. If a party discloses plans to use an expert witness early in the discovery period, the Board may choose not to suspend discovery activities unrelated to the expected expert witnesses and may direct that all discovery activities continue concurrently with the disclosures and discovery relative to the experts. [Note 14.] There may be cases in which a party may not decide until after the deadline for expert disclosure that it needs to present an expert witness at trial. In such cases, disclosure must be made promptly when the expert is retained and a motion for leave to present testimony by the expert must be filed. [Note 15.] Prompt disclosure after the deadline, however, does not necessarily ensure that the expert's testimony or evidence will be allowed into the record at trial. [Note 16.] The Board will decide on a case-by-case basis how to handle a party's late identification of experts. [Note 17.]

Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the Board, either on its own initiative or on notice from either party of the disclosure of expert testimony, may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert. [Note 18.]

A party has the prerogative of deciding not to use a designated expert for testimony. [Note 19.] In addition, a party may be permitted to withdraw a previously disclosed expert and expert report and substitute a new expert witness and expert report. [Note 20.] However, if the substitution occurs after the expert disclosure deadline, the Board will consider whether the substitution is substantially justified or harmless. [Note 21.] A party may redesignate a testifying expert witness as a non-testifying or consulting expert. [Note 22.] If a party redesignates the designated testifying expert witness as a non-testifying or consulting expert after an expert report has been disclosed, the expert will be subject to deposition only under exceptional circumstances. [Note 23.] If a party discloses an expert report after the expert disclosure deadline, the Board will consider whether the late disclosure is substantially justified or harmless. [Note 24.]

A motion to compel an expert testimony disclosure must be filed prior to the close of the discovery period. [Note 25.] For further information regarding motions to compel, see TBMP § 523.

A party may supplement or correct its expert disclosures "if the party learns that in some material respect the disclosure . . . is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing." [Note 26.] A party may supplement or correct information included in an expert report and information given in the expert's deposition

testimony up to and including the due date for a party's pretrial disclosures. [Note 27.] Fed. R. Civ. P. 26(e), however, does not allow an expert to bolster previously disclosed opinions or to add new opinions. [Note 28.]

Rebuttal expert reports should be limited to a rebuttal or critique of the methods proposed by the expert report and the analysis of the data that resulted. [Note 29.] Under appropriate circumstances, sur-rebuttal expert testimony may be allowed so long as a party that wishes to provide a sur-rebuttal expert report promptly seeks leave of the Board. [Note 30.]

For further information regarding the duty to cooperate and to the duty to supplement with regard to expert disclosures, see TBMP § 408.01(b) and TBMP § 408.03. For information regarding remedies for failure to disclose or inadequate expert disclosures, see TBMP § 411.01.

NOTES:

1. *RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1494-95 (TTAB 2013).

2. Fed. R. Evid. 702. *See also* Fed. R. Evid. 702, Notes of Advisory Committee on Proposed Rules. *See, e.g., McDonald's Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1298 n.58 (TTAB 2014) ("While a party is not required to employ an expert to be able to direct criticisms to an opposing party's survey, having a qualified expert confirm that the criticisms reflect the relevant standards employed in the survey field would lend additional weight to such criticisms."); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1757 (TTAB 2013) (witness qualified as an expert in the field of travel writing and journalism based on professional experience as a travel writer and editor), *aff'd mem*, 565 F. App'x 900 (Fed. Cir. 2014).

3. *See* 37 C.F.R. § 2.120(a)(2)(iii) and 37 C.F.R. § 2.120(a)(2)(iv). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016) ("an expert disclosure deadline must always be scheduled prior to the close of discovery"); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007) (in the absence of an order from the Board setting a deadline, expert disclosures are governed by Fed. R. Civ. P. 26(a)(2), per 37 C.F.R. § 2.120(a)(2)); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (party is to disclose its plan to use an expert 30 days before the close of discovery).

4. 37 C.F.R. § 2.120(a)(2)(iii). *See RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1494 (TTAB 2013) (use of testifying expert); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1891-92 (TTAB 2011).

5. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42254 (August 1, 2007). *See also* Fed. R. Civ. P 26(b)(4)(D); *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1567 (TTAB 2014) (discussing the differences between testifying and consulting experts in connection with redesignation of a testifying expert as a consulting expert).

6. Fed. R. Civ. P. 26(a)(2)(A).

7. Fed. R. Civ. P. 26(a)(2)(B); Fed. R. Civ. P. 26(a)(2)(C). *See RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1495 (TTAB 2013) (an expert is retained for purposes of Rule 26(a)(2)(B) and

required to provide a written report "[w]here an expert's opinion testimony arises from his enlistment as an expert and not from an on-the-scene involvement in any incidents giving rise to the litigation").

8. Fed. R. Civ. P. 26(a)(2)(C). A witness under Fed. R. Civ. P. 26(a)(2)(C) may testify as both a fact witness and also provide expert testimony under Fed. R. Evid. 702, 703 or 705. *See* Fed. R. Civ. P. 26(a)(2)(C) Committee Notes on Rules – 2010 Amendment.

9. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

10. 37 C.F.R. § 2.120(a)(2)(iii). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

11. *See General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 n.3 (TTAB 2011) (parties expected to cooperate to resolve problems arising from timely but incomplete expert disclosures).

12. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1493 n.3 (TTAB 2013) (a party must notify the Board of its plan to use an expert (without including copies of expert disclosures), and that it has made required expert disclosures to adversary; the best practice is to notify the Board concurrently with the expert disclosures to adverse party). *But see Monster Energy Co. v. Martin*, 125 USPQ2d 1774, 1776 (TTAB 2018) ("even the failure to inform the Board of the timely disclosure of an expert witness is not a ground to exclude the noticed testimony of such witness"); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (37 C.F.R. § 2.120(a)(2) does not mandate that a disclosing party inform the Board that an expert disclosure has been made; disclosing party's failure to notify the Board is not a ground to exclude the testimony).

13. *See* 37 C.F.R. § 2.120(a)(2)(iii); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007); *Monster Energy Co. v. Martin*, 125 USPQ2d 1774, 1777-78 (TTAB 2018) ("Trademark Rule 2.120(a)(2)(iii) provides the Board wide latitude in managing a proceeding following any party's disclosure of plans to use expert testimony, including but not limited to, suspending proceedings to allow for discovery of the expert and for any other party to disclose plans to use a rebuttal expert."). *But see, General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) ("The purpose of informing the Board of such a disclosure is to facilitate discovery," but notification to the Board may not be necessary if expert-related discovery can be concluded by the close of discovery).

14. *See General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (in any given case, suspension of proceedings for expert-related discovery may not be necessary).

15. *See* 37 C.F.R. § 2.120(a)(2)(iii).

16. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

17. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See, e.g., Entravision Communications Corp. v. Liberman Television LLC*, 113 USPQ2d 1526, 1528-29 (TTAB 2015) (after balancing relevant factors, substitution of witness and expert report after expert disclosure deadline due to witness unavailability found to be substantially justified and harmless under circumstances of the case); *Gemological Institute of America, Inc. v. Gemology Headquarters International, LLC*, 111 USPQ2d 1559, 1563-64 (TTAB 2014) (after balancing relevant factors, untimely disclosure of expert opinion found neither substantially justified nor harmless under circumstances of case).

18. 37 C.F.R. § 2.120(a)(2)(iii); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016).

19. *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1567 (TTAB 2014).

20. *Entravision Communications Corp. v. Liberman Television LLC*, 113 USPQ2d 1526, 1528-29 (TTAB 2015).

21. Fed. R. Civ. P. 37(c)(1). *See, e.g., Entravision Communications Corp. v. Liberman Television LLC*, 113 USPQ2d 1526, 1528 (TTAB 2015) (substitution of expert and expert report after expert disclosure deadline).

22. *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1567, 1567 n.9 (TTAB 2014) (noting that a designated expert witness can be redesignated as a non-testifying or consulting expert and shielded from discovery).

23. Fed. R. Civ. P. 26(b)(4)(D)(ii); *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1568 (TTAB 2014) (showing of exceptional circumstances required in case of noticed deposition (without subpoena) of party's redesignated consulting expert). **Please Note:** The Board has no jurisdiction over depositions of non-parties by subpoena.

24. *See* Fed. R. Civ. P. 37(c)(1). *See, e.g., Entravision Communications Corp. v. Liberman Television LLC*, 113 USPQ2d 1526, 1528 (TTAB 2015) (substitution of expert and expert report); *Gemological Institute of America, Inc. v. Gemology Headquarters Int'l, LLC*, 111 USPQ2d 1559, 1562 (TTAB 2014) (untimely expert report).

25. 37 C.F.R. § 2.120(f); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69961 (October 7, 2016).

26. *See Empresa Cubana Del Tabaco d.b.a Cubatabaco v. General Cigar Co., Inc.*, 2020 USPQ2d 10988, at *2 (TTAB 2020) (discussing what is proper supplementation of an expert report); *Gemological Institute of America, Inc. v. Gemology Headquarters International, LLC*, 111 USPQ2d 1559, 1561-62 (TTAB 2014) (same).

27. Fed. R. Civ. P. 26(e)(2). *Empresa Cubana Del Tabaco d.b.a Cubatabaco v. General Cigar Co., Inc.*, 2020 USPQ2d 10988, at *3 (TTAB 2020) (supplemental expert reports filed on the due date of pretrial disclosures are timely); *Entravision Communications Corp. v. Liberman Television LLC*, 113 USPQ2d 1526, 1528 n.5 (TTAB 2015) (motion to substitute an expert witness and new expert report analyzed under Fed. R. Civ. P. 37(c)(1)).

28. *See Empresa Cubana Del Tabaco d.b.a Cubatabaco v. General Cigar Co., Inc.*, 2020 USPQ2d 10988, at *4 (TTAB 2020) (respondent failed to demonstrate that "the [expert] Supplemental Report corrects, clarifies, or fills in a gap in the Original Report that rendered the original disclosure inaccurate or misleading;" seeking to add new examples and illustrations does not constitute proper supplementation under Fed. R. Civ. P. 26(e)(2)); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1241 (TTAB 2015) (expert witness not allowed to bolster previously disclosed opinions or to add new opinions). *See also Newegg Inc. v. Schoolhouse Outfitters, LLC*, 118 USPQ2d 1242, 1244 (TTAB 2016) (in connection with leave to file sur-rebuttal expert report, party's expert precluded from offering corrections or amplifications to original expert report, introducing new evidence or consumer surveys).

29. *See Newegg Inc. v. Schoolhouse Outfitters, LLC*, 118 USPQ2d 1242, 1244 (TTAB 2016) (discussing what constitutes proper rebuttal expert report); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1238-39 (TTAB 2015) (considering whether rebuttal expert report was proper rebuttal).

30. *Newegg Inc. v. Schoolhouse Outfitters, LLC*, 118 USPQ2d 1242, 1244 (TTAB 2016).

401.04 Modification of Disclosure Obligations

37 C.F.R. § 2.120(a)(2)(iv) *The parties may stipulate to a shortening of the discovery period, that there will be no discovery, that the number of discovery requests or depositions be limited, or that reciprocal disclosures be used in place of discovery. Limited extensions of the discovery period may be granted upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset. Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board, but the expert disclosure deadline must always be scheduled prior to the close of discovery. If a stipulation or motion for modification is denied, discovery disclosure deadlines may remain as originally set or reset and obligations may remain unaltered.*

Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, upon motion granted by the Board, or by order of the Board. [Note 1.] However, the expert disclosure deadline must always be scheduled prior to the close of discovery. [Note 2.] Written initial disclosures or disclosed documents and materials obtained through the disclosure process should not be filed with the Board, except when submitted with a motion relating to disclosure or discovery, or in support of or in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period. [Note 3.] The parties may agree to waive or otherwise modify their obligation to make disclosures, but must inform the Board by written stipulation or by motion. [Note 4.] A party who fails to make the required or adequate disclosures may be subject to a motion to compel, and ultimately a motion for sanctions, including possible judgment. [Note 5.] See TBMP § 411.01 and TBMP § 523 for further information on motions to compel initial or expert disclosures.

In instances where the defendant is in default, or a pleading motion under Fed. R. Civ. P. 12 or counterclaim has been filed, the parties' obligation to make initial disclosures is tolled or effectively stayed. [Note 6.] In such cases, the Board will reset the deadline for making initial disclosures, as well as the deadline for the discovery conference and all subsequent dates, after resolving or accounting for the default, motion, or counterclaim. [Note 7.] For further information regarding the rescheduling of the discovery conference in these circumstances, see TBMP § 401.01.

Pretrial disclosures are not part of the discovery process and, therefore, a motion to compel is not the remedy when a party fails to make, or makes inadequate, pretrial disclosures. See TBMP § 702.01 for further information on pretrial disclosures.

For a discussion regarding extensions of time to make disclosures and the impact of extensions of time regarding the close of discovery on disclosure obligations, see TBMP § 403.04.

NOTES:

1. 37 C.F.R. § 2.120(a)(2)(iv).

2. 37 C.F.R. § 2.120(a)(2)(iv). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016).

3. 37 C.F.R. § 2.120(k)(8). *See also Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1427 n.6 (TTAB 2013) (documents obtained through disclosure may be offered as exhibits in connection with the taking of an adversary's discovery deposition, and may be introduced as exhibits during the taking of an adversary's testimony).

4. 37 C.F.R. § 2.120(a)(2)(iv); 37 C.F.R. § 2.120(a)(2)(v); and 37 C.F.R. § 2.120(a)(3). *See, e.g., Sheetz of Delaware, Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1344 (TTAB 2013) (parties stipulated to waive pretrial disclosures); *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767-68 (TTAB 2008) (waiver of initial disclosures).

5. 37 C.F.R. § 2.120(f)(1); 37 C.F.R. § 2.120(h)(1); and 37 C.F.R. § 2.120(h)(2); *RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1493 (TTAB 2013) (motion to compel is an available remedy for inadequate expert disclosures); *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1760 n.2 (TTAB 2009) (motion to compel is remedy when adversary has failed to make or has made inadequate initial disclosures); *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008) (petitioner's motion to compel amended initial disclosures granted where respondent failed to identify the address or telephone number of listed witnesses, the subject matter(s) about which each has information, and the location or production of identified documents).

6. 37 C.F.R. § 2.106(a); 37 C.F.R. § 2.114(a); and 37 C.F.R. § 2.127(d). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69957, 69959 (October 7, 2016); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

7. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

401.05 Form of Disclosures

Fed. R. Civ. P. 26(a)(4) Form of Disclosures. *Unless the court orders otherwise, all disclosures under Rule 26(a) must be in writing, signed, and served.*

Fed. R. Civ. P. 26(g) Signing Disclosures and Discovery Requests, Responses, and Objections.

(1) ***Signature Required; Effect of Signature.*** *Every disclosure under Rule 26(a)(1) or (a)(3) and every discovery request, response, or objection must be signed by at least one attorney of record in the attorney's own name — or by the party personally, if unrepresented — and must state the signer's address, e-mail address, and telephone number. By signing, an attorney or party certifies that to the best of the person's knowledge, information, and belief formed after a reasonable inquiry:*

(A) *with respect to a disclosure, it is complete and correct as of the time it is made* * * * *

(2) ***Failure to Sign.*** *Other parties have no duty to act on an unsigned disclosure, request, response, or objection until it is signed, and the court must strike it unless a signature is promptly supplied after the omission is called to the attorney's or party's attention.*

Disclosures must be in writing, signed by either the party or its attorney, and bear the caption and proceeding number for the case. [Note 1.] The signer's address, email address, and telephone number must also be provided. [Note 2.] Signature of a disclosure constitutes certification that the disclosure is complete and correct at the time it was made. [Note 3.] Disclosures also must be served. [Note 4.]

Fed. R. Civ. P. 26 specifically exempts privileged information and work product from disclosure.

For a discussion of the duty to supplement initial disclosures, see TBMP § 408.03.

For a discussion of violations of Fed. R. Civ. P. 26(g), see TBMP § 408.01(c).

NOTES:

1. Fed. R. Civ. P. 26(a)(4); Fed. R. Civ. P. 26(g). *See Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008).

2. Fed. R. Civ. P. 26(g)(1).

3. Fed. R. Civ. P. 26(g)(1)(A).

4. Fed. R. Civ. P. 26(a)(4).

401.06 Other Requirements Under the Board's Disclosure Regime

As noted above, parties are also required to hold a discovery conference discussing the subjects set forth in Fed. R. Civ. P. 26(f) as well as the nature and basis of the involved claims and defenses, the possibility of settlement of the case or modification of the pleadings, and plans for disclosures and discovery and any other subjects that the Board may, in an institution order, require to be discussed. [Note 1.] The parties are free to discuss additional topics besides those outlined in the institution order that could promote settlement or efficient adjudication of the Board proceeding. [Note 2.] Because the parties may enter into stipulations altering disclosure obligations, they should continue to discuss their reciprocal obligations, and progress made in satisfying such obligations, even after the discovery conference has been held. [Note 3.]

A party that has not made initial disclosures may not serve discovery requests or file a motion for summary judgment, except for a motion addressing the Board's jurisdiction or claim or issue preclusion. [Note 4.] Under these circumstances, the requirement of service of initial disclosures cannot be waived. [Note 5.] For a further discussion regarding the timing of filing a motion for summary judgment, see TBMP § 528.02. A party that has not made initial disclosures is also precluded from filing a motion to compel, absent a Board-approved modification of the requirement to make initial disclosures prior to seeking discovery. [Note 6.]

Parties are also required to make pretrial disclosures prior to the opening of each testimony period. For further information on pretrial disclosures, see TBMP § 702.01.

The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the disclosure and discovery process, and looks with extreme disfavor on those who do not. For further guidance regarding the parties' duty to cooperate, see TBMP § 408.01.

For a discussion of the duty to supplement written discovery responses and disclosures, see TBMP § 408.03.

NOTES:

1. *See* 37 C.F.R. § 2.120(a)(1) and 37 C.F.R. § 2.120(a)(2)(i); Fed. R. Civ. P. 26(f); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69959, 69961 (October 7, 2016); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007); *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761 (TTAB 2009).

2. *See, e.g., Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761 (TTAB 2009).

3. 37 C.F.R. § 2.120(a)(2)(iv); 37 C.F.R. § 2.120(a)(2)(v); and 37 C.F.R. § 2.120(a)(3). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951 (October 7, 2016) (parties may "stipulate to limit discovery by shortening the period, limiting requests, using reciprocal disclosures in lieu of discovery, or eliminating discovery altogether").

4. 37 C.F.R. § 2.120(a)(3) and 37 C.F.R. § 2.127(e)(1). *See e.g., Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment denied as premature where movant had not yet made and served initial disclosures). *See also Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009) ("Because the Board does not allow a party to file a motion for summary judgment prior to the moving party's service of initial disclosures on the adverse party, the Board generally will no longer exercise its discretion to convert motions to dismiss that refer to matters outside the pleadings into motions for summary judgment, if such motions are filed before the moving party serves its initial disclosures.").

5. *Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010). *But see Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767-68 (TTAB 2008) (Board approved parties' stipulation to waive their reciprocal obligation to make initial disclosures).

6. 37 C.F.R. § 2.120(a)(3) ("A party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board, or by order of the Board."). *See Dating DNA, LLC v. Imagini Holdings, LLC*, 94 USPQ2d 1889, 1893 (TTAB 2010) (motion to compel denied where moving party failed to make initial disclosures).

402 Scope of Discovery

402.01 In General

Fed. R. Civ. P. 26(b)(1) Scope in General. *Unless otherwise limited by court order, the scope of discovery is as follows: Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of*

the proposed discovery outweighs its likely benefit. Information within this scope of discovery need not be admissible in evidence to be discoverable.

Fed. R. Civ. P. 26(g) Signing Disclosures and Discovery Requests, Responses, and Objections.

(1) ***Signature Required; Effect of Signature.*** *Every disclosure under Rule 26(a)(1) or (a)(3) and every discovery request, response, or objection must be signed by at least one attorney of record in the attorney's own name — or by the party personally, if unrepresented — and must state the signer's address, e-mail address, and telephone number. By signing, an attorney or party certifies that to the best of the person's knowledge, information, and belief formed after a reasonable inquiry:*

(A) *with respect to a disclosure, it is complete and correct as of the time it is made; and*

(B) *with respect to a discovery request, response, or objection, it is:*

(i) *consistent with these rules and warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law, or for establishing new law;*

(ii) *not interposed for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation; and*

(iii) *neither unreasonable nor unduly burdensome or expensive, considering the needs of the case, prior discovery in the case, the amount in controversy, and the importance of the issues at stake in the action.*

(2) ***Failure to Sign.*** *Other parties have no duty to act on an unsigned disclosure, request, response, or objection until it is signed, and the court must strike it unless a signature is promptly supplied after the omission is called to the attorney's or party's attention.*

37 C.F.R. § 2.120(a)(1) . . . *The provisions of Rule 26 of the Federal Rules of Civil Procedure relating to . . . the scope, proportionality, timing and sequence of discovery, protective orders, signing of disclosures and discovery responses, and supplementation of disclosures and discovery responses, are applicable to Board proceedings in modified form . . . .*

The general scope of discovery that may be obtained in inter partes proceedings before the Board is governed by Fed. R. Civ. P. 26(b)(1). [Note 1.]

A party may take discovery as to matters that are relevant to its claims and defenses (i.e., those specifically raised in the pleadings), [Note 2] and such discovery may serve as the basis for an additional claim, defense, or counterclaim. [Note 3.] Parties may not engage in "fishing expeditions" and must act reasonably in framing discovery requests. [Note 4.] The parties are expected to take into account the principles of proportionality with regard to discovery. [Note 5.] The scope of discovery in Board proceedings is generally narrower than in court proceedings, especially those involving infringement and/or where both parties have made extensive use of the marks. [Note 6.] The guidelines set forth in Fed. R. Civ. P. 26(b)(1) also apply to the discovery of information stored in digital or electronic form. [Note 7.] A party may not, by limiting its own discovery and/or presentation of evidence on the case, thereby restrict another party's discovery in any way. [Note 8.] However, parties are free to discuss agreed limits on discovery as a means of reducing the time and cost associated with discovery. [Note 9.]

Each party has a duty to make a good faith effort to satisfy the discovery needs of its adversary and to seek only such discovery as is proper and relevant to the specific issues involved in the proceeding. [Note 10.]

In addition, because the signature of a party or its attorney to a request for discovery constitutes, under the provisions of Fed. R. Civ. P. 26(g), a certification by the party or its attorney that, inter alia, the request is

warranted, consistent with the Federal Rules of Civil Procedure, and not unreasonable or unduly burdensome, a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary. [Note 11.] A contention of this nature will be entertained only if it is supported by a persuasive showing of reasons why the discovery request is proper when propounded by one party but improper when propounded by another. [Note 12.] For a further discussion regarding discovery guidelines, see TBMP § 408.01 and TBMP § 414.

For a discussion of the scope of required disclosures intended to obviate the need for some basic discovery, see TBMP § 401.

NOTES:

1. 37 C.F.R. § 2.120(a)(1). *See FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999) ("scope of discovery in a Board proceeding is governed by Fed. R. Civ. P. 26(b)(1)").

2. *See Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 287 (TTAB 1974) (opposer must answer interrogatories concerning allegations in notice of opposition). *See also The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2153 (TTAB 2013) (scope of permissible discovery would have been proportionately narrower if opposer had pleaded only the most relevant marks and clearly and specifically identified the goods and services relevant to this proceeding); Fed. R. Civ. P. 26(b)(1) Committee Notes on Rules – 2015 Amendment ("Proportional discovery relevant to any party's claim or defense suffices, given a proper understanding of what is relevant to a claim or defense. The distinction between matter relevant to a claim or defense and matter relevant to the subject matter was introduced in 2000. The 2000 Note offered three examples of information that, suitably focused, would be relevant to the parties' claims or defenses.").

3. *See J. B. Williams Co., Inc. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (information sought had a bearing on issues involved in proceeding but could also be a basis for providing information concerning possible abandonment, that, if revealed, may provide basis for counterclaim); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975) (the mere taking of discovery on matters concerning the validity of a pleaded registration, under any circumstances, cannot be construed as a collateral attack on the registration); Fed. R. Civ. P. 26(b)(1) Committee Notes on Rules – 2015 Amendment ("Discovery that is relevant to the parties' claims or defenses may also support amendment of the pleadings to add a new claim or defense that affects the scope of discovery."). *See also The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154, 2154 n.5 (TTAB 2013) (opposer's unpleaded registrations are beyond the scope of discovery; party is free to conduct own investigation to determine whether a permissive counterclaim is warranted but should avoid further complicating the case by conducting the investigation through discovery).

4. Fed. R. Civ. P. 26(b). *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (parties should seek only discovery which is proper and relevant to the specific issues involved in the case); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999) (". . . the right to discovery is not unlimited. Both the Trademark Rules and the Federal Rules of Civil Procedure grant the Board discretion to manage the discovery process."); *Dow Corning Corp. v. The Doric Corp.*, 183 USPQ 377, 378 (TTAB 1974) ("tremendous and prolonged discovery" which lacked specificity and was "too comprehensive in scope" not warranted).

5. 37 C.F.R. § 2.120(a)(1). *See, e.g., Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1386 (TTAB 2016) (Board expects parties to take into account the principles of proportionality with regard to discovery); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (Board applied proportionality

principle to interrogatories, document requests and requests for admission); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2153 (TTAB 2013) (discussing principles of proportionality with respect to requests for admissions); *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1908-10 (TTAB 2011) (Board applied proportionality principles to electronically-stored information). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951, 69960 (October 7, 2016).

6. *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1907 (TTAB 2011).

7. *See* 37 C.F.R. § 2.120(e); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951 (October 7, 2016) ("To further reflect the Federal Rules of Civil Procedure, the [trademark] rules explicitly include references to electronically stored information . . . as subject matter for discovery.").

8. *See Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975) (scope of discovery limited only by restrictions in Fed. R. Civ. P. 26).

9. 37 C.F.R. § 2.120(a)(2)(iv) ("The parties may stipulate to a shortening of the discovery period, that there will be no discovery, that the number of discovery requests or depositions be limited, or that reciprocal disclosures be used in place of discovery."); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951 (October 7, 2016).

10. Fed. R. Civ. P. 26(g). *See Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1387 (TTAB 2016) (taking into account the grounds for opposition and proportionality, the Board found discovery requests tailored to the claims and framed to seek information that is clearly relevant); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1267-68 (TTAB 2015) (plaintiff's discovery requests were irrelevant and improper because they went beyond what was necessary to prove the claims before the Board and were not appropriately tailored to elicit discoverable information); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2152 (TTAB 2013) (parties are entitled to seek discovery as they may deem necessary to help them prepare for trial, but it is not the practice of the Board to permit unlimited discovery to the point of harassment and oppressiveness); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) ("each party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case."); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (same); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (same). *Cf. Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1908 (TTAB 2011) (opposer's failure "to conduct an attorney-supervised ESI retrieval, research and review" does not necessarily mean the discovery efforts were inadequate under the circumstances).

11. *See* Fed. R. Civ. P. 26(g). *See also Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990) (petitioner estopped to challenge respondent's interrogatories as excessive in number having served virtually identical set on respondent); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (parties who served identical discovery requests on each other in effect waived their right to object and must answer each request completely). *See also Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (applicant, having served 114 interrogatories, is estopped from challenging opposer's 122 interrogatories as excessive); *Tektronix, Inc. v. Tek Associates, Inc.*, 183 USPQ 623, 623 (TTAB 1974) (each party was estopped from objecting to interrogatory requests served upon them by the opposing party which were essentially the same requests); *Gastown Inc. of Delaware v. Gas City, Ltd.*, 180 USPQ 477, 477 (TTAB 1974) (opposer must answer applicant's interrogatories which are similar to those which were served by opposer upon applicant). *Cf. Miss America Pageant v. Petite Productions, Inc.*, 17

USPQ2d 1067, 1069 (TTAB 1990) (no estoppel where opposer served a different, albeit also excessive, set of interrogatories on applicant); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990) (opposer not estopped from arguing that applicant's interrogatories are excessive even though opposer also exceeded the limit because applicant waived its rights to object).

12. *See Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990) (Board was persuaded that certain interrogatories would be burdensome).

402.02 Limitations on Right to Discovery and on Electronically Stored Information

Fed. R. Civ. P. 26(b)(2)(A) When Permitted. *By order, the court may alter the limits in these rules on the number of depositions and interrogatories or on the length of depositions under Rule 30. By order or local rule, the court may also limit the number of requests under Rule 36.*

Fed. R. Civ. P. 26(b)(2)(B) Specific Limitations on Electronically Stored Information. *A party need not provide discovery of electronically stored information from sources that the party identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the party from whom discovery is sought must show that the information is not reasonably accessible because of undue burden or cost. If that showing is made, the court may nonetheless order discovery from such sources if the requesting party shows good cause, considering the limitations of Rule 26(b)(2)(C). The court may specify conditions for the discovery.*

The right to discovery is not unlimited. Even if the discovery sought by a party is relevant, it will be limited, or not permitted, where, inter alia, it is unreasonably cumulative or duplicative; or is unduly burdensome or obtainable from some other source that is more convenient, less burdensome, or less expensive; or "where harm to the person from whom discovery is sought outweighs the need of the person seeking discovery of the information." [Note 1.]

For example, in those cases where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit the responding party to comply by providing a representative sampling of the information sought, or some other reduced amount of information which is nevertheless sufficient to meet the propounding party's discovery needs. [Note 2.]

In addition, a party will not be permitted to obtain, through a motion to compel, discovery broader in scope than that actually sought in the discovery request(s) to which the motion pertains. [Note 3.]

Discovery of confidential commercial information is subject to the terms of the Board's standard protective order, or an appropriate alternative protective agreement or order. [Note 4.] For a further discussion of protective orders, see TBMP § 412.

Similarly, information protected by the attorney-client privilege is not discoverable unless the privilege has been waived [Note 5]; and documents and things prepared in anticipation of litigation or for trial by or for another party, or by or for that other party's representative, are discoverable only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of its case and that it is unable, without undue hardship, to obtain the substantial equivalent of the materials by other means. [Note 6.]

Fed. R. Civ. P. 26(b)(2)(B) also provides for limitations regarding the discovery of electronically stored information (ESI). Specifically, a "party need not provide discovery of [ESI] from sources that the party

identifies as not reasonably accessible because of undue burden or cost." [Note 7.] Pursuant to the rule, when an adverse party seeks to compel the production of such material, the party resisting discovery must show that the material sought is "not reasonably accessible because of undue burden or cost." [Note 8.] If that showing is made, the burden shifts to the requesting party to show good cause for the production of the not-reasonably-accessible electronically stored information. [Note 9.] In deciding whether the requisite showing has been made, the Board will consider, as it would in any discovery dispute, whether (i) "the discovery sought is unreasonably cumulative or duplicative, or can be obtained from some other source that is more convenient, less burdensome, or less expensive;" (ii) "the party seeking discovery has had ample opportunity to obtain the information by discovery in the action;" or (iii) "proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit." [Note 10.]

With respect to the adequacy of ESI production, there is an increasing focus on the question of proportionality and whether extensive ESI discovery is necessary and justified. [Note 11.] In view of the Board's limited jurisdiction, the narrowness of the issues to be decided by the Board, and the concerns existing with respect to excessive e-discovery, the burden and expense of e-discovery will weigh heavily against requiring production in most cases. Parties are to be precise in their requests and should have as their first consideration how to significantly limit the expense of such production. [Note 12.] "Fed. R. Civ. P. 34 does not require that the requesting party specify a form of production, but where the parties have not specified the form of production for ESI, the responding party must produce it in the form in which it is 'ordinarily maintained' or in a 'reasonably usable form.'" [Note 13.]

NOTES:

1. *See Micro Motion Inc. v. Kane Steel Co.*, 894 F.2d 1318, 13 USPQ2d 1696, 1699 (Fed. Cir. 1990); Fed. R. Civ. P. 26(b)(2). *See also Haworth Inc. v. Herman Miller Inc.*, 998 F.2d 975, 27 USPQ2d 1469, 1472 (Fed. Cir. 1993) (must first seek discovery from party before burdening non-party); *Katz v. Batavia Marine & Sporting Supplies Inc.*, 984 F.2d 422, 25 USPQ2d 1547, 1549 (Fed. Cir. 1993) (in response to non-party's prima facie showing that discovery was burdensome, party did not meet burden of showing need for information sought); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (large number of discovery requests was unduly burdensome, harassing, and oppressive); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1763 (TTAB 1999) (motion for protective order to prohibit deposition of "very high-level official of a large corporation" granted). *Cf. Hewlett Packard Enterprise Development LP v. Arroware Industries, Inc.*, 2019 USPQ2d 158663, at *4 (TTAB 2019) (responding party may not rely on conclusory statements when objecting but must specifically state the underlying basis for the objection).

2. *See, e.g., Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1439 (Fed. Cir. 2012) (Board did not abuse its discretion by refusing to strike plaintiff's evidence where defendant failed to follow up on plaintiff's offer to produce the evidence at a mutually agreeable time and place and in view of defendant's failure to file a motion to compel); *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1910 (TTAB 2011) (representative samples of documents, including ESI, required for certain requests); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue material, objection to evidence introduced by applicant at trial was overruled), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987) (production of representative sample was not appropriate where full production, that is, a total of eleven documents, was clearly not burdensome); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147,

148 (TTAB 1985) (representative sample of invoices from identified calendar quarters is sufficient where there are so many items as to make respondent's task unduly burdensome); *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (permitted to identify reasonable number of corporate officers most knowledgeable); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (burden of calculating sales and advertising figures in round numbers for six categories of goods for each year since 1936 mitigated by limiting sales figures to five most recent years); *Van Dyk Research Corp. v. Xerox Corp.*, 181 USPQ 346, 348 (TTAB 1974) (applicant allowed to produce ten representative samples of documents pertaining to the marketing of each copy machine or as alternative, may allow opposer's representative to visit sites where relevant documents are kept); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 288 (TTAB 1974) (allowed to furnish representative samples of advertisements).

3. *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170 (TTAB 1980).

4. 37 C.F.R. § 2.116(g) (Board's standard protective order automatically applies to all cases absent Board approval of a substitute); Fed. R. Civ. P. 26(c)(1)(G); *Intex Recreation Corp. v. Coleman Co.*, 117 USPQ2d 1799, 1801 (TTAB 2016) (Board standard protective order is automatically in place, and party should have designated confidential documents under the appropriate tier of confidentiality or sought modification of the order); *Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1862 (TTAB 2001) (protective agreement would adequately protect against disclosure of trade secret manufacturing and technical information); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (unless issue is abandonment or first use, party need not reveal names of its customers, including dealers, it being sufficient to identify classes of customers and types of businesses); *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170 (TTAB 1980) (need for names of customers, as in case where issue is abandonment, outweighs justification for protecting customer confidentiality); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (protective order must contain provision that customer names will be revealed only to applicant's attorneys). *See also Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 148 (TTAB 1985) (protective orders available for confidential material); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) ("While it is the Board's policy not to require the disclosure of customer and mailing lists, a party may be asked to reveal the particular classes of customers or the types of businesses in which they are engaged."); *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (as a general rule, party need not furnish names of actual customers); *Ortho Pharmaceutical Corp. v. Schattner*, 184 USPQ 556, 557-58 (TTAB 1975) (discussing whether certain interrogatories seek proprietary or confidential matter); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495, 495-96 (TTAB 1975) (opposer need only reveal the classes of people to whom such goods sold under the mark are distributed and not the actual customer names); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618, 621 (TTAB 1974) (names of applicant's customers are confidential information and the need to protect customers from harm such as harassment outweighs disclosure).

5. Fed. R. Civ. P. 26(b)(5). *See, e.g., In re Seagate Technology LLC*, 497 F.3d 1360, 83 USPQ2d 1865, 1873 (Fed. Cir. 2007) (attorney-client privilege provides absolute protection from disclosure unless waived), abrogated on other grounds by *Halo Electronics, Inc. v. Pulse Electronics, Inc.*, 136 S.Ct. 1923, 118 USPQ2d 1761 (2016); *Genentech Inc. v. U.S. International Trade Commission*, 122 F.3d 1409, 43 USPQ2d 1722, 1728 (Fed. Cir. 1997) ("Generally disclosure of confidential communications or attorney work product to a third party, such as an adversary in litigation, constitutes a waiver of privilege as to those items."); *Red Wing Co. v. J. M. Smucker Co.*, 59 USPQ2d 1861, 1864 n.5 (TTAB 2001) (party making claim of privilege must do so expressly and otherwise describe the nature of the withheld information as provided in Fed. R. Civ. P. 26(b)(5)). See also Fed. R. Evid. 502 and Explanatory Note on Evidence Rule 502 (revised November 28, 2007) regarding attorney-client privilege and limitations on waiver.

6. Fed. R. Civ. P. 26(b)(3) and 26(b)(5). *See, e.g., In re Seagate Technology LLC*, 497 F.3d 1360, 83 USPQ2d 1865, 1874 (Fed. Cir. 2007) (work product protection is qualified and absent waiver may be overcome by a showing of need and undue hardship but a higher burden must be met to obtain that pertaining to mental processes), abrogated on other grounds by *Halo Electronics, Inc. v. Pulse Electronics, Inc.*, 136 S.Ct. 1923, 118 USPQ2d 1761 (2016); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975) (the fact that an attorney may have given an opinion to a client is not in and of itself privileged information; only the substance of the communication is considered privileged); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975) (opposer must provide discovery of matters, not privileged, relevant to the subject matter of the Board proceeding). *See also Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432, 434 (TTAB 1975) ("search reports, per se do not fall within the attorney-client privilege . . . [h]owever any comments or opinions provided by opposer's attorney in relation thereto are privileged"); *Amerace Corp. v. USM Corp.*, 183 USPQ 506, 507 (TTAB 1974) (trademark search report not privileged; comments or opinions of attorney relating thereto fall within attorney-client privilege); *Goodyear Tire & Rubber Co. v. Uniroyal, Inc.*, 183 USPQ 372, 374-75 (TTAB 1974) (discussing attorney-client privilege and work product rule). See also Fed. R. Evid. 502 and Explanatory Note on Evidence Rule 502 (revised November 28, 2007) for information regarding work product and limitations on waiver.

7. Fed. R. Civ. P. 26(b)(2)(B).

8. Fed. R. Civ. P. 26(b)(2)(B). *See, e.g., Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1910 (TTAB 2011) (opposer established that all of the specific materials applicant sought in response to specified requests were not reasonably accessible because of undue burden or costs).

9. Fed. R. Civ. P. 26(b)(2)(B). *See, e.g., Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1910 (TTAB 2011) (applicant established that some of the requested documents should be produced before taking depositions).

10. Fed. R. Civ. P. 26(b)(1) and 26(b)(2)(C).

11. *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1908 (TTAB 2011). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951 (October 7, 2016) ("The Board continues to view the universe of ESI within the context of its narrower scope of jurisdiction, as compared to that of the federal district courts. The burden and expense of e-discovery will weigh heavily in any consideration.").

12. *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1909 (TTAB 2011) (opposer not required to start its document production over where parties did not agree on ESI discovery protocol, applicant failed to show opposer's methods were insufficient, and given the nature of the requests and issues involved).

13. *Chix Gear, LLC v. Princess Race Wear Corp.*, 2019 USPQ2d 455321, at *3 (TTAB 2019) (opposer did not argue the photographs are not in the form ordinarily maintained, or not reasonably usable, or did not contain metadata but that applicant did not provide information showing the day the photographs were taken and by whom).

403 Timing of Discovery

403.01 In General

37 C.F.R. § 2.120(a) ***[Discovery]***

(1) *. . . The Board will specify the deadline for a discovery conference, the opening and closing dates for the taking of discovery, and the deadlines within the discovery period for making initial disclosures and expert disclosure. The trial order setting these deadlines and dates will be included with the notice of institution of the proceeding.*

(2)(i) *. . . The discovery period will be set for a period of 180 days.*

* * * *

(iv) *The parties may stipulate to a shortening of the discovery period . . . . Limited extensions of the discovery period may be granted upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset.* * * * *

(3) *. . . Discovery depositions must be properly noticed and taken during the discovery period. Interrogatories, requests for production of documents and things, and requests for admission must be served early enough in the discovery period, as originally set or as may been reset by the Board, so that responses will be due no later than the close of discovery.* * * * *

When a timely opposition or petition to cancel in proper form has been filed, and the required fee has been submitted (or at the time described in 37 C.F.R. § 2.92 for an interference and 37 C.F.R. § 2.99(c) for a concurrent use proceeding), the Board sends out a notice advising the parties of the institution of the proceeding and provides a web link or web address to access the electronic proceeding record which constitutes service of the proceeding. [Note 1.] *See*TBMP § 310, TBMP § 1003 and TBMP § 1106. The notice includes a trial order setting the opening and closing dates for the discovery period, assigning each party's time for taking testimony, and the deadlines for the discovery conference and disclosures. [Note 2.] The opening of discovery coincides with the deadline for the discovery conference. The date set for the close of discovery is 180 days after the opening of discovery.

Parties may modify the discovery and trial schedule, including the deadline for making disclosures, if the parties file, and the Board approves, a stipulation or motion to that effect. [Note 3.] Parties must inform the Board, by stipulation or motion, any time they agree to modify their obligations under the rules governing disclosures and discovery, as well as when they agree to modify deadlines or schedules that involve disclosures, discovery, trial or briefing. [Note 4.] In addition to stipulating to extend the discovery period, parties may stipulate to shorten the discovery period. [Note 5.] The expert disclosure deadline, however, must always be scheduled prior to the close of discovery. [Note 6.]

The traditional discovery devices, namely, discovery depositions, interrogatories, requests for production of documents and things, and requests for admission, are available for use only during the discovery period. [Note 7.] For further information regarding the timing of discovery requests and discovery depositions, see TBMP § 403.02. A party has no obligation to respond to the merits of an untimely request for discovery, nor is a party obliged to respond to the merits of discovery when initial disclosures have not been served, although a party should object on those bases. [Note 8.]

For further information regarding the timing of initial, expert, and pretrial disclosures for inter partes proceedings, see TBMP § 401.02, TBMP § 401.03, and TBMP § 702.01.

NOTES:

1. 37 C.F.R. § 2.105(a) and 37 C.F.R. § 2.113(a).

2. 37 C.F.R. § 2.120(a)(1) and 37 C.F.R. § 2.121(a); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

3. 37 C.F.R. § 2.120(a)(2)(iv); 37 C.F.R. § 2.120(a)(3); 37 C.F.R. § 2.121(a); 37 C.F.R. § 2.121(c); and 37 C.F.R. § 2.121(d). *See, e.g., Sheetz of Delaware, Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1344 (TTAB 2013) (parties stipulated to waive pretrial disclosures); *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767-68 (TTAB 2008) (Board approved parties' stipulation to waive their reciprocal obligation to make initial disclosures).

4. 37 C.F.R. § 2.120(a)(2)(iv); 37 C.F.R. § 2.120(a)(3); 37 C.F.R. § 2.121(a); 37 C.F.R. § 2.122(c); and 37 C.F.R. § 2.121(d). *See Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767-68 (TTAB 2008) (parties must inform Board by stipulation or motion when they agree to modify their disclosure and discovery obligations; the parties' filing should include a description of alternate plans for discovery).

5. 37 C.F.R. § 2.120(a)(2)(iv). *See H.D. Lee Co. v. Maidenform, Inc.*, 87 USPQ2d 1715, 1720 n.55 (TTAB 2008) (parties may stipulate to shortening of discovery period).

6. 37 C.F.R. § 2.120(a)(2)(iv).

7. 37 C.F.R. § 2.120(a)(3). *See also Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978) (although a specific time period is not provided in Fed. R. Civ. P. 34, it is implicit that utilization thereof is limited to the discovery period); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978) (depositions are to be taken during discovery period).

8. 37 C.F.R. § 2.120(a)(3). *See Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268, 1270 (TTAB 2017) (discovery must be served "early enough … so that responses will be due no later than the close of discovery"); *Dating DNA, LLC v. Imagini Holdings*, LLC, 94 USPQ2d 1889, 1893 (TTAB 2010) (service of initial disclosures is a prerequisite to taking discovery); *Amazon Technologies v. Wax*, 93 USPQ2d 1702, 1704-06 (TTAB 2009) (opposer's mistaken belief that applicant failed to serve initial disclosures does not excuse opposer's failure to respond to or properly object to applicant's interrogatories and document requests on the basis of failure to serve initial disclosures).

403.02 Time for Service of Discovery Requests and Taking of Depositions

37 C.F.R. § 2.120(a)(3) . . . *Discovery depositions must be properly noticed and taken during the discovery period. Interrogatories, requests for production of documents and things, and requests for admission must be served early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses will be due no later than the close of discovery.* * * * *

A party may serve written interrogatories, requests for production and things, and requests for admissions on an adversary during the discovery period in an inter partes proceeding before the Board; however, the serving party must have already made its initial disclosures, absent a granted stipulation, granted motion, or order of the Board to the contrary. [Note 1.] Written discovery may be served concurrently with initial disclosures. [Note 2.] Additionally, a party cannot notice depositions until it has served its initial disclosures, absent a granted stipulation, granted motion, or order of the Board to the contrary. [Note 3.] Discovery

depositions must be not only properly noticed but also taken during the discovery period (unless the parties stipulate, approved by the Board, to an extension of the period or the Board orders an extension of the period for purposes of taking the deposition). [Note 4.] Interrogatories, requests for production of documents and things, and requests for admission must be served early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses, including production or inspection of documents, will be due no later than the close of discovery. [Note 5.] Service of discovery must be made by email, unless otherwise stipulated, or if the serving party shows by written explanation that it attempted service by email but such service could not be made due to technical problems or extraordinary circumstances, by the manner described in 37 C.F.R. § 2.119(b)(1) - 37 C.F.R. § 2.119(b)(4). A party not domiciled in the United States and not yet represented by an attorney licensed to practice law in the United States, is not eligible to use United States postal mail. United States postal mail may not be available for U.S. counsel located outside the United States. [Note 6.]

NOTES:

1. 37 C.F.R. § 2.120(a)(3) ("A party must make its initial disclosures prior to seeking discovery . . . ."); *Dating DNA, LLC v. Imagini Holdings, LLC*, 94 USPQ2d 1889 (TTAB 2010) (motion to compel denied where moving party failed to make initial disclosures; service of initial disclosures is a prerequisite to taking discovery).

2. 37 C.F.R. § 2.120(a)(3). *See also Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1879 n.2 (TTAB 2012) (initial disclosures may be served concurrently with discovery requests).

3. 37 C.F.R. § 2.120(a)(2)(iv) and 37 C.F.R. § 2.120(a)(3).

4. 37 C.F.R. § 2.120(a)(2)(iv); 37 C.F.R. § 2.120(a)(3). *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852 (TTAB 2008) (motion to quash granted where deposition noticed during discovery but scheduled after close of discovery); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978) (discovery may not be taken outside the discovery period); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978) (motion to quash granted where party noticed deposition for a date subsequent to the expiration of the discovery period).

5. 37 C.F.R. § 2.120(a)(3). *See also Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268, 1270 (TTAB 2017) (discovery must be served "early enough … so that responses will be due no later than the close of discovery"); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951, 69960 (October 7, 2016).

6. 37 C.F.R. § 2.119(b) and 37 C.F.R. § 2.119(d).

403.03 Time for Service of Discovery Responses

37 C.F.R. § 2.120(a)(3) . . . *Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within thirty days from the date of service of such discovery requests. The time to respond may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board, but the response may not be due later than the close of discovery.* * * * *

Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within thirty days after the date of service of the request for discovery. [Note 1.] Service

must be made by email, unless otherwise stipulated, or if the serving party attempted service by email but service could not be made due to technical problems or extraordinary circumstances, by the manner described in 37 C.F.R. § 2.119(b)(1) - 37 C.F.R. § 2.119(b)(4). A party not domiciled in the United States and not yet represented by an attorney licensed to practice law in the United States, is not eligible to use United States postal mail. United States postal mail may not be available for U.S. counsel located residing outside the United States. [Note 2.] **Please Note:**37 C.F.R. § 2.119(c) was amended in January 2017 to remove the provision adding five days to the prescribed period for action after service by the postal service or overnight courier; no additional time is available for responding to discovery requests due to manner of service. [Note 3.]

The time to respond may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board, but the response may not be due later than the close of discovery. [Note 4.] For further information regarding extensions of the discovery period and time to respond to discovery requests and disclosures, see TBMP § 403.04.

Discovery in proceedings before the Board is not governed by any concept of priority of right to take discovery or depositions. That is, a party which is the first to serve a request for discovery does not thereby gain an absolute right to receive a response to its request before it must respond to its adversary's subsequently served request for discovery, and this is so even if its adversary fails to respond, or respond completely, to the first party's request for discovery. Instead, each party is under an obligation to cooperate and to respond to an adversary's request for discovery during the time allowed therefor under the applicable rules, irrespective of the sequence of requests for discovery or of an adversary's failure to respond to a pending request for discovery. [Note 5.] Thus, in the absence of objections or extensions, a party that is the first to serve discovery requests can be expected to receive responses first, and parties are always encouraged to initiate any necessary discovery early, but because the ability and/or willingness of an adverse party to respond to discovery can vary, there is no guarantee that the first party to serve discovery will be the first party to receive responses.

Because interrogatories, requests for production, and requests for admissions must be served early enough that responses will be due by the closing date of discovery, a responding party may object to such discovery requests on the ground that they were served so late that responses would be due after the close of discovery. [Note 6.]

A party which fails to respond to interrogatories or document requests during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery request on its merits. [Note 7.] For requests for admissions, which are deemed admitted due to failure to respond or timely object, a party may either (1) move to reopen its time to respond to the admission requests because its failure to timely respond was the result of excusable neglect under Fed. R. Civ. P. 6(b)(1)(B), or (2) move to withdraw and amend its admissions pursuant to Fed. R. Civ. P. 36(b). [Note 8.] For a further discussion regarding admission requests, see TBMP § 407. Objections going to the merits of a discovery request include claims that the information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead to the discovery of admissible evidence. [Note 9.] In contrast, objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but instead to a characteristic of the information sought. [Note 10.]

NOTES:

1. 37 C.F.R. § 2.120(a)(3); Fed. R. Civ. P. 33(b)(2), Fed. R. Civ. P. 34(b)(2)(A), and Fed. R. Civ. P. 36(a)(3). *See Amazon Technologies v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (opposer's mistaken belief that applicant failed to serve initial disclosures does not excuse opposer's failure to respond to or properly object

to applicant's interrogatories and document requests); *MySpace Inc. v. Donnell Mitchell*, 91 USPQ2d 1060, 1061 n.2 (TTAB 2009) (requirement to serve responses by particular date means having service copies in the mail on or before that date).

2. 37 C.F.R. § 2.119(b) and 37 C.F.R. § 2.119(d).

3. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016).

4. 37 C.F.R. § 2.120(a)(3); *Trans-High Corp. v. JFC Tobacco Corp.*, 127 USPQ2d 1175, 1176 (TTAB 2018) (time to respond may be extended by stipulation or order of the Board). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951 (October 7, 2016) ("[D]iscovery must be served early enough in the discovery period that responses will be provided and all discovery complete by the close of discovery.").

5. Fed. R. Civ. P. 26(d)(3); *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990) (discovery in Board proceeding not governed by any concept of priority of discovery); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 632 (TTAB 1986) (no priority of discovery; "it is not the prerogative . . . for parties or their counsel to unilaterally impose conditions upon the sequence and timing of discovery which are not provided by the rules governing practice before the Board").

6. 37 C.F.R. § 2.120(a)(3); *see Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268, 1271 (TTAB 2017) (sustaining an objection to discovery requests as untimely because the answers were due after the close of the discovery period; but allowing propounding party time to re-serve the requests due to its misunderstanding regarding the time by which the requests had to be served under the Board's recently revised rules).

7. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (stating that the Board has great discretion in determining whether such forfeiture should be found); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 449 (TTAB 1979) (excusable neglect not shown where opposer was out of the country and, upon return, failed to ascertain that responses were due); *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975) (waived right to object by refusing to respond to interrogatories, claiming that they served "no useful purpose"). *See also Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1387-88 (TTAB 2016) (applicant ordered to show cause why sanction forfeiting her right to object to discovery requests on the merits should not be entered after she filed improper motion for purpose of delaying her discovery responses); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1303 (TTAB 1987) (right to object not waived where although discovery responses were late, there was some confusion regarding time to answer); and *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979) (party seeking discovery is required to make good faith effort to determine why no response has been made before coming to Board with motion to compel).

8. *See Giersch v. Scripps Networks, Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007) (discussing reopening time to respond to requests for admissions under Fed. R. Civ. P. 6(b)(1)(B) and withdrawal and amendment of admissions under Fed. R. Civ. P. 36(b)). *See also Hobie Designs, Inc. v. Fred Hayman Beverly Hills, Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (amending admissions under Fed. R. Civ. P. 36(b)).

9. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000).

10. *See Cadbury UK Ltd. v. Meenaxi Enterprises, Inc.*, 115 USPQ2d 1404, 1408 n.7 (TTAB 2015) (Board has distinguished objections on the merits of a discovery request from other types of objections such as confidentiality and privilege); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (party will generally not be found to have waived the right to make non-merit objections).

403.04 Extensions of Discovery Period, Time to Respond to Discovery Requests and Disclosures

37 C.F.R. § 2.120(a)(2)(iv) ***[Discovery]*** *. . . Limited extensions of the discovery period may be granted upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset.*
* * * *

37 C.F.R. § 2.120(a)(3) *. . . The time to respond [to interrogatories, requests for production of documents and things, and requests for admission] may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board, but the response may not be due later than the close of discovery. The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.*

37 C.F.R. § 2.121(a) ***[Assignment of times for taking testimony and presenting evidence]*** *. . . The resetting of the closing date for discovery will result in the rescheduling of pretrial disclosure deadlines and testimony periods without action by any party.*

* * * *

37 C.F.R. § 2.121(d) *When parties stipulate to the rescheduling of a deadline for pretrial disclosures and subsequent testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of subsequent deadlines for pretrial disclosures and testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, shall be submitted to the Board through ESTTA, with the relevant dates set forth and an express statement that all parties agree to the new dates.*

Limited extensions of the discovery period may be granted upon stipulation of the parties approved by the Board, or on motion (pursuant to Fed. R. Civ. P. 6(b)) granted by the Board, or by order of the Board. [Note 1.] An extension of the closing date for discovery will result in a corresponding resetting of the pretrial disclosure deadlines and testimony periods without action by any party. [Note 2.] Also, the expert disclosure deadline must always be scheduled prior to the close of discovery. [Note 3.] Therefore, when the parties stipulate to an extension of the closing date for discovery, or a motion for such an extension is granted, or the Board orders such an extension, the Board ordinarily will reset the deadline for expert disclosure. However, if the time for serving expert disclosures has passed and it is clear from the record that such expert disclosures have been served or the parties have made it clear that they do not intend to use experts, the Board may not reset the time for expert disclosures. A stipulation or consented motion to extend discovery, pretrial disclosure, and trial dates must be filed with the Board through ESTTA, and should be presented in the form used in a trial order with the relevant dates set forth. [Note 4.] For information concerning stipulations to extend, see TBMP § 501.03. For information concerning motions to extend, see TBMP § 509.

Mere delay in initiating discovery does not constitute good cause for an extension of the discovery period. [Note 5.] Thus, a party which waits until late in the discovery period to serve interrogatories, requests for

production of documents and things, and/or requests for admission will not be heard to complain, when it receives responses thereto near the end of the discovery period, that it needs an extension or reopening of the discovery period in order to take "follow-up" discovery. [Note 6.]

At the same time, a party which receives discovery requests early in the discovery period may not, by delaying its response thereto, or by responding improperly so that its adversary is forced to file a motion to compel discovery, deprive its adversary of the opportunity to take "follow-up" discovery. Such a delay or improper response constitutes good cause for an extension of the discovery period. Therefore, the Board will, at the request of the propounding party, extend the discovery period (at least for the propounding party) so as to restore that amount of time which would have remained in the discovery period had the discovery responses been made in a timely and proper fashion. [Note 7.]

The time for responding to a request for discovery may be extended or reopened by stipulation of the parties, or on motion (pursuant to Fed. R. Civ. P. 6(b)) granted by the Board, or by order of the Board, but the response may not be due later than the close of discovery. [Note 8.] An extension of a party's time to respond to an outstanding request for discovery will not automatically result in a corresponding extension of the deadline for expert disclosures, close of discovery, or any subsequent deadlines (including pretrial disclosures and the close of the parties' testimony periods). [Note 9.] Such periods will be rescheduled only on stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board.

A stipulation to extend or reopen only the time for responding to written discovery (that is, a request that does not also seek to extend or reopen the closing date for the discovery period and/or other subsequent deadlines) does not always have to be filed with the Board, but may be required in certain circumstances. If the stipulation to extend or reopen the time for responding to a discovery request interferes with the orderly completion of discovery or the opening of trial, the parties must first obtain Board approval. [Note 10.] Further, to avoid any misunderstanding between the parties as to the existence and terms of such a stipulation, it is recommended that the stipulation be reduced to writing, even if it is not one which need be filed with the Board.

A party's time to make initial or expert disclosures may be reset upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board, but the expert disclosure deadline must always be scheduled prior to the close of discovery. [Note 11.] The resetting of a party's time to make initial disclosures (that is, a request that does not also seek to extend or reopen subsequent deadlines) will not result in an automatic rescheduling of the deadline for expert disclosure or of the close of discovery or any subsequent deadlines. Such dates will be rescheduled upon approval of an appropriate stipulation of the parties, or motion of a party, or by order of the Board. However, when the parties stipulate to an extension of the deadline for expert disclosure, or a motion seeking such an extension is granted, or the Board orders such an extension, the Board will extend the closing date of discovery to the extent necessary to schedule the expert disclosure deadline prior to the close of the discovery period.

For a discussion regarding modification of disclosure obligations, see TBMP § 401.04.

NOTES:

1. 37 C.F.R. § 2.120(a)(2)(iv). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016) ("The Office is further amending § 2.120(a)(2)(iv) to clarify that extensions of the discovery period granted by the Board will be limited.").

2. 37 C.F.R. § 2.121(a).

3. 37 C.F.R. § 2.120(a)(2)(iv). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016).

4. 37 C.F.R. § 2.121(d).

5. *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1854-55 (TTAB 2008) (opposers' motion to extend discovery period denied where opposers did not serve written discovery requests until final day of discovery, and did not attempt to depose applicant during prescribed discovery period, and evidence does not support opposers' claim that they delayed discovery because parties were engaged in settlement discussions); *Dating DNA, LLC v. Imagini Holdings, Ltd.*, 94 USPQ2d 1889, 1892 n.3 (TTAB 2010) ("a party that delays in initiating discovery . . . generally is not entitled to an extension to allow for follow-up discovery"); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (no reason given why discovery was not taken during the time allowed).

6. *See Dating DNA, LLC v. Imagini Holdings, Ltd.*, 94 USPQ2d 1889, 1892 n.3 (TTAB 2010); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987); *American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1316 n.4 (TTAB 1992).

7. *See Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990) (Board will, upon motion, reopen or extend discovery solely for benefit of party who was unfairly deprived of follow-up discovery by opponent who wrongfully refused to answer or delayed responses to discovery); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (granting motion to extend time to restore amount of time remaining in discovery to the day when applicant's interrogatories were served).

8. 37 C.F.R. § 2.120(a)(3); *Trans-High Corp. v. JFC Tobacco Corp.*, 127 USPQ2d 1175, 1176 (TTAB 2018) (time to respond may be extended by stipulation or order of the Board). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016) (". . . when the time to respond [to discovery] is extended, discovery responses may not be due later than the close of discovery.").

9. 37 C.F.R. § 2.120(a)(3) and 37 C.F.R. § 2.121(a). *See PolyJohn Enterprises Corp. v. 1-800-TOILETS, Inc.*, 61 USPQ2d 1860, 1861 (TTAB 2002) (mistaken belief that resetting time to respond to discovery also extended discovery and testimony periods did not constitute excusable neglect to reopen).

10. Fed. R. Civ. P. 29(b). *See Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1768 n.2 (TTAB 2008) (written stipulations to extend period to respond to discovery requests need only be filed with the Board when the extension may interfere with the orderly completion of discovery or the opening of trial).

11. 37 C.F.R. § 2.120(a)(2)(iv).

403.05 Need for Early Initiation of Discovery

403.05(a) To Allow Time for "Follow-up" Discovery

Pursuant to 37 C.F.R. § 2.120(a)(3), interrogatories, requests for production of documents and things, and requests for admission must be served early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses will be due no later than the close of discovery. If a party wishes to have an opportunity to take "follow-up" discovery after it receives responses to its initial requests for

discovery, it must serve its initial requests early in the discovery period, so that when it receives responses thereto, it will have time to prepare and serve additional discovery requests, the responses to which also must be due no later than the close of the discovery period. *See*TBMP § 403.04.

403.05(b) To Facilitate Introduction of Produced Documents

37 C.F.R. § 2.120(i) ***Requests for admission.*** *The total number of requests for admission which a party may serve . . . shall not exceed seventy-five. . . . [I]ndependent of this limit, a party may make one comprehensive request for admission of any adverse party that has produced documents for an admission authenticating specific documents, or specifying which of those documents cannot be authenticated.*

37 C.F.R. § 2.120(k)(3)(ii) ***[Use of discovery deposition, answer to interrogatory, admission or written disclosure.]*** *A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e), or the party has obtained an admission or stipulation from the producing party that authenticates the documents.*

37 C.F.R. § 2.122(e) ***Printed publications and official records.***

(1) *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant in a particular proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered in accordance with paragraph (g) of this section. The notice of reliance shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Office need not be certified to be offered in evidence.*

(2) *Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided.*

37 C.F.R. § 2.122(g) ***Notices of Reliance.*** *. . . A notice of reliance shall be filed during the testimony period of the party that files the notice. For all evidence offered by notice of reliance, the notice must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. Failure to identify the relevance of the evidence, or associate it with issues in the proceeding, with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order.*

Documents produced in response to a request for production of documents or through disclosures may not be made of record by notice of reliance alone, except to the extent that the documents are otherwise admissible by notice of reliance, for example, as printed publications or official records under 37 C.F.R. § 2.122(e). However, there are a number of different methods by which documents produced in response to a request for production of documents that do not qualify for submission under 37 C.F.R. § 2.122(e) may be made of record. *See*TBMP § 704.09 and TBMP § 704.11. The most straightforward way is for the parties to stipulate that any party may introduce by notice of reliance documents produced by any other party, subject only to objections as to relevance and competence, materiality, or weight. [Note 1.] Three other methods are available for use only if the request for production of documents is served relatively early in the discovery period.

First, if there remains sufficient time in the discovery period for requests for admission to be served and answered, a party that has obtained documents from another party through a request for production of documents or through disclosures may serve on its opponent a request for admission of the genuineness of the subject documents, which should be attached as exhibits to the request for admission. [Note 2.] Independent of the numerical limit on the number of requests for admission that may be served during a proceeding, a party is allowed one comprehensive request for admission of any adverse party that has produced documents for authenticating specific documents, or specifying which of those documents cannot be authenticated. [Note 3.] Then, during its testimony period, the propounding party may file a notice of reliance, pursuant to 37 C.F.R. § 2.120(k)(3)(ii), on the request for admission, the exhibits thereto, and its adversary's response.

Second, if the discovery period has not yet expired, the party which obtained the documents may make them of record by taking a discovery deposition of its adversary, marking the documents as exhibits thereto, and having the witness identify the documents during the deposition. The propounding party may then submit the deposition and identified exhibits during its testimony period under a notice of reliance. Alternatively, the documents may be introduced during the taking of a testimonial deposition of an adversary who can identify the documents. [Note 4.]

Third, the request for production of documents may be combined with a notice of the taking of the adversary's discovery deposition; that is, the combined request and notice may ask that the deponent bring the requested documents to his or her deposition. However, a party served with a request for production of documents has thirty days from the date of service of the request in which to respond thereto. *See*TBMP § 403.03. Moreover, in proceedings before the Board, a discovery deposition must be both properly noticed and taken before the end of the discovery period. [Note 5.] *See*TBMP § 403.02. Thus, a combined notice of deposition and request for production of documents normally must be served at least thirty days prior to the close of the discovery period. [Note 6.]

For a full discussion of making evidence of record in a Board proceeding, see TBMP Chapter 700.

NOTES:

1. 37 C.F.R. § 2.120(k)(3)(ii); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("…a party may make documents produced by another party of record by notice of reliance alone if the party has obtained an admission or stipulation from the producing party that authenticates the documents."). *See, e.g., ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351, 1353 n.6 (TTAB 2007) (opposer filed notice of reliance on applicant's response to request for admission and exhibits thereto that all documents it produced in response to opposer's discovery requests were authentic for purposes of admission into evidence during the testimony period in this opposition proceeding); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103-04 (TTAB 2007) (because respondent availed itself of Fed. R. Civ. P. 33(d) to provide documents in response to petitioner's interrogatories and admitted via a request for admission that the documents it produced were true and correct copies of authentic documents, the documents could be introduced by way of notice of reliance).

2. Fed. R. Civ. P. 36(a)(2).

3. 37 C.F.R. § 2.120(i); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69962 (October 7, 2016).

4. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1427 n.6 (TTAB 2013).

5. 37 C.F.R. § 2.120(a)(3).

6. *See* 37 C.F.R. § 2.120(a)(3) ("[R]equests for production of documents and things . . . must be served early enough in the discovery period . . . so that responses will be due no later than the close of discovery. Responses to . . . requests for production of documents and things . . . must be served within thirty days from the date of service of such discovery requests.").

404 Discovery Depositions

404.01 When Permitted and By Whom

Discovery depositions must be properly noticed and taken during the discovery period unless the parties stipulate that the deposition may be taken outside of the period. [Note 1.] *See*TBMP § 403.02. Discovery depositions generally may be taken by any party, of any adverse party or any relevant non-party.

As a matter of convenience and courtesy and to avoid scheduling conflicts, the parties should attempt to schedule depositions by agreement rather than have the deposing party unilaterally set a deposition date. [Note 2.] However, it is not unusual for the deposing party to notice a deposition and subsequently discuss alternative dates with the party to be deposed.

*See*TBMP § 408 regarding the parties' duty to cooperate in discovery.

NOTES:

1. *See* 37 C.F.R. § 2.120(a)(3); *National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008).

2. *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (parties have a duty to cooperate in resolving conflicts in the scheduling and taking of depositions); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 (TTAB 1987) (parties ordered to work out a mutually agreeable schedule for taking of discovery depositions).

404.02 Who May be Deposed

Fed. R. Civ. P. 30(a). Depositions by Oral Examination. When a Deposition May Be Taken.

(1) ***Without Leave.*** *A party may, by oral questions, depose any person, including a party, without leave of court except as provided in Rule 30(a)(2). The deponent's attendance may be compelled by subpoena under Rule 45.*

(2) ***With Leave.*** *A party must obtain leave of court, and the court must grant leave to the extent consistent with Rule 26(b)(1) and (2):*

(A) *if the parties have not stipulated to the deposition and:*

(i) *the deposition would result in more than 10 depositions being taken under this rule or Rule 31 by the plaintiffs, or by the defendants, or by the third-party defendants;*

(ii) *the deponent has already been deposed in the case; or*

(iii) *the party seeks to take the deposition before the time specified in Rule 26(d), unless the party certifies in the notice, with supporting facts, that the deponent is expected to leave the United States and be unavailable for examination in this country after that time; or*

(B) *if the deponent is confined in prison.*

A discovery deposition generally may be taken of any person, whether or not the person is a party, and whether or not the person resides in the United States. However, the Board's permission must be obtained under the following circumstances:

(1) If without written stipulation of the parties, (i) a proposed deposition would result in more than ten discovery depositions being taken by the plaintiff(s) or by the defendant(s), or (ii) the person to be examined already has been deposed in the case, or

(2) If the person to be examined is confined in prison.

[Note 1.]

Deposition of a non-party witness residing in the United States may be taken by subpoena under Fed. R. Civ. P. 45, or on notice alone if the non-party witness agrees to appear voluntarily. *See*TBMP § 404.03(a)(2).

For information concerning limitations on the right to discovery depositions, see TBMP § 402.01. For information on depositions of a party or non-party that does not reside in the United States, see TBMP § 404.03(b)TBMP § 404.03(c), and TBMP § 404.07(Discovery Depositions on Written Questions).

NOTES:

1. *See* Fed. R. Civ. P. 30(a).

404.03 Place of Deposition; Oral or Written Deposition; Securing Attendance of Deponent

404.03(a) Person Residing in the United States – In General

37 C.F.R. § 2.120(b) ***Discovery deposition within the United States.***

The deposition of a natural person shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree in writing * * *

The deposition of a natural person shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree by stipulation. [Note 1.] The deposition may be taken either orally, or on written questions in the manner described in 37 C.F.R. § 2.124. [Note 2.]

For information on the taking of a discovery deposition on written questions, see TBMP § 404.07.

NOTES:

1. 37 C.F.R. § 2.120(b). *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998) (general rule in federal district court that a plaintiff is required to make itself available for examination in district where suit is brought does not apply in Board proceedings).

2. *See* Fed. R. Civ. P. 30 and 31.

404.03(a)(1) Person Residing in the United States – Party

If a proposed deponent residing in the United States is a party, or, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party, the deposition may be taken on notice alone. [Note 1.] When such a proposed deponent fails to appear for a noticed deposition, the deposing party may seek to compel attendance by a motion to compel. *See*TBMP § 523.

For information concerning notices of deposition, see TBMP § 404.05.

For information concerning testimonial depositions of adverse party witnesses residing in the United States, seeTBMP § 703.01(f)(2).

NOTES:

1. 37 C.F.R. § 2.120(b); Fed. R. Civ. P. 30(b); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976).

404.03(a)(2) Person Residing in the United States – Non-party

35 U.S.C. § 24 ***Subpoenas, witnesses.***

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office.

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

37 C.F.R. § 2.120(b) ***Discovery deposition within the United States.***

. . . The responsibility rests wholly with the party taking discovery to secure the attendance of a proposed deponent other than a party or anyone who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure.

The responsibility rests with the deposing party to secure the attendance of a proposed deponent residing within the United States unless the proposed deponent is a party, or a person who, at the time set for the

taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party. [Note 1.] If the proposed non-party deponent is not willing to appear voluntarily, the deposing party must secure the non-party deponent's attendance by subpoena, pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45. [Note 2.]

The subpoena must be issued from the United States district court in the federal judicial district where the deponent resides or is regularly employed. [Note 3.]

If a person named in a subpoena compelling attendance at a discovery deposition fails to attend the deposition, or refuses to answer a question propounded at the deposition, the deposing party must seek enforcement from the United States district court that issued the subpoena; the Board has no jurisdiction to enforce the subpoena. [Note 4.]

For information regarding the taking of a testimonial deposition of a non-party witness residing in the United States, see TBMP § 703.01(f)(2).

NOTES:

1. 37 C.F.R. § 2.120(b).

2. Fed. R. Civ. P. 30(a)(1) and Fed. R. Civ. P. 45; *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2048-49 (TTAB 1988) (deposition of former employee can only be taken by voluntary appearance or by subpoena). *Cf.* regarding testimony depositions, *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990) (testimony deposition on written questions of adverse party); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976) (testimony deposition of adverse witness).

Please Note: To the extent that Fed. R. Civ. P. 45(a)(2) and 45(f), as amended in 2013, conflict with the provisions of 35 U.S.C. § 24, the statute is controlling. *See* 37 C.F.R. § 2.116(a) ("Except as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure.").

3. 37 C.F.R. § 2.120(b). See generally the cases cited in preceding Note 2.

4. *See, e.g., Ate My Heart v. GA GA Jeans*, 111 USPQ2d 1564, 1565 n.5 (TTAB 2014) (notice of deposition of unwilling non-party witness must include subpoena, and related motions must be filed with district court that issued subpoena, not Board); *Dan Foam ApS v. Sleep Innovations Inc.*, 106 USPQ2d 1939, 1942 n.4 (TTAB 2013) (Board cannot modify or quash a subpoena issued by a district court); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 n.3 (TTAB 1987) (motion to quash subpoenaed third-party depositions due to scheduling problems denied). *See also In re Johnson & Johnson*, 59 F.R.D. 174, 178 USPQ 201 (D. Del. 1973) (asserting jurisdiction to enforce subpoenas for TTAB proceeding); *PRD Electronics Inc. v. Pacific Roller Die Co.*, 169 USPQ 318, 319 n.3 (TTAB 1971).

404.03(b) Person Residing in a Foreign Country – Party

37 C.F.R. § 2.120(c) ***Discovery deposition in foreign countries; or of foreign party within jurisdiction of the United States.***

(1) *The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken*

in a foreign country, be taken in the manner prescribed by § 2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.

(2) *Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery. Whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf, present within the United States or any territory which is under the control and jurisdiction of the United States, such officer, director, managing agent, or other person who consents to testify in its behalf may be deposed by oral examination upon notice by the party seeking discovery. The party seeking discovery may have one or more officers, directors, managing agents, or other persons who consent to testify on behalf of the adverse party, designated under Rule 30(b)(6) of the Federal Rules of Civil Procedure. The deposition of a person under this paragraph shall be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition. This paragraph (c)(2) does not preclude the taking of a discovery deposition of a foreign party by any other procedure provided by paragraph (c)(1) of this section.*

The discovery deposition of a natural person who resides in a foreign country, and who is a party, or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party may be taken on notice alone. [Note 1.]

However, if the discovery deposition of such a person is taken in a foreign country, it must be taken on written questions, in the manner described in 37 C.F.R. § 2.124, unless the Board, on motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination. [Note 2.]

Similarly, if a testimonial deposition is taken in a foreign country, it must be taken by deposition on written questions, as described in 37 C.F.R. § 2.123(a)(2) unless the Board, on motion for good cause orders the deposition taken by oral examination, or the parties so stipulate; or by affidavit or declaration subject to the right of cross examination. [Note 3.] See TBMP § 703.01(b) for further information about the form of trial testimony. It should be noted, however that some countries prohibit the taking of testimony within their boundaries for use in any other country, including the United States, even though the witness is willing; or may permit the taking of testimony only if certain procedures are followed. A party that wishes to take a deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of the Legal Adviser, U.S. Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed.

For information concerning the procedure for taking discovery depositions on written questions, see TBMP § 404.07.

For information on a motion to take a foreign deposition orally, see TBMP § 520. For information on taking the testimony deposition of a willing or unwilling adverse party or non-party witness in a foreign country through the letter rogatory procedure or by procedures provided under the Hague Convention or other applicable treaties, see TBMP § 703.01(g).

The Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her discovery deposition. [Note 4.]

Parties seeking to take the discovery deposition of a natural person residing in a foreign country should be aware that the laws of some foreign countries may serve to preclude the taking of such depositions. [Note 5.] In determining when it is appropriate to impose sanctions for non-compliance with discovery due to a conflict with foreign laws, the following factors are considered: (1) the good faith of the non-complying party; (2) whether the non-complying party would incur foreign criminal liability; and (3) whether alternative sources of information are available. [Note 6.]

NOTES:

1. *See* 37 C.F.R. § 2.120(c) and 37 C.F.R. § 2.124.

2. 37 C.F.R. § 2.120(c)(1). *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998). *See also Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1925 (TTAB 1989) (by motion); *Jonergin Co. v. Jonergin Vermont Inc.*, 222 USPQ 337, 340 (Comm'r 1983) (by stipulation).

3. 37 C.F.R. § 2.123(a)(2). *See*TBMP § 703.02(a).

4. *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 374 (TTAB 1978) (deposition may only be taken by written questions unless otherwise stipulated, or unless the party is present in the U.S.). *See also Miller v. N. V. Cacao-En Chocoladefabrieken Boon*, 142 USPQ 364, 365-66 (E.D.N.Y. 1964); *Cf. Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises, Ltd*, 511 F.3d 437, 85 USPQ2d 1385, 1391 (4th Cir. 2007) (foreign corporation party required to obey a subpoena issued by the district court, pursuant to Rule 30(b)(6) notice, to appear in the United States to give trial testimony).

5. *Cf. Societe Internationale Pour Participations Industrielles et Commerciales, S.A. v. Rogers*, 357 U.S. 197, 200-01 (1958) (Swiss government ordered Swiss plaintiff in U.S. court proceeding not to produce certain documents).

6. *Cf. Cochran Consulting Inc. v. Uwatec USA Inc.*, 102 F.3d 1224, 41 USPQ2d 1161, 1163-67 (Fed. Cir. 1996) (citing *Societe Internationale Pour Participations Industrielles et Commerciales, S.A. v. Rogers*, 357 U.S. 197 (1958)).

404.03(c) Person Residing in a Foreign Country – Non-party

404.03(c)(1) Willing Non-party

The discovery deposition of a natural person who resides in a foreign country, and is not a party, or an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party, but is willing to appear voluntarily to be deposed, may be taken in the same manner as the discovery deposition of a natural person who resides in a foreign country and who is a party, i.e., in the manner described in TBMP § 404.03(b). [Note 1.] It should be noted, however that some countries prohibit the taking of testimony within their boundaries for use in any other country, including the United States, even though the witness is willing; or may permit the taking of testimony only if certain procedures are followed. A party which wishes to take a deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of the Legal Adviser, U.S. Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed.

NOTES:

1. *Cf.* 37 C.F.R. § 2.120(c) and 37 C.F.R. § 2.123(a).

404.03(c)(2) Unwilling Non-party – The Hague Convention and Letter Rogatory Procedure

28 U.S.C. § 1781 ***Transmittal of letter rogatory or request.***

(a) *The Department of State has power, directly, or through suitable channels—*

(1) *to receive a letter rogatory issued, or request made, by a foreign or international tribunal, to transmit it to the tribunal, officer, or agency in the United States to whom it is addressed, and to receive and return it after execution; and*

(2) *to receive a letter rogatory issued, or request made, by a tribunal in the United States, to transmit it to the foreign or international tribunal, officer, or agency to whom it is addressed, and to receive and return it after execution.*

(b) *This section does not preclude—*

(1) *the transmittal of a letter rogatory or request directly from a foreign or international tribunal to the tribunal, officer, or agency in the United States to whom it is addressed and its return in the same manner; or*

(2) *the transmittal of a letter rogatory or request directly from a tribunal in the United States to the foreign or international tribunal, officer, or agency to whom it is addressed and its return in the same manner.*

There is no certain procedure for obtaining, in an inter partes proceeding before the Board, the discovery deposition of a natural person who resides in a foreign country, is not a party, or an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party, and does not agree to appear voluntarily to be deposed. However, a party may be able to obtain the discovery deposition of such a person through the letter rogatory procedure, whereby an unwilling non-party witness in a foreign country sometimes may be compelled to respond to questions routed through diplomatic channels to an appropriate judicial authority in the foreign country. [Note 1.]

The term "letter rogatory" or "letter of request" is defined in Black's Law Dictionary (11th edition 2019) as follows:

*letter of request. 1. A document issued by one court to a foreign court, requesting that the foreign court (1) take evidence from a specific person within the foreign jurisdiction or serve process on an individual or corporation within the foreign jurisdiction and (2) return the testimony or proof of service for use in a pending case. See Fed. R. Civ. P. 28. — Also termed letter rogatory; rogatory letter; requisitory letter. * * * *

While the letter rogatory procedure is usually conducted through the judicial system, because the Board proceeding is before an administrative body, the Board would function as the initiating "court" contemplated by the preceding definition.

A party that wishes to have the Board issue a letter rogatory should file a written request therefor with the Board. [Note 2.] The party must also submit an original and two copies of the proposed letter rogatory, and an original and two copies of the questions to be propounded to the non-party witness. If the official language of the foreign country is not English, the propounding party must submit an original and two copies of the

letter rogatory and questions in English, and an original and two copies thereof translated into the official language of the country in which the witness will be deposed. In addition, the propounding party must serve on each adverse party a copy of every submission filed with the Board. [Note 3.]

If the request by the Board is granted (i.e. it is willing to issue the letter once all questions are exchanged and translations are provided), each adverse party will be given an opportunity to submit cross questions, a copy of which must also be served on the propounding party. If an adverse party submits cross questions, the propounding party, in turn, will be given an opportunity to submit redirect questions, a copy of which must be served on each adverse party. [Note 4.] As in the case of the initial questions, an original and two copies of any cross questions and redirect questions must be submitted to the Board; if the official language of the foreign country is not English, an original and two copies of the questions in English, and an original and two copies thereof translated into the official language, must be submitted.

After the original and copies of the letter rogatory, and of all of the questions, have been submitted to the Board, and the letter rogatory has been approved as to form, the letter rogatory will be issued by the Board. The letter rogatory will be signed by the Chief Administrative Trademark Judge; however, the propounding party will be responsible for having the signature authenticated in such a manner as to meet the requirements of the foreign country. After the signature is appropriately authenticated, the Board will forward the original and one copy of the letter rogatory and accompanying questions to the United States Department of State with a transmittal letter from the Board (the remaining copy of these papers will be retained in the Board proceeding file). In its transmittal letter, the Board will request, pursuant to 28 U.S.C. § 1781 (which authorizes the Department of State to, inter alia, "receive a letter rogatory issued, or request made, by a tribunal in the United States, to transmit it to the foreign or international tribunal, officer, or agency to whom it is addressed, and to receive and return it after execution"), that the Department of State transmit the letter rogatory to the appropriate judicial authority in the foreign country, and, after execution, receive it back and return it to the Board. Thereafter, the Department of State will transmit the letter rogatory, through diplomatic channels, to the appropriate judicial authority in the foreign country.

The party seeking discovery must pay all fees, including authentication, consular, and foreign government fees, charged in connection with the letter rogatory procedure. The Department of State will require the propounding party to make a deposit to cover the consular and foreign government fees. Payment must include a certified check payable to the U.S. Embassy [insert the name of the appropriate city, e.g., Paris, Bonn, Tokyo, etc.]. Any unused portion of the deposit will be returned to the depositor after completion of the letter rogatory process.

Further information concerning the letters rogatory process may be obtained from the Judicial Assistance Officer, U.S. Department of State, Office of Legal Affairs (L/CA/POG/GC), SA-17, 10th Floor, 2201 C Street NW, Washington, D.C. 20522-1710 or at the U.S. Department of State's website at https://travel.state.gov/content/travel/en/legal/travel-legal-considerations/internl-judicial-asst/obtaining-evidence/Preparation-Letters-Rogatory.html.

Once the appropriate foreign judicial authority has received the letter rogatory, it may or may not be executed. The letter rogatory "rest[s] entirely upon the comity of courts towards each other . . . ." [Note 5.] Some countries refuse or are reluctant to lend assistance in the taking of a discovery deposition in their country through the letter rogatory procedure, and compliance with the procedural requirements for a letter rogatory does not ensure that the requested deposition will be completed. [Note 6.] Before a request for issuance of a letter rogatory is filed with the Board, the requesting party should examine the law and policy of the involved foreign country, and consult with the Office of Legal Affairs, Department of State, in order to determine whether the country in question is likely to honor a letter rogatory, particularly a letter rogatory issued by the Board. The likelihood that the Board will agree to issue the letter rogatory may be influenced

by any information the requesting party is able to provide about the likelihood that the foreign country will execute the letter.

Even in those foreign countries that may be willing to execute a letter rogatory, the foreign judicial authority may refuse to honor a letter rogatory issued by the Board (an administrative tribunal) rather than by a United States district court. Further, if the foreign country has a "blocking statute" prohibiting its residents from disclosing certain types of information in judicial or administrative proceedings outside of the foreign country, a letter rogatory may not be honored if the foreign judicial authority believes that disclosure of the information requested therein would violate the blocking statute.

If a letter rogatory is honored, its probative value may be limited. In executing the letter rogatory, the foreign judicial tribunal will follow its customary procedures for taking discovery or testimony. The fact that these procedures may differ from those normally followed in proceedings before the Board does not mean that the deposition must necessarily be excluded. Rather, any such differences are matters to be considered by the Board in determining the probative value of the deposition. [Note 7.]

A party considering the filing of a request for issuance of a letter rogatory should bear in mind not only the complexity and uncertain outcome of the procedure, but also its time-consuming nature. The entire process, from the filing of the initial request for issuance of a letter rogatory, to receipt by the Board either of the completed deposition, or of notification that the letter rogatory will not be honored, will consume months, if not years. During the interim, proceedings in the case before the Board most likely will be suspended pending the execution and return to the Board of the letter rogatory. [Note 8.]

The Convention on the Taking of Evidence Abroad in Civil or Commercial Matters (commonly known as the "Hague Convention"), opened for signature March 18, 1970, 23 U.S.T. 2555, T.I.A.S. No. 7444, prescribes procedures under which a judicial authority in one member country may request evidence located in another. The Hague Convention offers another possible method by which a party to an inter partes proceeding before the Board may attempt to obtain the discovery deposition of an unwilling non-party witness residing in a foreign country, if the foreign country is a member of the Hague Convention. [Note 9.]

The Hague Convention provides for the compulsion of evidence (including the deposition of an unwilling witness) in a member country pursuant to a "letter of request," which is very similar in nature to a letter rogatory. [Note 10.] However, the Board has been advised by the Department of State that foreign countries are more likely to lend assistance in the taking of a discovery deposition if the request therefor is made under the more formal letter rogatory procedure. Before filing a motion for issuance of a letter of request under the Hague Convention, the moving party should consult with the Office of the Legal Adviser, U.S. Department of State, in order to determine whether the foreign country in question is likely to honor a letter of request, particularly a letter of request issued by the Board.

NOTES:

1. *Cf. DBMS Consultants Ltd. v. Computer Associates International, Inc.*, 18 Fed. R. Serv. 3d 33, 131 F.R.D. 367 (D. Mass. 1990) (court granted application for issuance of a letter rogatory finding that it would be unjust and inappropriate to require oral examination and that opposing party has shown no good reason to deny the application).

2. *See* Fed. R. Civ. P. 28(b).

3. 37 C.F.R. § 2.119(a). *Cf* . 37 C.F.R. § 2.124(b)(2).

4. *Cf.* 37 C.F.R. § 2.124(d)(1).

5. 22 C.F.R. § 92.54 ("Letters rogatory" defined).

6. *See* Fed. R. Civ. P. 28(b) Notes of Advisory Committee on Rules –1963 Amendment; 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2083 (3d ed. 2020).

7. *See* Fed. R. Civ. P. 28(b) Notes of Advisory Committee on Rules –1963 Amendment); 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2083 (3d ed. 2020).

8. *Cf.* 37 C.F.R. § 2.124(d)(2).

9. *See, e.g., Societe Nationale Industrielle Aerospatiale v. U.S. District Court for the Southern District of Iowa*, 482 U.S. 522, 533-40 (1987) (although Hague Convention not exclusive discovery procedure, it may apply even if Federal Rules of Civil Procedure are available); *In re Anschuetz & Co.*, 838 F.2d 1362, 1364 (5th Cir. 1988) (U.S. district courts have discretion to resolve discovery conflicts between Federal Rules of Civil Procedure and Hague Convention); 8 C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2005.1 (3d ed. 2020). For general information concerning the Hague Convention, see *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991) (applicant failed to establish necessity of using Hague procedures). [**Please Note:** This case involved the taking of discovery by interrogatories, requests for production of documents, and requests for admissions, rather than by deposition].

10. For information concerning the letter of request procedure under the Hague Convention, see Chapter 1 of the Convention. *See also Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991).

404.03(d) Foreign Person Present Within the United States – Party

37 C.F.R. § 2.120(c)(2) *Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery. Whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf, present within the United States or any territory which is under the control and jurisdiction of the United States, such officer, director, managing agent, or other person who consents to testify in its behalf may be deposed by oral examination upon notice by the party seeking discovery. The party seeking discovery may have one or more officers, directors, managing agents, or other persons who consent to testify on behalf of the adverse party, designated under Rule 30(b)(6) of the Federal Rules of Civil Procedure. The deposition of a person under this paragraph shall be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition. This paragraph (c)(2) does not preclude the taking of a discovery deposition of a foreign party by any other procedure provided by paragraph (c)(1) of this section.*

Whenever a natural person who is a foreign party, or an officer, director, or managing agent, of a foreign party, or some other person who consents to testify on a foreign party's behalf, is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party, officer, director, managing agent, or other person may be deposed, while

in the United States, by oral examination on notice pursuant to 37 C.F.R. § 2.120(c)(2). Indeed, this option was available even before the adoption of 37 C.F.R. § 2.120(c)(2). [Note 1.]

When the discovery deposition of a foreign party, or an officer, director, managing agent, or other person who consents to testify on behalf of a foreign party, is taken in the United States by oral examination pursuant to 37 C.F.R. § 2.120(c)(2), the deposition must be taken in the federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a federal judicial district, where the witness is at the time of the deposition. [Note 2.] Parties may obtain information regarding a potential foreign witness's presence in the United States during the discovery period in the form of an interrogatory request, which is subject to the duty to supplement. [Note 3.]

NOTES:

1. *See Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373-74 (TTAB 1978). *Cf. Jonergin Co. v. Jonergin Vermont Inc.*, 222 USPQ 337, 340 (Comm'r 1983) (parties may agree to take oral deposition of foreign domiciliary in U.S.).

2. 37 C.F.R. § 2.120(c)(2).

3. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69961 (October 7, 2016).

404.03(e) Foreign Person Present Within the United States – Non-party

If the proposed deponent is a foreign person who is present within the United States but the person is not a party to the proceeding and is not willing to appear voluntarily, it may be necessary to secure the deponent's attendance, if at all, by the procedures set forth in TBMP § 404.03(c).

404.04 Persons before Whom Depositions May be Taken

Fed. R. Civ. P. 28(a)(1). Persons Before Whom Depositions May Be Taken

(a) ***Within the United States.***

(1) ***In General.*** *Within the United States or a territory or insular possession subject to United States jurisdiction, a deposition must be taken before:*

(A) *an officer authorized to administer oaths either by federal law or by the law in the place of examination; or*

(B) *a person appointed by the court where the action is pending to administer oaths and take testimony.*

(2) ***Definition of "Officer."*** *The term "officer" in Rules 30, 31, and 32 includes a person appointed by the court under this rule or designated by the parties under Rule 29(a).*

(b) ***In a Foreign Country.***

(1) ***In General.*** *A deposition may be taken in a foreign country:*

(A) *under an applicable treaty or convention;*

(B) *under a letter of request, whether or not captioned a "letter rogatory";*

(C) *on notice, before a person authorized to administer oaths either by federal law or by the law in the place of examination; or*

(D) *before a person commissioned by the court to administer any necessary oath and take testimony.*

(2) ***Issuing a Letter of Request or a Commission.*** *A letter of request, a commission, or both may be issued:*

(A) *on appropriate terms after an application and notice of it; and*

(B) *without a showing that taking the deposition in another manner is impracticable or inconvenient.*

(3) ***Form of a Request, Notice, or Commission.*** *When a letter of request or any other device is used according to a treaty or convention, it must be captioned in the form prescribed by that treaty or convention. A letter of request may be addressed "To the Appropriate Authority in [name of country]." A deposition notice or a commission must designate by name or descriptive title the person before whom the deposition is to be taken.*

(4) ***Letter of Request—Admitting Evidence.*** *Evidence obtained in response to a letter of request need not be excluded merely because it is not a verbatim transcript, because the testimony was not taken under oath, or because of any similar departure from the requirements for depositions taken within the United States.*

(c) ***Disqualification.*** *A deposition must not be taken before a person who is any party's relative, employee, or attorney; who is related to or employed by any party's attorney; or who is financially interested in the action.*

Discovery depositions in Board inter partes proceedings may be taken before the persons designated by Fed. R. Civ. P. 28.

Thus, in the United States (or in any territory or insular possession subject to the jurisdiction of the United States) a discovery deposition in a Board proceeding "must be taken before an officer authorized to administer oaths either by federal law or by the law in the place of examination; or a person appointed by the court where the action is pending to administer oaths and take testimony." [Note 1.] As a practical matter, Board proceeding depositions taken in the United States are usually taken before a court reporter that is authorized to administer oaths in the jurisdiction where the deposition is taken.

In a foreign country, a discovery deposition in a Board proceeding may be taken pursuant to Fed. R. Civ. P. 28(b). This means, for example, that a discovery deposition in a Board proceeding, taken of a willing witness in a foreign country, usually may be taken on notice before a United States consular official, or before anyone authorized by the law of the foreign country to administer oaths therein. Some countries, however, may prohibit the taking of testimony within their boundaries for use in any other country, including the United States, even though the witness is willing; or may permit the taking of testimony only if certain procedures are followed. [Note 2.] A party which wishes to take a deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of the Legal Adviser, U.S. Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed.

NOTES:

1. Fed. R. Civ. P. 28(a).

2. *See* 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2083 (3d ed. 2020).

404.05 Notice of Deposition

Fed. R. Civ. P. 30(b) Notice of Deposition; Other Formal Requirements.

(1) ***Notice in General.*** *A party who wants to depose a person by oral questions must give reasonable written notice to every other party. The notice must state the time and place of the deposition and, if known, the deponent's name and address. If the name is unknown, the notice must provide a general description sufficient to identify the person or the particular class or group to which the person belongs.*

(2) ***Producing Documents.*** *. . . The notice to a party deponent may be accompanied by a request under Rule 34 to produce documents and tangible things at the deposition.*

* * * *

(6) ***Notice or Subpoena Directed to an Organization.*** *In its notice or subpoena, a party may name as the deponent a public or private corporation, a partnership, an association, a governmental agency, or other entity and must describe with reasonable particularity the matters for examination. The named organization must then designate one or more officers, directors, or managing agents, or designate other persons who consent to testify on its behalf; and it may set out the matters on which each person designated will testify. A subpoena must advise a nonparty organization of its duty to make this designation. The persons designated must testify about information known or reasonably available to the organization. This paragraph (6) does not preclude a deposition by any other procedure allowed by these rules.*

37 C.F.R. § 2.124(b)(2) ***[Depositions upon written questions]*** *A party desiring to take a discovery deposition upon written questions shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board. The notice shall state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify the witness or the particular class or group to which he or she belongs shall be stated in the notice, and the party from whom the discovery deposition is to be taken shall designate one or more persons to be deposed in the same manner as is provided by Rule 30(b)(6) of the Federal Rules of Civil Procedure.*

37 C.F.R. § 2.124(c) *Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.*

In an inter partes proceeding before the Board, the discovery deposition of a natural person who is a party, or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party may be taken on notice alone.

Prior to the taking of a discovery deposition on notice alone, the party seeking to take the deposition ("the deposing party") must give reasonable notice in writing to every adverse party. [Note 1.] Whether notice is reasonable depends upon the individual circumstances of each case. [Note 2.] The elements to be included in the notice are specified in Fed. R. Civ. P. 30(b)(1) for a deposition on oral examination, and in 37 C.F.R. § 2.124(b)(2) and 37 C.F.R. § 2.124(c) for a deposition on written questions. [Note 3.] It is strongly recommended that the deposing party contact the party sought to be deposed (or whose officer, director, etc., is sought to be deposed) well in advance of the proposed deposition in order to arrange a mutually convenient time for the deposition. The closing of a party's discovery period does not constitute a compelling need for failing to provide reasonable notice of deposition. [Note 4.]

A party may request from a party deponent the production of documents at a deposition under Fed. R. Civ. P. 34. [Note 5.] Proceeding under this rule facilitates discovery when the documents are few and simple and closely related to the oral examination. [Note 6.] In requesting documents, the deposing party must allow at least 30 days between the date of the request and the deposition to comply with Fed. R. Civ. P. 34. [Note 7.] For information concerning the procedure for combining a notice of taking a discovery deposition with a request for production of documents, see TBMP § 406.01. A deposition must be properly noticed and taken during the discovery period. The parties may stipulate to extend or reopen the discovery period to accommodate the taking of the deposition. [Note 8.]

In noticing the deposition of a corporation, partnership, association, governmental agency, or other juristic person, the deposing party may, in lieu of naming a person to be deposed, simply name as the deponent the corporation, partnership, association, governmental agency, or other juristic person, and describe with reasonable particularity the matters on which examination is requested. The named organization must, in turn, designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may state, for each person designated, the matters on which he or she will testify. Each designated person must testify not only as to those matters within his or her knowledge, but also as to matters known or reasonably available to the organization. [Note 9.]

For information regarding notice of testimonial deposition, see TBMP § 703.01(e).

For information regarding the time for service of discovery requests, see TBMP § 403.02.

For information regarding a motion to quash a notice of deposition or for protective order, see TBMP § 410, TBMP § 412, TBMP § 521, and TBMP § 526.

NOTES:

1. Fed. R. Civ. P. 30(b)(1); 37 C.F.R. § 2.124(b)(2); 37 C.F.R. § 2.124(c). *See* Fed. R. Civ. P. 31(a)(3) and 37 C.F.R. § 2.120(c). *Cf.* 37 C.F.R. § 2.123(c).

2. *Gaudreau v. American Promotional Events Inc.*, 82 USPQ2d 1692, 1696 (TTAB 2007).

3. *See, e.g.*, *Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1864 (TTAB 2001) (subject matter of deposition to be described with reasonable particularity in the notice).

4. *Cf. Gaudreau v. American Promotional Events Inc.*, 82 USPQ2d 1692, 1696 (TTAB 2007).

5. Fed. R. Civ. P. 30(b)(2).

6. Fed. R. Civ. P. 30(b), Notes of Advisory Committee on Rules –1970 Amendment.

7. Fed. R. Civ. P. 34(b)(2)(A).

8. 37 C.F.R. § 2.120(a)(3). *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008) (granting motion to quash opposer's notice of Fed. R. Civ. P. 30(b)(6) deposition noticed on the last day of discovery but setting date of deposition to take place after close of discovery).

9. Fed. R. Civ. P. 30(b)(6); Fed. R. Civ. P. 31(a)(4).

404.06 Taking a Discovery Deposition

Fed. R. Civ. P. 30(b)(4) By Remote Means. *The parties may stipulate — or the court may on motion order — that a deposition be taken by telephone or other remote means. For the purpose of this rule and Rules 28(a), 37(a)(2), and 37(b)(1), the deposition takes place where the deponent answers the questions.*

The manner of taking a discovery deposition in an inter partes proceeding before the Board is similar to taking a testimony deposition. [Note 1.]

For information concerning the procedure for taking a testimony deposition (including the examination of witnesses, the form of a deposition, and the protection of confidential information or trade secret material forming part of a deposition transcript or exhibits thereto), see TBMP § 703.01 and TBMP § 703.02. For a discussion of significant differences between discovery depositions and testimony depositions, see TBMP § 404.09. For information concerning the procedure for taking a discovery deposition on written questions, see TBMP § 404.07.

On stipulation of the parties, or on motion granted by the Board, or by Board order, a deposition may be taken or attended by telephone or other remote means, such as video conferencing. [Note 2.] A deposition taken by telephone or other remote means is regarded as taken in the federal judicial district and at the place where the witness is to answer the questions propounded to him or her. A discovery deposition taken by remote means (such as by video conference) must be transcribed if submitted as evidence at trial. *See*TBMP § 703.01(i).

NOTES:

1. *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1553 (TTAB 1991).

2. *See* Fed. R. Civ. P. 30(b)(4). *See, e.g.* , *Andrew R. Flanders v. DiMarzio, Inc.*, 2020 USPQ2d 10671, at *6 (TTAB 2020) (in view of the COVID-19 pandemic, Board ordered parties to conduct a teleconference to discuss their options for taking deposition of respondent's designated Rule 30(b)(6) witness by video teleconference, telephone or other similar acceptable means); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (to resolve conflict in scheduling a deposition where travel is involved, parties may stipulate or the Board may order upon motion that deposition be taken by telephone or other remote means); *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1553 (TTAB 1991) (leave to take telephonic depositions should be liberally granted in appropriate cases as current federal practice favors use of technological benefits).

404.06(a) Fed. R. Civ. P. 30(b)(1) Depositions by Oral Examination of a Natural Person

Fed. R. Civ. P. 30(b)(1) Notice in General. *A party who wants to depose a person by oral questions must give reasonable written notice to every other party. The notice must state the time and place of the deposition and, if known, the deponent's name and address. If the name is unknown, the notice must provide a general description sufficient to identify the person or the particular class or group to which the person belongs.*

Fed. R. Civ. P. 30(b)(1) provides for the taking of a discovery deposition of a natural person. An individual witness deposition under Fed. R. Civ. P. 30(b)(1) seeks information regarding an individual's personal knowledge of facts. If the party is a corporation, organization, partnership association or other juristic person, Fed. R. Civ. P. 30(b)(1) allows an adverse party to notice the deposition of a particular officer, director, or managing agent of a party organization. [Note 1.] Taking a deposition of a party's officer, director, or

managing agent in his or her individual capacity under Fed. R. Civ. P. 30(b)(1) is different from taking a deposition of a party's officer, director, or managing agent in his or her organizational capacity under Fed. R. Civ. P. 30(b)(1) or as an organization's representative under Fed. R. Civ. P. 30(b)(6). The deposition of a party's officer, director, or managing agent in his or her individual capacity probes that individual deponent's personal knowledge of the facts and not that of the party organization. [Note 2.] On the other hand, a Fed. R. Civ. P. 30(b)(1) deposition of a named officer, director, or managing agent of the party organization in his or her organizational capacity, just like a Fed. R. Civ. P. 30(b)(6) deposition taken of a representative of an organization, is testimony of the organization. Assuming that the organization is a party, the testimony elicited from a Fed. R. Civ. P. 30(b)(1) deposition of a named officer, director, or managing agent of the organization in his or her organizational capacity may be used at trial by the adverse party for any purpose. [Note 3.] See TBMP § 412.06(a) for information regarding the taking of a deposition of a high-level official or executive of a corporation. See TBMP § 404.06(b) for information regarding the taking of a deposition of a corporation, organization, partnership, association, or other juristic person under Fed. R. Civ. P. 30(b)(6).

An employee or agent of an organization who does not qualify as an officer, director, or managing agent is not subject to deposition by notice under Fed. R. Civ. P. 30(b)(1). [Note 4.] If a person does not qualify as an officer, director, or managing agent, he or she must be treated as a non-party witness. [Note 5.]

It is possible for a witness to be deposed in his or her individual capacity under a Fed. R. Civ. P. 30(b)(1) notice of deposition and in his or her representative capacity as a Fed. R. Civ. P. 30(b)(6) designee under a Fed. R. Civ. P. 30(b)(6) notice of deposition. [Note 6.]

For more information regarding depositions of natural persons, both parties and non-parties, see TBMP § 404.03.

NOTES:

1. *United States v. One Parcel of Real Estate at 5860 North Bay Road, Miami Beach, Fla.*, 121 F.R.D. 439, 440 (S.D. Fla. 1988).

2. *See* 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2103 (3d ed. 2020) (discussing differences between a Fed. R. Civ. P. 30(b)(6) deposition and a "normal deposition").

3. *United States v. One Parcel of Real Estate at 5860 North Bay Road, Miami Beach, Fla.*, 121 F.R.D. 439, 440 (S.D. Fla. 1988).

4. *JSC Foreign Economic Association Technostroyexport v. International Development and Trade Services, Inc.*, 220 F.R.D. 235, 238 (S.D.N.Y 2004).

5. *JSC Foreign Economic Association Technostroyexport v. International Development and Trade Services, Inc.*, 220 F.R.D. 235, 238 (S.D.N.Y 2004). *See, e.g., HighBeam Marketing LLC v. Highbeam Research LLC*, 85 USPQ2d 1902, 1906 (TTAB 2008) (expert witness in employ of opposer for Board opposition proceeding was not an officer, director, or managing agent of opposer and was "technically a non-party witness" subject to deposition by subpoena).

6. *See* Fed. R. Civ. P. 30(b)(6) ("This paragraph (6) does not preclude a deposition by any other procedure allowed by these rules."); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d

1672, 1673 (TTAB 2005) (noting that Board granted motion to continue deposition of an officer in his capacity as Fed. R. Civ. P. 30(b)(6) witness and in his individual capacity).

404.06(b) Fed. R. Civ. P. 30(b)(6) Deposition of a Corporation, Organization, Partnership, Association, or Other Juristic Person

Fed. R. Civ. P. 30(b)(6) Notice or Subpoena Directed to an Organization. *In its notice or subpoena, a party may name as the deponent a public or private corporation, a partnership, an association, a governmental agency, or other entity and must describe with reasonable particularity the matters for examination. The named organization must then designate one or more officers, directors, or managing agents, or designate other persons who consent to testify on its behalf; and it may set out the matters on which each person designated will testify. A subpoena must advise a nonparty organization of its duty to make this designation. The persons designated must testify about information known or reasonably available to the organization. This paragraph (6) does not preclude a deposition by any other procedure allowed by these rules.*

The preferred method for deposing a corporation, organization, partnership, association, or other juristic person is through a deposition under Fed. R. Civ. P. 30(b)(6). [Note 1.] A Fed. R. Civ. P. 30(b)(6) deposition provides a party an efficient way to find out details about the organization as well as learn information that might warrant further exploration through individual depositions of natural persons.

The deponent at a Fed. R. Civ. P. 30(b)(6) deposition is the organization, and the organization speaks through the representative appearing at the deposition. [Note 2.] A Fed. R. Civ. P. 30(b)(6) witness is responsible for providing all the relevant information known or reasonably available to the organization and his or her answers bind the organization. [Note 3.] A party may notice a Fed. R. Civ. P. 30(b)(6) deposition of an organization without naming a specific person to be deposed, instead describing the information sought. The organization then must designate one or more individuals to testify on the organization's behalf. [Note 4.] A party seeking to depose the adverse party organization through a particular officer, director, or managing agent may notice the deposition of that officer, director, or managing agent, in their organizational capacity, under Fed. R. Civ. P. 30(b)(1). [Note 5.] See TBMP § 404.03 and TBMP § 404.06(a) for information regarding depositions of natural persons, both parties and non-parties.

When an organization is named as a deponent by a party seeking discovery, the subject matter of the deposition is to be described with reasonable particularity in the notice. [Note 6.] An organization served with a Fed. R. Civ. P. 30(b)(6) notice of deposition has an obligation not only to pick and produce persons who have knowledge of the subject matter identified in the notice [Note 7] but also to prepare those persons so that they can give complete, knowledgeable, and binding answers as to matters known or reasonably available to the organization. [Note 8.] The organization may either produce as many deponents as are necessary to respond to the areas of inquiry in the notice if there is no witness with personal knowledge of all areas of inquiry, or alternatively, may produce a witness who reviews the organization's records to become familiar with the topics for the deposition so that he or she may give knowledgeable and binding answers for the organization. [Note 9.] If more than one Fed. R. Civ. P. 30(b)(6) witness will be designated, those individuals should be identified and the areas on which each person will testify be described. [Note 10.] Even if no current employees have knowledge of matters identified in the notice, an organization is not relieved of preparing a Fed. R. Civ. P. 30(b)(6) designee for deposition to the extent that such matters are reasonably available to the organization from past documents, past employees, or other sources. [Note 11.]

If it becomes obvious during the course of a Fed. R. Civ. P. 30(b)(6) deposition that the organization's designee is deficient regarding his or her knowledge of matters reasonably known to the organization, the

organization is obliged to provide a substitute and to prepare a designee to provide testimony in areas as to which its other representative was uninformed. [Note 12.]

A party may be subject to a motion to compel for failure to designate a person pursuant to Fed. R. Civ. P. 30(b)(6) or if such designated person fails to appear for deposition or fails to answer any question propounded in a discovery deposition. [Note 13.] A party may be subject to sanctions for failure of a designated person to attend the Fed. R. Civ. P. 30(b)(6) discovery deposition if after being served with proper notice, the party informs the party seeking the deposition that no response will be made. [Note 14.] The production of an unprepared witness is tantamount to a failure to appear. [Note 15.]

For more information regarding motions to compel and motions for sanctions, see TBMP § 523 and TBMP § 527.

Even though more than one person may be designated to testify under Fed. R. Civ. P. 30(b)(6) on various topics identified in the deposition notice, for purposes of the ten deposition limit under Fed. R. Civ. P. 30(a)(2)(A)(i), which also applies in Board proceedings, [Note 16], the Fed. R. Civ. P. 30(b)(6) deposition is treated as a single deposition. [Note 17.] For purposes of the time limitation under Fed. R. Civ. P. 30(d)(1) limiting a deposition to "1 day of 7 hours," the deposition of each designated person under a Fed. R. Civ. P. 30(b)(6) notice of deposition is considered a separate deposition. [Note 18.]

Prior deposition testimony from an individual witness on a particular topic, does not relieve a party organization of its responsibility to designate a witness in response to a Fed. R. Civ. P. 30(b)(6) notice of deposition on that topic as individual witness testimony under Fed. R. Civ. P. 30(b)(1) is not binding on the organization. [Note 19.]

NOTES:

1. *Folwell v. Hernandez*, 210 F.R.D. 169, 173 (M.D.N.C. 2002). *See also City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1672 n.4 (TTAB 2013) (citing Fed. R. Civ. P. 30(b)(6) Advisory Committee Notes) ("one purpose of this rule is that it 'will curb the "bandying" by which officers or managing agents of a corporation are deposed in turn but each disclaims knowledge of facts that are clearly known to persons in the organization and thereby to it.'").

2. Fed. R. Civ. P. 30(b)(6). *See Pioneer Drive, LLC v. Nissan Diesel America, Inc.*, 262 F.R.D. 552, 558 (D. Mont., 2009) (Fed. R. Civ. P. 30(b)(6) designee speaks for the organization as a whole and must make efforts to be able to do so). 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2103 (3d ed. 2020).

3. Fed. R. Civ. P. 30(b)(6); 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2103 (3d ed. 2020).

4. *Folwell v. Hernandez*, 210 F.R.D. 169, 172 (M.D.N.C. 2002). ("One of the important consequences of Rule 30(b)(6) is that under it, only the [organization] selects the persons who will testify.")

5. *See JSC Foreign Economic Association Technostroyexport v. International Development and Trade Services, Inc.*, 220 F.R.D. 235, 238 (S.D.N.Y. 2004) (Although a corporate officer, director, or managing agent may be subject to deposition by notice under Fed. R. Civ. P. 30(b)(1), a corporate employee or agent who does not qualify as an officer, director, or managing agent of the corporation is not subject to deposition by notice under Fed. R. Civ. P. 30(b)(1)). *Cf. HighBeam Marketing LLC v. Highbeam Research LLC*, 85

USPQ2d 1902, 1906 (TTAB 2008) (expert witness in employ of opposer for Board opposition proceeding was not an officer, director or managing agent of opposer and was "technically a non-party witness" subject to deposition by subpoena).

6. Fed. R. Civ. P. 30(b)(6).

7. *City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1672 n.4 (TTAB 2013) ("Rule 30(b)(6) anticipates that a party's designated witness will not necessarily have personal knowledge of all matters but will nonetheless offer testimony regarding information that the 'party' should be able to provide."); *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2049 n.5 (TTAB 1988). *See also Mattel Inc. v. Walking Mountain Productions*, 353 F3d 792, 69 USPQ2d 1257, 1260 n.4 (9th Cir. 2003) ("Rule 30(b)(6) depositions . . . are often referred to as 'persons most knowledgeable' or 'persons most qualified' depositions because 'the notice of deposition or subpoena is directed at the entity itself' and '[t]he entity will then be obligated to produce the "most qualified" person [or persons] to testify on its behalf . . . .'").

8. *A&E Products Group L.P. v. Mainetti USA Inc.*, 70 USPQ2d 1080, 1086 (S.D.N.Y. 2004) (and cases cited therein).

9. *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1605 (TTAB 2002).

10. Fed. R. Civ. P. 30(b)(6).

11. *United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc.*, 50 USPQ2d 1060, 1062 (E.D. Mich. 1998).

12. *United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc.*, 50 USPQ2d 1060, 1062 (E.D. Mich. 1998). *See Tulip Computers International B.V. v. Dell Computer Corp.*, 63 USPQ2d 1527, 1533 (D. Del. 2002) (purported failure to produce an adequately prepared Fed. R. Civ. P. 30(b)(6) witness may require a second deposition of that or another Fed. R. Civ. P. 30(b)(6) witness and payment of costs for second deposition).

13. 37 C.F.R. § 2.120(f). *See United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc.*, 50 USPQ2d 1060, 1063 (E.D. Mich. 1998) (motion to compel due to unprepared 30(b)(6) witness); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297-98 (TTAB 1997) (motion to compel appearance at Fed. R. Civ. P. 30(b)(6) deposition due to refusal to appear).

14. 37 C.F.R. § 2.120(h)(2).

15. *United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc.*, 50 USPQ2d 1060, 1061 (E.D. Mich. 1998).

16. *See Spliethoff's Bevrachtingskantoor B.V. v. United Yacht Transport LLC dba United Yacht Transport*, 2020 USPQ2d 10605, at *2 (TTAB 2020) (the deposition limit of the Federal Rules of Civil Procedure applies in Board proceedings).

17. Fed. R. Civ. P. 30(b)(6) Notes of Advisory Committee on Rules –1993 Amendment.

18. Fed. R. Civ. P. 30(d) Committee Notes on Rules – 2000 Amendment.

19. *Cf. Foster-Miller Inc. v. Babcock & Wilcox Canada*, 210 F.3d 1, 54 USPQ2d 1193, 1205 (1st Cir. 2000) (fact that examining party had previously taken individual depositions of employees who were regarded as most knowledgeable on certain topics identified in a Fed. R. Civ. P. 30(b)(6) notice of deposition does not obviate responsibility of responding party to designate and produce those individuals as witnesses competent to testify on those topics on behalf of corporation).

404.06(c) Time for Deposition

Fed. R. Civ. P. 30(d)(1) Duration. *Unless otherwise stipulated or ordered by the court, a deposition is limited to 1 day of 7 hours. The court must allow additional time consistent with Rule 26(b)(1) and (2) if needed to fairly examine the deponent or if the deponent, another person, or any other circumstance impedes or delays the examination.*

A deposition is limited to one day of seven hours unless stipulated by the parties or otherwise authorized by Board order. [Note 1.] Only actual deposition time counts against the presumptive limit; reasonable lunch and other breaks do not count against the seven hours. [Note 2.] For Fed. R. Civ. P. 30(b)(6) depositions, the deposition of each designated person is considered a separate deposition for purposes of the durational limit. [Note 3.]

The party seeking an order extending the examination or otherwise altering the time limitation is expected to show good cause. [Note 4.] Fed. R. Civ. P. 30(d)(1) allows for additional time consistent with Fed. R. Civ. P. 26(b)(2) if needed for fair examination of the deponent. [Note 5.] If the deponent or other person impedes or delays examination, additional time must be allowed. [Note 6.] Additional time for deposition should be allowed if examination is delayed by "other circumstance" which might include "a power outage, health emergency, or other event." [Note 7.] Orders directing shorter depositions or limited periods on several days are permitted. [Note 8.]

The parties are expected to make reasonable accommodations to obviate the need for motion practice before the Board regarding deposition time limits. However, a party who requires Board intervention may wish to contact the Board attorney by telephone for assistance. *See* TBMP § 413.01.

NOTES:

1. Fed. R. Civ. P. 30(d)(1).

2. Fed. R. Civ. P. 30(d) Committee Notes on Rules – 2000 Amendment.

3. Fed. R. Civ. P. 30(d) Committee Notes on Rules – 2000 Amendment.

4. Fed. R. Civ. P. 30(d) Committee Notes on Rules – 2000 Amendment.

5. Fed. R. Civ. P. 30(d) Committee Notes on Rules – 2000 Amendment.

6. Fed. R. Civ. P. 30(d) Committee Notes on Rules – 2000 Amendment.

7. Fed. R. Civ. P. 30(d) Committee Notes on Rules – 2000 Amendment.

8. Fed. R. Civ. P. 30(d) Committee Notes on Rules – 2000 Amendment; *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1677 (TTAB 2005) (limiting depositions of three deponents to three hours per deponent and conducted consecutively over one and one half days).

404.06(d) Re-Deposing a Witness

Fed. R. Civ. P. 30(a). When A Deposition May Be Taken.

* * * *

(2) ***With Leave.*** *A party must obtain leave of court, and the court must grant leave to the extent consistent with Rule 26(b)(1) and (2):* * * * *

(A) *if the parties have not stipulated to the deposition and:* * * * *

(ii) *the deponent has already been deposed in the case;* * * * *

When a person has already been deposed in the case, a party must seek leave of the Board to take a second deposition if the parties have not stipulated thereto. [Note 1.]

The decision to grant or deny leave to re-depose a witness is at the discretion of the Board and is guided by Fed. R. Civ. P. 26(b)(1) and (2). [Note 2.]

In deciding the motion, the Board will consider whether the discovery sought is unreasonably cumulative or duplicative, or is obtainable from some other source that is more convenient, less burdensome, or less expensive; the party seeking discovery has had ample opportunity by discovery in the action to obtain the information sought; and the burden or expense of the proposed discovery outweighs its likely benefit. [Note 3.]

The requirement to seek leave does not apply if the deposition is temporarily recessed for the convenience of counsel or the deponent, or to enable additional materials to be gathered for review or discussion during the deposition. [Note 4.] If significant travel costs would be incurred to resume the deposition, the parties should consider the possibility of conducting the remaining examination by telephonic or other remote means, if feasible. [Note 5.]

NOTES:

1. Fed. R. Civ. P. 30(a)(2)(A)(ii).

2. Fed. R. Civ. P. 30(a)(2).

3. Fed. R. Civ. P. 26(b)(2)(C)(i)-(iii); *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1605 (TTAB 2002) (denying motion to take a second Fed. R. Civ. P. 30(b)(6) witness deposition when a designated Fed. R. Civ. P. 30(b)(6) witness had already testified at length on the same noticed topics).

4. Fed. R. Civ. P. 30(a)(2)(A)(ii) Notes of Advisory Committee on Rules – 1993 Amendment. *Cf. Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1673 (TTAB 2005) (noting that Board had previously granted motion to compel continued deposition of officer in individual and corporate capacity because original deposition had been adjourned to enable completion of document production).

5. Fed. R. Civ. P. 30(a)(2)(A)(ii) Notes of Advisory Committee on Rules – 1993 Amendment.

404.07 Discovery Depositions on Written Questions

Discovery depositions on written questions are taken in the manner prescribed by 37 C.F.R. § 2.124.

404.07(a) Depositions on Written Questions: Before Whom Taken

37 C.F.R. § 2.124(a) *A deposition upon written questions may be taken before any person before whom depositions may be taken as provided by Rule 28 of the Federal Rules of Civil Procedure.*

A deposition on written questions, like a deposition on oral examination, may be taken before the persons described in Fed. R. Civ. P. 28. [Note 1.] TBMP § 404.04.

NOTES:

1. 37 C.F.R. § 2.124(a).

404.07(b) Depositions on Written Questions: When Taken

37 C.F.R. § 2.120(a)(3) . . . *Discovery depositions must be properly noticed and taken during the discovery period.* * * * *

Discovery depositions must be both properly noticed and taken during the discovery period. [Note 1.] TBMP § 404.01. Thus, it is recommended that a party that desires to take a discovery deposition on written questions initiate the procedure early in its discovery period. The question whether to suspend discovery activities unrelated to a proposed discovery deposition on written questions, or to allow other discovery activities to proceed, is a matter left to the Board's exercise of its discretion to schedule matters before it. [Note 2.]

NOTES:

1. 37 C.F.R. § 2.120(a)(3).

2. *Cf.* 37 C.F.R. § 2.124(d)(2) (Board "shall" suspend for testimonial deposition on written questions).

404.07(c) Depositions on Written Questions: Place of Deposition

For information concerning the place where a discovery deposition on written questions is taken, see TBMP § 404.03.

404.07(d) Depositions on Written Questions: Notice of Deposition

37 C.F.R. § 2.124(b)(2) *A party desiring to take a discovery deposition upon written questions shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board. The notice shall state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify the witness or the particular class or group to which he or she belongs shall be stated in the notice, and the party from*

whom the discovery deposition is to be taken shall designate one or more persons to be deposed in the same manner as is provided by Rule 30(b)(6) of the Federal Rules of Civil Procedure.

37 C.F.R. § 2.124(c) *Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.*

37 C.F.R. § 2.124(d)(1) *Every notice served on any adverse party under the provisions of paragraphs (b)(1) and (2) of this section, for the taking of direct examination, shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition.* * * * *

37 C.F.R. § 2.124(d)(3) *Service of written questions, responses, and cross-examination questions shall be in accordance with § 2.119(b).*

A party that desires to take a discovery deposition on written questions must serve notice thereof on each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board. [Note 1.]

The notice must state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify the person is to be provided so the responding party can designate one or more persons to be deposed. The notice must also be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken. [Note 2.] Copies of the notice served on adverse parties must be accompanied by the written questions to be propounded on behalf of the deposing party. [Note 3.]

For further information concerning notices of deposition in general, see TBMP § 404.05.

NOTES:

1. 37 C.F.R. § 2.124(b)(2).

2. 37 C.F.R. § 2.124(b)(2) and 37 C.F.R. § 2.124(c).

3. 37 C.F.R. § 2.124(d)(1).

404.07(e) Depositions on Written Questions: Examination of Witness

37 C.F.R. § 2.124(d)(1) . . . *Every notice served on any adverse party under the provisions of paragraph (b)(3) of this section, for the taking of cross-examination, shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the cross-examination. Within twenty days from the date of service of the notice of taking direct examination or service of a testimony affidavit or declaration, any adverse party may serve cross questions upon the party who proposes to take the deposition. Any party who serves cross questions, whether in response to direct examination questions or under paragraph (b)(3) of this section, shall also serve every other adverse party. Within ten days from the date of service of the cross questions, the party who proposes to take the deposition, or who earlier offered testimony of the witness by affidavit or declaration, may serve redirect questions on every adverse party. Within ten days from the date of service of the redirect questions, any party who served cross questions may serve recross questions upon the party who proposes to take the deposition or who earlier offered testimony of the witness by affidavit or declaration; any party who serves recross questions shall also serve every other adverse party. Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may*

be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.

37 C.F.R. § 2.124(d)(2) *Upon motion for good cause by any party, or upon its own initiative, the Trademark Trial and Appeal Board may extend any of the time periods provided by paragraph (d)(1) of this section. * * * *

37 C.F.R.§ 2.124(d)(3) *Service of written questions, responses, and cross-examination questions shall be in accordance with § 2.119(b).*

37 C.F.R. § 2.124(e) *Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.*

Within 20 days from the date of service of the notice in accordance with 37 C.F.R. § 2.119(b), [Note 1], any adverse party may serve cross questions on the deposing party. A party that serves cross questions on the deposing party must also serve copies thereof on every other adverse party. Within 10 days from the date of service of the cross questions in accordance with 37 C.F.R. § 2.119(b), the deposing party may serve redirect questions on every adverse party. Within 10 days from the date of service of the redirect questions in accordance with 37 C.F.R. § 2.119(b), any party that served cross questions may serve recross questions on the deposing party. A party which serves recross questions on the deposing party must also serve copies thereof on every other adverse party. [Note 2.]

Written objections to questions may be served on the party that propounded the questions. A party that serves objections on a propounding party must also serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within 10 days from the date of service of the objections in accordance with 37 C.F.R. § 2.119(b). The substitute questions must also be served on every other adverse party. [Note 3.]

As all discovery depositions must be completed within the discovery period, including depositions on written questions, on motion for good cause filed by any party, or on its own initiative, the Board may extend any of the time periods specified in 37 C.F.R. § 2.124(d)(1), that is, the time periods for serving cross questions, redirect questions, recross questions, objections, and substitute questions to allow for the orderly completion of the depositions on written questions. [Note 4.]

Within 10 days after the last date when questions, objections, or substitute questions may be served, the deposing party must mail a copy of the notice and copies of all the questions to the officer designated in the notice. A copy of the notice and of all the questions mailed to the officer must also be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions, and shall record each answer immediately after the corresponding question. [Note 5.] **Please Note:** There is no longer an additional five days to act under 37 C.F.R. 2.119(c) when service is made by first-class mail, Priority Mail Express®, or overnight courier. [Note 6.]

NOTES:

1. 37 C.F.R. § 2.119(c).

2. 37 C.F.R. § 2.124(d)(1). *See Nahshin v. Product Source International LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013) (discussing the procedure for deposition on written questions under 37 C.F.R. § 2.124(d)); *Fischer GmbH. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979).

3. 37 C.F.R. § 2.124(d)(1). *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990).

4. See 37 C.F.R. § 2.124(d)(2) for information regarding suspension of proceedings for testimonial depositions on written questions.

5. 37 C.F.R. § 2.124(e).

6. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016).

404.07(f) Depositions on Written Questions: Objections

37 C.F.R. § 2.124(d)(1) . . . *Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.*

37 C.F.R. § 2.124(d)(3) *Service of written questions, responses, and cross-examination questions shall be in accordance with § 2.119(b).*

37 C.F.R. § 2.124(g) *Objections to questions and answers in depositions upon written questions may be considered at final hearing.*

Written objections to questions propounded for a deposition on written questions may be served on the party that propounded the questions. Any party that serves written objections on a propounding party must also serve a copy of the objections on every other adverse party. [Note 1.] For information regarding objections to testimony depositions on written questions, see TBMP § 703.02(k).

Objections to questions and answers in depositions on written questions, as in oral depositions, generally are considered by the Board (unless waived) at final hearing. [Note 2.] If a party's objections have been overcome by service of revised questions, the objecting party should file and serve notice of which objections no longer need be considered by the Board. Further, objections not maintained in a brief at final hearing may be considered waived by the Board. *See*TBMP § 707.03(c) and TBMP § 707.04.

For further information concerning the raising of objections to discovery depositions, see TBMP § 404.08. For information concerning the raising of objections to a notice of reliance on a discovery deposition, see TBMP § 707.02 and TBMP § 532.

NOTES:

1. 37 C.F.R. § 2.124(d)(1).

2. 37 C.F.R. § 2.124(g); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (objections based on relevancy deferred until final hearing). *See also Nahshin v. Product Source International LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013) (discussing objections on depositions on written questions under 37 C.F.R. § 2.124(d)(1)).

404.07(g) Depositions on Written Questions: Form of Deposition; Signature

37 C.F.R. § 2.124(e) . . . *The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question.* * * * *

The officer before whom a deposition on written questions is taken shall record each answer immediately after the corresponding question. [Note 1.]

For further information concerning the form of a deposition taken in an inter partes proceeding before the Board, see 37 C.F.R. § 2.123(g) and TBMP § 703.01(i). For information concerning signature of a deposition taken in an inter partes proceeding before the Board, see 37 C.F.R. § 2.123(e)(5) and TBMP § 703.01(j).

NOTES:

1. 37 C.F.R. § 2.124(e).

404.07(h) Depositions on Written Questions: Certification of Deposition

37 C.F.R. § 2.124(e) *Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.*

After the officer designated in the notice of deposition has taken a deposition on written questions, the officer must certify the transcript of the deposition. When the transcript has been certified, the officer shall mail the transcript and exhibits to the party that took the deposition. [Note 1.] For further information concerning certification of a deposition taken in an inter partes proceeding before the Board, see TBMP § 703.01(k).

NOTES:

1. 37 C.F.R. § 2.124(e). *See* 37 C.F.R. § 2.123(f).

404.07(i) Depositions on Written Questions: Service, Correction, and Making the Deposition of Record

37 C.F.R. § 2.124(f) *The party who took the deposition shall promptly serve a copy of the transcript, copies of documentary exhibits, and duplicates or photographs of physical exhibits on every adverse party. It is the responsibility of the party who takes the deposition to assure that the transcript is correct (see § 2.125(c)). If the deposition is a discovery deposition, it may be made of record as provided by § 2.120(k). If the deposition is a testimonial deposition, the original, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be filed promptly with the Trademark Trial and Appeal Board.*

The party that took the deposition on written questions must promptly serve a copy of the transcript, with exhibits, on every adverse party. [Note 1.] See also TBMP § 703.01(m) for information regarding service of a testimony deposition transcript. The party that took the deposition must also assure that the transcript is correct. [Note 2.] For information concerning correction of errors in a testimony deposition taken in a Board inter partes proceeding, see TBMP § 703.01(n).

If the discovery deposition is to be made of record, the same procedures provided by 37 C.F.R. § 2.120(k) are to be followed. [Note 3.] With respect to making a discovery deposition of record, see TBMP § 704.09.

NOTES:

1. 37 C.F.R. § 2.124(f).

2. 37 C.F.R. § 2.124(f) and 37 C.F.R. § 2.125(b). *Cf. Hollywood Casino LLC v. Chateau Celeste, Inc.*, 116 USPQ2d 1988. 1994-97 (TTAB 2015) (while a party may submit an errata sheet correcting typographical errors to a deposition transcript, such party may not submit or rely upon an errata sheet which substantively changes the deposition testimony).

3. 37 C.F.R. § 2.124(f). *See also Fischer GmbH v. Molnar & Co., Inc.*, 203 USPQ 861, 866 n.6 (TTAB 1979).

404.07(j) Deposition on Written Questions: Utility

A deposition on written questions is a cumbersome, time-consuming procedure. It requires that cross questions, redirect questions, recross questions, and objections all be framed and served before the questions on direct examination have even been answered. Moreover, it deprives an adverse party of face-to-face confrontation and the opportunity to ask follow-up questions based on answers to previous questions. [Note 1.] For information regarding the utility of taking testimony depositions on written questions, see TBMP § 703.02(m).

Nevertheless, it has some utility. It may be the only means by which a deposition may be taken in a foreign country. Moreover, the deposition on written questions may be less expensive than the deposition on oral examination, and is usually more convenient for the witness.

NOTES:

1. 37 C.F.R. § 2.124(d)(1); *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1926 (TTAB 1989). *See also Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB

1990), *corrected at* 19 USPQ2d 1479; *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980); *Fischer GmbH v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979).

404.08 Discovery Deposition Objections

Objections made to the taking of a discovery deposition include errors and irregularities to the notice of deposition, the manner of taking the deposition, the form of a question or answer, the oath or affirmation or a party's conduct, and the disqualification of an officer. [Note 1.] Objections may also be made as to the competency of a witness or to the competency, relevancy, or materiality of discovery deposition testimony. [Note 2.]

NOTES:

1. Fed. R. Civ. P. 30(c)(2); Fed. R. Civ. P. 32(d)(1)-(2); Fed. R. Civ. P. 32(d)(3)(B).

2. Fed. R. Civ. P. 30(c)(2); Fed. R. Civ. P. 32(d)(3)(A).

404.08(a) Objections to Notice

Objections to errors and irregularities in a notice of the taking of a discovery deposition must be promptly served, in writing, on the party giving the notice; any such objections that are not promptly served are waived. [Note 1.] For information concerning the raising of objections to a notice of reliance on a discovery deposition, see TBMP § 707.02 and TBMP § 532. For information regarding a motion to quash a notice of deposition or for a protective order, see TBMP § 410, TBMP § 412, TBMP § 521, and TBMP § 526.

NOTES:

1. Fed. R. Civ. P. 32(d)(1). *Compare S. Industries Inc. v. Lamb-Weston Inc.* , 45 USPQ2d 1293, 1298 (TTAB 1997) (Board will not rule in advance of deposition as to whether information sought is confidential or otherwise objectionable); *Neville Chemical Co. v. Lubrizol Corp.* , 183 USPQ 184, 189 (TTAB1974) (objections to subject matter of deposition may only be raised during, not prior to, the deposition), with *Red Wing Co. v. J.M. Smucker Co.* , 59 USPQ2d 1861, 1864 (TTAB 2001) (objections to subject matter of Fed. R. Civ. P. 30(b)(6) deposition raised prior to deposition). *Cf.* with regard to notice of testimony depositions, 37 C.F.R. § 2.123(j); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1652 and 1655 (TTAB 2007) (overruling objections that notice of deposition was facially deficient and noting that a ruling on sufficiency of notice could have been made prior to the deposition by seeking a telephone conference with a Board attorney); *Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (premature taking of testimony deposition could have been corrected upon seasonable objection); *Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169 (TTAB 1984) (testimony deposition excluded where notice did not name witness and objection was timely made and consistently maintained), *reconsideration granted on other grounds*, 3 USPQ2d 1708 (TTAB 1984); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982).

404.08(b) Objections as to Disqualification of Officer

An objection to the taking of a discovery deposition because of a disqualification of the officer before whom the deposition is to be taken is waived unless it is made before the deposition begins, or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence. [Note 1.]

NOTES:

1. Fed. R. Civ. P. 32(d)(2). *Cf* . 37 C.F.R. § 2.123(j).

404.08(c) Objections During Deposition

Fed. R. Civ. P. 30(c)(2) Objections. *An objection at the time of the examination—whether to evidence, to a party's conduct, to the officer's qualifications, to the manner of taking the deposition, or to any other aspect of the deposition—must be noted on the record, but the examination still proceeds; the testimony is taken subject to any objection. An objection must be stated concisely in a nonargumentative and nonsuggestive manner. A person may instruct a deponent not to answer only when necessary to preserve a privilege, to enforce a limitation ordered by the court, or to present a motion under Rule 30(d)(3).*

Fed. R. Civ. P. 32(d) Waiver of Objections.

(3) ***To the Taking of the Deposition.***

(A) ***Objection to Competence, Relevance, or Materiality.*** *An objection to a deponent's competence—or to the competence, relevance, or materiality of testimony—is not waived by a failure to make the objection before or during the deposition, unless the ground for it might have been corrected at that time.*

(B) ***Objection to an Error or Irregularity.*** *An objection to an error or irregularity at an oral examination is waived if:*

(i) *it relates to the manner of taking the deposition, the form of a question or answer, the oath or affirmation, a party's conduct, or other matters that might have been corrected at that time; and*

(ii) *it is not timely made during the deposition.*

Objections to the competency of a witness or to the competency, relevancy, or materiality of discovery deposition testimony are not waived by failure to make them before or during the taking of the deposition, unless the ground of the objection is one which might have been obviated or removed if presented at that time. [Note 1.]

In the case of a discovery deposition taken on oral examination, objections to errors and irregularities occurring at the deposition in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of the parties, and objections to errors of any kind which might be obviated, removed, or cured if promptly presented, are waived unless seasonably made at the deposition. [Note 2.]

For information concerning objections to the form of questions in the case of a discovery deposition on written questions, see TBMP § 404.07(f).

If a party believes that a question propounded at a discovery deposition is improper, it may state its objection thereto. Objections should be made concisely and in a nonargumentative manner. [Note 3.] Objections should ordinarily be limited to those that under Fed. R. Civ. P. 32(d)(3) might be waived if not made at that time. [Note 4.] Questions objected to ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information which is, for example, privileged or not otherwise subject to disclosure under the terms of either the Board's standard protective order or, if the parties have made modifications thereto, the parties' agreed and approved protective order. [Note 5.] If a witness, having stated an objection to a discovery deposition question, answers the question subject to the objection, and the deposition is subsequently made of record in the proceeding pursuant to the provisions

of 37 C.F.R. § 2.120(k)(1), 37 C.F.R. § 2.120(k)(2), 37 C.F.R. § 2.120(k)(3)(i), or 37 C.F.R. § 2.120(k)(4), the propriety of the objection will be considered by the Board at final hearing when the objection is preserved in the final brief; that is, the Board will evaluate the testimony in light of the stated objection. [Note 6.]

For information concerning the propounding party's options if a witness not only objects to, but also refuses to answer, a particular question during a discovery deposition, see TBMP § 411.04. [Note 7.]

NOTES:

1. Fed. R. Civ. P. 32(d)(3)(A). *Cf.* 37 C.F.R. § 2.123(k); *Nahshin v. Product Source International LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013) (in unusual circumstance involving testimonial deposition on written questions where adverse party had opportunity to review deponent's answers before drafting its cross-questions, procedure was akin to an oral deposition and adverse party's failure to object at the time of service of cross-questions when defect could have been cured resulted in waiver).

2. Fed. R. Civ. P. 32(d)(3)(B). *Cf.* 37 C.F.R. § 2.123(j).

3. Fed. R. Civ. P. 30(c)(2).

4. Fed. R. Civ. P. 30(d); Fed. R. Civ. P. 30(d) Notes of Advisory Committee on Rules – 1993 Amendment.

5. *See* 37 C.F.R. § 2.116(g) and 37 C.F.R. § 2.123(e)(4); Fed. R. Civ. P. 26(b), 30(c)(2), and 37(a); Fed. R. Evid. 501; 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2113 (3d ed. 2020). *See also Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1676 (TTAB 1988) (Board, upon motion to compel, allowed parties time to work out protective order under which confidential information would be provided).

6. 37 C.F.R. § 2.120(k)(3)(i); *Fischer GmbH. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979) (objections to discovery deposition questions should be preserved and argued in the briefs at final hearing); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974). *Cf. Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (objections made during testimonial deposition waived due to failure to preserve the objections by renewing them in brief); *Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741, 1746-47 (TTAB 2006) (while objections made at time of testimonial deposition were renewed in brief on case, Board deemed objections insufficiently preserved because brief failed to identify the objections with specificity).

7. *See also Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974) (if party objects to and refuses to answer certain deposition questions, party deposing may seek subpoena from court to compel responses or file motion with Board to compel answers).

404.09 Discovery Depositions Compared to Testimony Depositions

A discovery deposition, like a testimony deposition, may be taken either on oral examination or on written questions. [Note 1.] In fact, the actual taking of a discovery deposition is similar to the taking of a testimony deposition. Nevertheless, there are substantial differences between the two, stemming from the differences between the discovery and trial stages of a proceeding. [Note 2.] Some of the most significant differences are discussed below. A discovery deposition is a broad discovery device used by a party to obtain from an adversary information about the adversary's case, or to obtain from a non-party information that may be helpful to the deposing party's case. The discovery deposition is taken of the adversary or a non-party, or

an official or employee of the adversary or a non-party. A testimony deposition, on the other hand, is a narrower device used by a party to present evidence in support of its own case. During a party's testimony period, testimony depositions are taken, by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness testifying (either willingly or under subpoena) on behalf of the party. [Note 3.]

The discovery deposition may only be taken during the discovery period, which is ongoing for all parties at the same time. *See*TBMP § 403.02. [Note 4.] A party may only take a testimony deposition during the party's assigned testimony period; each party has an assigned testimony period, and only the party to which a particular testimony period is assigned may take testimony during that particular period. [Note 5.]

In a discovery deposition, a party may seek information that would be inadmissible at trial, provided that the information sought appears relevant to any party's claim or defense and proportional to the needs of the case. [Note 6.] In a testimony deposition, a party may properly adduce only evidence admissible under the applicable rules of evidence; inadmissibility is a valid ground for objection. [Note 7.]

In both types of depositions, questions objected to ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information that is, for example, privileged or not otherwise subject to disclosure under the terms of either the Board's standard protective order or, if the parties have made modifications thereto, the parties' agreed and approved protective order. [Note 8.] Both types of depositions are taken out of the presence of the Board, and if a witness not only objects to, but also refuses to answer a particular question, and if the deposition is being taken pursuant to a subpoena, issued pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45, the propounding party may attempt to obtain an immediate ruling on the propriety of the objection only by adjourning the deposition and applying, under 35 U.S.C. § 24, to the federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer. [Note 9.]

In the case of a discovery deposition, there is also available to the propounding party the simpler and more convenient alternative of completing the deposition and then filing a motion with the Board to compel the witness to answer the unanswered question. [Note 10.] A motion to compel is not available, however, in the case of a testimony deposition taken in a proceeding before the Board, nor is there any other mechanism for obtaining from the Board, prior to final hearing, a ruling on the propriety of an objection to a question propounded during a testimony deposition. [Note 11.]

Accordingly, in those cases where the witness in a testimony deposition refuses to answer a particular question, no court action is sought, and the Board finds at final hearing that the objection was not well taken, the Board may presume that the answer would have been unfavorable to the position of the party whose witness refused to answer, or may find that the refusal to answer reduces the probative value of the witness testimony. [Note 12.]

A discovery deposition does not form part of the evidentiary record in a case unless a party entitled to offer it into evidence files, during the party's testimony period, the deposition together with a notice of reliance thereon. [Note 13.] TBMP § 704.09. That is, the offering of a discovery deposition in evidence is voluntary, not mandatory. [Note 14.] See TBMP § 704.09 for information regarding introducing discovery depositions into evidence.

Every testimony deposition taken must be filed, and, when filed, becomes part of the record; a notice of reliance thereon is not necessary. [Note 15.] TBMP § 703.01(l).

The discovery deposition of an adverse party may be taken on notice alone. TBMP § 404.03. However, the testimony deposition of an adverse party, unless obtained voluntarily (or as cross-examination under 37 C.F.R. § 2.123(a) after the adverse party takes testimony by affidavit or declaration), may only be taken pursuant to a subpoena issued by a United States district court. [Note 16.] See TBMP § 703.01(f) for information regarding securing attendance of an adverse party or non-party and TBMP § 707.03(d) for information regarding the refusal of a party to answer testimony deposition question.

NOTES:

1. *See* 37 C.F.R. § 2.120(b); 37 C.F.R. § 2.120(c); 37 C.F.R. § 2.123(a); 37 C.F.R. § 2.124; *see also* Fed. R. Civ. P. 30 and 31.

2. *See Spliethoff's Bevrachtingskantoor B.V. v. United Yacht Transport LLC dba United Yacht Transport*, 2020 USPQ2d 10605, at *5-6 (TTAB 2020) (comparing discovery and testimony depositions).

3. *See Fischer GmbH v. Molnar & Co.*, 203 USPQ 861, 865-66 (TTAB 1979); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978). *Cf. Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987) ("The purpose of discovery is to provide information which may aid a party in the preparation of its own case or in the cross-examination of its adversary's witnesses.").

4. *See Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978) (deposition notices served before discovery period ended for depositions scheduled after discovery period ended are untimely).

5. 37 C.F.R. § 2.121(a).

6. *See* Fed. R. Civ. P. 26(b)(1).

7. *See* 37 C.F.R. § 2.122(a) and 37 C.F.R. § 2.123(k).

8. *See* 37 C.F.R. § 2.116(g); 37 C.F.R. § 2.123(e)(4); Fed. R. Civ. P. 26(b)(5), 30(c)(2), and 37(a)(3)(B); Fed. R. Evid. 501; 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2113 (3d ed. 2020).

9. *See Ferro Corp. v. SCM Corp.*, 219 USPQ 346, 351 (TTAB 1983); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974).

10. 37 C.F.R. § 2.120(f); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974).

11. *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431-32 (TTAB 1998) (motion to compel not available for testimonial depositions); *Ferro Corp. v. SCM Corp.*, 219 USPQ 346, 351 (TTAB 1983) (should have applied to district court for order compelling answers).

12. *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (a refusal to answer, if found to be unjustified, may be construed against the objecting party).

13. *See* 37 C.F.R. § 2.120(k). *See also, e.g., Azalea Health Innovations, Inc. v. Rural Health Care, Inc.*, 125 USPQ2d 1236 (TTAB 2017) (absent stipulation of the parties or motion claiming exceptional circumstances granted by the Board, the discovery deposition of a non-party witness may not be introduced

into evidence via notice of reliance); *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009) (motion granted allowing opposer to offer into evidence discovery deposition of non-party witness residing in a foreign country via notice of reliance because witness unavailable during trial phase and not willing to appear voluntarily); *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1831 (TTAB 2013) (parties stipulated that either party "may use any and all discovery depositions" as testimonial depositions); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1847 n.5 (TTAB 2008) (parties stipulated in notice of reliance to use of discovery depositions as trial testimony); *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1014 (TTAB 2007) (applicant's discovery deposition submitted by applicant by way of notice of reliance with consent of opposer). *But see Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1901 (TTAB 2006) (discovery deposition of adverse party's president, although not submitted properly via notice of reliance was treated as being of record by the parties and therefore considered to have been stipulated into the record).

14. *See, e.g., Fischer GmbH v. Molnar & Co.* , 203 USPQ 861, 867 (TTAB 1979); 37 C.F.R. § 2.120(k)(1), 37 C.F.R. § 2.120(k)(2), and 37 C.F.R. § 2.120(k)(3).

15. *See generally* 37 C.F.R. § 2.123.

16. *See* 35 U.S.C. § 24; 37 C.F.R. § 2.120(b); 37 C.F.R. § 2.123(a); Fed. R. Civ. P. 30(b) and Fed. R. Civ. P. 45; *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976). For further information concerning differences between discovery and testimony depositions, see *Fischer GmbH v. Molnar & Co.*, 203 USPQ 861, 865-67 (TTAB 1979) (discovery deposition of non-party is not admissible as evidence under a notice of reliance absent compelling circumstances or consent of the adverse party given the functional and historical differences between discovery and trial); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 250 (TTAB 1978) (discovery and testimony depositions are "quite distinguishable"); *see also Azalea Health Innovations, Inc. v. Rural Health Care, Inc.*, 125 USPQ2d 1236 (TTAB 2017) (absent stipulation of the parties or motion claiming exceptional circumstances granted by the Board, the discovery deposition of a non-party witness may not be introduced into evidence via notice of reliance).

Please Note: Fed. R. Civ. P. 45(a)(2) and 45(f), as amended in 2013, both related to subpoenas, are not applicable as 35 U.S.C. § 24 is controlling. *See* 37 C.F.R. § 2.116(a) ("Except as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure.").

404.10 Limit on Number of Discovery Depositions

The Trademark Rules do not specify a limit on the number of discovery depositions. [Note 1.] Therefore, the deposition limit of the Federal Rules of Civil Procedure applies in Board proceedings. [Note 2.] Accordingly, each party in a Board inter partes proceeding is limited to conducting ten discovery depositions [Note 3], unless the parties agree otherwise by written stipulation [Note 4], or if the Board, in its discretion, authorizes a party to conduct one or more additional depositions based on that party's "particularized showing" of why the additional discovery is necessary, and the party establishes that each deposition previously taken without leave of the Board was necessary and the proposed additional deposition is proportional to the needs of the case in view of the Board's limited jurisdiction. [Note 5.]

For information on filing a motion for leave to serve additional depositions over the ten deposition limit, see TBMP § 519.

NOTES:

1. 37 C.F.R. § 2.120(b).

2. *See* 37 C.F.R. § 2.116(a); *Spliethoff's Bevrachtingskantoor B.V. v. United Yacht Transport LLC dba United Yacht Transport*, 2020 USPQ2d 10605, at *2 (TTAB 2020).

3. Fed. R. Civ. P. 30(a); 37 C.F.R. § 2.116(a).

4. Fed. R. Civ. P. 30(a)(2); *Spliethoff's Bevrachtingskantoor B.V. v. United Yacht Transport LLC dba United Yacht Transport*, 2020 USPQ2d 10605, at *4 (TTAB 2020).

5. *Spliethoff's Bevrachtingskantoor B.V. v. United Yacht Transport LLC dba United Yacht Transport*, 2020 USPQ2d 10605, at *2-4 (TTAB 2020).

405 Interrogatories

405.01 When Permitted and By Whom

A party may only serve written interrogatories on any other party during the discovery period if the serving party previously served or concurrently serves therewith its initial disclosures, absent a stipulation or a granted motion, or upon order of the Board to the contrary. [Note 1.] *See*TBMP § 403.02. Interrogatories must be served early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses will be due no later than the close of discovery. [Note 2.] TBMP § 403.02. Interrogatories may not be served on a non-party. [Note 3.]

NOTES:

1. 37 C.F.R. § 2.120(a)(3).

2. 37 C.F.R. § 2.120(a)(3). *See also Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268, 1270 (TTAB 2017) (discovery must be served "early enough … so that responses will be due no later than the close of discovery"); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69962 (October 7, 2016).

2. *See* Fed. R. Civ. P. 33; 37 C.F.R. § 2.120(d).

405.02 Scope

Interrogatories may seek any information that is discoverable under Fed. R. Civ. P. 26(b). [Note 1.] An interrogatory that is otherwise proper is not necessarily objectionable merely because it requires a party to give an opinion or contention that relates to fact or the application of law to fact. [Note 2.]

NOTES:

1. Fed. R. Civ. P. 33(a)(2).

2. Fed. R. Civ. P. 33(a)(2). *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1676 (TTAB 1988) (query whether opposer believes marks in question to be confusingly similar must be answered even though it requires opposer to draw legal conclusion). *See also Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313, 314 (TTAB 1973) ("interrogatories may relate to any matters which can be inquired into under FRCP 26(b)").

405.03 Limit on Number

405.03(a) Description of Limit

37 C.F.R. § 2.120(d) ***Interrogatories.*** *The total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional interrogatories upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. A motion for leave to serve additional interrogatories must be filed and granted prior to the service of the proposed additional interrogatories and must be accompanied by a copy of the interrogatories, if any, which have already been served by the moving party, and by a copy of the interrogatories proposed to be served.* * * * *

The total number of interrogatories which a party may serve on another party, in a proceeding, may not exceed 75, counting subparts, except that the Board may allow additional interrogatories on motion therefor showing good cause, or on stipulation of the parties. [Note 1.] *See*TBMP § 519. Parties may also stipulate that the limit on interrogatories shall be fewer than 75. [Note 2.]

NOTES:

1. *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1467 n.5 (TTAB 1990) ("good cause will generally be found only where a legitimate need for further discovery by means of interrogatories is shown . . . the fact that the additional interrogatories served by opposer may be relevant and narrowly drawn to a single issue is insufficient, in and of itself, to demonstrate good cause.").

2. 37 C.F.R. § 2.120(a)(2)(iv).

405.03(b) Application of Limit: Sets of Interrogatories

The numerical limit specified in 37 C.F.R. § 2.120(d) pertains to the total number of interrogatories that one party may serve on another party over the course of an entire proceeding, not just per set of interrogatories. Thus, if a party to a proceeding before the Board serves, over the course of the proceeding, two or more separate sets of interrogatories directed to the same party, the interrogatories in the separate sets would be added together for purposes of determining whether the numerical limit specified in the rule has been exceeded. [Note 1.]

Accordingly, a party which is preparing a first set of interrogatories should reserve a portion of its allotted 75 interrogatories (counting subparts) to use for follow-up discovery, unless it is sure that it will not be serving follow-up interrogatories.

NOTES:

1. *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1467 (TTAB 1990).

405.03(c) Application of Limit: Multiple Marks, Etc.

37 C.F.R. § 2.120(d) does not provide for extra interrogatories in cases where more than one mark is pleaded and/or attacked by the plaintiff (whether in a single proceeding, or in consolidated proceedings), because in such cases, the propounding party may simply request that each interrogatory be answered with respect to each involved mark of the responding party, and the interrogatories will be counted the same as if they pertained to only one mark. Similarly, the rule does not provide for extra interrogatories in cases where there is a counterclaim, because in a proceeding before the Board, the discovery information needed by a party for purposes of litigating the plaintiff's claim usually encompasses the information needed by that party for purposes of litigating a counterclaim. That is, the mere fact that a proceeding involves multiple marks (whether in a single proceeding, or in consolidated proceedings) and/or a counterclaim does not mean that a party is entitled to serve 75 interrogatories, counting subparts, for each mark, or for each proceeding that has been consolidated, or for both the main claim and the counterclaim. Nor does such fact, in and of itself, constitute good cause for a motion for leave to serve additional interrogatories. However, if a proceeding with multiple marks and/or a counterclaim involves unusually numerous or complex issues, these are factors that will be considered in determining a motion for leave to serve additional interrogatories.

405.03(d) Application of Limit: Counting Interrogatories

In determining whether the number of interrogatories served by one party on another exceeds the limit specified in 37 C.F.R. § 2.120(d), the Board will count each subpart within an interrogatory as a separate interrogatory, regardless of whether the subpart is separately designated (i.e., separately numbered or lettered). [Note 1.]

If an interrogatory includes questions set forth as numbered or lettered subparts, each separately designated subpart will be counted by the Board as a separate interrogatory. The propounding party will, to that extent, be bound by its own numbering system, and will not be heard to complain that an interrogatory, although propounded with separately designated subparts, should nevertheless be counted as a single interrogatory because the interrogatory concerns a single transaction, set of facts, etc., or because the division was made for clarification or convenience. [Note 2.]

On the other hand, if a propounding party sets forth its interrogatories as 75 or fewer separately designated questions (counting both separately designated interrogatories and separately designated subparts), but the interrogatories actually contain more than 75 questions, the Board will not be bound by the propounding party's numbering or designating system. Rather, the Board will look to the substance of the interrogatories, and count each question as a separate interrogatory. [Note 3.] For example, if two or more questions are combined in a single compound interrogatory, and are not set out as separate subparts, the Board will look to the substance of the interrogatory, and count each of the combined questions as a separate interrogatory. [Note 4.]

If an interrogatory contains both an initial question, and follow-up questions to be answered if the first is answered in the affirmative, the initial question and each follow-up question will be counted as separate interrogatories. [Note 5.]

Similarly, if an interrogatory begins with a broad introductory clause ("Describe fully the facts and circumstances surrounding applicant's first use of the mark XYZ, including:") followed by several subparts ("Applicant's date of first use of the mark on the goods listed in the application," "Applicant's date of first use of the mark on such goods in commerce," etc.), the Board will count the broad introductory clause and each subpart as a separate interrogatory, whether or not the subparts are separately designated. [Note 6.]

If an interrogatory requests information concerning more than one issue, such as information concerning both "sales and advertising figures," or both "adoption and use," the Board will count each issue on which information is sought as a separate interrogatory. In contrast, if an interrogatory requests "all relevant facts and circumstances" concerning a single issue, event, or matter; or asks that a particular piece of information, such as, for example, annual sales figures under a mark, be given for multiple years, and/or for each of the responding party's involved marks, it will be counted as a single interrogatory. [Note 7.]

The introductory instructions or preamble to a set of interrogatories will not be counted by the Board as interrogatories or subparts for purposes of determining whether the limit specified in 37 C.F.R. § 2.120(d) has been exceeded. Moreover, the Board's determination, on a motion to compel, of the adequacy of an interrogatory answer will not be governed by the introductory instructions or preamble; the Board is not bound by the instructions or preamble, and will make its own independent determination of the adequacy of the answer, without regard to the instructions or preamble. [Note 8.]

NOTES:

1. *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990). *Cf. Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385, 1387 (TTAB 2016) (parties should discuss their respective counting methods in attempt to resolve dispute over number; under no counting method did the interrogatories at issue exceed 75).

2. *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 (TTAB 1990).

3. *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990). *Cf. Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016) (parties should nonetheless discuss their respective counting methods in attempt to resolve dispute over number).

4. *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990).

5. *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990).

6. *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990).

7. *See* NOTICE OF FINAL RULEMAKING, 54 Fed. Reg. 34886 (August 22, 1989).

8. *See Chix Gear, LLC v. Princess Race Wear Corp.*, 2019 USPQ2d 455321, at *3 n.13 (TTAB 2019) ("The Board is not bound by the instructions or preamble a party may attach to its discovery requests and makes its own independent determination of the adequacy of a discovery response."); *Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625, 1626 (TTAB 1992) (adequacy of an interrogatory answer will not be governed by the introductory instructions or preamble).

405.03(e) Remedy for Excessive Interrogatories

37 C.F.R. § 2.120(d) . . . *If a party upon which interrogatories have been served believes that the number of interrogatories served exceeds the limitation specified in this paragraph (d), and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. If the inquiring party, in turn, files a motion to compel discovery, the motion must be accompanied by a copy of the set(s) of interrogatories, which together, are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (f) of this section.*

If a party on which interrogatories have been served, in a proceeding before the Board, believes that the number of interrogatories exceeds the limit specified in 37 C.F.R. § 2.120(d), and wishes to object to the interrogatories on that basis, the party must, within the time for, and instead of, serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. [Note 1.] A party should not answer what it considers to be the first 75 interrogatories and object to the rest as excessive. [Note 2.] Failure to comply with the procedure set forth in 37 C.F.R. § 2.120(d) and to serve a general objection instead of responding to the interrogatories may result in waiver of the right to object to the requests on the ground that they exceed the number permissible under the Board's rules. [Note 3.]

If a general objection on the ground of excessive number is asserted, and the propounding party, in turn, believes that the objection is not well taken, and wishes to obtain an adjudication from the Board as to the sufficiency thereof, the propounding party must file a motion to compel discovery. The motion must be accompanied by a copy of the set(s) of interrogatories which together are said to exceed the limitation, and must otherwise comply with the requirements of 37 C.F.R. § 2.120(f), including the requirement that a motion to compel be supported by a showing from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion and has been unable to reach agreement. [Note 4.] The moving party should also set out its counting method showing that the number of interrogatories does not exceed 75. [Note 5.] For further information concerning motions to compel discovery, see TBMP § 523.

If, on determining a motion to compel filed in response to a general objection to interrogatories on the ground of excessive number, the Board finds that the interrogatories are excessive in number, and that the propounding party has not previously used up its allotted 75 interrogatories, the Board normally will allow the propounding party an opportunity to serve a revised set of interrogatories not exceeding the limit specified in 37 C.F.R. § 2.120(d). The revised set of interrogatories serves as a substitute for the excessive set, and thus is deemed timely if the excessive set was timely. [Note 6.] For information regarding the timing of interrogatories, see TBMP § 405.01.

However, if an order providing for a revised set is issued late in the discovery period or after the close of the discovery period, the discovery period will be extended or reopened, as appropriate, to permit service of and responses to the revised set. Where discovery is reopened, the scope of the revised set may not exceed the scope of the excessive set, that is, the revised set may not seek information beyond the scope of the excessive set. [Note 7.]

A party may properly refuse to respond to a document request seeking all documents identified or referred to in response to interrogatories if the number of interrogatories is believed to be excessive. [Note 8.]

In those cases where a party which has propounded interrogatories realizes, on receipt of a general objection thereto on the ground of excessive number, that the interrogatories are, in fact, excessive in number, it is strongly recommended that the parties voluntarily agree to the service of a revised set of interrogatories, in

the manner normally allowed by the Board, instead of bringing their dispute to the Board by motion to compel.

NOTES:

1. 37 C.F.R. § 2.120(d); *Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016). *Cf. Amazon Technologies v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (where party believes that it need not respond to discovery requests because the propounding party did not serve initial disclosures, it has a duty to specifically object on that basis).

2. *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990).

3. *Hewlett Packard Enterprise Development LP v. Arroware Industries, Inc.*, 2019 USPQ2d 158663, at *3 (TTAB 2019) ("Allowing Respondent to limit its responses to only those answers it chose to give prior to asserting the discovery requests are excessive in number, and thereby precluding Petitioner an opportunity to reformulate its requests, would defeat the purpose of Trademark Rules 2.120(d) and 2.120(e) and disregard the parties' affirmative duty to cooperate in the discovery process.").

4. 37 C.F.R. § 2.120(d) and 37 C.F.R. § 2.120(f).

5. *See, e.g., Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016) (parties should specifically discuss their respective counting methods in attempt to resolve dispute over number of interrogatories).

6. *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990). *See also Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398, 1398-99 (TTAB 1990) (excusing obligation to answer excessive set); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990). *Cf. Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1468 n.6 (TTAB 1990) (opposer may seek answers by taking discovery deposition of applicant).

7. 37 C.F.R. § 2.120(a)(3). *See, e.g., Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990).

8. *See Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398, 1399 (TTAB 1990) (refusal to respond to document requests was proper; petitioner could not respond to document requests without first having to answer excessive interrogatories).

405.04 Responses to Interrogatories

405.04(a) Time for Service of Responses

37 C.F.R. § 2.120(a)(3) . . . *Responses to interrogatories . . . must be served within thirty days from the date of service of such discovery requests.* * * * *

Fed. R. Civ. P. 33(b)(2) Time to Respond. *The responding party must serve its answers and any objections within 30 days after being served with the interrogatories.* * * * *

Responses to interrogatories must be served within 30 days after the date of service of the interrogatories. TBMP § 403.03. The time to respond may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board, but the response may not be due later than the close of discovery. [Note 1.] The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. [Note 2.]

Service of responses to interrogatories must be made by email, unless otherwise stipulated, or if the serving party attempted service by email but service could not be made due to technical problems or extraordinary circumstances, by the manner described in 37 C.F.R. § 2.119(b)(1) - 37 C.F.R. § 2.119(b)(4). A party not domiciled in the United States and not yet represented by an attorney licensed to practice law in the United States is not eligible to use United States postal mail. United States postal mail may not be available for U.S. counsel located outside the United States. [Note 3.] *See*TBMP § 113.04. Additionally, even if interrogatories are served by postal service or overnight courier (either by agreement or when email service was attempted but could not be made), 37 C.F.R. § 2.119(c) has been amended to remove the previous provision that added five days to the prescribed period for action after the date of service so that no additional time for service of discovery responses is allowed for responding to the requests by any manner of service. [Note 4.] TBMP § 113.05 and TBMP § 403.03.

A party which fails to respond to interrogatories during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, on motion to compel filed by the propounding party, to have forfeited its right to object to the interrogatories on their merits. [Note 5.] Objections going to the merits of an interrogatory or other discovery request include claims that the information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead to the discovery of admissible evidence. [Note 6.] In contrast, objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but instead to a characteristic of the information sought. [Note 7.] Objections based on confidentiality are expected to be extremely limited because the Board's standard protective order is in place for all Board inter partes proceedings. [Note 8.]

NOTES:

1. 37 C.F.R. § 2.120(a)(3).

2. 37 C.F.R. § 2.120(a)(3).

3. 37 C.F.R. § 2.119(b) and 37 C.F.R. § 2.119(d). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69959 (October 7, 2016).

4. 37 C.F.R. § 2.119(c). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016).

5. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (stating that the Board has great discretion in determining whether such forfeiture should be found); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 449 (TTAB 1979) (excusable neglect not shown where opposer was out of the country and, upon return, failed to ascertain that responses were due); *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975) (waived right to object by refusing to respond to interrogatories, claiming that they served "no useful purpose"). *See also Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1303 (TTAB 1987) (right to object not waived where although discovery responses were late, there was some confusion regarding

time to respond); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979) (although party failed to timely respond to discovery, party seeking such discovery is required to make good faith effort to determine why no response has been made before filing motion to compel).

6. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000).

7. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (party will generally not be found to have waived the right to make these objections).

8. 37 C.F.R. § 2.116(g).

405.04(b) Nature of Responses

Fed. R. Civ. P. 33(b)(3) Answering Each Interrogatory. *Each interrogatory must, to the extent it is not objected to, be answered separately and fully in writing under oath.*

Fed. R. Civ. P. 33(b)(4) Objections. *The grounds for objecting to an interrogatory must be stated with specificity. Any ground not stated in a timely objection is waived unless the court, for good cause, excuses the failure.*

Fed. R. Civ. P. 33(d) Option to Produce Business Records. *If the answer to an interrogatory may be determined by examining, auditing, compiling, abstracting, or summarizing a party's business records (including electronically stored information), and if the burden of deriving or ascertaining the answer will be substantially the same for either party, the responding party may answer by:*

(1) *specifying the records that must be reviewed, in sufficient detail to enable the interrogating party to locate and identify them as readily as the responding party could; and*

(2) *giving the interrogating party a reasonable opportunity to examine and audit the records and to make copies, compilations, abstracts, or summaries.*

Ordinarily, a party on which interrogatories have been served should respond to them by stating, with respect to each interrogatory, either an answer or an objection. If an interrogatory is answered, the answer must be made separately and fully, in writing under oath. If an interrogatory is objected to, the reasons for objection must be specifically stated in lieu of an answer. [Note 1.] In responding to interrogatories, "general objections" or boilerplate "specific objections" are not proper. Objections, if any, must be specifically asserted in response to each interrogatory against which they are interposed, and the ground or basis for each objection must be stated with specificity. [Note 2.] The Board generally looks with disfavor on the practice of responding to written discovery by inserting repeated or "boilerplate" lists of objections which fail to set forth the ground or basis for the objection with respect to the interrogatory at issue. It is incumbent upon a party who has been served with interrogatories to respond by articulating its objections with particularity to those interrogatories (or parts of interrogatories) which it believes to be objectionable, and by providing the information sought in those interrogatories (or parts of interrogatories) which it believes to be proper. [Note 3.] The burden of persuasion is on the objecting party to show that an interrogatory or part thereof should not be answered. [Note 4.] If a responding party believes that the number of interrogatories served exceeds the limit specified in 37 C.F.R. § 2.120(d), and wishes to object to the interrogatories on this basis, the party must, within the time for, and instead of, serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. [Note 5.] TBMP § 405.03(e).

The Board prefers that the responding party reproduce each interrogatory immediately preceding the answer or objection thereto.

In some cases, pursuant to Fed. R. Civ. P. 33(d), the information sought in an interrogatory may be derived or ascertained from the business records of the responding party, or from an examination, audit, or inspection of those business records (including a compilation, abstract, or summary thereof) when the burden of deriving or ascertaining the information is substantially the same for the propounding party as for the responding party. In those cases, the responding party may answer the interrogatory by itself providing, in its written answer to the interrogatory, the information sought. Alternatively, the responding party may answer the interrogatory by specifying the records from which the information may be derived or ascertained, and affording to the propounding party reasonable opportunity to examine, audit, or inspect the records and to make copies, compilations, abstracts, or summaries. If the responding party elects to answer an interrogatory by specifying and producing business records, the specification must be in sufficient detail to permit the propounding party to locate and identify, as readily as can the responding party, the records from which the answer may be ascertained. [Note 6.]

A party seeking to invoke Fed. R. Civ. P. 33(d) with regard to electronic information may be required to provide some combination of technical support, information on application software, or other assistance to the requesting party. [Note 7.] If direct access to its electronic information system is necessary to afford the requesting party an adequate opportunity to derive or ascertain the answer to an interrogatory, the answering party may determine that its need for privacy or confidentiality requires it to derive or ascertain the answer itself rather than invoke Fed. R. Civ. P. 33(d). [Note 8.]

A responding party cannot simultaneously invoke the option to produce business records and claim the protection of a privilege as to the documents. [Note 9.]

It is generally inappropriate for a party to respond to interrogatories by filing a motion attacking them, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. [Note 10.] Rather, the party ordinarily should respond by answering those interrogatories that it believes to be proper and stating its objections to those that it believes to be improper. TBMP § 410.

For information regarding a party's duty to supplement responses to interrogatories, see TBMP § 408.03.

NOTES:

1. Fed. R. Civ. P. 33(b)(2), 33(b)(4).

2. Fed. R. Civ. P. 33(b)(4); *Hewlett Packard Enterprise Development LP v. Arroware Industries, Inc.*, 2019 USPQ2d 158663, at *4 (TTAB 2019) (responding party may not rely on conclusory statements when objecting but must specifically state the underlying basis for the objection); *Amazon Technologies, Inc. v. Wax*, 93 USPQ2d 1702, 1704 (TTAB 2009) (objections to interrogatories must be made with particularity); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (same); *see also* 8B C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2173 (3d ed. 2020).

3. Fed. R. Civ. P. 33(b)(4); *Hewlett Packard Enterprise Development LP v. Arroware Industries, Inc.*, 2019 USPQ2d 158663, at *4 (TTAB 2019); *Amazon Technologies, Inc. v. Wax*, 93 USPQ2d 1702, 1704 (TTAB 2009); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984); *see also* 8B C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2173 (3d ed. 2020).

4. *Medtronic, Inc. v. Pacesetter Sys., Inc.*, 222 USPQ 80, 83 (TTAB 1984); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 472 (TTAB 1974); *see also* 8B C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2173 (3d ed. 2020).

5. 37 C.F.R. § 2.120(d). *Hewlett Packard Enterprise Development LP v. Arroware Industries, Inc.*, 2019 USPQ2d 158663, at *3 (TTAB 2019); *Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016).

6. Fed. R. Civ. P. 33(d); *Johnson & Johnson v. Obschestvo s ogranitchennoy; otvetstvennostiu "WDS,"* 95 USPQ2d 1567, 1570 (TTAB 2010) (responding party not entitled to invoke Fed. R. Civ. P. 33(d) by producing business records in Russian language with no English translation); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (responding party may not merely agree to provide access to voluminous records which may contain responsive information); *Jain v. Ramparts, Inc.*, 49 USPQ2d 1429, 1435 (TTAB 1998) (identifying prerequisites for exercising the option to produce business records in lieu of answering interrogatories); *see also Hewlett Packard Enterprise Development LP v. Arroware Industries, Inc.*, 2019 USPQ2d 158663, at *8-9 (TTAB 2019) (same).

7. Fed. R. Civ. P. 33 Committee Notes on Rules – 2006 Amendment.

8. Fed. R. Civ. P. 33 Committee Notes on Rules – 2006 Amendment.

9. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000); 8B C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2178 (3d ed. 2020).

10. *Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016).

405.04(c) Signature of Responses and Authority of Signer

Fed. R. Civ. P. 33(b)(1) Responding Party. *The interrogatories must be answered:*

(A) *by the party to whom they are directed; or*

(B) *if that party is a public or private corporation, a partnership, an association, or a governmental agency, by any officer or agent, who must furnish the information available to the party.*

Fed. R. Civ. P. 33(b)(5) Signature. *The person who makes the answers must sign them, and the attorney who objects must sign any objections.*

Interrogatories must be answered by the party served. If the party served is a corporation, partnership, association, or governmental agency, the interrogatories must be answered by an officer, partner, or agent, who must furnish whatever information is available to the party served. [Note 1.]

The term "agent" includes an attorney, who may answer even though he has no personal knowledge of the facts stated in the answers; the attorney's answers, like an officer's or partner's answers, must contain the information available to the party served. [Note 2.] However, an attorney who answers interrogatories on behalf of a corporation, partnership, association, or governmental agency may thereafter be exposed to additional discovery and possibly even disqualification. [Note 3.]

Responses to interrogatories must be signed by the person making them, and objections to interrogatories must be signed by the attorney making them. [Note 4.]

NOTES:

1. Fed. R. Civ. P. 33(b)(1)(B).

2. *See Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ2d 1663, 1665 (TTAB 1988).

3. *See* 37 C.F.R. § 11.307; *Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ2d 1663 n.4 (TTAB 1988).

4. Fed. R. Civ. P. 33(b)(5).

406 Requests for Production of Documents and Things and Electronically Stored Information

406.01 When Permitted and By Whom

A party may serve discovery written requests for the production of documents and things on any other party only during the discovery period, provided that the serving party has either previously served or concurrently serves therewith its initial disclosures, absent a stipulation by the parties or a granted motion or upon order of the Board to the contrary. [Note 1.] TBMP § 403.02. Requests for production of documents and things must be served early enough in the discovery period, as originally set or as may have been reset by the Board, so that the written responses will be due and production of documents will be provided no later than the close of discovery. [Note 2.] TBMP § 403.02. If requests for production are combined with a notice of taking a discovery deposition (i.e., if it is requested that the deponent bring designated documents to the deposition), the requests for production must be served at least 30 days prior to the scheduled date of the deposition. [Note 3.] TBMP § 113.04 (Manner of Service), and TBMP § 403.03 (Time for Service of Discovery Responses).

Requests for production may not be served on a non-party. [Note 4.] However, if a discovery deposition deponent is a non-party witness residing in the United States, production of designated documents by the witness at the deposition may be obtained by means of a subpoena duces tecum. [Note 5.] *See*TBMP § 404.03(a)(2). A subpoena is unnecessary, however, if the non-party witness is willing to produce the documents voluntarily.

Parties seeking to serve document production requests on a natural person residing in a foreign country should be aware that the laws of some foreign countries may preclude such discovery. [Note 6.] In determining when it is appropriate to impose sanctions for non-compliance with discovery due to a conflict with foreign laws, the following factors are considered: (1) the good faith of the non-complying party, (2) whether the non-complying party would incur foreign criminal liability, and (3) whether alternative sources of information are available. [Note 7.]

NOTES:

1. 37 C.F.R. § 2.120(a)(3).

2. 37 C.F.R. § 2.120(a)(3). *See also Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268, 1270 (TTAB 2017) (discovery must be served "early enough … so that responses will be due no later than the close of discovery"); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951 (October 7, 2016).

3. *See* Fed. R. Civ. P. 34(a); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978).

4. *See* Fed. R. Civ. P. 34(a).

5. 35 U.S.C. § 24; Fed. R. Civ. P. 45. *But see El Encanto, Inc. v. Hatch Chile Co., Inc.*, 825 F.3d 1161, 119 USPQ2d 1139, 1144 (10th Cir. 2016) (party to Board proceeding can obtain nonparty documents by subpoena duces tecum under Fed. R. Civ. P. 45 without deposition); *Dan Foam ApS v. Sleep Innovations Inc.*, 106 USPQ2d 1939, 1942-43 (TTAB 2013) (discussing notice requirement to adverse party under Fed. R. Civ. P. 45(b)(1) for a subpoena duces tecum (without deposition) issued to non-party and noting that respondent could have sought its own subpoena of the non-party to obtain additional documents and/or a discovery deposition).

6. *Societe Internationale Pour Participations Industrielles et Commerciales, S.A. v. Rogers*, 357 U.S. 197, 200-01 (1958) (Swiss government ordered Swiss plaintiff in U.S. court proceeding not to produce certain documents).

7. *Cochran Consulting Inc. v. Uwatec USA Inc.*, 102 F.3d 1224, 41 USPQ2d 1161, 1163 (Fed. Cir. 1996) (citing *Societe Internationale Pour Participations Industrielles et Commerciales, S.A. v. Rogers*, 357 U.S. 197 (1958)).

406.02 Scope

Fed. R. Civ. P. 34(a) In General. *A party may serve on any other party a request within the scope of Rule 26(b):*

(1) *to produce and permit the requesting party or its representative to inspect, copy, test, or sample the following items in the responding party's possession, custody, or control:*

(A) *any designated documents or electronically stored information — including writings, drawings, graphs, charts, photographs, sound recordings, images, and other data or data compilations — stored in any medium from which information can be obtained either directly or, if necessary, after translation by the responding party into a reasonably usable form; or*

(B) *any designated tangible things; or*

(2) *to permit entry onto designated land or other property possessed or controlled by the responding party, so that the requesting party may inspect, measure, survey, photograph, test, or sample the property or any designated object or operation on it.*

The scope of a request for production, in an inter partes proceeding before the Board, is governed by Fed. R. Civ. P. 34(a), which in turn refers to Fed. R. Civ. P. 26(b). *See* TBMP § 402 (discussion of scope of discovery permitted under Fed. R. Civ. P. 26(b)).

Generally, a party does not have an obligation to locate documents that are not in its possession, custody, or control and produce them during discovery. [Note 1.] However, a party may not mislead its adversary by stating that it will produce documents and then fail to do so and claim the documents are not in its possession or control. [Note 2.] A party also is not under an obligation in response to a discovery request to create or prepare documents that do not already exist. [Note 3.]

Because proceedings before the Board involve only the right to register trademarks, the request for entry upon land for inspection and other purposes is rarely, if ever, used in Board proceedings.

NOTES:

1. *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1715 (TTAB 1999), *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), *aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009).

2. *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1679 (TTAB 2005).

3. 8B C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2210 (3d ed. 2020) ("A document or thing is not in the possession, custody, or control of a party if it does not exist. Production cannot be required of a document no longer in existence nor of one yet to be prepared.").

406.03 Elements of Request for Production

Fed. R. Civ. P. 34(b)(1) Contents of the Request. *The request:*

(A) *must describe with reasonable particularity each item or category of items to be inspected;*

(B) *must specify a reasonable time, place, and manner for the inspection and for performing the related acts; and*

(C) *may specify the form or forms in which electronically stored information is to be produced.*

A request for production must include the elements specified in Fed. R. Civ. P. 34(b)(1)(A)-(B), as set forth above. Fed. R. Civ. P. 34(b)(1)(C) allows but does not require a requesting party to specify in its requests the preferred data format(s) for production of electronically stored information. Parties are expected to discuss the format for production during their mandatory discovery conference. [Note 1.] For more information regarding discovery conferences, see TBMP § 401.01 and TBMP § 408.01(a).

NOTES:

1. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69961 (October 7, 2016); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 and 42252 (August 1, 2007); 37 C.F.R. § 2.120(a)(2)(i); Fed. R. Civ. P. 26(f). *See also Chix Gear, LLC v. Princess Race Wear Corp*., 2019 USPQ2d 455321, at *3 (TTAB 2019) (unless otherwise specified by the parties, responding party must produce ESI in the form in which it is 'ordinarily maintained' or in a 'reasonably usable form); *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1908 (TTAB 2011) (parties agreed only to the form of their ESI production).

406.04 Responses to Requests for Production

Fed. R. Civ. P. 34(b)(2)(A) Time to Respond. *The party to whom the request is directed must respond in writing within 30 days after being served or — if the request was delivered under Rule 26(d)(2) — within 30 days after the parties' first Rule 26(f) conference. A shorter or longer time may be stipulated to under Rule 29 or be ordered by the court.*

(B) ***Responding to Each Item.*** *For each item or category, the response must either state that inspection and related activities will be permitted as requested or state with specificity the grounds for objecting to the request, including the reasons. The responding party may state that it will produce copies of documents or of electronically stored information instead of permitting inspection. The production must then be*

completed no later than the time for inspection specified in the request or another reasonable time specified in the response.

(C) ***Objections.*** *An objection must state whether any responsive materials are being withheld on the basis of that objection. An objection to part of a request must specify the part and permit inspection of the rest.*

(D) ***Responding to a Request for Production of Electronically Stored Information.*** *The response may state an objection to a requested form for producing electronically stored information. If the responding party objects to a requested form — or if no form was specified in the request — the party must state the form or forms it intends to use.*

(E) ***Producing the Documents or Electronically Stored Information.*** *Unless otherwise stipulated or ordered by the court, these procedures apply to producing documents or electronically stored information:*

(i) *A party must produce documents as they are kept in the usual course of business or must organize and label them to correspond to the categories in the request;*

(ii) *If a request does not specify a form for producing electronically stored information, a party must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms; and*

(iii) *A party need not produce the same electronically stored information in more than one form.*

Responses to requests for production should comply with the provisions of Fed. R. Civ. P. 34(b). Documents produced in electronically stored form not kept in the ordinary course of business must be organized and labeled to correspond to the categories in each request, and if the form of production is not specified, produced in a form or forms in which it is ordinarily maintained, or in a form or forms that are reasonably usable. [Note 1.] The Board encourages electronic production whenever possible, and if email is not practical due to the volume of documents, the Board encourages the parties to agree on an effective alternative method of service (e.g., a file hosting service that provides cloud storage, or delivery of a USB drive). [Note 2.]

NOTES:

1. Fed. R. Civ. P. 34(b)(2)(E). *Chix Gear, LLC v. Princess Race Wear Corp.*, 2019 USPQ2d 455321, at *3 (TTAB 2019) (unless otherwise specified by the parties, responding party must produce ESI in the form in which it is "ordinarily maintained" or in a "reasonably usable form"). *See e.g., Amazon Technologies, Inc. v. Wax*, 95 USPQ2d 1865, 1869 (TTAB 2010) (for documents produced on DVD, opposer ordered to serve a complete index to all 31,144 pages of produced documents, cross-referencing the categories of documents and the discovery requests to which they are responsive, with no category in the index to exceed 300 pages).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69959, 69961 (October 7, 2016).

406.04(a) Time for Service of Responses

Fed. R. Civ. P. 34(b)(2)(A) Time to Respond. *The party to whom the request is directed must respond in writing within 30 days after being served.*

37 C.F.R. § 2.120(a)(3) *. . . Responses to . . . requests for production of documents and things . . . must be served within thirty days from the date of service of such discovery requests. * * * **

Responses to requests for production must be served within 30 days after the date of service of the requests. [Note 1.] TBMP § 403.03. The time to respond may be extended upon stipulation of the parties, or upon

motion granted by the Board, or by order of the Board, but the response may not be due later than the close of discovery. [Note 2.] The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. [Note 3.]TBMP § 403.03.

Service of responses to requests for production must be made by email, unless otherwise stipulated, or if the serving party attempted service by email but service could not be made due to technical problems or extraordinary circumstances, by the manner described in 37 C.F.R. § 2.119(b)(1) - 37 C.F.R. § 2.119(b)(4). A party not domiciled in the United States or and not yet represented by an attorney licensed to practice law or authorized representative in the United States is not eligible to use United States postal mail. United States postal mail may not be available for U.S. counsel located outside the United States. [Note 4.] TBMP § 113.04. Additionally, even if requests for production are served on a party by postal service or overnight courier (either by agreement or because email service was attempted but could not be made), 37 C.F.R. § 2.119(c) has been amended to remove the previous provision adding five days to the proscribed period for action after the date of service so that no additional time for service of discovery responses is allowed for responding to the requests for any manner of service. [Note 5.] TBMP § 403.03.

A party which fails to respond to requests for production during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, on motion to compel filed by the propounding party, to have forfeited its right to object to the requests on their merits. [Note 6.] TBMP § 403.03 and TBMP § 405.04(a).

NOTES:

1. Fed. R. Civ. P. 34(b)(2)(A); 37 C.F.R. § 2.120(a)(3).

2. 37 C.F.R. § 2.120(a)(3).

3. 37 C.F.R. § 2.120(a)(3).

4. 37 C.F.R. § 2.119(b); 37 C.F.R. § 2.119(d). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69959 (October 7, 2016).

5. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016).

6. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (applicant, having waived its right to object to discovery requests on their merits was not entitled to raise objection regarding place of production of documents).

406.04(b) Place and Form of Production

37 C.F.R. § 2.120(e) . . . *The time, place, and manner for production of documents, electronically stored information, and tangible things shall comport with the provisions of Rule 34 of the Federal Rules of Civil Procedure, or be made pursuant to agreement of the parties, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.*

Fed. R. Civ. P. 34(b)(2)(E) Producing the Documents or Electronically Stored Information. *Unless otherwise stipulated or ordered by the court, these procedures apply to producing documents or electronically stored information:*

(i) *A party must produce documents as they are kept in the usual course of business or must organize and label them to correspond to the categories in the request;*

(ii) *If a request does not specify a form for producing electronically stored information, a party must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms; and*

(iii) *A party need not produce the same electronically stored information in more than one form.*

The place of production is governed by 37 C.F.R. § 2.120(e) which states that production shall comport with the Fed. R. Civ. P. 34, or be made pursuant to the agreement of the parties, or where the Board, upon motion, orders. [Note 1.] A party is only obliged to make documents and materials available for inspection and copying, as they are kept in the ordinary course of business, [Note 2] or as organized and labeled to correspond to the requests, or a party may produce copies of the documents or of the electronically stored information instead of permitting inspection. [Note 3.] In Board cases, parties often extend each other the courtesy of providing copies of responsive documents electronically or producing requested documents by photocopying the documents and forwarding them to the requesting party at the requesting party's expense. [Note 4.] Indeed, the Board believes serving documents electronically is more efficient and thus encourages this method of producing documents. [Note 5.] Electronic production should be used whenever possible, and parties are expected to discuss such arrangements, as well as the arrangements for production of electronically stored information, and alternative methods of service if email is not practical, in their mandatory discovery conference. [Note 6.] For more information regarding discovery conferences, see TBMP § 401.01 and TBMP § 408.01(a).

Electronically stored information may be produced in the form specified by the request. If no specification is made, the party must produce the electronically stored information in the form in which it is ordinarily maintained, or in a reasonably usable form. [Note 7.] Fed. R. Civ. P. 34(a) "requires that, if necessary, a responding party 'translate' information it produces into a 'reasonably usable' form." [Note 8.] However, the option to produce in a reasonably usable form does not mean that a responding party is free to convert electronically stored information from the form in which it is maintained to a different form that makes it more difficult or burdensome for the requesting party to use the information efficiently in the litigation. [Note 9.] A party does not have to produce electronically stored information in more than one format. [Note 10.] Electronically stored information produced during discovery can be used during depositions to question witnesses and may come in as exhibits thereto.

On motion pursuant to 37 C.F.R. § 2.120(e), the Board may by order specify the place and the manner in which the documents are to be produced, and in situations involving electronically stored information, the form of production. The Board may, for example, order that the responding party photocopy the documents designated in a request and mail the photocopies to the requesting party when the responding party has unreasonably refused to produce documents. [Note 11.]

NOTES:

1. 37 C.F.R. § 2.120(e).

2. Fed. R. Civ. P. 34(b)(2)(E)(i); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (responding party within its rights to choose to make documents available for inspection and copying by the inquiring party).

3. Fed. R. Civ. P. 34(b)(2)(E)(i); Fed. R. Civ. P. 34(b)(2)(B); Fed. R. Civ. P. 34(a)(1). Fed. R. Civ. P. 34 Committee Notes on Rules – 2015 Amendment ("Rule 34(b)(2)(B) is further amended to reflect the common practice of producing copies of documents or electronically stored information rather than simply permitting inspection").

4. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1777 (TTAB 1998).

5. *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008) (most efficient means of making initial disclosures of documents and the option the Board encourages parties to use is to actually exchange copies of disclosed documents rather than merely identifying location). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69961 (October 7, 2016) ("The Board encourages electronic production wherever possible . . . .").

6. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69959, 69961 (October 7, 2016); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 19296, 19297 (to be codified at 37 C.F.R. pt. 2 (proposed April 4, 2016)) (methods of service of discovery requests and responses and document production are to be discussed during discovery conference; "the proposed rules nonetheless allow for parties to stipulate otherwise [than email service for discovery], to accommodate other methods of communication that may promote convenience and expediency (for example, a file hosting service that provides cloud storage, delivery of a USB drive, etc.")); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 and 42252 (August 1, 2007); 37 C.F.R. § 2.120(a)(2); Fed. R. Civ. P. 26(f).

7. Fed. R. Civ. P. 34(b)(2)(E)(ii). *Chix Gear, LLC v. Princess Race Wear Corp.*, 2019 USPQ2d 455321, at *3 (TTAB 2019) (unless otherwise specified by the parties, the responding party must produce ESI in the form in which it is "ordinarily maintained" or in a "reasonably usable form"). *See* Fed. R. Civ. P. 34 Committee Notes on Rules – 2006 Amendment. *Cf. Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1908 (TTAB 2011) (where the parties only agreed as to form of production, not as to other aspects such as a protocol for identifying and segregating potentially responsive ESI, applicant cannot insist that opposer start its ESI search and production over).

8. Fed. R. Civ. P. 34 Committee Notes on Rules – 2006 Amendment.

9. Fed. R. Civ. P. 34 Committee Notes on Rules – 2006 Amendment. *Cf. Chix Gear, LLC v. Princess Race Wear Corp.*, 2019 USPQ2d 455321, at *3 (TTAB 2019) (nothing inherent in Rule 34 requires production of metadata where neither party has specified the form in which discovery will be provided, or where metadata has not been requested).

10. Fed. R. Civ. P. 34(b)(2)(E)(iii). *See also Chix Gear, LLC v. Princess Race Wear Corp.*, 2019 USPQ2d 455321, at *2 (TTAB 2019).

11. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (at the responding party's expense as a discovery sanction); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1778 (TTAB 1998) (at responding party's expense, as a discovery sanction); *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013 (TTAB 1983) (at the requesting party's expense).

406.04(c) Nature of Responses

Fed. R. Civ. P. 34(b)(2)(B) Responding to Each Item. *For each item or category, the response must either state that inspection and related activities will be permitted as requested or state with specificity the grounds for objecting to the request, including the reasons. The responding party may state that it will produce copies of documents or of electronically stored information instead of permitting inspection. The production must then be completed no later than the time for inspection specified in the request or another reasonable time specified in the response.*

Fed. R. Civ. P. 34(b)(2)(C) Objections. *An objection must state whether any responsive materials are being withheld on the basis of that objection. An objection to part of a request must specify the part and permit inspection of the rest.*

Fed. R. Civ. P. 34(b)(2)(D) Responding to a Request for Production of Electronically Stored Information. *The response may state an objection to a requested form for producing electronically stored information. If the responding party objects to a requested form — or if no form was specified in the request — the party must state the form or forms it intends to use.*

Fed. R. Civ. P. 37(e) Failure to Preserve Electronically Stored Information. *If electronically stored information that should have been preserved in the anticipation or conduct of litigation is lost because a party failed to take reasonable steps to preserve it, and it cannot be restored or replaced through additional discovery, the court:*

(1) *upon finding prejudice to another party from loss of the information, may order measures no greater than necessary to cure the prejudice; or*

(2) *only upon finding that the party acted with the intent to deprive another party of the information's use in the litigation may:*

(A) *presume that the lost information was unfavorable to the party;*

(B) *instruct the jury that it may or must presume the information was unfavorable to the party; or*

(C) *dismiss the action or enter a default judgment.*

A response to a request for production of documents and things must state, with respect to each item or category of documents or things requested to be produced, that inspection and related activities will be permitted as requested, or state with specificity the grounds for objecting to the request, including the reasons. [Note 1.] The responding party may state that it will produce copies of documents or electronically stored information instead of permitting inspection. [Note 2.]

It is incumbent upon a responding party to respond to each request by stating whether or not responsive documents exist and, if so, whether they will be produced at a specified reasonable time for inspection or are being withheld based on a claim of privilege or a specified objection. [Note 3.] If copies are to be produced in lieu of inspection, the response must so state. [Note 4.] If accurate, a party may respond that the requested documents are not in existence (e.g., lost or destroyed or that the documents are not within its possession, custody, or control). [Note 5.] If an objection is made to only part of an item or category, the part must be specified, and inspection must be permitted of the rest of the responsive documents or things. [Note 6.] A party may not redact portions of responsive documents on the ground that the non-disclosed information is not relevant or responsive where the information appears in a document that contains otherwise relevant or responsive information. [Note 7.] A party may object to a requested form of data production for electronically stored information ("ESI"). [Note 8.] If no form for the ESI is specified in the request, the party must state

the form it intends to use, and must produce the ESI in the form in which it is ordinarily maintained or in a reasonably usable form.

A party that produces documents for inspection must produce them as they are kept in the usual course of business, or must organize and label them to correspond with the categories in the request. [Note 9.] A party that produces ESI must produce the information in the form specified by the request, if no objection is made. It is contemplated that the parties will attempt to resolve such issues, i.e., the manner in which ESI will be produced, during their discovery conference. [Note 10.] Aspects of ESI production other than form that should be discussed during the discovery conference, or when it becomes apparent that ESI will be produced, include a protocol for identifying and segregating potentially responsive ESI, who should review the ESI to determine whether the production of particular documents or information would be appropriate, and methods of searching the ESI, such as the use of "keywords," to identify documents and information responsive to the discovery requests. [Note 11.]

A party has an obligation to take reasonable steps to preserve ESI in the anticipation or conduct of litigation. [Note 12.] A duty to preserve electronically stored information arises not only during litigation but also extends to that period before litigation when a party reasonably should know that the evidence may be relevant to the litigation. [Note 13.]

As amended on December 1, 2015, Fed. R. Civ. P. 37(e) provides that if electronically stored information that should have been preserved in the anticipation or conduct of litigation is lost because a party failed to take reasonable steps to preserve it, and it cannot be restored or replaced through additional discovery, the court: (1) upon finding prejudice to another party from loss of the information, may order measures no greater than necessary to cure the prejudice; or (2) only upon finding that the party acted with the intent to deprive another party of the information's use in the litigation may, among other things: presume that the lost information was unfavorable to the party or dismiss the action or enter a default judgment. [Note 14.] For more guidelines regarding the application of remedies in the event of lost ESI, see Fed. R. Civ. P. 37(e) Committee Notes on Rules – 2015 Amendment.

A party withholding responsive documents on the basis of a claim of privilege must "(i) expressly make the claim; and (ii) describe the nature of the documents, communications, or tangible things not produced or disclosed – and do so in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the claim." [Note 15.]

Fed. R. Civ. P. 26(b)(5) does not specify exactly how the party asserting privilege/protection must particularize its claim. The most common way is by using a privilege log, which identifies each document withheld, information regarding the nature of the privilege/protection claimed, the name of the person making/receiving the communication, the date and place of the communication, and the document's general subject matter. [Note 16.]

It is generally inappropriate for a party to respond to requests for production by filing a motion attacking them, such as a motion to strike, a motion to suppress, or a motion for a protective order. [Note 17.] Rather, the party ordinarily should respond by indicating, with respect to those requests that it believes to be proper, that inspection and related activities will be permitted, and by stating reasons for objection with respect to those requests that it believes to be improper. *See* TBMP § 410.

For information regarding a party's duty to supplement responses to requests for production, see TBMP § 408.03.

NOTES:

1. Fed. R. Civ. P. 34(b)(2)(B) and 34(b)(2)(C).

2. Fed. R. Civ. P. 34(b)(2)(B).

3. Fed. R. Civ. P. 34(b)(2)(B) and 34(b)(2)(C); Fed. R. Civ. P. 34 Committee Notes on Rules – 2015 Amendment ("an objection to a Rule 34 request must state whether anything is being withheld on the basis of the objection"); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

4. Fed. R. Civ. P. 34(b)(2)(B); Fed. R. Civ. P. 34 Committee Notes on Rules – 2015 Amendment; *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

5. *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1679 (TTAB 2005).

6. Fed. R. Civ. P. 34(b)(2)(C); Fed. R. Civ. P. 34 Committee Notes on Rules – 2015 Amendment ("if the objection recognizes that some part of the request is appropriate the objection should state the scope that is not [objectionable and] ... the statement of what has been withheld can properly identify as matters 'withheld' anything beyond the scope of the search specified in the objection").

7. *Intex Recreation Corp. v. The Coleman Co.*, 117 USPQ2d 1799 (TTAB 2016).

8. Fed. R. Civ. P. 34(b)(2)(D).

9. Fed. R. Civ. P. 34(b)(2)(E)(i); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000) (party may not simply dump large quantities of documents containing responsive as well as unresponsive documents).

10. Fed. R. Civ. P. 26(f)(3)(c). *See also* Fed. R. Civ. P. 34 Committee Notes on Rules – 2006 Amendment.

11. *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1905 (TTAB 2011).

12. *See generally Zubulake v. UBS Warburg LLC*, 220 F.R.D. 212, 216-18 (S.D.N.Y. 2003) (discussing the obligation to preserve electronically stored information); *Busy Beauty, Inc. v. JPB Group, LLC*, 2019 USPQ2d 338392, at *4 (TTAB 2019) (same).

13. *Leon v. IDX Systems Corp.*, 464 F.3d 951, 956 (9th Cir. 2006); *Silvestri v. General Motors Corp.*, 271 F.3d 583, 591 (4th Cir. 2001); *Busy Beauty, Inc. v. JPB Group, LLC*, 2019 USPQ2d 338392, at *4 (TTAB 2019) ("Once a party reasonably anticipates litigation, it must preserve information that falls within the scope of discovery as articulated in Rule 26(b)(1), namely 'any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case.'").

14. *Busy Beauty, Inc. v. JPB Group, LLC*, 2019 USPQ2d 338392, at *5-6 (TTAB 2019); *Optimal Chemical Inc. v. Srills LLC*, 2019 USPQ2d 338409, at *5 (TTAB 2019).

15. Fed. R. Civ. P. 26(b)(5)(A)(i)-(ii).

16. Fed. R. Civ. P. 26(b)(5) Notes of Advisory Committee on Rules – 1993 Amendment; *see Victor Stanley, Inc. v. Creative Pipe, Inc.*, 250 F.R.D. 251, 264-65 (D. Md. 2008) (discussing form of privilege logs under Fed. R. Civ. P. 26(b)(5)).

17. *Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016).

406.05 Limit on Number

406.05(a) Description of Limit

37 C.F.R. § 2.120(e) ***Requests for production.*** *The total number of requests for production which a party may serve upon another party pursuant to Rule 34 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional requests upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. A motion for leave to serve additional requests must be filed and granted prior to the service of the proposed additional requests and must be accompanied by a copy of the requests, if any, which have already been served by the moving party, and by a copy of the requests proposed to be served.* * * * *

The total number of requests for production of documents and things which a party may serve on another party, in a proceeding, may not exceed 75, counting subparts, except that the Board may allow additional requests for production on motion therefor showing good cause or on stipulation of the parties. [Note 1.] *See*TBMP § 519. Parties may also stipulate that the limit on requests for production shall be fewer than 75. [Note 2.]

NOTES:

1. 37 C.F.R. § 2.120(e); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951, 69961 (October 7, 2016). *Cf. Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1467 n.5 (TTAB 1990) (the Board stating in the context of interrogatories in excess of the limit that "good cause will generally be found only where a legitimate need for further discovery by means of interrogatories is shown . . . the fact that the additional interrogatories served by opposer may be relevant and narrowly drawn to a single issue is insufficient, in and of itself, to demonstrate good cause.").

2. 37 C.F.R. § 2.120(a)(2)(iv).

406.05(b) Application of Limit: Sets of Requests for Production

The numerical limit specified in37 C.F.R. § 2.120(e) pertains to the total number of requests for production of documents and things that one party may serve on another party over the course of an entire proceeding, not just per set of production requests. Thus, if a party to a proceeding before the Board serves, over the course of the proceeding, two or more separate sets of requests for production directed to the same party, the requests in the separate sets would be added together for purposes of determining whether the numerical limit specified in the rule has been exceeded. [Note 1.]

Accordingly, a party which is preparing a first set of requests for production should consider reserving a portion of its allotted 75 requests for production (counting subparts) to use for follow-up discovery, unless it is sure that it will not be serving follow-up requests.

NOTES:

1. *Cf. Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1467 (TTAB 1990) (interrogatories).

406.05(c) Application of Limit: Multiple Marks, Etc.

37 C.F.R. § 2.120(e) does not provide for extra requests for production of documents and things in cases where more than one mark is pleaded and/or attacked by the plaintiff (whether in a single proceeding, or in consolidated proceedings), because in such cases the propounding party may simply request that each request for production be answered with respect to each involved mark of the responding party, and the requests for production will be counted the same as if they pertained to only one mark. Similarly, the rule does not provide for extra requests for production in cases where there is a counterclaim, because in a proceeding before the Board, the discovery information needed by a party for purposes of litigating the plaintiff's claim usually encompasses the information needed by that party for purposes of litigating a counterclaim. That is, the mere fact that a proceeding involves multiple marks (whether in a single proceeding, or in consolidated proceedings) and/or a counterclaim does not mean that a party is entitled to serve 75 requests for production, counting subparts, for each mark, or for each proceeding that has been consolidated, or for both the main claim and the counterclaim. Nor does such fact, in and of itself, constitute good cause for a motion for leave to serve additional requests for production. However, a proceeding with multiple marks and/or a counterclaim may involve unusually numerous or complex issues, and these are factors that will be considered in determining a motion for leave to serve additional requests for production.

406.05(d) Application of Limit: Counting Requests for Production

In determining whether the number of requests for production served by one party on another exceeds the limit specified in 37 C.F.R. § 2.120(e), requests will be counted in the same manner as interrogatories. [Note 1.] *See*TBMP § 405.03(d) (Application of Limit: Counting Interrogatories).

NOTES:

1. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69962 (October 7, 2016).

406.05(e) Remedy for Excessive Requests for Production

37 C.F.R. § 2.120(e) . . . *If a party upon which requests have been served believes that the number of requests served exceeds the limitation specified in this paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving responses and specific objections to the requests, serve a general objection on the ground of their excessive number. If the inquiring party, in turn, files a motion to compel discovery, the motion must be accompanied by a copy of the set(s) of the requests which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (f) of this section.* * * * *

If a party on which requests for production of documents and things have been served, in a proceeding before the Board, believes that the number of requests exceeds the limit specified in 37 C.F.R. § 2.120(e), and wishes to object to the requests on this basis, the party must, within the time for (and instead of) serving responses and specific objections to the requests, serve a general objection on the ground of their excessive number. [Note 1.] A party should not answer what it considers to be the first 75 requests and object to the

rest as excessive. [Note 2.] Failure to comply with the procedure set forth in 37 C.F.R. § 2.120(e) and to serve a general objection instead of responding to the requests may result in waiver of the right to object to the requests on the ground that they exceed the number permissible under the Board's rules. [Note 3.]

If a general objection on the ground of excessive number is asserted, and the propounding party, in turn, believes that the objection is not well taken, and wishes to obtain an adjudication from the Board as to the sufficiency thereof, the propounding party must file a motion to compel discovery. The motion must be accompanied by a copy of the set(s) of requests for production which together are said to exceed the limitation, and must otherwise comply with the requirements of 37 C.F.R. § 2.120(f), including the requirement that a motion to compel be supported by a showing from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion and has been unable to reach agreement. [Note 4.] It is further recommended that the moving party set out its counting method showing that the number of requests for production does not exceed 75. [Note 5.] For further information concerning motions to compel discovery, see TBMP § 523.

If, on determining a motion to compel filed in response to a general objection to requests for production on the ground of excessive number, the Board finds that the requests for production are excessive in number, and that the propounding party has not previously used up its allotted 75 requests for production, the Board normally will allow the propounding party an opportunity to serve a revised set of requests for production not exceeding the numerical limit. The revised set of requests for production serves as a substitute for the excessive set, and thus is deemed timely if the excessive set was timely. [Note 6.]

However, if an order providing for a revised set of requests for production is not issued until late in the discovery period or after the close of the discovery period, the discovery period will be extended or reopened, as appropriate, to permit service of and responses to the revised set. Where discovery is reopened, the scope of the revised set may not exceed the scope of the excessive set, that is, the revised set may not seek information beyond the scope of the excessive set. [Note 7.]

A party may properly refuse to respond to a document request seeking all documents identified or referred to in response to interrogatories if the number of interrogatories is believed to be excessive. [Note 8.]

In those cases where a party which has propounded requests for production realizes, on receipt of a general objection thereto on the ground of excessive number, that the requests for production are, in fact, excessive in number, it is strongly recommended that the parties voluntarily agree to the service of a revised set of requests for production, in the manner normally allowed by the Board, instead of bringing their dispute to the Board by motion to compel.

NOTES:

1. 37 C.F.R. § 2.120(e). *Cf. Amazon Technologies v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009).

2. *Cf. Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990).

3. *Hewlett Packard Enterprise Development LP v. Arroware Industries, Inc.*, 2019 USPQ2d 158663, at *3 (TTAB 2019) ("Allowing Respondent to limit its responses to only those answers it chose to give prior to asserting the discovery requests are excessive in number, and thereby precluding Petitioner an opportunity to reformulate its requests, would defeat the purpose of Trademark Rules 2.120(d) and 2.120(e) and disregard the parties' affirmative duty to cooperate in the discovery process.").

4. 37 C.F.R. § 2.120(e) and 37 C.F.R. § 2.120(f).

5. *Cf. Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016) (parties should specifically discuss their respective counting methods in attempt to resolve dispute over number of interrogatories).

6. *Cf. Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990). *See also Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398, 1398-99 (TTAB 1990) (excusing obligation to answer excessive set); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990). *Cf. Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1468 n.6 (TTAB 1990) (opposer may seek answers by taking discovery deposition of applicant).

7. 37 C.F.R. § 2.120(a)(3). *Cf. Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990).

8. *Cf. Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398, 1399 (TTAB 1990) (refusal to respond to document requests was proper; petitioner could not respond to document requests without first having to answer excessive interrogatories).

407 Requests for Admissions

407.01 When Permitted and By Whom

During the discovery period in an inter partes proceeding before the Board, any party may serve written requests for admissions on any other party. [Note 1.] Like interrogatories and requests for production of documents, requests for admission may be served on an adversary after service of or contemporaneously with initial disclosures, absent a stipulation or granted motion or order of the Board to the contrary. [Note 2.] TBMP § 403.01 and TBMP § 403.02. Requests for admissions, like interrogatories and requests for production of documents, must be served early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses will be due no later than the close of discovery. [Note 3.] TBMP § 403.02.

NOTES:

1. Fed. R. Civ. P. 36(a); 37 C.F.R. § 2.120(i).

2. 37 C.F.R. § 2.120(a)(3).

3. 37 C.F.R. § 2.120(a)(3). *See also Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268, 1270 (TTAB 2017) (discovery must be served "early enough … so that responses will be due no later than the close of discovery"); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951 (October 7, 2016).

407.02 Scope and Nature of Requests for Admission

Fed. R. Civ. P. 36(a) Requests for Admission.

Fed. R. Civ. P. 36(a)(1) Scope. *A party may serve on any other party a written request to admit, for purposes of the pending action only, of the truth of any matters within the scope of Rule 26(b)(1) relating to:*

(A) *facts, the application of law to fact, or opinions about either; and*

(B) *the genuineness of any described documents.*

Fed. R. Civ. P. 36(a)(2) Form; Copy of a Document. *Each matter must be separately stated. A request to admit the genuineness of a document must be accompanied by a copy of the document unless it is, or has been, or otherwise furnished or made available for inspection and copying.*

The scope and nature of requests for admission, in inter partes proceedings before the Board, are governed by Fed. R. Civ. P. 36(a), which in turn refers to Fed. R. Civ. P. 26(b)(1).

For a discussion of the scope of discovery permitted under Fed. R. Civ. P. 26(b)(1) and electronically stored information, see TBMP § 402.01 and TBMP § 402.02.

By definition, requests for admissions are designed to confirm the accuracy of information already available and are not designed to seek discovery of unknown information. Requests for admission are particularly useful for determining, prior to trial, which facts are not in dispute, thereby narrowing the matters that must be tried. These requests are also useful as a means of facilitating the introduction into evidence of documents produced by an adversary in response to a request for production of documents. [Note 1.] TBMP § 403.05(b).

Unlike an interrogatory, through which a party asks its adversary to provide certain substantive information, a request for admission is a means through which a party asks its adversary to stipulate to a certain matter so as to reduce issues for trial. [Note 2.] A party responding to a request for admission must admit the matter of which an admission is requested, deny the matter, or state in detail the reasons why the responding party cannot truthfully admit or deny the matter. [Note 3.] *See*TBMP § 407.03(b) (Nature of Responses). An admission in response to a request for admission "conclusively establishe[s]" the matter that is the subject of that request. [Note 4.] However, a denial in response to a request for admission is merely a refusal to stipulate to a certain matter, thus leaving that matter to be resolved on the merits. [Note 5.] Accordingly, requests for admission are not properly used as additional means of obtaining substantive information to circumvent the numerical limit on interrogatories. [Note 6.] Further, a motion to test the sufficiency of a response to a request for admission is not properly based on a denial of a request for admissions that a propounding party/movant believes should have been admitted. [Note 7.]

NOTES:

1. *See, e.g., ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351, 1353 n.6 (TTAB 2007) (opposer filed notice of reliance on applicant's response to request for admission and exhibits thereto that all documents it produced in response to opposer's discovery requests were authentic for purposes of admission into evidence during the testimony period in the opposition proceeding); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103 (TTAB 2007) (documents produced in response to petitioner's interrogatories under Fed. R. Civ. P. 33(d) for which respondent admitted via a request for admission were true and correct copies of authentic documents could be introduced by way of notice of reliance).

2. *See The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2152 (TTAB 2013).

3. Fed. R. Civ. P. 36(a)(4).

4. Fed. R. Civ. P. 36(b).

5. *See The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d, 2149, 2152 (TTAB 2013); *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1036 n.8 (TTAB 2007).

6. *Cf. Hewlett Packard Enterprise Development LP v. Arroware Industries, Inc.*, 2019 USPQ2d 158663, at *7 (TTAB 2019) (use of a blanket interrogatory or document request to discover information or documents that form the factual bases for a responding party's answer to each request for admission is impermissible).

7. *See National Semiconductor Corp. v. Ramtron International Corp.*, 265 F.Supp.2d 71 (D.D.C. 2003).

407.03 Responses to Requests for Admission

407.03(a) Time for Service of Responses

37 C.F.R. § 2.120(a)(3) . . . *Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within thirty days from the date of service of such discovery requests.* * * * *

Fed. R. Civ. P. 36(a)(3) Time to Respond; Effect of Not responding. *A matter is admitted unless, within 30 days after being served, the party to whom the request is directed serves on the requesting party a written answer or objection addressed to the matter and signed by the party or its attorney.*

Fed. R. Civ. P. 6(b)(1)(B) *When an act may or must be done within a specified time, the court may, for good cause, extend the time: on motion made after the time has expired if the party failed to act because of excusable neglect.*

Responses to requests for admission must be served within 30 days after the date of service of the requests. [Note 1.] TBMP § 403.03. The time to respond may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board, but the response may not be due later than the close of discovery. [Note 2.] The resetting of a party's time to respond to any outstanding requests for admission will not result in the automatic rescheduling of the discovery and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. [Note 3.]

Service of responses to requests for production must be made by email, unless otherwise stipulated, or if the serving party attempted service by email but service could not be made due to technical problems or extraordinary circumstances, by the manner described in 37 C.F.R. § 2.119(b)(1) - 37 C.F.R. § 2.119(b)(4). A party not domiciled in the United States and not yet represented by an attorney licensed to practice law in the United States is not eligible to use United States postal mail. United States postal mail may not be available for U.S. counsel located outside the United States. [Note 4.] TBMP § 113.05. Additionally, even if service of requests for admission is made by postal service or overnight courier, 37 C.F.R. § 2.119(c) has been amended to remove the past provision that allowed an additional five days to the proscribed response period after the date of service so that no additional time for service of discovery responses is allowed for responding to the requests under any manner of service. [Note 5.] TBMP § 403.03

Under Fed. R. Civ. P. 36, a requested admission is deemed admitted unless a written answer or objection is provided to the requesting party within thirty days after service of the request, or within such time as the parties agree to in writing. [Note 6.]

If a party on which requests for admission have been served fails to timely respond thereto, the requests will stand admitted by operation of law [Note 7] unless the party is able to show that its failure to timely respond was the result of excusable neglect [Note 8] or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b) and granted by the Board. [Note 9.] It is not necessary to file a motion to deem requests for admissions admitted when no response is served, since the admissions are deemed admitted by operation of Fed. R. Civ. P. 36(a).

For further information concerning motions pursuant to Fed. R. Civ. P. 36(b) to withdraw or amend admissions, see TBMP § 525.

NOTES:

1. Fed. R. Civ. P. 36(a)(3); 37 C.F.R. § 2.120(a)(3).

2. 37 C.F.R. § 2.120(a)(3).

3. 37 C.F.R. § 2.120(a)(3).

4. 37 C.F.R. § 2.119(b); 37 C.F.R. § 2.119(d). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69959 (October 7, 2016).

5. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (October 7, 2016).

6. Fed. R. Civ. P. 36(a)(3).

7. *Fram Trak Industries v. Wiretracks LLC*, 77 USPQ2d 2000, 2005 (TTAB 2006) (requests for admissions deemed admitted by respondent's failure to respond to petitioner's requests for admissions); *Pinnochio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1228 n.5 (TTAB 1989) (same).

8. Fed. R. Civ. P. 6(b)(1)(B); *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007) (counsel's mistaken belief that opposing counsel would grant an extension for responding to admissions did not constitute excusable neglect to reopen time to respond under Fed. R. Civ. P. 6(b)); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2064 n.1 (TTAB 1990) (to the extent applicant by its motion sought to be relieved of the untimeliness of its response, motion was not well taken because the reasons for failing to timely respond did not constitute excusable neglect).

9. Fed. R. Civ. P. 36(b); *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007) (finding merits of action subserved by withdrawal of admissions and replacement with later served responses and finding no prejudice to petitioner under Fed. R. Civ. P. 36(b)); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) ("...where failure to timely respond to a request for admission has harsh result, Rule 36(b) provides method for obtaining relief."). *See also American Automobile Association (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) (court may not sua sponte withdraw or ignore admissions without a motion to withdraw or amend); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989) (presentation of merits of case aided by relieving opposer of admission on relevant issue and prejudice avoided by allowing applicant limited discovery as to the amended answer); *BankAmerica Corp. v. International Travelers Cheque Co.*, 205 USPQ 1233, 1235 (TTAB 1979) (motion to withdraw admissions by default denied, but to extent admissions are contradicted by evidence, they will not be relied on for

purposes of deciding whether entry of summary judgment is appropriate); *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 361 n.2 (TTAB 1978) (by failing to answer requests for admissions, opposer admitted that it abandoned use of certain registered marks), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979).

407.03(b) Nature of Responses

Fed. R. Civ. P. 36(a)(4) Answer. *If a matter is not admitted, the answer must specifically deny it or state in detail why the answering party cannot truthfully admit or deny it. A denial must fairly respond to the substance of the matter; and when good faith requires that a party qualify an answer or deny only a part of a matter, the answer must specify the part admitted and qualify or deny the rest. The answering party may assert lack of knowledge or information as a reason for failing to admit or deny only if the party states that it has made reasonable inquiry and that the information it knows or can readily obtain is insufficient to enable it to admit or deny.*

Fed. R. Civ. P. 36(a)(5) Objections. *The grounds for objecting to a request must be stated. A party must not object solely on the ground that the request presents a genuine issue for trial.*

Responses to requests for admission must be made in writing, and should include an answer or objection to each matter of which an admission is requested. [Note 1.]

The Board prefers that the responding party reproduce each request immediately preceding the answer or objection thereto.

An answer must admit the matter of which an admission is requested, deny the matter, or state in detail the reasons why the responding party cannot truthfully admit or deny the matter. A denial shall fairly meet the substance of the requested admission, and when good faith requires that a party qualify an answer or deny only a part of the matter of which an admission is requested, the party shall specify as much of it as is true and qualify or deny the remainder. An answering party may not give lack of information or knowledge as a reason for failure to admit or deny unless the party states that the party has made reasonable inquiry and that the information known or readily obtainable by the party is insufficient to enable the party to admit or deny. [Note 2.]

If the responding party objects to a request for admission, the reasons for objection must be stated. If a responding party believes that a matter of which an admission has been requested presents a genuine issue for trial, the party may not object to the request on that ground alone. Rather, the party may deny the matter; alternatively, the party may set forth reasons why it cannot admit or deny the matter. [Note 3.]

It is generally inappropriate for a party to respond to requests for admission by filing a motion attacking them, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by answering those requests that it believes to be proper and by stating its reasons for objecting to those that it believes to be improper. [Note 4.] *See*TBMP § 410. For information regarding a party's duty to supplement requests for admissions, see TBMP § 408.03.

NOTES:

1. Fed. R. Civ. P. 36(a).

2. Fed. R. Civ. P. 36(a).

3. Fed. R. Civ. P. 36(a).

4. *Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016).

407.03(c) Signature of Responses

Answers and objections to requests for admission may be signed either by the responding party, or by its attorney. [Note 1.] However, an attorney who signs answers or objections to requests for admission risks becoming a witness or disqualification from representation. [Note 2.]

NOTES:

1. Fed. R. Civ. P. 36(a)(3).

2. *See* 37 C.F.R. § 11.307. *Cf. Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ2d 1663, 1666 n.4 (TTAB 1988).

407.04 Effect of Admission

Any matter admitted (either expressly, or for failure to timely respond) under Fed. R. Civ. P. 36(a) is conclusively established unless the Board, on motion, permits withdrawal or amendment of the admission or the Board permits a reopening of the time for responding to the admission requests. [Note 1.]

For further information concerning motions to withdraw or amend an admission, see TBMP § 525.

An admission made by a party under Fed. R. Civ. P. 36(a) is only for the purpose of the pending proceeding. It is not an admission for any other purpose, nor may it be used against that party in any other proceeding. [Note 2.]

The denial of a request for admission establishes neither the truth nor the falsity of the assertion, but rather leaves the matter for proof at trial. [Note 3.]

NOTES:

1. Fed. R. Civ. P. 36(b); Fed. R. Civ. P. 6(b)(1)(B). *See Texas Department of Transportation v. Tucker*, 95 USPQ2d 1241, 1244 (TTAB 2010) (admission conclusively establishes matter that is the subject of request for admission, subsequent argument to the contrary in response brief insufficient to raise genuine issue of material fact); *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1037 n.8 (TTAB 2007) ("An admission in response to a request for admission 'conclusively establishe[s]' the matter that is subject of that request . . . . However, a denial in response to a request for admission is merely a refusal to stipulate to certain matter."). *See also American Automobile Association, v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1144 (5th Cir. 1991) (an admission not withdrawn or amended cannot be rebutted by contrary testimony at trial); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1846 n.7 (TTAB 2004) (because proceedings were deemed suspended prior to service of requests for admissions, Board declined to treat requests for admissions as having been admitted by applicant for failure to timely respond, considering only those requests applicant expressly admitted); *Olin Corp. v. Hydrotreat, Inc.*, 210 USPQ 63, 65 n.4 (TTAB 1981) (anything not admitted is not established).

2. Fed. R. Civ. P. 36(b).

3. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957 n.10 (TTAB 2008).

407.05 Limit on Number

407.05(a) Description of Limit

37 C.F.R. § 2.120(i) ***Requests for admission.*** *The total number of requests for admission which a party may serve upon another party pursuant to Rule 36 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts . . . . However, independent of this limit, a party may make one comprehensive request for admission of any adverse party that has produced documents for an admission authenticating specific documents, or specifying which of those documents cannot be authenticated.*

The total number of requests for admission which a party may serve on another party in a proceeding may not exceed 75, counting subparts, except that the Board, may allow additional requests for admission upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. [Note 1.] *See*TBMP § 519. Independent of this numerical limit, a party may make one additional comprehensive request for admission of any adverse party that has produced documents, for authenticating specific documents, or specifying which of those documents cannot be authenticated. [Note 2.]

NOTES:

1. 37 C.F.R. § 2.120(i); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951, 69961 (October 7, 2016). *Cf. Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1467 n.5 (TTAB 1990) (the Board stating in the context of interrogatories in excess of the limit that "good cause will generally be found only where a legitimate need for further discovery by means of interrogatories is shown . . . the fact that the additional interrogatories served by opposer may be relevant and narrowly drawn to a single issue is insufficient, in and of itself, to demonstrate good cause.").

2. 37 C.F.R. § 2.120(j); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951, 69961 (October 7, 2016).

407.05(b) Application of Limit: Sets of Requests for Admission

The numerical limit specified in 37 C.F.R. § 2.120(i) pertains to the total number of requests for admission that one party may serve on another party over the course of an entire proceeding, not just per set of requests for admission. Thus, if a party to a proceeding before the Board serves, over the course of the proceeding, two or more separate sets of requests for admission directed to the same party, the requests in the separate sets would be added together for purposes of determining whether the numerical limit specified in the rule has been exceeded. [Note 1.]

Accordingly, a party which is preparing a first set of requests for admission should consider reserving a portion of its allotted 75 requests (counting subparts) to use for follow-up discovery, unless it is sure that it will not be serving follow-up requests for admission.

NOTES:

1. *Cf. Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1467 (TTAB 1990) (interrogatories).

407.05(c) Application of Limit: Multiple Marks, Etc.

37 C.F.R. § 2.120(i) does not provide for extra requests for admission in cases where more than one mark is pleaded and/or attacked by the plaintiff (whether in a single proceeding, or in consolidated proceedings). Similarly, the rule does not provide for extra requests for admission in cases where there is a counterclaim. That is, the mere fact that a proceeding involves multiple marks (whether in a single proceeding, or in consolidated proceedings) and/or a counterclaim does not mean that a party is entitled to serve 75 requests for admission, counting subparts, for each mark, or for each proceeding that has been consolidated, or for both the main claim and the counterclaim. Nor does such fact, in and of itself, constitute good cause for a motion for leave to serve additional requests for admission. However, a proceeding with multiple marks and/or a counterclaim may involve unusually numerous or complex issues, and these are factors that will be considered in determining a motion for leave to serve additional requests for admission. [Note 1.]

NOTES:

1. 37 C.F.R. § 2.120(i). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69961 (October 7, 2016) (providing examples that may support a showing of good cause for leave to serve additional requests for admission).

407.05(d) Application of Limit: Counting Requests for Admission

In determining whether the number of requests for admission served by one party on another exceeds the limit specified in 37 C.F.R. § 2.120(i), requests for admission will be counted reflecting the form articulated in Fed. R. Civ. P. 36(a)(2), which states: "Each matter must be separately stated." [Note 1.] The method for counting requests for admission therefore differs from the method for counting interrogatories and requests for production of document and things.

NOTES:

1. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69962 (October 7, 2016).

407.05(e) Remedy for Excessive Requests for Admission

37 C.F.R. § 2.120(j) . . . *If a party upon which requests for admission have been served believes that the number of requests for admission exceeds the limitation specified in this paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving answers and specific objections to the requests for admission, serve a general objection on the ground of their excessive number.*

If a party on which requests for admissions have been served, in a proceeding before the Board, believes that the number of requests exceeds the limit specified in 37 C.F.R. § 2.120(i), and wishes to object to the requests on this basis, the party must, within the time for (and instead of) serving responses and specific objections to the requests, serve a general objection on the ground of their excessive number. [Note 1.] A party should not answer what it considers to be the first 75 requests for admissions and object to the rest as excessive. [Note 2.] Failure to comply with the procedure set forth in 37 C.F.R. § 2.120(i) and to serve a general objection instead of responding to the requests may result in waiver of the right to object to the requests on the ground that they exceed the number permissible under the Board's rules. [Note 3.]

If a general objection on the ground of excessive number is asserted, and the propounding party, in turn, believes that the objection is not well taken, and wishes to obtain an adjudication from the Board as to the sufficiency thereof, the propounding party must file a motion to determine the sufficiency of the general objection. [Note 4.] The motion must be accompanied by copies of the set(s) of requests for admission which together are said to exceed the limitation, any exhibits to the requests, and the general objection to the requests, and must be supported by a showing from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion and has been unable to reach agreement. [Note 5.] It is further recommended that the moving party set out its counting method showing that the number of requests for admission does not exceed 75. [Note 6.] For further information concerning motions to test the sufficiency of objections to requests for admission, see TBMP § 524.

If, on a motion to determine the sufficiency of a general objection to requests for admission on the ground of excessive number, the Board finds that the requests for admission are excessive in number, and that the propounding party has not previously used up its allotted 75 requests, the Board normally will allow the propounding party an opportunity to serve a revised set of requests for admission not exceeding the numerical limit. The revised set of requests for admission serves as a substitute for the excessive set, and thus is deemed timely if the excessive set was timely. [Note 7.]

However, if an order providing for a revised set of requests for admission is issued late in the discovery period or after the close of the discovery period, the discovery period will be extended or reopened, as appropriate, to permit service of and responses to the revised set. Where discovery is reopened, the scope of the revised set may not exceed the scope of the excessive set, that is, the revised set may not seek information beyond the scope of the excessive set. [Note 8.]

In those cases where a party which has propounded requests for admission realizes, on receipt of a general objection thereto on the ground of excessive number, that the requests for admission are, in fact, excessive in number, it is strongly recommended that the parties voluntarily agree to the service of a revised set of requests, in the manner normally allowed by the Board, instead of bringing their dispute to the Board by a motion to test the sufficiency of the general objection.

NOTES:

1. 37 C.F.R. § 2.120(i). *Cf. Amazon Technologies v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009).

2. *Cf. Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990) (stating that a party responding to interrogatories should not answer what it considers to be the first seventy-five interrogatories and file a motion for a protective order as to the remainder).

3. *Cf. Hewlett Packard Enterprise Development LP v. Arroware Industries, Inc.*, 2019 USPQ2d 158663, at *3 (TTAB 2019) ("Allowing Respondent to limit its responses to only those answers it chose to give prior to asserting the discovery requests are excessive in number, and thereby precluding Petitioner an opportunity to reformulate its requests, would defeat the purpose of Trademark Rules 2.120(d) and 2.120(e) and disregard the parties' affirmative duty to cooperate in the discovery process.").

4. *See* Fed. R. Civ. P. 36(a)(3); 37 C.F.R. § 2.120(i)(1); TBMP § 524.01.

5. 37 C.F.R. § 2.120(i)(1).

6. *Cf. Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016) (parties should specifically discuss their respective counting methods in attempt to resolve dispute over number of interrogatories).

7. *Cf. Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990). *See also Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398, 1398-99 (TTAB 1990) (excusing obligation to answer excessive set); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990). *Cf. Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1468 n.6 (TTAB 1990) (opposer may seek answers by taking discovery deposition of applicant).

8. 37 C.F.R. § 2.120(a)(3). *Cf. Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990).

408 Duties to Cooperate, Search Records, Supplement

408.01 Duty to Cooperate

The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, [Note 1] and looks with extreme disfavor on those who do not. Each party and its attorney or other authorized representative has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. [Note 2.] Discovery before the Board is not governed by the concept of priority of discovery – that is, a party is not relieved of its discovery obligations, including its duty to cooperate, in spite of the fact that an adverse party wrongfully may have failed to fulfill its own obligations. [Note 3.]

NOTES:

1. *See Anand K. Chavakula v. Praise Broadcasting aka Praise FM*, 2020 USPQ2d 10855, at *4 (TTAB 2020) (Board found "troubling" petitioner's actions deliberately misleading respondent with "promised future service of its discovery responses while in fact it was preparing to file a summary judgment motion…"); *Andrew R. Flanders v. DiMarzio, Inc.*, 2020 USPQ2d 10671, at *2 (TTAB 2020) (Board found that moving party made good faith effort prior to filing motion for protective order where the parties had previously conferenced with the assigned interlocutory attorney to attempt to resolve dispute regarding deposition location of respondent's designated Fed. R. Civ. P. 30(b)(6) witness); *Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016) (parties have affirmative duty to cooperate in the discovery process; improper to file motion for protective order instead of responding to discovery requests in a timely manner); *Cadbury UK Ltd. v. Meenaxi Enter., Inc.*, 115 USPQ2d 1404, 1408 (TTAB 2015) (parties expected to demonstrate good faith and cooperation during discovery; party cannot avoid discovery obligations due to an obvious typographical error in discovery requests); *Panda Travel Inc. v Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009) ("Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary."); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (quoting *Nevada Power Co. v. Monsanto Co.*, 151 F.R.D. 118, 120 (D. Nev. 1993)) ("In order for the meet and confer process to be meaningful and serve its intended purpose, 'the parties must present to each other the merits of their respective positions with the same candor, specificity, and support during informal negotiations as during the briefing of discovery motions.'"). *See also Hot*

Tamale Mama…and More, LLC v. SF Investments, Inc., 110 USPQ2d 1080, 1081 n.1 (TTAB 2014) (simply ignoring deadlines to serve discovery responses or seek an extension of time to do so is inconsistent with the Board's expectation that the parties and their attorneys cooperate in the discovery process); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (parties have a duty to cooperate in resolving conflicts in the scheduling and taking of depositions).

2. Fed. R. Civ. P. 26(g). *See, e.g., SFM, LLC v. Corcamore, LLC*, 129 USPQ2d 1072, 1078 (TTAB 2018) (defendant refused to cooperate in the discovery process for over sixteen months); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (parties expected to cooperate in the meet and confer process by presenting to each other the merits of their respective positions with candor, specificity and support); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 n.4 (TTAB 1989) (Board warned counsel for opposer that its conduct of discovery in the case was "uncooperative" and "improper" and that any further misconduct may result in the imposition of the estoppel sanction); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (in view of parties' impasse, Board was burdened with resolving numerous requests for discovery); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304-05 (TTAB 1987) (both parties failed to cooperate, thus saddling Board with needless motions); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (prior to seeking Board intervention, parties must narrow amount of disputed requests to reasonable number); *Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341, 344 (TTAB 1984) (failure to cooperate in discovery and comply with Board order resulted in the entry of sanctions in the form of judgment); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (it was clear from number and nature of opposer's discovery requests and applicant's blanket objections thereto that neither party was cooperating). *See also C. H. Stuart Inc. v. Carolina Closet, Inc.*, 213 USPQ 506, 507 (TTAB 1980) (opposer's "voluminous" discovery requests were "oppressive and nothing short of harassment" to applicant); *C. H. Stuart Inc. v. S. S. Sarna, Inc.*, 212 USPQ 386, 387 (TTAB 1980) (Board granted applicant's motion for protective order; opposer's "boiler-plate" discovery requests designed for an infringement action deemed harassment); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 584 (TTAB 1975) (applicant's motion to compel denied due to lack of good faith effort to resolve dispute); *Tektronix, Inc. v. Tek Associates, Inc.*, 183 USPQ 623, 624 (TTAB 1974) (lack of good faith effort); *Gastown Inc. of Delaware v. Gas City, Ltd.*, 180 USPQ 477, 477-78 (TTAB 1974) (opposer precluded from objecting to applicant's interrogatories in view of its having served essentially the same interrogatories).

3. *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990) (citing Fed. R. Civ. P. 26(d)) and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986)).

408.01(a) Obligation to Conduct Discovery Conference

In the interest of promoting, among other things, cooperation in the discovery process, parties are required to hold a conference to discuss settlement and plans for discovery. [Note 1.] The purpose of the conference for the parties is to discuss the "nature and basis of the involved claims and defenses, the possibility of settlement of the case or modification of the pleadings, and plans for disclosures and discovery," as well as the subjects set forth in Fed. R. Civ. P. 26(f) and any other subjects that the Board requires to be discussed in the institution order for the case, including alternative means for case resolution such as Accelerated Case Resolution (ACR). [Note 2.] *See* TBMP § 528.05(a)(2) and TBMP § 702.04 for further information on ACR. The parties are free to discuss additional topics besides those outlined in Fed. R. Civ. P 26(f) and the institution order that could promote settlement or efficient adjudication of the Board proceeding. [Note 3.] Mere discussion of settlement does not substitute for a full discovery conference addressing the issues outlined in Fed. R. Civ. P. 26 and the Board's institution order. [Note 4.] Thus, the parties are *required* to discuss their plans relating to disclosures, discovery and trial evidence unless they are successful in settling the case.

All parties to a proceeding have a duty to cooperate and conduct the discovery conference in a timely fashion. [Note 5.] If a party refuses to cooperate in scheduling the discovery conference, it is recommended that the party seeking to schedule the conference contact the assigned Board attorney via telephone to facilitate the matter prior to the deadline for the conference. [Note 6.] In such instances, the Board professional will contact the non-cooperating party directly to schedule the conference. If the uncooperative party fails to respond to Board communications within a reasonable time frame, the Board will issue an order setting a date for the conference, and warning the uncooperative party that the conference will be held as scheduled, and that any party that has not participated may be subject to a motion for sanctions under 37 C.F.R. § 2.120(h). In certain instances, the Board may also order the uncooperative party to show cause why judgment should not be entered against it for failure to participate in the discovery conference. Alternatively, in instances where the party seeking to schedule the conference did not engage the Board, the party may file a motion for sanctions pursuant to 37 C.F.R. § 2.120(h). The Board may, upon grant of a motion for sanctions for failure of a party to participate in a discovery conference, impose any of the sanctions provided in Fed. R. Civ. P. 37(b)(2), including judgment. [Note 7.]

A motion to compel a party to participate in a discovery conference is not a prerequisite to filing a motion for sanctions under 37 C.F.R. § 2.120(h) because of an adverse party's unwillingness to participate in the required conference; however, the moving party must provide evidence of a good faith effort to schedule the conference in order to be able to prevail on a motion for such sanctions. [Note 8.] A motion for sanctions against a party for its failure to participate in the required discovery conference must be filed prior to the deadline for any party to make initial disclosures. [Note 9.]

For a more detailed discussion of discovery conferences, see TBMP § 401.01.

For general information on the conduct of telephone conferences, participation in telephone conferences, and issuance of rulings resulting from telephone conferences, see TBMP § 502.06(a).

NOTES:

1. *See* 37 C.F.R. § 2.120(a)(2); Fed. R. Civ. P. 26(f). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007). *See, e.g., Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761 (TTAB 2009).

2. *See, e.g., Promgirl, Inc. v. JPC Co.* , 94 USPQ2d 1759, 1761 (TTAB 2009). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69959, 69961 (October 7, 2016) (if voluminous productions anticipated, method of service is worthwhile issue to discuss at Board discovery conference; production of ESI is a subject for discussion at discovery conference); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244-45, 42252 (August 1, 2007) (possible modification or supplementation of standard protective order a subject for discovery conference; settlement a subject for discovery conference as well as modification of standard deadlines/obligations, specificity of initial disclosures, and expert disclosures sequence, timing and extent of information or material that must be disclosed to satisfy the expert disclosure obligation; whether to seek mediation, arbitration, mediation, or to proceed under Accelerated Case Resolution, manner in which evidence may be presented at trial, stipulations of facts for trial subject of discovery conference).

3. *See, e.g., Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761 (TTAB 2009).

4. *See, e.g., Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761 (TTAB 2009) (mere discussion of settlement does not substitute for full discovery conference of subjects set forth in Fed. R. Civ. P. 26 and Board's institution order).

5. *See, e.g., Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1762 (TTAB 2009) (responsibility to schedule a conference and to confer on each of the topics outlined in Fed. R. Civ. P. 26 and the institution order is a shared responsibility); *Guthy-Renker Corp. v. Boyd*, 88 USPQ2d 1701, 1703 (TTAB 2008) ("it is the equal responsibility of both parties to ensure that the discovery conference takes place by the assigned deadline"); *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1860 n.2 (TTAB 2008) (holding discovery conference is a mutual obligation).

6. *See, e.g., Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1762 (TTAB 2009).

7. 37 C.F.R. § 2.120(h); *Patagonia, Inc. v. Azzolini*, 109 USPQ2d 1859, 1861-63 (TTAB 2014).

8. *See, e.g., Promgirl, Inc., v. JPC Co.*, 94 USPQ2d 1759, 1762 (TTAB 2009) (opposer's motion for sanctions in the form of judgment denied where parties were engaged in settlement discussions and opposer did not broach the subject of scheduling the discovery conference until the deadline date, and only after opposer's settlement offer was rejected); *Guthy-Renker Corp. v. Boyd*, 88 USPQ2d 1701, 1703-04 (TTAB 2008) (motion for sanctions denied; moving party could have made additional efforts with adverse party to schedule discovery conference, including requesting Board participation in the discovery conference, but failed to do so).

9. 37 C.F.R. § 2.120(h)(1).

408.01(b) Obligation to Make Initial and Expert Testimony Disclosures

Fed. R. Civ. P. 26. Duty to Disclose; General Provisions Governing Discovery

(a) ***Required Disclosures.***

(1) ***Initial Disclosure.***

(A) ***In General.*** *Except as exempted by Rule 26(a)(1)(B) or as otherwise stipulated or ordered by the court, a party must, without awaiting a discovery request, provide to the other parties:*

(i) *the name and, if known, the address and telephone number of each individual likely to have discoverable information—along with the subjects of that information—that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment;*

(ii) *a copy—or a description by category and location—of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment;*

* * * *

(2) ***Disclosure of Expert Testimony.***

(A) ***In General.*** *In addition to the disclosures required by Rule 26(a)(1), a party must disclose to the other parties the identity of any witness it may use at trial to present evidence under Federal Rule of Evidence 702, 703, or 705.*

(B) ***Witnesses Who Must Provide a Written Report.*** *Unless otherwise stipulated or ordered by the court, this disclosure must be accompanied by a written report—prepared and signed by the witness—if*

the witness is one retained or specially employed to provide expert testimony in the case or one whose duties as the party's employee regularly involve giving expert testimony. The report must contain:

(i) *a complete statement of all opinions the witness will express and the basis and reasons for them;*

(ii) *the facts or data considered by the witness in forming them;*

(iii) *any exhibits that will be used to summarize or support them;*

(iv) *the witness's qualifications, including a list of all publications authored in the previous 10 years;*

(v) *a list of all other cases in which, during the previous 4 years, the witness testified as an expert at trial or by deposition; and*

(vi) *a statement of the compensation to be paid for the study and testimony in the case.*

(C) ***Witnesses Who Do Not Provide a Written Report.*** *Unless otherwise stipulated or ordered by the court, if the witness is not required to provide a written report, this disclosure must state:*

(i) *the subject matter on which the witness is expected to present evidence under Federal Rule of Evidence 702, 703, or 705; and*

(ii) *a summary of the facts and opinions to which the witness is expected to testify.*

37 C.F.R. § 2.120(a)(2)

(ii) *Initial disclosures must be made no later than thirty days after the opening of the discovery period.*

(iii) *Disclosure of expert testimony must occur in the manner and sequence provided in Rule 26(a)(2) of the Federal Rules of Civil Procedure, unless alternate directions have been provided by the Board in an institution order or any subsequent order resetting disclosure, discovery or trial dates. If the expert is retained after the deadline for disclosure of expert testimony, the party must promptly file a motion for leave to use expert testimony. Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the Board, either on its own initiative or on notice from either party of the disclosure of expert testimony, may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert.*

As part of the discovery phase parties are obliged to make initial disclosures and, when necessary, expert testimony disclosures. The Board adopted a disclosure regime to promote the early exchange of information and settlement and, for cases that do not settle, "more efficient discovery and trial, reduction of incidents of unfair surprise, and increase the likelihood of fair disposition of the parties' claims and defenses." [Note 1.] In addition, the use of routine disclosures of the types provided for in the Federal Rules of Civil Procedure is intended to "obviate the need to use traditional discovery to obtain 'basic information' about a party's claims or defenses." [Note 2.]

Each party involved in an inter partes proceeding is obligated to make initial disclosures to every other party, by the deadline set in the Board's institution order, or as may be reset by stipulation of the parties approved by the Board, or by motion granted by the Board, or by order of the Board. [Note 3.] The initial disclosure requirement is intended to provide for the disclosure of names of potential witnesses and basic information about documents and things that a party may use to support a claim or defense. [Note 4.] Parties are encouraged in the spirit of cooperation to stipulate to rely on more expansive use of reciprocal disclosures in lieu of formal discovery, as a more efficient and less costly manner of litigating a Board proceeding, subject to Board approval. [Note 5.]

For a further discussion of initial disclosures, see TBMP § 401.02.

If a party decides to use expert testimony in a Board proceeding, pursuant to Fed. R. Civ. P. 26(a)(2), the party must serve expert disclosures 30 days prior to the close of discovery, and any reset expert disclosure deadline must always be scheduled prior to the close of discovery. [Note 6.] The expert disclosure requirement is intended to avoid any unfair surprise during the testimony period. [Note 7.] While the expert disclosure provided for in Fed. R. Civ. P. 26 may be extensive and should not, therefore be filed with the Board, the parties should inform the Board when an expert disclosure is made, so the Board can issue any appropriate order. [Note 8.] The Board may, for example, suspend proceedings to provide for the taking of any necessary discovery of the proposed expert witness, and to allow the adverse party or parties to determine whether it will be necessary to rely on a rebutting expert. [Note 9.] Parties are expected to cooperate in the process of exchanging information about any testifying experts, and should discuss during the discovery conference, the possibility of the presentation of expert testimony. [Note 10.] The parties should revisit these discussions whenever it appears that a testifying expert witness may become involved in the case. [Note 11.]

Where a party in its disclosures identifies an expert as a possible testifying witness under Rule 26(b)(4)(A), but subsequently re-designates the expert as a non-testifying or consulting expert under Fed. R. Civ. P. 26(b)(4)(D), the opposing party may depose that expert only upon a showing of "exceptional circumstances" under Fed. R. Civ. P. 26(b)(4)(D)(ii). [Note 12.]

For further information regarding expert disclosures, see TBMP § 401.03.

For a discussion regarding the modification of disclosure obligations, see TBMP § 401.04.

NOTES:

1. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244 (August 1, 2007). *See Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012) (disclosures, from initial through pretrial, and discovery responses should be viewed as a continuum of communication designed to avoid unfair surprise and to facilitate a fair adjudication of the case on the merits).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

3. 37 C.F.R. § 2.120(a)(1); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

4. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

5. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

6. 37 C.F.R. § 2.120(a)(2)(iii); 37 C.F.R. § 2.120(a)(2)(iv); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007) (under 37 C.F.R. § 2.120(a)(2), expert disclosures are governed by Fed. R. Civ. P. 26(a)(2) in the absence of an order from the Board setting a deadline). *See, e.g., Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1564 n.2 (TTAB 2014) (parties stipulated to deadlines for expert and rebuttal expert reports); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (because Rule 2.120(a)(2) does not require that a disclosing party inform the Board that an

expert disclosure has been made; failure to inform the Board of timely disclosure of an expert witness is not a basis for excluding the testimony of such expert witness); *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443, 1445 (TTAB 2009) (motion to strike witness testimony granted in view of noncompliance with 37 C.F.R. § 2.121(e)).

7. *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012) (disclosures, from initial through pretrial, and discovery responses should be viewed as a continuum of communication designed to avoid unfair surprise).

8. *See* 37 C.F.R. § 2.120(a)(2)(iii); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See also RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1493 n.3 (TTAB 2013); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011).

9. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See e.g.*, *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564-65 (TTAB 2014); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011).

10. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

11. *See General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 n.3 (TTAB 2011) (parties expected to cooperate to resolve problems arising from timely but incomplete expert disclosures).

12. *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1568 (TTAB 2014).

408.01(c) Duty to Cooperate With Regard to Written Discovery and Disclosures

Fed. R. Civ. P. 26(g)(1) Signature Required; Effect of Signature. *Every disclosure under Rule 26(a)(1) or (a)(3) and every discovery request, response, or objection must be signed by at least one attorney of record in the attorney's own name—or by the party personally, if unrepresented—and must state the signer's address, e-mail address, and telephone number. By signing, an attorney or party certifies that to the best of the person's knowledge, information, and belief formed after a reasonable inquiry:*

(A) *with respect to a disclosure, it is complete and correct as of the time it is made; and*

(B) *with respect to a discovery request, response, or objection, it is:*

(i) *consistent with these rules and warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law, or for establishing new law;*

(ii) *not interposed for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation; and*

(iii) *neither unreasonable nor unduly burdensome or expensive, considering the needs of the case, prior discovery in the case, the amount in controversy, and the importance of the issues at stake in the action.*

37 C.F.R. § 2.120(f)(1) *If a party fails to make required initial disclosures or expert testimony disclosure, or fails to designate a person pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, or if a party, or such designated person, or an officer, director or managing agent of a party fails to attend*

a deposition or fails to answer any question propounded in a discovery deposition, or any interrogatory, or fails to produce and permit the inspection and copying of any document, electronically stored information, or tangible thing, the party entitled to disclosure or seeking discovery may file a motion to compel disclosure, a designation, or attendance at a deposition, or an answer, or production and an opportunity to inspect and copy. A motion to compel initial disclosures must be filed within thirty days after the deadline therefor and include a copy of the disclosure(s), if any, and a motion to compel an expert testimony disclosure must be filed prior to the close of the discovery period. A motion to compel discovery must be filed before the day of the deadline for pretrial disclosures for the first testimony period as originally set or as reset. . . . A motion to compel initial disclosures, expert testimony disclosure, or discovery must be supported by a showing from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion but the parties were unable to resolve their differences. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.

The signature of a party or attorney constitutes a certification as to a discovery request, response, or objection and disclosure as set forth in Fed. R. Civ. P. 26(g)(1). [Note 1.] Provision is made, in Fed. R. Civ. P. 26(g), for the imposition of appropriate sanctions if a certification is made in violation of the rule. *See also*TBMP § 106.02 (Signature of Submissions). "The certification duty requires the party or attorney to make a reasonable inquiry into the factual basis of his response, request or objection." [Note 2.]

Because the signature of a party or its attorney to a request for discovery constitutes a certification by the party or its attorney that, inter alia, the request is warranted, consistent with the Federal Rules of Civil Procedure, and not unreasonable or unduly burdensome, a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary. A contention of this nature will be entertained only if it is supported by a persuasive showing of reasons why the discovery request is proper when propounded by one party but improper when propounded by another. [Note 3.] Similarly, the signature of a party or its attorney to a discovery response (i.e., response to interrogatory, request to admit, or request for production) or objection is a certification by the party or its attorney that, inter alia, the response or objection is warranted, consistent with the Federal Rules of Civil Procedure, and not interposed for any improper purpose such as to cause unnecessary delay or needlessly increase the cost of litigation. The certification requirement is distinguishable from the signature requirements in rules such as Fed. R. Civ. P. 33 [Note 4] and certifies that the party or attorney has made a reasonable effort to assure that all available information and documents responsive to the discovery demand have been provided. [Note 5.]

Under Fed. R. Civ. P. 26(g)(1)(A), a signature with respect to a disclosure constitutes certification that the disclosure is complete and correct at the time it was made. For further information regarding the form and signatures of disclosures, see TBMP § 401.06.

In addition, the duty to cooperate is embodied in the prerequisite that prior to filing a motion to compel disclosure or discovery, the moving party must make a good faith effort, by conference or correspondence, to resolve the discovery dispute prior to seeking Board intervention. [Note 6.] *See also*TBMP § 523.02. The motion must be supported by a showing that such a good faith effort was made by conference or correspondence. [Note 7.] The Board may, as necessary in any particular case, ensure that the parties have engaged in a sufficient effort to resolve their differences regarding discovery by requiring the parties to conference with the Board attorney assigned to the case prior to filing a motion to compel disclosures or discovery. *See*TBMP § 413.01.

NOTES:

1. *See Miss America Pageant v. Petite Productions, Inc.* , 17 USPQ2d 1067, 1069 (TTAB 1990). *Cf.* 37 C.F.R. § 11.18(b); Fed. R. Civ. P. 11.

2. Fed. R. Civ. P. 26 Notes of Advisory Committee on Rules – 1983 Amendment.

3. *See, e.g., Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990) (Board was persuaded that certain interrogatories would be unduly burdensome).

4. Fed. R. Civ. P. 26 Notes of Advisory Committee on Rules – 1983 Amendment.

5. Fed. R. Civ. P. 26 Notes of Advisory Committee on Rules – 1983 Amendment.

6. 37 C.F.R. § 2.120(f)(1). *See, e.g., Hot Tamale Mama…and More, LLC v. SF Investments., Inc.*, 110 USPQ2d 1080, 1082 (TTAB 2014) (Board found that single email exchange alone was insufficient to satisfy the good faith effort obligation to resolve discovery dispute prior to filing motion to compel); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (parties expected to cooperate in the meet and confer process by presenting to each other the merits of their respective positions with candor, specificity and support).

7. 37 C.F.R. § 2.120(f)(1). *See Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014) (statement of good faith effort to be supported by recitation of communications conducted including dates, summary of telephone conversations and copies of correspondence exchanged, where applicable). *Cf. International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1605 (TTAB 2002) (permission to file motion to compel denied where motion was devoid of good faith effort to resolve dispute prior to seeking Board intervention).

408.02 Duty to Search Records

A party served with a request for discovery has a duty to thoroughly search its records for all information properly sought in the request, and to provide such information to the requesting party within the time allowed for responding to the request. [Note 1.] With regard to document production requests, a proper written response to each request requires the responding party to state that there are responsive documents and that they either will be produced or will be withheld on a claim of privilege; to state an objection with appropriate reasons; or to state that no responsive documents exist. [Note 2.] With regard to electronically stored information, if no form for the electronically stored information is specified in the request or the party objects to the form, a proper written response includes a statement of the form the party intends to use in its response. [Note 3.] In addition, the responding party has a duty "to select and produce the items requested [and to avoid] simply dumping large quantities of unrequested materials onto the discovering party along with the items actually sought under [Fed. R. Civ. P. 34]." [Note 4.]

A responding party that, due to an incomplete search of its records, provides an incomplete response to a discovery request, may not thereafter rely at trial on information from its records which was properly sought in the discovery request but was not included in the response thereto (provided that the requesting party raises the matter by objecting to the evidence in question) unless the response is supplemented in a timely fashion pursuant to Fed. R. Civ. P. 26(e). [Note 5.] *See*TBMP § 527.01(e) ("Estoppel Sanction").

NOTES:

1. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

2. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000).

3. Fed. R. Civ. P. 34(b)(2)(D).

4. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000).

5. *See Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791-92 (TTAB 2009); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987).

408.03 Duty to Supplement Disclosures and Discovery Responses

Fed. R. Civ. P. 26(e) Supplementing Disclosures and Responses.

(1) ***In General.*** *A party who has made a disclosure under Rule 26(a)—or who responded to an interrogatory, request for production, or request for admission—must supplement or correct its disclosure or response:*

(A) *in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing; or*

(B) *as ordered by the court.*

(2) ***Expert Witness.*** *For an expert whose report must be disclosed under Rule 26(a)(2)(B), the party's duty to supplement extends both to information included in the report and to information given during the expert's deposition. Any additions or changes to this information must be disclosed by the time the party's pretrial disclosures under Rule 26(a)(3) are due.*

The duty to supplement disclosures and discovery responses in proceedings before the Board is governed by Fed. R. Civ. P. 26(e). [Note 1.] Under that rule, a party that has made an initial or expert disclosure or has responded to a request for discovery is under a duty to supplement or correct the disclosure or response in a timely manner to include information under the particular circumstances specified in Fed. R. Civ. P. 26(e). [Note 2.] However, if the information has otherwise been made known to the propounding party during the discovery process such as through a witness deposition or formal discovery, or was otherwise made known in writing, the answering party need not amend its prior response or previously made disclosure. [Note 3.] This is not an invitation to hold back material items and disclose them at the last minute. [Note 4.] A party who does so may be subject to the preclusion sanction set forth in Fed. R. Civ. P. 37(c)(1). [Note 5.] *See*TBMP § 527.01(e) ("Estoppel Sanction"). However, where there is prompt supplementation of the disclosure, either upon the initiative of the disclosing party, or after notification by the adverse party that the disclosure was incomplete, and while the discovery period remains open, the Board's policy is that neither the testimony to be proffered by the expert witness nor the information originally omitted will be excluded. [Note 6.] Fed. R. Civ. P. 37(c)(1)(A) and (B) do not apply in Board proceedings.

In addition, a duty to supplement disclosures or responses may be imposed by order of the Board. [Note 7.]

An expert report introduced during trial that contains additional opinions intended to rebut an adverse party's testimony, rather than to correct inaccuracies in the expert's report or deposition or to complete an otherwise

incomplete earlier expert report with newly discovered information does not qualify as a supplemental expert report under Fed. R. Civ. P. 26(e)(1)(A) and 26(e)(2). [Note 8.]

NOTES:

1. *See* 37 C.F.R. § 2.116(a).

2. *See Empresa Cubana Del Tabaco d.b.a Cubatabaco v. General Cigar Co., Inc.*, 2020 USPQ2d 10988, at *2 (TTAB 2020) (clarifying that supplemental expert reports filed on the pretrial disclosure due date are timely); *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1242-43 (TTAB 2012) (witness first identified in pretrial disclosure could have been identified in supplementary initial disclosures, discovery responses or supplemental discovery responses); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326-27 (TTAB 2011) (opposer was under a duty to supplement its discovery responses and disclosing for the first time in its pretrial and amended pretrial disclosures the identities of twenty-seven witnesses resulted in surprise to applicant); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1892 (TTAB 2011) (respondent supplemented its expert disclosures as soon as the deficiencies were brought to its attention so Board did not need to consider question of whether the omissions were substantially justified or harmless); *Vignette Corp. v. Marino*, 77 USPQ2d 1408 (TTAB 2005); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998).

3. *See Sheetz of Delaware, Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1345 n.7 (TTAB 2013) (party not required to supplement or correct initial disclosures to provide identifying information about witness listed in pretrial disclosures if that information previously has been made known to the other party in writing or during the discovery process); *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009) (opposer's failure to supplement its initial disclosures to identify foreign non-party witness as a potential witness does not preclude introduction of witness' discovery deposition at trial, even though opposer should have supplemented initial disclosures, because applicant was aware of witnesses' identity and subject matter of her testimony and was able to cross-examine the witness during the discovery phase). *See also* Fed. R. Civ. P. 26(e) Notes of Advisory Committee on Rules – 1983 Amendment ("no obligation to provide supplemental or corrective information that has been otherwise made known to the parties in writing or during the discovery process, as when a witness not previously disclosed is identified during the taking of a deposition. . . ."). *Cf. Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175 (TTAB 2010) (although identity of witness disclosed through responses to written discovery, pretrial disclosures required to be revised to limit witness testimony to certain subject matter).

4. *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009).

5. *See Empresa Cubana Del Tabaco d.b.a Cubatabaco v. General Cigar Co., Inc.*, 2020 USPQ2d 10988, at *4-6 (TTAB 2020) (applying Great Seats factors, Board found respondent's failure to timely disclose an expert supplemental report was not substantially justified or harmless; motion to strike granted as an estoppel sanction); *Gemological Institute of America, Inc. v. Gemology Headquarters International, LLC*, 111 USPQ2d 1559, 1562-63 (TTAB 2014) (estoppel sanction applies to untimely disclosure of expert opinion); *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012) (estoppel sanction imposed where witness first identified in pretrial disclosure); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326-28 (TTAB 2011) (estoppel sanction imposed with respect to the witnesses first disclosed in the amended and supplemental pretrial disclosures); *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1177 (TTAB 2010) (party warned during teleconference that it may be subject to the preclusion sanction where it "claimed" to have produced all responsive documents in its possession); *Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005) (opposer's request for reconsideration of Board order denying its motion for summary judgment denied; Board properly considered applicant's declaration provided

on summary judgment, reasoning that it would be "unfair to foreclose applicant from the opportunity to amplify the assertions made in his previous discovery responses in order to defend against opposer's motion for summary judgment"). *See also Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1758 (TTAB 2013), *aff'd mem.*, 565 F. App'x 900 (Fed. Cir. 2014) (declining to apply estoppel sanction with regard to opposer's failure to supplement discovery in connection with non-party witnesses and documents, which information was not available until after the close of discovery); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (deficiencies in timely expert disclosures cured promptly, motion to exclude expert testimony denied); *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859 (TTAB 2009) (because identity of non-party witness was made known during the discovery phase of the proceeding with more than two months remaining in discovery period and applicant had an opportunity to obtain additional discovery about witness, opposer's failure to supplement its initial disclosures did not preclude introduction of deposition at trial).

6. *See General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1892 (TTAB 2011). *Cf. Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326 (TTAB 2011) (testimony of witnesses first identified in supplemental pretrial disclosures made five days after service of amended pretrial disclosures made not excluded based on alleged untimeliness).

7. *See Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1179 (TTAB 2010) (party ordered to serve revised pretrial disclosures). *Cf. Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720-21 (TTAB 1987); *Andersen Corp. v. Therm-O-Shield International, Inc.*, 226 USPQ 431, 434 n.8 (TTAB 1985); *JSB International, Inc. v. Auto Sound North, Inc.*, 215 USPQ 60, 62 (TTAB 1982); *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, 805 (CCPA 1978).

8. *See Empresa Cubana Del Tabaco d.b.a Cubatabaco v. General Cigar Co., Inc.*. 2020 USPQ2d 10988, at *4 (TTAB 2020) (respondent failed to demonstrate that "the [expert] Supplemental Report corrects, clarifies, or fills in a gap in the Original Report that rendered the original disclosure inaccurate or misleading;" seeking to add new examples and illustrations does not constitute proper supplementation under Fed. R. Civ. P. 26(e)(2)); *Gemological Institute of America, Inc. v. Gemology Headquarters International, LLC*, 111 USPQ2d 1559, 1562 (TTAB 2014) (discussing what is proper supplementation to an expert report).

409 Filing Discovery Requests, Discovery Responses, and Disclosures With Board

37 C.F.R. § 2.120(k) ***Use of discovery deposition, answer to interrogatory, admission, or written disclosure.***

* * * *

37 C.F.R. § 2.120(k)(6) *Paragraph (k) of this section will not be interpreted to preclude reading or use of written disclosures or documents, a discovery deposition, or answer to an interrogatory, or admission as part of the examination or cross-examination of any witness during the testimony period of any party.*

* * * *

37 C.F.R. § 2.120(k)(8) *Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the discovery process should not be filed with the Board except when submitted with a motion relating to disclosure or discovery, or in support of or response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.*

Discovery requests, discovery responses, materials or depositions obtained through the discovery process, as well as initial and expert disclosures should not be filed with the Board except when submitted:

(1) with a motion relating to discovery (e.g., motion to compel, motion to determine the sufficiency of an answer or objection to a request for admission, motion for leave to serve additional interrogatories, motion to challenge the sufficiency of initial or expert disclosures);

(2) in support of or in response to a motion for summary judgment;

(3) under a notice of reliance during a party's testimony period, to the extent that the discovery response or disclosure may properly be submitted by notice of reliance [Note 1]; or

(4) as exhibits to a testimony deposition.

While a party that has disclosed to an adverse party or parties that it will or may use expert testimony should not file with the Board copies of the documents and information being disclosed to the adverse party or parties, it should file with the Board a notice that it has made such a disclosure. [Note 2.] "Any party disclosing plans to use an expert must notify the Board that it has made the required disclosure. The Board may then suspend proceedings to allow for discovery limited to experts. The suspension order may anticipate and also provide for discovery regarding any expert that may subsequently be retained for rebuttal purposes." [Note 3.]

Pretrial disclosures, *see* 37 C.F.R. § 2.121(e), are not discovery period disclosures, as are initial disclosures and expert disclosures. However, like the latter, neither pretrial disclosures nor notification of service of pretrial disclosures need be filed with the Board, unless a motion to strike evidence or testimony of a witness has been filed. [Note 4.] For further information on pretrial disclosures, see TBMP § 702.01.

In addition, when a party objects to proffered evidence or files a motion to strike the testimony of a witness on the ground that the name of the witness or the identification of documents or other evidence should have been, but was not, provided in response to a request for discovery or in disclosures (whether initial, expert or pretrial), a copy of the pertinent discovery request(s) and response(s) or disclosures should be submitted in support of the objection or motion to strike.

For more information regarding the filing of discovery material, see the cases cited in the note below. [Note 5.]

NOTES:

1. *Hiraga v. Arena* , 90 USPQ2d 1102, 1105 (TTAB 2009) (ordinarily, an answer to an interrogatory may be submitted and made part of the record by only the inquiring party, i.e., a party generally may not rely on his own responses to discovery requests under a notice of reliance; the only produced documents that may be submitted by a notice of reliance under 37 C.F.R. § 2.122(e) are printed publications and official records); *Life Zone Inc. v. Middleman Group Inc.* , 87 USPQ2d 1953, 1955 (TTAB 2008) (the categories of materials which may be submitted under a notice of reliance are limited, consisting only of an adverse party's discovery deposition, answer to an interrogatory, or admission to a request for admission, 37 C.F.R. § 2.120(j)(3)(i), redesignated by amendment to 37 C.F.R. § 2.120(k)(3)(i); printed publications and official records, 37 C.F.R. § 2.122(e)); *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.* , 84 USPQ2d 1912, 1914 n.3 (TTAB 2007) (written response to document requests that no such documents exist can be made of record by notice of reliance); *ProQuest Information and Learning Co. v. Island* , 83 USPQ2d 1351, 1353 n.6 (TTAB 2007) (opposer filed a notice of reliance, pursuant to 37 C.F.R. § 2.120(j)(3)(i), redesignated by amendment to 37 C.F.R. § 2.120(k)(3)(i), on the request for admission, the exhibits thereto, and its adversary's response by which adversary admitted that documents produced in response to discovery requests were authentic for

purposes of admission into evidence during testimony period of opposition proceeding); *Kohler Co. v. Baldwin Hardware Corp.* , 82 USPQ2d 1100, 1103-04 (TTAB 2007) (because respondent availed itself under Fed. R. Civ. P. 33(d) of the option to provide documents in response to petitioner's interrogatories and admitted via a request for admission that the documents it produced were true and correct copies of authentic documents, the documents could be introduced by way of notice of reliance); *B.V.D. Licensing Corp. v. Rodriguez* , 83 USPQ2d 1500, 1503 (TTAB 2007)(applicant's catalog, produced in lieu of an interrogatory response, is therefore permissibly made of record by opposer's notice of reliance); and *Genesco Inc. v. Martz* , 66 USPQ2d 1260, 1266 n.15 (TTAB 2003) (if documents are offered in response to an interrogatory, they are admissible under 37 C.F.R. § 2.120(j)(3)(i)), redesignated by amendment to 37 C.F.R. § 2.120(k)(3)(i)). **Please Note:** Effective January 14, 2017, 37 C.F.R. § 2.120(j) has been redesignated by amendment to 37 C.F.R. § 2.120(k).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007); 37 C.F.R. § 2.120(a)(2). *But see General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (37 C.F.R. § 2.120(a)(2) does not mandate that a disclosing party inform the Board that an expert disclosure has been made).

3. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See also General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (the purpose of informing the Board of such a disclosure is to facilitate discovery, including a suspension of proceedings, but notification to the Board may not be necessary if expert-related discovery can be concluded by the close of discovery).

4. *See Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1372-73 (TTAB 2011) (no reason to file routinely pretrial disclosures with the Board).

5. *See* 37 C.F.R. § 2.120(k)(6) and 37 C.F.R. § 2.120(k)(8). *See also Turdin v. Trilobite, Ltd.* , 109 USPQ2d 1473 (TTAB 2014) (rebuttal disclosures are not a means for filing evidence); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.* , 107 USPQ2d 1424, 1428 (TTAB 2013) (supplemental discovery responses, like all discovery, should not be filed with the Board except under circumstances specified in 37 C.F.R. § 2.120(j)(8), redesignated by amendment to 37 C.F.R. § 2.120(k)(8)); *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC* , 88 USPQ2d 1541, 1542 n.2 (TTAB 2008) (opposer reminded that initial and expert disclosures are not to be filed with the Board, except under circumstances specified in 37 C.F.R. § 2.120(j)(8), redesignated by amendment to 37 C.F.R. § 2.120(k)(8)); *Chicago Corp. v. North American Chicago Corp.* , 16 USPQ2d 1479, 1480 (TTAB 1990) (regarding combined sets of interrogatories which are subject to a motion relating to discovery); *Kellogg Co. v. Pack'Em Enterprises, Inc.* , 14 USPQ2d 1545, 1549 n.9 (TTAB 1990) (to be considered on summary judgment, responses to discovery requests must be submitted with motion or responsive brief), *aff'd* , 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.* , 5 USPQ2d 1067, 1070 (TTAB 1987) (respondent again reminded that discovery materials are not to be filed with the Board except under circumstances specified in 37 C.F.R. § 2.120(j)(8), redesignated by amendment to 37 C.F.R. § 2.120(k)(8)); *Fischer GmbH v. Molnar & Co.* , 203 USPQ 861, 865 (TTAB 1979) (filing of a discovery deposition not required or desired in the absence of a notice of reliance). **Please Note:** Effective January 14, 2017, 37 C.F.R. § 2.120(j) has been redesignated by amendment to 37 C.F.R. § 2.120(k).

410 Asserting Objections to Requests for Discovery, Motions Attacking Requests for Discovery, and Disclosures

The rules governing discovery in proceedings before the Board provide both for the assertion of objections to discovery requests believed to be improper, and a means (namely, the motion to compel, in the case of discovery depositions, interrogatories, and requests for production; and the motion to test the sufficiency of answers or objections, in the case of requests for admission) for testing the sufficiency of those objections.

However, a party which fails to respond to discovery requests during the time allowed therefor and which is unable to show that its failure was a result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery requests on their merits. [Note 1.] *See also*TBMP § 403.03 and TBMP § 407.01. Objections going to the merits of a discovery request include those which challenge the request as overly broad, unduly vague and ambiguous, burdensome and oppressive, as seeking non-discoverable information on expert witnesses, or as not calculated to lead to the discovery of admissible evidence. [Note 2.] In contrast, claims that information sought by a discovery request is trade secret, business-sensitive or otherwise confidential, is subject to attorney-client or a like privilege, or comprises attorney work product, goes not to the merits of the request but to a characteristic or attribute of the responsive information. Objections based on the confidentiality of information or matter being sought are expected to be minimal in view of the automatic imposition of the Board's standard protective order. [Note 3.] *See*TBMP § 412. The Board generally is not inclined to hold a party to have waived the right to make these objections, even where the party is otherwise held to have waived its right to make objections to the merits of discovery requests. [Note 4.]

In addition, failure to serve initial disclosures constitutes a proper ground for objection to discovery requests. [Note 5.] As a corollary, if a party believes it need not respond to discovery requests because the propounding party has not served initial disclosures, it has a duty to object on that basis. [Note 6.]

It is generally inappropriate for a party to respond to a request for discovery by filing a motion attacking it, such as a motion to strike, a motion to suppress or a motion for a protective order. Rather, the party ordinarily should respond by providing the information sought in those requests or portions of requests that it believes to be proper, and stating its objections to those requests or portions of requests that it believes to be improper. [Note 7.] *See also*TBMP § 526.

If a party on which interrogatories have been served, for a proceeding before the Board, believes that the number of interrogatories served exceeds the limit specified in 37 C.F.R. § 2.120(d), and wishes to object to the interrogatories on this basis, the responding party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. A motion for a protective order is not the proper method for raising the objection of excessive number. [Note 8.] *See* TBMP § 405.03(e) (Remedy for Excessive Interrogatories). Similarly, if a party on which requests for production or requests for admissions have been served, believes that the number of requests for production or requests for admissions exceeds the limit specified in either 37 C.F.R. § 2.120(e) or 37 C.F.R. § 2.120(i), and the responding party wishes to object to the requests for production or requests for admissions on this basis, the responding party must, within the time for (and instead of) serving answers and specific objections to the requests for production or requests for admissions serve a general objection on the ground of their excessive number. A motion for a protective order is not the proper method for raising the objection of excessive number. [Note 9.]

Nevertheless, there are some situations in which a party may properly respond to a request for discovery by filing a motion attacking it. In cases where a request for discovery constitutes clear harassment, or where a request for discovery has been served and the receiving party is not and was not, at the time of the

commencement of the proceeding, the real party in interest, the party on which the request was served may properly respond to it by filing a motion for a protective order that the discovery not be had, or be had only on specified terms and conditions. [Note 10.]

A party on which a notice of deposition was served may file either a motion to quash the notice of deposition or a motion for a protective order in certain circumstances, for example, if the notice of deposition can be shown to be insufficient, vague or unclear; if the notice would result in the inquiring party exceeding the permitted number of discovery depositions absent a stipulation or upon prior leave granted by the Board; or if the notice would result in a deposition being taken outside the discovery period. [Note 11.] *See also*TBMP § 521 (Motion to Quash Notice of Deposition) and TBMP § 526 (Motion for a Protective Order).

Parties may object to or challenge the sufficiency of initial disclosures or expert disclosures by filing a motion to compel. [Note 12.] Initial disclosures must comply with the requirements set forth in Fed. R. Civ. P. 26(a)(1)(A) and (E) and expert disclosures must comply with the requirements set forth in Fed. R. Civ. P. 26(a)(2). A motion to compel initial disclosures must be filed within thirty days after the deadline for such disclosures; a motion to compel expert testimony disclosures must be filed prior to the close of the discovery period. [Note 13.] The filing of a motion to compel initial disclosures is a prerequisite to the filing of a motion for sanctions for failure to make initial disclosures or for making insufficient initial disclosures. [Note 14.] For further information concerning disclosures and motions to compel disclosures, unless the disclosing party has expressly stated that initial disclosures will not be made, see TBMP § 401 and TBMP § 523.

NOTES:

1. *See No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 (TTAB 1987); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 449 (TTAB 1979); *McMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979); *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975).

2. *See No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000).

3. *See* 37 C.F.R. § 2.116(g).

4. *See No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

5. *Dating DNA, LLC v. Imagini Holdings, LLC*, 94 USPQ2d 1889, 1892 (TTAB 2010).

6. *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (opposer's mistaken belief that applicant failed to serve initial disclosures does not excuse opposer's failure to substantively respond to applicant's discovery requests or to assert an objection on that basis).

7. *See Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016) (filing of a motion for a protective order instead of responding to discovery requests in timely manner procedurally improper manner of objecting to what applicant asserts are an excessive number of interrogatories); *Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1863 (TTAB 2001) (burden is on the party seeking the information to establish why it is relevant); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (party must articulate objections to interrogatories with particularity); *Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127, 128 (TTAB 1976) (a motion to strike interrogatories is

improper; objections to interrogatories should be served upon the interrogating party); *Volkswagenwerk AG v. Ridewell Corp.*, 188 USPQ 690, 691 (TTAB 1975) (opposer's motion to be relieved of its obligation to respond to applicant's requests for admissions denied as "manifestly inappropriate;" opposer must either respond to the requests or state its objections thereto); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974); *Dow Corning Corp. v. Doric Corp.*, 183 USPQ 126, 127 (TTAB 1974); *Atwood Vacuum Machine Co. v. Automation Industries, Inc.*, 181 USPQ 606, 607 (TTAB 1974).

8. 37 C.F.R. § 2.120(d); *Hewlett Packard Enterprise Development LP v. Arroware Industries, Inc.*, 2019 USPQ2d 158663, at *3 (TTAB 2019).

9. 37 C.F.R. § 2.120(e); 37 C.F.R. § 2.120(i); *Hewlett Packard Enterprise Development LP v. Arroware Industries, Inc.*, 2019 USPQ2d 158663, at *3 (TTAB 2019).

10. *See, e.g.,* Fed. R. Civ. P. 26(c); 37 C.F.R. § 2.120(g); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1266 (TTAB 2015) (protective relief granted; discovery requests were unduly burdensome and harassing); *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1566 (TTAB 2014) (protective order sought to prevent deposition of testifying expert redesignated as non-testifying expert); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2152 (TTAB 2013) (party may file request for protective order for harassing and oppressive requests for admissions).

11. *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008) (Board granted motion to quash where deposition was noticed during the discovery period but deposition was to be taken after discovery closed). *See, e.g., FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1764 (TTAB 1999) (motion for protective order) and *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2049 (TTAB 1988) (motion to quash).

12. 37 C.F.R. § 2.120(f); *Influance v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008) (petitioner's motion to compel amended initial disclosures granted where respondent failed to identify the address or telephone number of listed witnesses, the subject matter(s) about which each has information, and the location or production of identified documents).

13. 37 C.F.R. § 2.120(f).

14. 37 C.F.R. § 2.120(h)(1) - 37 C.F.R. § 2.120(h)(2). *See Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008).

411 Remedy for Failure to Provide Disclosures or Discovery

411.01 Initial and Expert Testimony Disclosures

If a party fails to provide any adverse party with required initial disclosures or expert testimony disclosures, the adverse party may file a motion to compel. [Note 1.] A motion to compel initial disclosures must be filed thirty days after the deadline for initial disclosures; a motion to compel expert testimony disclosures must be filed prior to the close of the discovery period. [Note 2.] For further information concerning motions to compel, see TBMP § 523. A party may not seek entry of sanctions against an adverse party that has failed to make required initial or expert disclosures without first pursuing the disclosures by motion to compel, unless the disclosing party has expressly stated that initial disclosures will not be made. [Note 3.] For further information concerning discovery sanctions and when they are available, see TBMP § 527.01. For information regarding a party's failure to make pretrial disclosures, see TBMP § 702.01.

NOTES:

1. 37 C.F.R. § 2.120(f); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42256 (August 1, 2007) ("A motion to compel is the available remedy when an adversary has failed to make, or has made inadequate, initial disclosures or disclosures of expert testimony. Both of these types of disclosures are made during discovery, and a motion to compel must precede a motion for sanctions."). *See also Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1879 (TTAB 2012) (motion to compel is available remedy for failure to serve, or insufficient, initial disclosures); *RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1493 (TTAB 2013) (motion to compel available for inadequate expert disclosures); *Influance v. Zuker*, 88 USPQ2d 1859, 1861 (TTAB 2008) (petitioner's motion to compel amended initial disclosures granted where respondent failed to identify the address or telephone number of listed witnesses, the subject matter(s) about which each has information, and the location or production of identified documents).

2. 37 C.F.R. § 2.120(f)(1). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951, 69977 (October 7, 2016).

3. 37 C.F.R. § 2.120(h)(1) and 37 C.F.R. § 2.120(h)(2); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42256 (August 1, 2007) ("A motion for sanctions is only appropriate if a motion to compel these respective disclosures has already been granted."); *Amazon Technologies v. Wax* , 93 USPQ2d 1702, 1706 (TTAB 2009) (motion for sanctions under 37 C.F.R. § 2.120(g)(1), redesignated by amendment to 37 C.F.R. § 2.120(h)(1), denied as premature where no Board order in place compelling discovery). *But see* 37 C.F.R. § 2.120(h)(2); *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC* , 88 USPQ2d 1541, 1543 (TTAB 2008) (discussing both 37 C.F.R. §§ 2.120(g)(1) and (g)(2)). **Please Note:** Effective January 14, 2017, 37 C.F.R. § 2.120(g) has been redesignated by amendment to 37 C.F.R. § 2.120(h).

411.02 Interrogatories or Requests for Production

If any party fails to answer any interrogatory, the party seeking discovery may file a motion with the Board for an order to compel an answer. [Note 1.] Similarly, if any party fails to produce and permit the inspection and copying of any document or thing, the party seeking discovery may file a motion for an order to compel production and an opportunity to inspect and copy. [Note 2.] A motion to compel responses to interrogatories or requests for production must be filed before the day of the deadline for pretrial disclosures for the first testimony period as originally set or as reset. [Note 3.] The party seeking interrogatory responses or production of documents may not seek immediate entry of sanctions for no response unless the responding party has expressly informed the inquiring party that no response will be made to the discovery requests. [Note 4.]

For information concerning motions to compel, see TBMP § 523.

NOTES:

1. 37 C.F.R. § 2.120(f).

2. 37 C.F.R. § 2.120(f). *Cf.* Fed. R. Civ. P. 37(a)(3)(B).

3. 37 C.F.R. §2.120(f)(1). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE; CLARIFICATION, 82 Fed. Reg. 33804 (July 21, 2017).

4. 37 C.F.R. § 2.120(h)(2). *Cf. Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC* , 88 USPQ2d 1541, 1543 (TTAB 2008) (regarding disclosures); *HighBeam Marketing LLC v. Highbeam Research LLC* , 85 USPQ2d 1902, 1906 (TTAB 2008) ("Under Trademark Rule 2.120(g)(2), if a party witness fails to attend a discovery deposition after receiving proper notice, and such party or the party's attorney or other authorized representative informs the party seeking discovery that no such attendance will take place, the Board may enter sanctions against that party."). **Please Note:** Effective January 14, 2017, 37 C.F.R. § 2.120(g) has been redesignated by amendment to 37 C.F.R. § 2.120(h).

411.03 Requests for Admission

If a party on which requests for admission have been served fails to file a timely response thereto, the requests are deemed admitted by operation of Fed. R. Civ. P. 36(a) unless the party is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b), and granted by the Board. [Note 1.] It is not necessary to file a motion to deem requests for admissions admitted when no response is served, since the admissions are deemed admitted by operation of Fed. R. Civ. P. 36(a). *See*TBMP § 407.03(a) (Time for Service of Responses). For information on motions to withdraw or amend admissions, see TBMP § 525.

If a propounding party is dissatisfied with a responding party's answer or objection to a request for admission, and wishes to obtain a ruling on the sufficiency thereof, the propounding party may file a motion with the Board to determine the sufficiency of the response or objection. [Note 2.] If the Board determines that a response does not comply with the requirements of Fed. R. Civ. P. 36(a), it may order either that the matter is admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that a response be served. [Note 3.] In instances, however, where a request for admission is either admitted or denied, such admissions or denials constitute a proper response even if the response also includes objections. [Note 4.] The requesting party therefore should refrain from challenging the sufficiency of the response.

For information on motions to determine the sufficiency of answers or objections to requests for admission, see TBMP § 524.

NOTES:

1. *See Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007) (contrasting standard of review for motion to reopen time to respond to requests for admission and for motion to withdraw requests that stand admitted); *Hobie Designs, Inc. v. Fred Hayman Beverly Hills, Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990).

2. Fed. R. Civ. P. 36(a); 37 C.F.R. § 2.120(i).

3. Fed. R. Civ. P. 36(a).

4. Fed. R. Civ. P. 36(a).

411.04 Discovery Depositions

A discovery deposition is taken out of the presence of the Board. Therefore, if the witness being deposed, or the attorney for the witness, believes a question is improper, an objection may be stated, but the question normally should be answered subject to the stated objection.

If a party fails to designate a person pursuant to Fed. R. Civ. P. 30(b)(6) or Fed. R. Civ. P. 31(a)(4), or if a party or such designated person, or an officer, director, or managing agent of a party, fails to attend a discovery deposition, or fails to answer any question propounded in a discovery deposition, the party seeking discovery may file a motion with the Board for an order to compel a designation, or attendance at a deposition, or an answer. [Note 1.] A motion to compel discovery must be filed before the day of the deadline for pretrial disclosures for the first testimony period as originally set or as reset. [Note 2.] For information concerning motions to compel, see TBMP § 523.

Because the Board does not have jurisdiction over a non-party witness, a motion to compel is not available as a remedy when such a witness refuses a request for deposition. However, if the deposing party has secured the non-party's attendance by obtaining a subpoena from an appropriate United States district court, *see*35 U.S.C. § 24, the subpoena may be enforced by returning to the issuing court. *See*TBMP § 404.03(a)(2). Similarly, if a non-party witness has appeared voluntarily for a deposition, but objects to and refuses to answer particular questions propounded during the deposition, the deposing party must seek relief from an appropriate United States district court and may not file a motion to compel with the Board. Specifically, the propounding party may attempt to obtain an immediate ruling on the propriety of the objection by adjourning the deposition and applying, under 35 U.S.C. § 24, to the federal district court in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer. [Note 3.] See TBMP §404.08(c).

NOTES:

1. 37 C.F.R. § 2.120(f)(1). *See Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974) (if a party fails or refuses to answer any proper question during the taking of a discovery deposition, the party may file a motion to compel with the Board). *Cf.* Fed. R. Civ. P. 37(a).

2. 37 C.F.R. §2.120(f)(1). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE; CLARIFICATION, 82 Fed. Reg. 33804 (July 21, 2017).

3. *See Ferro Corp. v. SCM Corp.*, 219 USPQ 346, 351 (TTAB 1983); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974).

411.05 Sanctions Related to Disclosures and Discovery

In inter partes proceedings before the Board, a variety of sanctions may be imposed, in appropriate cases, for failure to provide disclosures or discovery pursuant to 37 C.F.R. § 2.120(h). [Note 1.] The Board also may impose sanctions against the non-cooperating party for failure to participate in the discovery conference. [Note 2.] *See* TBMP § 408.01(a).The Board's authority to enter sanctions for conduct or misconduct related to disclosures or discovery is rooted in Fed. R. Civ. P. 37, most portions of which are made applicable to Board proceedings by 37 C.F.R. § 2.116(a) (but certain portions of Fed. R. Civ. P. 37 are, on their face, irrelevant to Board proceedings). The range of sanctions listed in Fed. R. Civ. P. 37(b)(2), and which may be entered by the Board include, inter alia, striking all or part of the pleadings of the disobedient party, refusing to allow the disobedient party to support or oppose designated claims or defenses, drawing adverse inferences against uncooperative party, prohibiting the disobedient party from introducing designated matters in evidence, and entering judgment against the disobedient party. [Note 3.] A sanction also "can consist of requiring a party to take an action which it would not otherwise be required to take by applicable rules, or to refrain from taking an action it would otherwise take." [Note 4.] However, the Board will not hold any person in contempt, or award any expenses, including attorneys' fees, to any party. [Note 5.]

For further information concerning discovery sanctions and when they are available, see TBMP § 527.01.

For further information concerning attorneys' fees and other expenses in Board proceedings, see TBMP § 502.05 and cases cited therein.

NOTES:

1. *See, e.g., Benedict v. Super Bakery, Inc.*, 665 F.3d 1263, 101 USPQ2d 1089 (Fed. Cir. 2011) (affirming Board's entry of default judgment as sanction for noncompliance with discovery and Board orders); *Fifth Generation Inc. v. Titomirov Vodka LLC*, 2019 USPQ2d 418666, at *4–5 (TTAB 2019) (entry of judgment as a sanction for failing to comply with Board's orders and pattern of avoiding discovery obligations); *Amazon Technologies, Inc. v. Wax*, 95 USPQ2d 1865, 1868-69 (TTAB 2010) (Board imposed sanctions pursuant to 37 C.F.R. § 2.120(g)(1), redesignated effective January 14, 2017 by amendment to 37 C.F.R. § 2.120(h)(1)); opposer ordered to serve index of produced documents, supplemental answers to certain interrogatories; discovery reopened for applicant only); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1778 (TTAB 1999) (as a sanction, party required to study certain TBMP sections and to file a statement with the Board certifying completion of the task, to prepare complete set of responses to discovery requests, to consult with opposing counsel to ensure responses are appropriate, and to forward copies to counsel).

2. *Patagonia, Inc. v. Azzolini*, 109 USPQ2d 1859, 1861-63 (TTAB 2014); *Promgirl, Inc., v. JPC Co.*, 94 USPQ2d 1759, 1762 (TTAB 2009); *Guthy-Renker Corp. v. Boyd*, 88 USPQ2d 1701, 1704 (TTAB 2008).

3. *See, e.g., SFM, LLC v. Corcamore, LLC*, 129 USPQ2d 1072, 1074 (TTAB 2018) (motion granted for sanctions in the form of judgment for party's misconduct including failure to comply with Board's orders related to discovery).

4. *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1778 n.11 (TTAB 1999).

5. 37 C.F.R. § 2.120(h)(1), 37 C.F.R. § 2.120(h)(2), and 37 C.F.R. § 2.127(f). *See SFM, LLC v. Corcamore, LLC*, 129 USPQ2d 1072, 1074 (TTAB 2018) (Board does not impose monetary sanctions or award attorney's fees or expenses).

412 Protective Orders

37 C.F.R. § 2.116(g) *The Trademark Trial and Appeal Board's standard protective order is automatically imposed in all inter partes proceedings unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. The standard protective order is available at the Office's web site. No material disclosed or produced by a party, presented at trial, or filed with the Board, including motions or briefs which discuss such material, shall be treated as confidential or shielded from public view unless designated as protected under the Board's standard protective order, or under an alternative order stipulated to by the parties and approved by the Board, or under an order submitted by motion of a party granted by the Board. The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.*

Excerpts from Board's Standard Protective Order:

1) Classes of Protected Information.

The Rules of Practice in Trademark Cases provide that all inter partes proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this Order are not to be used to undermine public access to such files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing one of the following designations.

Confidential *- Material to be shielded by the Board from public access.*

Confidential – Attorneys' Eyes Only (Trade Secret/Commercially Sensitive) *- Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by* ***outside counsel*** *for the parties and, subject to the provisions of paragraphs 4 and 5, by independent experts or consultants for the parties.*

Material designated as Confidential - Attorneys' Eyes Only (Trade Secret/Commercially Sensitive *may include the following types of information: (1) sensitive technical information, including current research, development and manufacturing information; (2) sensitive business information, including highly sensitive financial or marketing information; (3) competitive technical information, including technical analyses or comparisons of competitor's products or services; (4) competitive business information, including non-public financial and marketing analyses, media scheduling, comparisons of competitor's products or services, and strategic product/service expansion plans; (5) personal health or medical information; (6) an individual's personal credit, banking or other financial information; or (7) any other commercially sensitive information the disclosure of which to non-qualified persons subject to this Order the producing party reasonably and in good faith believes would likely cause harm.*

2) Information Not to Be Designated as Protected.

Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this Order; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

3) Access to Protected Information.

The provisions of this Order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys and approval by the Board.

Administrative Trademark Judges, Board attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected, except as otherwise required by law, but are not required to sign forms acknowledging the terms and existence of this Order. Court reporters, stenographers, video technicians or others who may be employed by the parties or their attorneys to perform services incidental to this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of paragraph 4.

Parties *are defined as including individuals, officers of corporations, partners of partnerships, members of limited liability companies/corporations, and management employees of any type of business organization.*

Attorneys *for parties are defined as including* ***in-house counsel*** *and* ***outside counsel****, including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.*

Independent experts or consultants *include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not current or former employees, officers, members, directors, or partners of any party, affiliates of any party, or the attorneys of any party or its affiliates, or competitors to any party, or employees or consultants of such competitors with respect to the subject matter of the proceeding.*

Non-party witnesses *include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.*

Parties *and their* ***attorneys*** *shall have access to information designated as confidential, subject to any agreed exceptions.*

Outside counsel, but not in-house counsel, *shall have access to information designated as* ***Confidential – Attorneys' Eyes Only (trade secret/commercially sensitive).***

Independent experts or consultants, non-party witnesses*, and****any other individual*** *not otherwise specifically covered by the terms of this order may be afforded access to* ***confidential*** *information in accordance with the terms that follow in paragraph 4. Further,* ***independent experts or consultants*** *may have access to* ***Confidential – Attorneys' Eyes Only (trade secret/commercially sensitive)*** *information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraphs 4 and 5.*

37 C.F.R. § 2.120(g) ***Motion for a protective order.*** *Upon motion by a party obligated to make initial disclosures or expert testimony disclosure or from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (A) through (H), inclusive, of Rule 26(c)(1) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party comply with disclosure obligations or provide or permit discovery.*

Fed. R. Civ. P. 26(c)(1) In General. *A party or any person from whom discovery is sought may move for a protective order in the court where the action is pending—or as an alternative on matters relating to a deposition, in the court for the district where the deposition will be taken. The motion must include a certification that the movant has in good faith conferred or attempted to confer with other affected parties in an effort to resolve the dispute without court action. The court may, for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the following:*

(A) *forbidding the disclosure or discovery;*

(B) *specifying terms, including time and place or the allocation of expenses, for the disclosure or discovery;*

(C) *prescribing a discovery method other than the one selected by the party seeking discovery;*

(D) *forbidding inquiry into certain matters, or limiting the scope of disclosure or discovery to certain matters;*

(E) *designating the persons who may be present while the discovery is conducted;*

(F) *requiring that a deposition be sealed and opened only on court order;*

(G) *requiring that a trade secret or other confidential research, development, or commercial information not be revealed or be revealed only in a specified way; and*

(H) *requiring that the parties simultaneously file specified documents or information in sealed envelopes, to be opened as the court directs.*

Fed. R. Civ. P. 26(c)(2) Ordering Discovery. *If a motion for a protective order is wholly or partly denied, the court may, on just terms, order that any party or person provide or permit discovery.*

Protective orders in the context of Board inter partes proceedings refer to (1) the Board's standard protective order governing the exchange of information and materials and modifications thereto, and (2) motions for protective orders pursuant to 37 C.F.R. § 2.120(g), "to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, ..." Both types of protective orders are discussed below.

412.01 In General – Board Standard Protective Order

For inter partes proceedings pending or commenced on or after August 31, 2007, the Board's standard protective order is automatically in place to govern the exchange of information unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. [Note 1.] The Board's notice of institution will advise parties that the standard protective order applies, and that parties may view the Board's standard protective order at the USPTO website at **www.uspto.gov**. [Note 2.] It is not necessary for the parties to sign copies of the Board's protective order for it to take effect, although it may be desirable to sign for other reasons. *See*TBMP § 412.03.

The Board's standard protective order provides for two tiers of protected information (1) Confidential and (2) Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive). Parties and their attorneys shall have access to information designated as confidential, subject to any agreed exceptions. Outside counsel, but not in-house counsel, shall have access to information designated as trade secret/commercially sensitive. [Note 3.] Parties and those parties or individuals appearing pro se will not have access to information designated as "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)". In cases involving independent experts or consultants, non-party witnesses, or any individual not falling within the definition of a party or attorney, such individuals must sign an acknowledgement form agreeing to be bound by the standard protective order during and after the proceedings, as a condition for obtaining access to protected information. [Note 4.] The Board has the authority to sanction attorneys and individuals determined to be in breach during a proceeding. [Note 5.] *See also*TBMP § 527.

In Board proceedings, access to a party's "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" is not provided as a matter of course, but rather must only be provided in response to a proper and relevant discovery request or when the party chooses to use such information in support of its case at trial. [Note 6.] The Board's standard protective order does not automatically protect all information. [Note 7.] Parties must actively utilize the provisions when seeking to designate protected information. [Note 8.] Thus, the burden falls on the party seeking to designate information as protected. If a party fails to designate a discovery response or submission as confidential under the terms of the protective order and/or redact confidential portions thereof, the confidentiality of the information is deemed waived. [Note 9.] Nonetheless, when responding to discovery or filing submissions before the Board, the party seeking to designate information as "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" has a duty to make a meaningful effort to designate only that information that warrants the designated level of protection. [Note 10.] For information regarding the designation of material as confidential and procedures regarding redaction at trial, see TBMP § 412.01(a) and TBMP § 703.01(p).

Parties cannot withhold properly discoverable information on the basis of confidentiality since the terms of the Board's standard protective order automatically apply. [Note 11.] In instances where a party has refused to provide discoverable information on such grounds, the Board, where appropriate, may order the party to provide such information consistent with the terms of the protective order. [Note 12.]

Parties are free to modify the terms of the Board's standard protective order, and are encouraged to discuss any proposed modifications during their discovery conference. [Note 13.] For further information regarding modifications to the Board's standard protective order upon stipulation, see TBMP § 412.02(a).

Apart from protective orders protecting a party's information, the Board may issue protective orders addressing other issues. On motion pursuant to 37 C.F.R. § 2.120(g), showing good cause, by a party from which discovery is sought, the Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders described in clauses (A) through (H) of Fed. R. Civ. P. 26(c). [Note 14.] *See also*TBMP § 527 and TBMP § 703.01(p). To establish good cause, the movant must submit "a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements." [Note 15.] The moving party seeking a protective order bears the burden of showing good cause. The movant must demonstrate that its ability to litigate will be prejudiced, not merely increase the difficulty of managing the litigation. [Note 16.] Among the types of discovery orders that may be entered, the Board has the discretion to enter a protective order that a discovery deposition not be had or that requests for admissions need not be answered. [Note 17.] The applicability of the Board's standard protective order does not preclude a party, when appropriate, from moving for a protective order under applicable Trademark or Federal Rules, when the Board's standard order does not cover the extant circumstances or is viewed by the moving party as providing insufficient protection. [Note 18.] For further information on motions for protective orders, see TBMP § 410 (Motions Attacking Requests for Discovery), TBMP § 412.02 and TBMP § 526.

NOTES:

1. 37 C.F.R. § 2.116(g); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244 (August 1, 2007). *See, e.g., Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1544 (TTAB 2009).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244 (August 1, 2007). The standard protective order can be viewed on the Board's home page of the USPTO website at **www.uspto.gov**.

3. *United States Polo Association v. David McLane Enterprises, Inc.*, 2019 USPQ2d 108442, at *2 (TTAB 2019) ("Parties, including in-house counsel, do not have access to information designated 'AEO'.").

4. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42251 (August 1, 2007).

5. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42251 (August 1, 2007).

6. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42251 (August 1, 2007). *See e.g., Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 (TTAB 2014) (while trade secret/commercially sensitive information as to witness identity was protectable during discovery, once party relied on testimony of so designated witness at trial,

identity of witness designated as trade secret/commercially sensitive waived), *dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016).

7. 37 C.F.R. § 2.116(g). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

8. *See* 37 C.F.R. § 2.116(g); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

9. *See, e.g., Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1633 n.6 (TTAB 2007).

10. *See, e.g., Azalea Health Innovations, Inc. v. Rural Health Care, Inc.* , 125 USPQ2d 1236, 1238 (TTAB 2017) ("A rule of reasonableness dictates what information should be [designated confidential and] redacted, and only in very rare instances should an entire submission be deemed confidential."); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC* , 110 USPQ2d 1458, 1461 (TTAB 2014) (Board proceedings are designed to be transparent to the public and the contents of proceeding files publicly available; improper designation of materials as confidential thwarts that intention); *General Mills Inc. v. Fage Dairy Processing Industry SA* , 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) (excessive markings of various information as confidential complicates record and often indicates that matter is improperly designated or not useful to case), *judgment set aside on other grounds* , 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Blackhorse v. Pro-Football Inc.* , 98 USPQ2d 1633, 1635 (TTAB 2011) (parties to refrain from improperly designating evidence or a show cause order may issue); *Georgia Pacific Corp. v. Solo Cup Co.* , 80 USPQ2d 1950, 1954 (TTAB 2006) (finding that information concerning expert's credentials and background were overdesignated as confidential or highly confidential in expert report and granting motion to redesignate that portion of the expert report as non-confidential); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.* , 77 USPQ2d 1492, 1495, n.5 (TTAB 2005) (where entirety of the briefs were deemed "confidential," Board subsequently requested and received redacted copies). *See also* 37 C.F.R. § 2.116(g) ("The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.")

11. *See, e.g., Intex Recreation Corp. v The Coleman Co.*, 117 USPQ2d 1799, 1801 (TTAB 2016) (party may not redact confidential information from documents responsive to document requests); *Amazon Technologies, Inc. v. Wax*, 93 USPQ2d 1702, 1706 n.6 (TTAB 2009).

12. 37 C.F.R. § 2.120(f)(1) and 37 C.F.R. § 2.120(h)(1).

13. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244 (August 1, 2007). *But see United States Polo Association v. David McLane Enterprises, Inc.*, 2019 USPQ2d 108442, at *3 (TTAB 2019) ("[T]he parties may not agree to redefine the Board's definition of what information constitutes 'Confidential' and 'AEO' information. The parties may agree to change who has access to information and materials, but the designations retain the meaning the Board dictated in the Standard Protective Order.").

14.*See* Fed. R. Civ. P. 26(c)(1); 37 C.F.R. § 2.120(g). *See, e.g., Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1674 (TTAB 2005).

15. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999). *See also The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013) (finding opposer's allegations of undue burden and expense "merely conclusory.").

16. *A. Hirsh, Inc. v. United States*, 657 F. Supp. 1297, 1305 (C.I.T. 1987). *See also The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2153 (TTAB 2013) (citing *A. Hirsh Inc. v. United States*, 657 F.Supp. 1297, 1305 (C.I.T. 1987)).

17. *See, e.g., The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013) (granting protective order with regard to duplicative requests for admissions and those that sought admissions as to unpleaded registrations); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1675 (TTAB 2005) (applicant's motion for protective order to prevent taking of additional discovery depositions is granted as to three out of six employees of applicant who were to be deposed).

18. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

412.01(a) Proper Designation of Confidential Matter

Excerpts from Board's Standard Protective Order:

1) Classes of Protected Information.

The Rules of Practice in Trademark Cases provide that all inter partes proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this Order are not to be used to undermine public access to such files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing one of the following designations.

Confidential *- Material to be shielded by the Board from public access.*

Confidential – Attorneys' Eyes Only (Trade Secret/Commercially Sensitive) *- Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by* ***outside counsel*** *for the parties and, subject to the provisions of paragraphs 4 and 5, by independent experts or consultants for the parties.*

Material designated as Confidential - Attorneys' Eyes Only (Trade Secret/Commercially Sensitive) *may include the following types of information: (1) sensitive technical information, including current research, development and manufacturing information; (2) sensitive business information, including highly sensitive financial or marketing information; (3) competitive technical information, including technical analyses or comparisons of competitor's products or services; (4) competitive business information, including non-public financial and marketing analyses, media scheduling, comparisons of competitor's products or services, and strategic product/service expansion plans; (5) personal health or medical information; (6) an individual's personal credit, banking or other financial information; or (7) any other commercially sensitive information the disclosure of which to non-qualified persons subject to this Order the producing party reasonably and in good faith believes would likely cause harm.*

2) Information Not to Be Designated as Protected.

Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this Order; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such

information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

14) Challenges to Designations of Information as Protected.

If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time. The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

37 C.F.R. § 2.27(c) ***[Pending trademark application index; access to applications.]*** *Decisions of the Director and the Trademark Trial and Appeal Board in applications and proceedings relating thereto are published or available for inspection or publication.*

37 C.F.R. § 2.116(g) *The Trademark Trial and Appeal Board's standard protective order is automatically imposed in all inter partes proceedings unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. The standard protective order is available at the Office's web site. No material disclosed or produced by a party, presented at trial, or filed with the Board, including motions or briefs which discuss such material, shall be treated as confidential or shielded from public view unless designated as protected under the Board's standard protective order, or under an alternative order stipulated to by the parties and approved by the Board, or under an order submitted by motion of a party granted by the Board. The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.*

37 C.F.R. § 2.120(g) ***Motion for a protective order.*** *Upon motion by a party obligated to make initial disclosures or expert testimony disclosure or from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (A) through (H), inclusive, of Rule 26(c)(1) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party comply with disclosure obligations or provide or permit discovery.*

37 C.F.R. § 2.125(f) *Upon motion by any party, for good cause, the Trademark Trial and Appeal Board may order that any part of a deposition transcript or any exhibits that directly disclose any trade secret or other confidential research, development, or commercial information may be filed under seal and kept confidential under the provisions of § 2.27(e). If any party or any attorney or agent of a party fails to comply with an order made under this paragraph, the Board may impose any of the sanctions authorized by § 2.120(h).*

Fed. R. Civ. P. 26(c) Protective Orders.

(1) ***In General.*** *A party or any person from whom discovery is sought may move for a protective order in the court where the action is pending—or as an alternative on matters relating to a deposition, in the court for the district where the deposition will be taken. The motion must include a certification that the movant has in good faith conferred or attempted to confer with other affected parties in an effort to resolve the dispute without court action. The court may, for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the following:*

(A) *forbidding the disclosure or discovery;*

(B) *specifying terms, including time and place or the allocation of expenses, for the disclosure or discovery;*

(C) *prescribing a discovery method other than the one selected by the party seeking discovery;*

(D) *forbidding inquiry into certain matters, or limiting the scope of disclosure or discovery to certain matters;*

(E) *designating the persons who may be present while the discovery is conducted;*

(F) *requiring that a deposition be sealed and opened only on court order;*

(G) *requiring that a trade secret or other confidential research, development, or commercial information not be revealed or be revealed only in a specified way; and*

(H) *requiring that the parties simultaneously file specified documents or information in sealed envelopes, to be opened as the court directs.*

(2) ***Ordering Discovery.*** *If a motion for a protective order is wholly or partly denied, the court may, on just terms, order that any party or person provide or permit discovery.*

Fed. R. Civ. P. 26(g) Signing Disclosures and Discovery Requests, Responses, and Objections.

(1) ***Signature Required; Effect of Signature.*** *Every disclosure under Rule 26(a)(1) or (a)(3) and every discovery request, response, or objection must be signed by at least one attorney of record in the attorney's own name—or by the party personally, if unrepresented—and must state the signer's address, e-mail address, and telephone number. By signing, an attorney or party certifies that to the best of the person's knowledge, information, and belief formed after a reasonable inquiry:*

(A) *with respect to a disclosure, it is complete and correct as of the time it is made; and*

(B) *with respect to a discovery request, response, or objection, it is:*

(i) *consistent with these rules and warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law, or for establishing new law;*

(ii) *not interposed for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation; and*

(iii) *neither unreasonable nor unduly burdensome or expensive, considering the needs of the case, prior discovery in the case, the amount in controversy, and the importance of the issues at stake in the action.*

The automatic imposition of the Board's standard protective order upon commencement of the Board proceeding [Note 1] is designed to facilitate the exchange of information in connection with disclosures and during pretrial discovery by allowing parties to designate materials as "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" without a preliminary showing of good cause under 37 C.F.R. § 2.120(g) and Fed. R. Civ. P. 26(c). The Board's standard protective order is a blanket

protective order [Note 2] which does not automatically protect all information [Note 3] but allows parties to designate in good faith only those items a party and/or its counsel believes are subject to protection. [Note 4.]

Parties must actively utilize the provisions in the Board's standard protective order to designate information as "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)". [Note 5.] Thus, the burden falls on the party seeking to designate information as protected, and if a party fails to designate the information as protected under the terms of the Board's standard protective order and/or redact "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" portions thereof, the confidentiality of the information is deemed waived. [Note 6.]

Because a confidential designation of discovery or deposition testimony or other information limits what an opposing party can do with the materials and is one step removed from filing documents under seal, producing parties or their counsel are expected to act in good faith in designating information as "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" under the terms of the Board's standard protective order. [Note 7.] The fact that the Board's standard protective order is automatically entered upon commencement in a Board proceeding does not give a party unbridled authority to designate its discovery responses and production as protected. [Note 8.] When responding to discovery, the party seeking to designate information as "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" has a duty to make a meaningful good faith effort to designate only that information that warrants the designated level of protection, if any. [Note 9.] It is improper for a party to designate all produced discovery as confidential under the Board's standard protective order. Producing parties should designate only those particular discovery responses, documents, deposition exhibits, and depositions transcript pages as confidential within the scope of and consistent with the protective order entered in the proceeding. See TBMP § 408.01 for information regarding a party's duty to cooperate with regard to discovery.

The designations "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" should be limited to information that the producing party or their counsel has determined, in good faith, contains, reflects, or reveals non-public, confidential, proprietary or commercial information that is not readily ascertainable through proper means by the public or the receiving party, to the extent that information either is the type of information that the party normally attempts to protect from disclosure or is subject to privacy protection under federal, state or local law. [Note 10.]

The designation "trade secret" should be limited to any information that the producing party or their counsel has determined in good faith "can be used in the operation of a business or other enterprise and that is sufficiently valuable and secret to afford an actual or potential economic advantage over others." [Note 11.] Information that is confidential or that imparts private information may require a different level of protection than information that may be considered a trade secret or commercially sensitive. [Note 12.] Information which may not be designated as subject to any form of protection includes information that is or becomes publicly available or information that has been disclosed to the public or a third party, under the circumstances specifically set forth in the Board's standard protective order. [Note 13.]

While there is no preliminary showing of good cause required for designations under the Board's standard protective order, such a showing can be triggered by the receiving party raising an issue with respect to a party's designation as to any documents, information or testimony. Thus, the party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected. [Note 14.]

The parties are expected to make a good faith effort to resolve disputes with regard to the propriety of challenged designations before bringing such matters to the Board. [Note 15.] The Board expects that disputes as to designations that are brought to the Board will be significantly narrow, resulting from the parties' mutual obligation to negotiate the propriety of the challenged designations and come to a resolution under the Board's standard protective order. [Note 16.]

See TBMP § 412.06 for information regarding the good faith effort required for motions for protective orders. *Cf.*TBMP § 523.02 and TBMP § 524.02 in regard to good faith efforts required for motions to compel and to test the sufficiency of responses to requests for admissions.

The Board's standard protective order is applicable during disclosures, discovery, and at trial. [Note 17.] When filing submissions electronically as confidential in connection with motions, briefs or evidence via ESTTA, or where appropriate, filing on paper, under seal, parties should designate only those particular discovery responses, exhibits, depositions transcript pages, or portions of a motion or brief as confidential consistent with and within the scope of the protective order entered in the proceeding. [Note 18.] A party may not improperly mark its filings as confidential so as to shield them from public view [Note 19] nor may the Board's standard protective order, or any modified protective agreement stipulated to by the parties, be used as a means of circumventing relevant provisions of 37 C.F.R. § 2.27, which provides that trademark application and registration files, and related TTAB proceeding files, generally should be available for public inspection. [Note 20.]

Any confidential filing must include redacted versions for the public record. *See* 37 C.F.R. § 2.126(c). For any confidential unredacted version of a submission for which a redacted version must be filed, the parties are strongly encouraged to enclose the confidential information in brackets so as to facilitate a better comparison between the public and confidential versions of the filing when the Board is issuing an order or preparing a final decision.

Please Note: as part of general restyling, effective December 1, 2007, former Fed. R. Civ. P. 26(c)(1)(7) is now Fed. R. Civ. P. 26(c)(1)(G).

The Board's standard protective order is available for viewing at **http://www.uspto.gov**.

NOTES:

1. 37 C.F.R. § 2.116(g). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244 (August 1, 2007); *Standard Form Agreement or Order for Protecting Confidentiality of Information and Documents Disclosed During Proceedings Before the Trademark Trial and Appeal Board*, O.G. Notice (June 20, 2000); *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000). *See also Layne Christensen Co. v. Purolite Co.*, 271 F.R.D. 240, 246-47 (D. Kan. 2010) (tiered protective orders are commonly entered in cases involving intellectual property, trade secrets, and unique technological information, affording fuller protection to particularly sensitive information than is extended to ordinary business information).

2. *See Gillard v. Boulder Valley School District Re.-2*, 196 F.R.D. 382, 385-86 (D. Colo. 2000) (explaining the difference between "particular protective orders," "umbrella protective orders," and "blanket protective orders").

3. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

4. Fed. R. Civ. P. 26(g)(1)(B)(ii) (requiring discovery responses to be "not interposed for any improper purpose"). *See Gillard v. Boulder Valley School District Re.-2*, 196 F.R.D. 382, 386 (D. Colo 2000) ("Normally, a blanket protective order requires that counsel for a producing party review the information to be disclosed and designate the information it believes, in good faith, is confidential or otherwise entitled to protection.").

5. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

6. 37 C.F.R. § 2.116(g). *See, e.g., Wet Seal, Inc. v. FD Management, Inc.* , 82 USPQ2d 1629, 1633 n.6 (TTAB 2007) (waiver of confidential designation of settlement agreement as the agreement was not redacted nor made confidential, was introduced as an exhibit during a deposition without mention of its confidential nature, and the parties openly discussed provisions of the agreement in their briefs). *But see* 37 C.F.R. § 2.120(f); *Ayoub, Inc. v. ACS Ayoub Carpet Service*, 118 USPQ2d 1392, 1398 n.39 (TTAB 2016) (parties electronically filed documents marked as confidential without identifying them in ESTTA as confidential and without filing a redacted public version; parties allowed 30 days from the date of the decision to file redacted copies, failing which the documents would be treated as part of public record); *Rolex Watch U.S.A. Inc. v. AFP Imaging Corp.*, 101 USPQ2d 1188, 1189 n.1 (TTAB 2011) (granting opposer's motion to designate as confidential portions of testimony previously submitted without designation and setting aside original opinion in the case on that basis; opinion reissued), *judgment vacated based on action of defendant on appeal*, 107 USPQ2d 1626 (TTAB 2013); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 n.6 (TTAB 2001) (noting parties failed to submit under seal deposition testimony that had been marked as confidential and affording the parties 30 days from date of decision to file, for the record, redacted and confidential versions of those portions of testimony which were confidential).

7. Fed. R. Civ. P. 26(g)(1) (requiring discovery responses to be "not interposed for any improper purpose"). *See Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (party to be circumspect and to limit the "confidential" designation only to information that is truly confidential or commercially sensitive); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 (TTAB 2008) (urging counsel to exercise discretion and designate as confidential only such information that is truly confidential when appearing before the Board in future proceedings); *THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255, 1253 (N.D. Ill. 1993) (it is counsel's "place and responsibility" to ensure that the proper confidential designations are assigned to documents produced"); *Parkway Gallery Furniture, Inc. v. Kittinger/Pennsylvania House Group, Inc.*, 121 F.R.D. 264, 268 (M.D.N.C. 1988) (party to blanket protective order must invoke confidential designation in good faith). *See also Mancia v. Mayflower Textile Services Co.*, 253 F.R.D. 354, 358 (D. Md. 2008) (discussing Fed. R. Civ. P. 26(g) generally).

8. *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.12 (TTAB 2014) ("the mere assertion that information is confidential does not make such designation proper."), *dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) (excessive markings of various information as confidential often indicates that matter is improperly designated or not useful to case), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential). *See, e.g., THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255-56 (N.D. Ill. 1993) (with regard to its document production, party improperly used "Attorney Eyes Only" designation four times as often as lower confidentiality designation as well as improperly designated non-confidential matter as confidential; court ordered party to de-designate all of the Attorney's Eyes Only documents and reclassify them "Confidential" or "Non-confidential").

9. Fed. R. Civ. P. 26(g)(1); *Blackhorse v. Pro Football Inc.* , 98 USPQ2d 1633, 1635 (TTAB 2011) (party to be circumspect and to limit the "confidential" designation only to information that is truly confidential or commercially sensitive); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.* , 89 USPQ2d 1844, 1848 (TTAB 2008) (urging counsel to exercise discretion and designate as confidential only such information that is truly confidential when appearing before the Board in future proceedings). *See also THK America Inc. v. NSK Co. Ltd.* , 157 F.R.D. 637, 33 USPQ2d 1248, 1255-56 (N.D. Ill. 1993) (nothing prevented the defendants from designating the trade secret pages of a document as "confidential" and the admittedly public pages included therewith or attached thereto as "non-confidential"; some form of redaction along these lines would have indicated a bona fide approach to the court-ordered discovery); *Parkway Gallery Furniture, Inc. v. Kittinger/Pennsylvania House Group, Inc.* , 121 F.R.D. 264, 268 (M.D.N.C. 1988) (party to blanket protective order must invoke confidential designation in good faith). *See also Mancia v. Mayflower Textile Services Co.* , 253 F.R.D. 354, 358 (D. Md. 2008) (discussing Fed. R. Civ. P. 26(g) generally); 37 C.F.R. § 2.116(g) ("The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.).

10. *See, e.g., Layne Christensen Co. v. Purolite Co.* , 271 F.R.D. 240, 246 (D. Kan. 2010) (information that is designated as confidential prohibits the disclosure or dissemination of the information to third parties while "attorneys-eyes only" information is usually reserved for more sensitive information such as trade secret information, future product plans, competitive pricing, customer lists or competitive business financial information). *See also* 37 C.F.R. § 2.125(f); Trademark Trial and Appeal Board Standard Protective Order (effective Feb. 5, 2020), Section 1, for a listing of the type of information that may be trade secret/commercially sensitive.

11. Restatement (Third) Unfair Competition § 39 (1995); *see also* Restatement of Torts (First) § 757, cmt. b (1939) (discussing six factors courts have considered in determining whether information is trade secret under the common law). *Black's Law Dictionary* (11th ed. 2019) (A "trade secret" is defined as "[a] formula, process, device, or other business information that is kept confidential to maintain an advantage over competitors; information — including a formula, pattern, compilation, program, device, method, technique, or process — that (1) derives independent economic value, actual or potential, from not being generally known or readily ascertainable by others who can obtain economic value from its disclosure or use, and (2) is the subject of reasonable efforts, under the circumstances, to maintain its secrecy."). *See also* 37 C.F.R. § 2.125(f); Trademark Trial and Appeal Board Standard Protective Order (effective Feb. 5, 2020), Section 1, for a listing of the type of information that may be trade secret/commercially sensitive.

12. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010).

13. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000). *See e.g.*, *THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255-56 (N.D. Ill. 1993) (publicly available documents including catalogs, patents, books, magazines, technical journals and newspaper articles were non-confidential; confirmation letters regarding employee seminars, responses to business invitations, requests for permission to attend business trips and internal memos regarding public seminars were found non-confidential; memoranda or similar documents predicated upon or relating to public information which may be confidential, were not entitled to "attorneys eyes only" designation; customer documents that were innocuous and far from current were not entitled to "attorneys eyes only" designation but may be confidential); *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1416 n.21, 1418 n.28, 1419 n.31 (TTAB 2016) (title of witness as "Operations Officer," respondent's status as limited liability company organized under the Commonwealth of Kentucky, and Respondent's status as a wholly-owned subsidiary are not confidential; cover page of marketing proposal sent to third party without any indication there was a nondisclosure agreement and the recipient was identified in the publicly available discovery deposition of witness not confidential; advertising or marketing proposal

send to third party, not confidential); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1460 (TTAB 2014) (improper designation of marketing materials that were distributed to respondent's purchasers and potential purchasers not confidential; presentation used to describe program directed to interested employer groups, associations, hospitals, schools that had no warning or legend that the information was trade secret and should be kept confidential, were not confidential); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014) (printout of shopping cart webpage available to the public is not confidential); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) (user manuals for opposer's heart monitors distributed to opposer's purchasers and which contained no warning or legend advising they contained trade secrets and should be kept in a secure location were not confidential).

Cf. Blackhorse v. Pro Football Inc., 98 USPQ2d 1633, 1635 (TTAB 2011) (If party designates more than a minimal amount of evidence as confidential or commercially sensitive and the information is more than 20 years old, party should anticipate an order to show cause why such information should warrant a designation as confidential and be shielded from public view); *United States Polo Association v. David McLane Enterprises, Inc.*, 2019 USPQ2d 108442, at *7 (TTAB 2019) ("Where commercially sensitive information is stale, this can undermine a party's claim that disclosure will create a competitive disadvantage.").

14. 37 C.F.R. § 2.120(g); Fed. R. Civ. P. 26(c)(1); *United States Polo Association v. David McLane Enterprises, Inc.*, 2019 USPQ2d 108442, at *2–3 (TTAB 2019) (the designating party "bears the burden of demonstrating that its confidentiality designations are appropriate" and "must demonstrate a particular need for protection and that a clearly defined and serious injury will result otherwise.").

15. Fed. R. Civ. P. 26(c)(1); *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding* , O.G. Notice (June 20, 2000). *See also United States Polo Association v. David McLane Enterprises, Inc.* , 2019 USPQ2d 108442, at *2 (TTAB 2019) (good faith effort satisfied with respect to designation under protective order); *Emilio Pucci International BV v. Sachdev* , 118 USPQ2d 1383, 1386 (TTAB 2016) (good faith effort required for motion for protective order in connection with discovery requests); *Hot Tamale Mama…and More, LLC v. SF Investments, Inc.* , 110 USPQ2d 1080, 1081 (TTAB 2014) (good faith effort should be directed to understanding differences and investigating ways in which to resolve dispute). 37 C.F.R. §2.120(f); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (quoting *Dondi Properties Corp. v. Commerce Savings and Loan Ass'n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988) ("[t]he purpose of the conference requirement is to promote a frank exchange between counsel to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought.")).

16. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000). *Cf. Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (prior to seeking Board intervention, parties must narrow amount of disputed requests to reasonable number); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (nature and the number of discovery requests subject to motion to compel clearly demonstrated that no good faith effort had been made by the parties).

17. 37 C.F.R. § 2.116(g).

18. *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (parties must make an attempt to delineate the truly confidential portions by redaction when filing submissions with the Board). *See also Baxter International Inc. v. Abbott Laboratories*, 297 F.3d 544, 63 USPQ2d 1859, 1859 (7th Cir. 2002) ("Secrecy is fine at the discovery stage, before the material enters the judicial record. . . . But those documents, usually a small subset of all discovery, that influence or underpin the judicial decision are open to public

inspection unless they meet the definition of trade secrets or other categories of bona fide long-term confidentiality.”).

19. *In re Violation of Rule 28(d)* , 635 F.3d 1352, 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (public version of brief contained extensive markings as confidential which ignores the requirements of public access); *Baxter International Inc. v. Abbott Laboratories* , 297 F.3d 544, 63 USPQ2d 1859, 1859 (7th Cir. 2002) (“But those documents, usually a small subset of all discovery, that influence or underpin the judicial decision are open to public inspection unless they meet the definition of trade secrets or other categories of bona fide long-term confidentiality.”); *United States v. Corbitt* , 879 F.2d 224, 228 (7th Cir. 1989) (citations omitted) (“ . . . the common law right of access creates a ‘strong presumption’ in favor of public access to material submitted as evidence in open court . . . the public’s right to inspect judicial documents may not be evaded by the wholesale sealing of court papers”). *See also* 37 C.F.R. § 2.116(g) (“The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.)

20. *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2001); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

412.01(b) Challenging the Designation of Confidential Matter

Excerpt from Board’s Standard Protective Order:

14) Challenges to Designations of Information as Protected.

If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time. The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

37 C.F.R. § 2.116(g) *The Trademark Trial and Appeal Board’s standard protective order is automatically imposed in all inter partes proceedings unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. The standard protective order is available at the Office’s web site. No material disclosed or produced by a party, presented at trial, or filed with the Board, including motions or briefs which discuss such material, shall be treated as confidential or shielded from public view unless designated as protected under the Board’s standard protective order, or under an alternative order stipulated to by the parties and approved by the Board, or under an order submitted by motion of a party granted by the Board. The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.*

Once information is designated as protected, its use and dissemination are circumscribed as provided in the Board’s standard protective order. [Note 1.] A party who disagrees with another party’s designation of

protected information under the Board's standard protective order may challenge the designation (i.e., "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)". [Note 2.]

Circumstances by which a party may challenge a designation include a challenge to information as protected versus unprotected [Note 3], a challenge to the level of classification as protected [Note 4], and challenging the right to use protected information in connection with a dispositive motion or at trial (which could include both redesignation and access to the protected information). [Note 5.] A challenge to right to access protected information differs from a motion in limine which the Board does not consider. *See*TBMP § 527.01(f).

Prior to seeking Board intervention via in camera inspection as to the propriety of the designation of protected information, the parties must first attempt to negotiate in good faith to resolve or narrow the disagreement as to the producing party's designations. [Note 6.] The party challenging the confidentiality designation should initiate the meet and confer process by providing written notice of each challenged designation, i.e., specifically identify the confidential information or restriction on access in dispute, and describe the basis for each challenge in the written notice. [Note 7.] If, despite good faith effort and negotiation, the dispute cannot be resolved by the parties as to the challenged designations, the objecting party may seek relief from the Board by motion. [Note 8.] When a Board determination of the propriety of a designation is sought, the Board expects that any unresolved challenges will be significantly narrowed in scope due to the requirement for good faith negotiations among the parties as set forth in the Board's standard protective order. [Note 9.] During such a challenge, the initial designation would remain in place until the Board determines that it was, in fact, improper.

The Board has wide discretion under Rule 26(c) to "decide when a protective order is appropriate and what degree of protection is required." [Note 10.] Although a party may mark matter as confidential, Fed. R. Civ. P. 26(c)(1) "does not furnish an absolute privilege against disclosure of material that a party might wish to mark confidential." [Note 11.]

A motion to challenge a designation under the Board's standard protective order should be substantially contemporaneous with the designation, or made as soon as practicable after the basis for the challenge is known. [Note 12.] If a challenge is made long after designation, the party will be expected to demonstrate why it could not have made the challenge at an earlier time. [Note 13.] Thus, a designation may remain as designated if the party fails to timely challenge a designation and cannot show cause as to why the challenge as to the propriety of the designation was not made sooner. [Note 14.]

When a designation has been challenged, it is the party seeking protection that bears the burden of demonstrating that its confidentiality designations are appropriate. [Note 15.] To successfully carry the burden of establishing good cause, the producing party must demonstrate a particular need for protection and that a clearly defined and serious injury will result otherwise. [Note 16.] In this regard, the party must provide particular and specific demonstrations of fact, as distinguished from stereotyped and conclusory statements. [Note 17.]

To establish that a document or other information is entitled to protection from disclosure under Fed. R. Civ. P. 26(c)(1)(G), the producing party must show that the information is trade secret or other confidential information and that the disclosure would cause identifiable and serious harm. [Note 18.] Where the producing party seeking protection under Fed. R. Civ. P. 26(c)(1)(G) is a business that seeks to maintain designations related to confidential business information, the producing party must show that disclosure would cause a clearly defined serious injury to its business such as harm to its competitive and financial position. [Note 19.] Such a showing of harm to a party's business requires support, where possible, by affidavits or declarations and concrete, specific examples. [Note 20.]

"At the dispositive motions or trial stage of a proceeding, the showing necessary to justify continued designation of material as confidential increases, as the material at issue transitions from potential evidence produced during discovery to actual evidence to be used in disposition of the case, and a party's interest in such a designation must be weighed against the traditional public right of access to judicial materials." [Note 21.] While information designated Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) is protectable during discovery from access by the adverse party, it may be no longer be subject to the same level of protection if the designating party chooses to rely on the information or testimony at trial and such designation has restricted the access of the adverse party to such information. [Note 22.] Use at trial may require that the adverse party have access to material designated as Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) for trial preparation. [Note 23.]

An objecting party who seeks to use an adverse party's designated information, in connection with a dispositive motion or at trial, may seek to challenge the designation on that basis. [Note 24.] A party seeking to maintain protection of a confidential designation or the level of designation (i.e., "trade secret/commercially sensitive" versus "confidential") of challenged materials sought to be used by the objecting party in connection with a dispositive motion or at trial must establish with specificity that disclosure of the material will result in some kind of substantial harm to its business, and that such harm outweighs the necessity of the material to the dispositive motion or to trial practice. [Note 25.] In the case where redesignation of challenged material to a non-confidential designation is sought in connection with its use for a dispositive motion or at trial, the party seeking to maintain the designation must establish not only some kind of substantial harm to its business, but also that the harm to the party's business outweighs both the necessity of the material to the dispositive motion or to trial practice and to the traditional right to public access of judicial documents and records. [Note 26.] Nonetheless, information appropriately designated as Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) may remain under seal, even if relied on in connection with a dispositive motion or final decision, as the Board's standard protective order is applicable. [Note 27.]

Please Note: As part of general restyling, effective December 1, 2007, former Fed. R. Civ. P. 26(c)(1)(7) is now Fed. R. Civ. P. 26(c)(1)(G).

NOTES:

1. 37 C.F.R. § 2.116(g); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244 (August 1, 2007); *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding* , O.G. Notice (June 20, 2000). *But see* 37 C.F.R. § 2.116(g) ("The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.").

2. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000). *Cf. Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (Board ordered redesignation of portions of expert report and deposition transcript as non-confidential based on party's challenge to designation).

3. *See, e.g., THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255-56 (N.D. Ill. 1993) (requiring redesignation of publicly available documents marked confidential as non-confidential); *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (Board ordered redesignation of portions of expert report and deposition transcript as non-confidential).

4. *See, e.g., THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255-56 (N.D. Ill. 1993) (finding party had used "Attorney Eyes Only" classification four times as often as lower confidentiality

designation and ordering party to "de-designate" all of the "Attorney's Eyes Only" documents and reclassify them "Confidential" or "Non-confidential").

5. *Beasley v. John Wiley & Sons, Inc.*, 111 USPQ2d 1623, 1631 (N.D. Ill. 2014) (party moved to provisionally file exhibits which had confidentiality designations with its summary judgment motion and sought leave to file the exhibits publicly, but once defendant withdrew the confidentiality designations for those exhibits, the court deemed the motion moot, allowing plaintiff to file an unredacted version of its summary judgment motion with a public filing of the exhibits); *Waterkeeper Alliance, Inc. v. Alan & Kristin Hudson Farm*, 278 F.R.D. 136, 141 (D. Md. 2011) (plaintiff challenged defendants' designations in advance of the submission of dispositive motions, intending to include some of the challenged documents as exhibits to its summary judgment motion); *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (to help prepare counsel for cross-examination of applicant's expert, Board required applicant to provide advance notice to opposer of plans to use expert report or to take expert testimony at trial, and in such a case, opposer's in-house technical experts may access portion of expert report and expert deposition transcript, which had been designated by applicant to allow only opposer's outside counsel access). *But see Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656, 1656 n.11 (TTAB 2014) (party unable to raise by motion the issue regarding "trade secret/commercially sensitive" designation of declaration testimony in ACR proceeding in advance of submission of declaration during adverse party's testimony period, as the Board does not entertain motions in limine), *dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016).

6. Fed. R. Civ. P. 26(c)(1); *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding* , O.G. Notice (June 20, 2000). *See also United States Polo Association v. David McLane Enterprises, Inc.* , 2019 USPQ2d 108442, at *2 (TTAB 2019) (good faith effort satisfied with respect to designation under protective order). *Cf.* 37 C.F.R. § 2.120(f)(1); *Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014) (good faith effort should be directed to understanding differences and investigating ways in which to resolve dispute) *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (quoting *Dondi Properties Corp. v. Commerce Savings and Loan Ass'n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988) ("[t]he purpose of the conference requirement is to promote a frank exchange between counsel to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought.")).

7. *Cf. Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) ("In order for the meet and confer process to be meaningful and serve its intended purpose, "the parties must present to each other the merits of their respective positions with the same candor, specificity, and support during informal negotiations as during the briefing of discovery motions;" nonmoving party under equal obligation to participate in good faith efforts to resolve the matter).

8. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000). *Cf. Amazon Technologies, Inc. v. Wax*, 95 USPQ2d 1865, 1868 n.8 (TTAB 2010) (in connection with motion for sanctions, Board found, based on an in camera inspection, opposer properly designated produced materials as trade secret/commercially sensitive).

9. *Cf. Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (prior to seeking Board intervention, parties must narrow amount of disputed requests to reasonable number); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (nature and the number of discovery requests subject to motion to compel clearly demonstrated that no good faith effort had been made by the parties).

10. *In re Violation of Rule 28(d)*, 635 F.3d 1352, 98 USPQ2d 1144, 1147 (Fed. Cir. 2011) (Rule 26(c)(1) permits court to "issue limited protective orders to prevent the discovery or disclosure of certain information or to specify the use that may be made of the discovered information."); *R.C. Olmstead Inc. v. CU Interface*

LLC, 606 F.3d 262, 94 USPQ2d 1897, 1902 (6th Cir. 2010) (court had discretion to limit access to trade secrets by adverse party's employees, allowing access only by adverse party's experts); *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950 (TTAB 2006) (citing Fed. R. Civ. P. 26(c)(7), restyled by amendment, to Fed. R. Civ. P. 26(c)(1)(G)). *See also* Fed. R. Civ. P. 26(c) Notes of Advisory Committee on Rules – 1970 Amendment ("The courts have not given trade secrets automatic and complete immunity against disclosure, but have in each case weighed their claim to privacy against the need for disclosure. Frequently, they have been afforded a limited protection.").

11. *In re Violation of Rule 28(d)* , 635 F.3d 1352, 98 USPQ2d 1144, 1147 (Fed. Cir. 2011). *See also* 37 C.F.R. § 2.116(g) ("The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.").

12. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

13. *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000) ("As between a receiving party which raises a late objection to a designation of confidentiality and a producing party that is forced to move for protection of material previously designated as confidential without objection by the producing party, the Board will look much more favorably on the producing party.").

14. *Compare Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.12 (TTAB 2014) (because Board does not entertain motions in limine, party could not raise issue regarding confidentiality designation of declaration testimony until defendant filed its declarations during its testimony period in ACR case), *dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016), *with Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1495 n.6 (TTAB 2005) (overruling applicant's objections as to confidentiality designations of brand awareness studies raised for the first time in final brief, finding such objections untimely and the delay a "waiver as to the 'confidential' designation of this evidence.").

15. Fed. R. Civ. P. 26(c)(1); *United States Polo Association v. David McLane Enterprises, Inc.*, 2019 USPQ2d 108442, at *2–3 (TTAB 2019) (the designating party "bears the burden of demonstrating that its confidentiality designations are appropriate"); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999).

16. Fed. R. Civ. P. 26(c)(1). *United States Polo Association v. David McLane Enterprises, Inc.*, 2019 USPQ2d 108442, at *3 (TTAB 2019) (the designating party "must demonstrate a particular need for protection and that a clearly defined and serious injury will result otherwise."). *See also, e.g., Deford v. Schmid Products Co.*, 120 F.R.D. 648, 653 (D. Md. 1987)) (citing cases); 8 C. WRIGHT, A. MILLER, & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2035 (3d ed. 2020).

17. *United States Polo Association v. David McLane Enterprises, Inc.*, 2019 USPQ2d 108442, at *3 (TTAB 2019); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1762 (TTAB 1999).

18. *Deford v. Schmid Products Co.*, 120 F.R.D. 648, 653 (D. Md. 1987)) (citing cases); *Waelde v. Merck, Sharpe, & Dohme*, 94 F.R.D. 27, 28 (E.D. Mich. 1981) (citing cases); *United States v. IBM Corp.*, 67 F.R.D. 40, 46 (S.D.N.Y. 1975)).

19. *Deford v. Schmid Products. Co.*, 120 F.R.D. 648, 653 (D.Md.1987)) (business will have to show disclosure would cause harm to competitive and financial position); *Waelde v. Merck, Sharpe, & Dohme*, 94 F.R.D. 27, 28 (E.D. Mich. 1981) (citing cases). *See, e.g., Apple, Inc. v. Samsung Electronics Co.*, 727

F.3d 1214, 107 USPQ2d 2048, 2057, 2058 (Fed. Cir. 2013) (finding district court erred in denying motion to seal portions of documents that contained product-specific financial information, including costs, sales, profits and profit margins, and market research, where the parties established that disclosure would cause competitive harm); *Baxter International Inc. v. Abbott Laboratories*, 297 F.3d 544, 63 USPQ2d 1859 (7th Cir. 2002) (denying motion to place documents under seal because the parties failed to explain why disclosure would harm their competitive position).

20. *Deford v. Schmid Products Co.*, 120 F.R.D. 648, 653 (D. Md. 1987) (citing cases). *See, e.g., Apple, Inc. v. Samsung Electronics Co.*, 727 F.3d 1214, 107 USPQ2d 2048, 2055, 2057 (Fed. Cir. 2013) (finding district court erred in denying motion to seal portions of documents that contained product-specific financial information, including costs, sales, profits and profit margins, which motions to seal were supported by declarations from the parties).

21. *Waterkeeper Alliance, Inc. v. Alan & Kristin Hudson Farm*, 278 F.R.D. 136, 141 (D. Md. 2011). *See Seattle Times Co. v. Rhinehart*, 467 U.S. 20, 33 (1984) (pretrial discovery, unlike the trial itself, is usually conducted in private; "restraints placed on discovered, but not yet admitted information are not a restriction on a traditionally public source of information"); *Rushford v. New Yorker Magazine, Inc.*, 846 F.2d 249, 252-53 (4th Cir. 1988)) (discovery, "which is ordinarily conducted in private, stands on a wholly different footing than does a motion filed by a party seeking action by the court;" when documents that are "the subject of a pretrial discovery protective order ... [are] made part of a dispositive motion, they los[e] their status as being 'raw fruits of discovery'"); 8A C. WRIGHT, A. MILLER, & R. MARCUS, FEDERAL PRACTICE & PROCEDURE CIVIL § 2042 (3d ed. 2020) ("One of the reasons for authorizing broad trial court latitude in restricting dissemination of material garnered through discovery is that the scope of discovery is very broad, often including topics having little bearing on the lawsuit. But when some of those materials are relied upon in a judicial decision, or form the basis for it, the justifications for public access on both First Amendment and common–law grounds increase."). *See, e.g., Apple, Inc. v. Samsung Electronics Co.*, 727 F.3d 1214, 107 USPQ2d 2048, 2055, 2057 (Fed. Cir. 2013) (in considering appeal denying motion to seal, court considered the parties' competitive need to keep financial and market research private against right to public access to information regarding judicial process).

22. *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 (TTAB 2014) (when identity of individual identified during discovery as "trade secret/commercially sensitive" is named as a witness at trial and party chooses to rely on the testimony of that witness at trial, it has waived the protection provided to "trade secret/commercially sensitive" information, and can no longer shield the witness' identity from adverse party), *dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016); *Central Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1143 n.6 (TTAB 2013) (Board noted that while a study was submitted under seal "it is hard to understand how Central can maintain that this information is confidential, yet at the same time rely on it in an attempt to establish the previous public perception of its mark for priority purposes"); *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (applicant will not be able to restrict access by opposer's in-house technical experts to portions of expert deposition testimony and expert report if using expert as witness at trial); *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1713 (TTAB 1999) (in connection with submission of protective order, parties were required to explain why already filed testimony and exhibits proposed to be considered confidential are confidential in nature).

23. *Compare Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1655-56 (TTAB 2014) (when a party relies on testimonial evidence at trial its adversary must have meaningful opportunity to confront witness and inquire into his or her credibility and the facts to which the witness testifies; Board struck declaration testimony which over-designated the identifying information of the declarants as "trade secret/commercially sensitive," which restricted access to this information by opposer's in-house personnel and was critical to considering adverse testimony and should not be kept from a party), *dismissed per stipulation*, No.

14-CV-4463 (D. Minn. Jan. 20, 2016), *with Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (so as to help counsel prepare for cross-examination of applicant's expert, applicant required by Board to provide advance notice to opposer of plans to use expert report take expert testimony at trial, and in such a case, opposer's in-house technical experts may access portion of expert report and expert deposition transcript which had been designated to allow only outside counsel to access).

24. *See, e.g., Beasley v. John Wiley & Sons, Inc.*, 111 USPQ2d 1623, 1631 (N.D. Ill. 2014) (party moved to provisionally file exhibits publicly which had confidentiality designations with its summary judgment motion, once defendant withdrew the confidentiality designations for those exhibits, the court deemed the motion moot, allowing plaintiff to file an unredacted version of its summary judgment motion with a public filing of the exhibits); *Waterkeeper Alliance, Inc. v. Alan & Kristin Hudson Farm*, 278 F.R.D. 136, 141 (D. Md. 2011) (plaintiff challenged defendants' designations in advance of the submission of dispositive motions in the case, intending to include some of the challenged documents as exhibits to its summary judgment motion). *Cf. Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (seeking redesignation of expert report and expert testimony so that it could determine whether the hiring of a rebuttal expert was necessary for trial).

25. *Waterkeeper Alliance, Inc. v. Alan & Kristin Hudson Farm*, 278 F.R.D. 136, 142 (D. Md. 2011).

26. *Waterkeeper Alliance, Inc. v. Alan & Kristin Hudson Farm*, 278 F.R.D. 136, 142 (D. Md. 2011).

27. 37 C.F.R. § 2.116(g); *Baxter International Inc. v. Abbott Laboratories*, 63 USPQ2d 1859 (7th Cir. 2002) ("But those documents, usually a small subset of all discovery, that influence or underpin the judicial decision are open to public inspection unless they meet the definition of trade secrets or other categories of bona fide long-term confidentiality."); *Rushford v. New Yorker Magazine, Inc.*, 846 F.2d 249, 253 (4th Cir. 1988) ("there may be instances in which discovery materials should be kept under seal even after they are made part of a dispositive motion" and the court makes this determination at the time it grants the dispositive motion "and not merely allow[s] continued effect to a pretrial discovery protective order."); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012) ("because proceedings before the Board are public, all papers should be available to the public, except for information that is truly confidential."). *Cf. Apple, Inc. v. Samsung Electronics Co.*, 727 F.3d 1214, 107 USPQ2d 2048, 2056, 2058 (Fed. Cir. 2013) (district court erred in denying motion to seal with regard to a small subset of financial documents as none of the documents were introduced into evidence so the financial information at issue was not considered by the jury and was not essential to the public understanding of the jury's damages award, nor was it essential to district court's rulings on any of the parties' pretrial motions; with regard to market research reports, district court erred in denying motion to seal where party agreed to make public all information actually cited by the district court or the parties, but sought to seal other information neither cited nor discussed by the district court).

412.01(c) Over-designation: Improper designation of confidential filings with the Board

Excerpt from Board's Standard Protective Order:

12) Redaction; Filing Material with the Board.

When a party or attorney must file protected information with the Board, or a motion or final brief that discusses such information, the protected information or portion of the motion/brief discussing the same should be redacted from the remainder. Redactions are subject to a rule of reasonableness.

Redaction can entail merely covering or omitting a portion of a page of material when it is copied or printed in anticipation of filing but can also entail the more extreme measure of simply filing the entire page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied, or omitting the material, would be appropriate.

In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be effected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal. ***Occasions when a whole document or motion/brief must be submitted under seal should be very rare.***

37 C.F.R. § 2.27(c) ***[Pending trademark application index; access to applications.]*** *Decisions of the Director and the Trademark Trial and Appeal Board in applications and proceedings relating thereto are published or available for inspection or publication.*

37 C.F.R. § 2.116(g) *The Trademark Trial and Appeal Board's standard protective order is automatically imposed in all inter partes proceedings unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. The standard protective order is available at the Office's web site. No material disclosed or produced by a party, presented at trial, or filed with the Board, including motions or briefs which discuss such material, shall be treated as confidential or shielded from public view unless designated as protected under the Board's standard protective order, or under an alternative order stipulated to by the parties and approved by the Board, or under an order submitted by motion of a party granted by the Board. The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.*

Board proceedings are designed to be conducted in public and transparent to the public. [Note 1.] Records of Board proceedings are open to public view and available for access by the public [Note 2], subject only to the exception of limited submissions (exhibits, testimony portions of a brief, or other documents) which contain information which is truly confidential in nature. [Note 3.] Improper designation of materials filed in Board proceedings as confidential thwarts the intention of allowing the public the right to inspect judicial records and documents [Note 4] and is "an improper casual approach" to a party's good faith requirement to designate only material that is truly confidential as "confidential." [Note 5.] At final decision, improper designation makes it more difficult to make findings of fact, apply the facts to the law, discuss evidence, and write decisions that make sense when the facts may not be discussed. [Note 6.] In granting a dispositive motion or at final decision, the Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decisions. [Note 7.]

The fact that the Board's standard protective order is automatically entered upon commencement in the proceeding does not give a party unbridled authority to designate its filed submissions to the Board as protected. [Note 8.] A party may not improperly mark its filings as confidential so as to shield them from public view nor may the Board's standard protective order, or any modified protective agreement stipulated to by the parties, be used as a means of circumventing relevant provisions of 37 C.F.R. § 2.27, which provides, that trademark application and registration files, and related TTAB proceeding files, generally should be available for public inspection. [Note 9.] Improper designation has been found where parties have filed entire briefs or motions or portions thereof as confidential, [note 10] filed entire depositions or portions

thereof as confidential [Note 11], filed publicly disclosed [Note 12] or publicly available [Note 13] documents as confidential, or shielded a testifying witnesses' identity from the adverse party. [Note 14.]

The Board addresses improper designation of filed submissions in a number of ways. The Board may disregard the designation as "confidential" for those matters which are improperly designated [Note 15], it may issue an order to show cause why the submission should not be made open to public view [Note 16], it may require the party to reduce redactions by redesignating as non-confidential the overdesignated information and resubmit a properly designated redacted copy for public view [Note 17], or the Board may not consider the improperly designated matter in rendering its decision. [Note 18.] In the case of an order to show cause, or request for resubmission of a filing with proper redaction (i.e., proper designation of confidential matter for public access), if no response is received, the Board will redesignate the confidentially filed material as non-confidential and make it available for public view. [Note 19.]

When filing submissions with the Board, parties should avoid excessive marking of various information as confidential and limit such designations to only those particular discovery responses, exhibits, and deposition transcript pages that are truly confidential, within the scope of and consistent with the protective order entered in the proceeding. [Note 20.] Any confidential filing must include redacted versions for the public record. *See* 37 C.F.R. § 2.126. For any confidential unredacted version of a submission for which a redacted version must be filed, the parties are encouraged to enclose the confidential information in brackets so as to facilitate a better comparison between the public and confidential versions of the filing when the Board is issuing an order or preparing a final decision. Occasions when a document or brief or testimony are submitted in their entirety under seal should be rare. [Note 21.] In decisions, the Board refers to properly designated confidential matter in general terms. [Note 22.]

For further information regarding the filing of confidential materials and redaction, see TBMP § 120.02, TBMP § 412.01, TBMP § 412.02(d), TBMP § 412.04 and TBMP § 412.05. For further information regarding the designation of material as confidential and procedures regarding redaction at trial, see TBMP § 412.01(a) and TBMP § 703.01(p).

NOTES:

1. 37 C.F.R. § 2.27(c); *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2016) (it is intended that filings in Board proceedings be publicly available); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014) (contents of Board proceedings publicly available; proceedings are meant to be transparent to the public); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.12 (TTAB 2014) ("except in unusual circumstances, Board proceedings are open to the public"), *dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012) ("because proceedings before the Board are public, all papers should be available to the public, except for information that is truly confidential."); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) ("record created [in Board] proceeding is entirely or almost entirely public"), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential). *See also Nixon v. Warner Communications, Inc.*, 435 U.S. 589, 598 (1978) (courts recognize "a general right to inspect and copy public records and documents, including judicial records and documents"); *Cox Broadcasting Corp. v. Cohn*, 420 U.S. 469, 492 (1975) ("official records and documents open to the public are the basic data of governmental operations").

2. 37 C.F.R. § 2.27(c); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458 (TTAB 2014) (contents of proceeding files publicly available); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1084 n.8 (TTAB 2014) (TTABVUE is the Board's public online database that contains the electronic

case file for the proceeding, available at the USPTO website), *aff'd*, 112 F.Supp.3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *vacated and remanded onother grounds*, 709 F. App'x 182 (mem.) (4th Cir. Jan. 18, 2018); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014) (documents which are designated confidential do not appear in the electronic docket, TTABVUE); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) ("record created [in Board proceeding] is entirely or almost entirely public"), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009) (Board proceedings must be open to the public). *See also Cox Broadcasting Corp. v. Cohn*, 420 U.S. 469, 492 (1975) ("The common law presumes a right to inspect and copy judicial records and documents.").

3. 37 C.F.R. § 2.116(g); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012) ("because proceedings before the Board are public, all papers should be available to the public, except for information that is truly confidential."); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) ("record created [in Board proceeding] is entirely or almost entirely public"), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential). *See also Baxter International Inc. v. Abbott Laboratories*, 63 USPQ2d 1859 (7th Cir. 2002) ("But those documents, usually a small subset of all discovery, that influence or underpin the judicial decision are open to public inspection unless they meet the definition of trade secrets or other categories of bona fide long-term confidentiality."); *Rushford v. New Yorker Magazine, Inc.*, 846 F.2d 249, 253 (4th Cir. 1988) ("there may be instances in which discovery materials should be kept under seal even after they are made part of a dispositive motion" and the court makes this determination at the time it grants the dispositive motion "and not merely allow[s] continued effect to a pretrial discovery protective order").

4. *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2016); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010). *See also Nixon v. Warner Communications, Inc.*, 435 U.S. 589, 598 (1978) (courts recognize "a general right to inspect and copy public records and documents, including judicial records and documents"); *In re Violation of Rule 28(d)*, 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (confidentiality markings in this case were so extensive that the non-confidential version of the brief ignored the requirements of public access).

5. *In re Violation of Rule 28(d)*, 635 F.3d 1352 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (counsel took an "improper casual approach" to marking the non-confidential version of the brief making it virtually incomprehensible).

6. *In re Violation of Rule 28(d)* , 635 F.3d 1352, 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (confidentiality markings in non-confidential version of brief were so extensive that it hampered the court's consideration and opinion writing); *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC* , 118 USPQ2d 1413, 1416 n.21 (TTAB 2016 ("It is more difficult to make findings of fact, apply the facts to the law, and write decisions that make sense when the facts shown by the evidence may not be discussed."); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC* , 110 USPQ2d 1458, 1461 (TTAB 2014) (same); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry* , 101 USPQ2d 1731, 1736 n.12 (TTAB 2012) ("In order to adequately explain our analysis and the facts on which it is based we must refer to some of the testimony and exhibits, although we have tried to be sensitive about revealing anything that may be truly confidential."); *Edwards Lifesciences Corp. v. VigiLanz Corp.* , 94 USPQ2d 1399, 1402 (TTAB 2010) (improper confidential designations make it "more difficult to make findings of fact, apply the facts to the law, and write decisions that make sense when the facts may not be discussed."). *See also* 37 C.F.R. § 2.116(g) ("The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.").

7. *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2016) ("The Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decision."); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014) (same); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012) ("In order to adequately explain our analysis and the facts on which it is based we must refer to some of the testimony and exhibits, although we have tried to be sensitive about revealing anything that may be truly confidential."); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) ("Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decisions."). *Cf. In re Violation of Rule 28(d)*, 635 F.3d 1352, 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (confidentiality markings in non-confidential version of brief were so extensive that it hampered the court's consideration and opinion writing).

8. *See THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255, 1253 (N.D. Ill. 1993) (it is counsel's "place and responsibility" to ensure that the proper confidential designations are assigned); *Azalea Health Innovations, Inc. v. Rural Health Care, Inc.*, 125 USPQ2d 1236, 1238 (TTAB 2017) ("A rule of reasonableness dictates what information should be [designated confidential and] redacted, and only in very rare instances should an entire submission be deemed confidential."); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.12 (TTAB 2014) ("the mere assertion that information is confidential does not make such designation proper"), *dismissed per stipulation*, No. 14-CV-4463 (D. Minn.); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) (in cases where parties have excessively marked information as confidential the Board may require parties to resubmit those documents so that only truly confidential material is redacted, urging parties to limit confidential designations), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 (TTAB 2008) (urging counsel to exercise discretion and designate as confidential only such information that is truly confidential when appearing before the Board in future proceedings). *Cf.* Fed. R. Civ. P. 26(g)(1)(B)(ii) (requiring discovery responses to be "not interposed for any improper purpose").

9. *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2001); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000). *Cf. In re Violation of Rule 28(d)*, 635 F.3d 1352, 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (improper redaction of non-confidential version of brief ignores the requirements of public access).

10. *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009) (opposer ordered to file redacted brief in which only information which is truly confidential is redacted); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495, n.5 (TTAB 2005) (where entirety of the briefs were deemed "confidential," Board subsequently requested and received redacted copies). *See also In re Violation of Rule 28(d)*, 635 F.3d 1352, 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (improper designations of large portions of appeal brief as confidential, including legal argument and case citations and quotations from case; marking of legal argument as confidential under Rule 26(c)(1)(G) cannot be justified unless argument discloses facts or figures of genuine competitive or commercial significance).

11. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1460-61 (TTAB 2014) (discussing improper designation as confidential of testimony and exhibits submitted in Board proceeding); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12, 1739 (TTAB 2012) (party submitted entire deposition testimony of witness under seal, and was ordered to resubmit copies of evidence in which only truly confidential material was redacted, failing which deposition testimony would be unsealed); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402-03

(TTAB 2010) (discussing improper designation as confidential testimony and exhibits submitted in Board proceeding including discovery deposition testimony regarding how applicant's mark was selected, products on which applicant intended to use its mark, and to whom applicant makes its initial sales contacts); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2001) (parties were not "precise in the handling and submission of apparently confidential testimony and documents," noting that "whole transcripts of testimony depositions have been labeled as confidential when it is clear from reading the transcripts that only portions thereof were intended to be shielded from public view.").

12. *THK America Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255-56 (N.D. Ill. 1993) (improper designation as confidential confirmation letters regarding employee seminars, responses to business invitations, requests for permission to attend business trips and internal memos regarding public seminars); *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1416 n.21, 1418 n.28, 1419 n.31 (TTAB 2016) (cover page of marketing proposal sent to third party without any indication there was a nondisclosure agreement, not confidential; advertising or marketing proposal sent to third party, not confidential); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1460 (TTAB 2014) (improper designation of marketing materials that were distributed to respondent's purchasers and potential purchasers not confidential; presentation found not confidential where presentation directed to interested employer groups, associations, hospitals, schools and the presentation had no warning or legend that the information in the presentation was trade secret and should be kept confidential); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) (where sales figures, advertising expenditures and similar information appeared in publicly available documents or submissions, Board did not treat the information as confidential); *Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1874 (TTAB 2011) (improper designations of whole documents and large amount of non-confidential information improperly designated as confidential).

13. *THK America Inc. v. NSK Co. Ltd.*, 33 USPQ2d 1248 (N.D. Ill. 1993) (improper designation of published, publicly available documents, among which are catalogs, patents, books, magazines, technical journals and newspaper articles); *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1416 n.21, 1418 n.28 (TTAB 2016) (title of witness as "Operations Officer," respondent's status as limited liability company organized under the Commonwealth of Kentucky, and Respondent's status as a wholly-owned subsidiary are not confidential; cover page of marketing proposal sent to third party without any indication there was a nondisclosure agreement and the recipient was identified in the publicly available discovery deposition of witness, not confidential); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014) (printout of shopping cart webpage available to the public is not confidential); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) (user manuals for opposer's heart monitors distributed to opposer's purchasers and which contained no warning or legend advising they contain trade secrets and should be kept in a secure location were not confidential); *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1954 (TTAB 2006) (overdesignation of non-confidential matter with respect to portions of expert report as related to expert's credentials and background, his involvement as an expert or witness in other matters, how he came to be a witness in this proceeding, the role his assistant played, whether other documents beside the report were reviewed or prepared, information about other tests done outside the context of this proceeding, and knowledge of other persons and tests done outside the context of this proceeding).

14. *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 (TTAB 2014) (improper designation of testifying witnesses' identity as "trade secret/commercially sensitive" under Board's standard protective order, as modified by the parties' ACR agreement, opposer's counsel should have been able to share with opposer the names of witnesses testifying against opposer; applicant had identified these witness' names in pretrial disclosures), *dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016).

15. 37 C.F.R. § 2.116(g); *Micro Motion Inc. v. Kane Steel Co.*, 894 F.2d 1318, 13 USPQ2d 1696, 1702 (Fed. Cir. 1990) (designation of material as confidential not controlling; court retains authority to decide what materials are deemed confidential and what part of trial shall be in camera); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1476 (TTAB 2017) (Board not bound by inappropriate designations of material as confidential); *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2016) ("we will treat only evidence and testimony that is truly confidential or commercially sensitive as such"); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014) (Board would not be bound by parties' confidential designations at final decision, treating only evidence and testimony that is clearly of private nature or commercially sensitive as confidential); *Miller v. Miller*, 105 USPQ2d 1615, 1617 n.4 (TTAB 2013) (discussing those portions of testimony and evidence "that truly contain confidential information only in general terms."); *General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179, 1181 (TTAB 2008) ("Depositions have been marked confidential, which limit our reference to them. However, in order to render a decision that relates to the relevant facts of this case, we have referred to selective portions of the record that appear to us to be not truly confidential."); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) (Board not bound by parties' designation of confidential matter); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951, 69959 (October 7, 2016) ("This final rule also codifies practice and precedent that the Board may treat as not confidential material that cannot reasonably be considered confidential, notwithstanding party designations."; "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.").

16. *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (If party designates more than a minimal amount of evidence as confidential or commercially sensitive and the information is more than 20 years old, party should anticipate an order to show cause why such information should warrant a designation as confidential and be shielded from public view.). *Cf. Therrien v. Target Corp.*, 617 F.3d 1242, 1259 (10th Cir. 2010) (sealed portions of the appendices will be unsealed 20 days from the filing of the opinion unless one of the parties files a motion, under seal if necessary, "setting forth precisely what information should be kept confidential and why lesser measures (such as submission of a redacted [appendix]) would not provide effective protection"); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1714 (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).

17. *Azalea Health Innovations, Inc. v. Rural Health Care, Inc.*, 125 USPQ2d 1236, 1237–38 (TTAB 2017) (where the parties designated as confidential the entirety of certain notices of reliance and testimony without submitting redacted copies for public viewing the Board ordered them to resubmit copies in which only truly confidential material was redacted, failing which the materials would be treated as part of the public record); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 (TTAB 2012) (party submitted certain deposition testimony under seal, and was ordered to resubmit copies of testimony in which only truly confidential testimony was redacted); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) (in cases where parties have excessively marked information as confidential the Board may require parties to resubmit those documents so that only truly confidential material is redacted), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009) (opposer ordered to file redacted brief in which only information which is truly confidential is deleted); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495, n.5 (TTAB 2005) (where entirety of the briefs were deemed "confidential," Board subsequently requested and received redacted copies).

18. *Hunter Industries., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 (TTAB 2014) (improperly designated declaration testimony not considered and stricken from record), *dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016).

19. *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012).

20. *In re Violation of Rule 28(d)*, 635 F.3d 1352 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (parties must confine their confidentiality markings to information covered by a protective order; confidentiality markings in appellant's brief went beyond the scope of the protective order). *See Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) ("confidential" designation should be limited to information that is truly confidential or commercially sensitive); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) (urging parties to limit confidential designations), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009) (because Board proceeding is open to the public, only truly confidential information should be marked as such); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 (TTAB 2008) (urging counsel to exercise discretion and designate as confidential only such information that is truly confidential when appearing before the Board in future proceedings); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2001) ("Material should be designated as confidential, and as requiring handling as such, only when absolutely necessary.").

21. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000). *Cf. Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012) (Board required a testimonial deposition designated entirely as confidential to be resubmitted with portions truly confidential redacted, otherwise, would be redesignated as non-confidential); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868 (TTAB 2011) (improper designations of whole documents); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495, n.5 (TTAB 2005) (where entirety of the briefs were deemed "confidential," Board subsequently requested and received redacted copies).

22. *See e.g.*, *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1739 (TTAB 2012) (for information in testimony that is truly confidential, Board will refer to it generally); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1878 (TTAB 2011) (information regarding sales and promotion by parties designated as confidential and the Board referred to this information generally); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1078 n.29 (TTAB 2011) (portions of testimony designated confidential referred to only in general terms); *Holmes Oil Co. v. Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1150 n.4 (TTAB 2011) (referring to parties' consent agreement generally, due to confidential designation); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402, 1408 (TTAB 2010) (sales and advertising matter designated as confidential and "truly appropriate matter for a confidential designation" so the Board referred to that information in general terms); *Safer Inc. v. OMS Invests. Inc.*, 94 USPQ2d 1031, 1042 (TTAB 2010) (information as to sales figures designated as confidential so Board referred to those figures in general terms); *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009) (advertising and revenue figures designated confidential, so referred to only generally in Board's decision); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1514 (TTAB 2009) (discussing only sales and advertising expenditures set forth in the parties' briefs but otherwise referring to the evidence designated "confidential" generally); *Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d 1393, 1396 n.3 (TTAB 2009) (Board is mindful of the portions of documents and testimony designated as "confidential" and has referred to such matters in general terms).

412.02 Modification of Board's Standard Protective Order Governing the Exchange of Confidential and Trade Secret/Commercially Sensitive Information

The terms of the Board's standard protective order may be modified, upon motion or upon stipulation approved by the Board, to govern the exchange of "Confidential" or "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" information. [Note 1.] The most common kind of order allowing discovery on conditions is an order limiting the persons who are to have access to the information disclosed. [Note 2.] However, the parties may not agree to redefine the Board's definition of what information constitutes "Confidential" and "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)" information. The parties may agree to change who has access to information and materials, but the designations retain the meaning the Board dictated in the Standard Protective Order. [Note 3.]

NOTES:

1. 37 C.F.R. § 2.116(g).

2. 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2043 (3d ed. 2020); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42244 (August 1, 2007) ("parties are free to agree to modify the standard protective order").

3. *United States Polo Association v. David McLane Enterprises, Inc*., 2019 USPQ2d 108442, at *3 (TTAB 2019).

412.02(a) Modification of Board's Standard Protective Order upon Stipulation

If the parties choose to modify the terms of the Board's standard protective order and enter into their own stipulated protective order, a copy of the executed agreement should be filed with the Board. The Board will acknowledge receipt of the agreement, but the parties should not wait for the Board's acknowledgement to conduct themselves in accordance with the terms of their agreement. The terms of the agreement are binding as of the date the agreement is signed. Such an order may not be used as a means of circumventing paragraphs (d) and (e) of 37 C.F.R. § 2.27, which provide, in essence, that except for matter filed under seal pursuant to a protective order issued by a court or by the Board, the file of a published application or issued registration, and all proceedings relating thereto, are available for public inspection. [Note 1.]

NOTES:

1. *See Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

412.02(b) Pro Se Litigants and In-House Legal Counsel

While the Board's standard protective order sets forth guidelines for the disclosure of confidential information to pro se litigants and in-house counsel, in some cases, a modification of the Board's standard protective order upon motion or by stipulation of the parties, approved by the Board, may be desirable. Special issues regarding the exchange and disclosure of information during discovery may arise in cases involving pro se litigants and in-house legal counsel. For example, under the terms of the Board's standard protective order, such individuals do not have access to Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) information. [Note 1.] The financial burden of retaining either legal counsel in the case of a pro se litigant or outside legal counsel in the case of in-house counsel does not constitute good cause to amend

the Board's protective order to remove the restriction with respect to Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) information. [Note 2.] In instances where in-house counsel moves to amend the Board's protective order to permit access to Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) information, the determining factor is whether in-house counsel is involved in its employer-litigant's "competitive decision making." [Note 3.]

NOTES:

1. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000). *See Amazon Technologies Inc. v. Wax*, 95 USPQ2d 1865, 1867 n.6 (TTAB 2010) (pro se applicant hired outside attorney solely for purpose of reviewing opposer's "trade secret/commercially sensitive" information and documents pursuant to the protective order).

2. *See A. Hirsh, Inc. v. United States*, 657 F. Supp. 1297, 1305 (C.I.T. 1987).

3. *See U.S. Steel Corp. v. United States*, 730 F.2d 1465, 1468 (Fed. Cir. 1984); *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1953 (TTAB 2006) (Board applied test to deny opposer's motion to modify protective order to permit in-house counsel access to trade secret or commercially sensitive information where opposers made only minimal showing that their in-house legal counsel was not involved in "competitive decision-making" activities).

412.02(c) In Camera Inspection

In situations where there is a dispute between the parties to a proceeding as to the relevance and/or confidentiality of a document, or portions thereof, sought to be discovered, and the Board cannot determine from the arguments of the parties, on motion to compel production, whether the document is relevant and/or confidential, the Board may request that a copy of the document be submitted to the Board for an in camera inspection. [Note 1.]

See TBMP § 412.05 with regard to the handling of confidential materials that are filed electronically or, where appropriate, on paper with the Board.

NOTES:

1. *Amazon Technologies, Inc. v. Wax*, 95 USPQ2d 1865, 1869 n.8 (TTAB 2010) (based on an in camera inspection, opposer properly designated produced materials as trade secret/commercially sensitive).

412.02(d) Contents of Protective Order

In some cases, parties may agree to modify the Board's standard protective order, or the standard protective order is modified upon motion approved by the Board. The revised protective order typically may include provisions further clarifying the following:

(1) The description of the manner in which confidential or trade secret information is to be handled.

(2) The requirement that a party claiming confidentiality or trade secret protection designate the information covered by the claim prior to disclosure of the information to the discovering party.

(3) The provision that a party may not designate information as confidential or trade secret unless the party has a reasonable basis for believing that the information is, in fact, confidential or trade secret in nature.

(4) The provision that information designated by the disclosing party as confidential or trade secret may not include information which, at or prior to disclosure thereof to the discovering party, is known to or independently developed by the discovering party; or is public knowledge or becomes available to the public without violation of the agreement.

(5) The provision that information designated by the disclosing party as confidential or trade secret may not include information that, after the disclosure thereof, is revealed to the public by a person having the unrestricted right to do so.

(6) The provision that information designated by the disclosing party as confidential or trade secret may not include information which is acquired by the discovering party from a third party, which lawfully possesses the information and/or owes no duty of nondisclosure to the party providing discovery.

(7) The specification of the persons to whom confidential or trade secret information may be disclosed (e.g., outside counsel; in-house counsel; counsel's necessary legal and clerical personnel).

(8) The provision that all persons to whom confidential or trade secret information is disclosed shall be advised of the existence and terms of the protective order.

(9) The provision that the discovering party will not disclose or make use of confidential or trade secret information provided to it under the order except for purposes of the proceeding in which the information is provided.

(10) The means for resolving disputes over whether particular matter constitutes confidential or trade secret information.

(11) The statement that at the end of the proceeding, each party shall return to the disclosing party all confidential information and materials, including all copies, summaries, and abstracts thereof.

(12) For material designated as confidential or trade secret to be made of record in the proceeding, it shall be submitted to the Board electronically designated as "CONFIDENTIAL" via ESTTA, or, where appropriate, by paper in a separate sealed envelope or other sealed container bearing the proceeding number and name, an indication of the general nature of the contents of the container, e.g. opposer's brief, or applicant's motion with specification of the subject of the brief or motion, and, in large letters, the designation "CONFIDENTIAL." For Confidential or Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) submissions filed either via ESTTA or, where appropriate, by paper, two versions are required – a confidential version as well as a redacted version available for public viewing. The redacted copy of the submission must be submitted concurrently with the confidential filing, see 37 C.F.R. § 2.126(c). The parties must file Confidential or Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive) materials via ESTTA. For confidential submissions, it is preferable for the parties to enclose the confidential information in brackets so as to facilitate a better comparison between the public and confidential versions of the filing when the Board is issuing an order or preparing a final decision. In addition, when referring to material or testimony that has been designated confidential and which cannot be viewed on TTABVUE, the TTABVUE docket and entry number where such material or testimony is located should be included in any citation.For further information regarding the filing of confidential materials, see TBMP § 120.02, TBMP § 412.04 and TBMP § 412.05.

The Board's standard protective order can be found on the USPTO website at: **www.uspto.gov/ttab**.

For additional information concerning the contents of a protective order, see the cases and authorities cited in the note below. [Note 1.]

NOTES:

1. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.* , 10 USPQ2d 1671, 1676 (TTAB 1988) (in addition to provisions mandated by Board, protective order may contain other provisions as are

agreeable to parties); *Neville Chemical Co. v. Lubrizol Corp.* , 184 USPQ 689, 690 (TTAB 1975) (Board required provision that information furnished by opposer would be confined to applicant's attorneys). **Please Note:** These cases were decided prior to automatic imposition of the Board's standard protective order under 37 C.F.R. § 2.116(g).

412.03 Duration of Protective Order

Excerpt from Board's Standard Protective Order:

16) Board's Jurisdiction; Handling of Materials after Termination.

The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

The parties may agree that archival copies of evidence, memoranda, discovery deposition transcripts, testimony deposition transcripts, affidavits, declarations, and briefs may be retained solely by outside counsel, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, each party and their attorneys, as well as any other persons subject to the terms of this agreement, shall return to each disclosing party (1) all materials and documents, including ESI, containing protected information, (2) all copies, summaries, and abstracts thereof, and (3) all other materials, memoranda or documents embodying data concerning said material, including all copies provided pursuant to paragraphs 4 and 5 of this Order. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned. Additionally, parties to this agreement are precluded from disclosing orally or in writing any protected information provided during the course of a Board proceeding once this Board proceeding is terminated.

Under the Board's protective order, once a proceeding before the Board has been finally determined, the Board has no further jurisdiction over the parties thereto. [Note 1.] According to the terms of the Board's protective order, within thirty days following termination of a proceeding, the parties and their attorneys must return to each disclosing party the protected information disclosed during the proceeding, including any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. Alternatively, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

It is unclear whether the Board can order parties to enter into a contract that will govern the protection of information after the Board proceeding is concluded. [Note 2.] Thus, it may be advisable for both the parties and their attorneys to sign a stipulated protective order, so that it is clear that they are all bound thereby; that they have created a contract which will survive the proceeding; and that there may be a remedy at court for any breach of that contract which occurs after the conclusion of the Board proceeding. [Note 3.] Nonetheless, any determination of whether the agreement establishes contractual rights or is enforceable outside of the Board proceeding is for a court to decide should such matter come before it. [Note 4.]

NOTES:

1. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, O.G. Notice (June 20, 2000); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 n.5 (TTAB 2001) ("the Board's jurisdiction over the parties ends when this proceeding does and the Board will not be involved in enforcing provisions of the [protective] agreement after conclusion of the opposition.").

2. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42251 (August 1, 2007).

3. *See Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 n.3 (TTAB 2000) (Board's jurisdiction would not extend to third-party signatory); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 n.3 (TTAB 1987) (Board approves stipulated protective orders signed by parties' counsel but both counsel "may wish to have the parties sign themselves . . . so that the parties will clearly realize that they have created a contract that will survive the proceeding"); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1226 n.10 (TTAB 1987) (suggesting that "for the protection of both parties, the parties, as well as their counsel should sign the stipulated protective order so as to create a contract that will survive the proceeding"). *See also* with respect to violation of a Board protective order after the conclusion of the Board proceeding, *Alltrade Inc. v. Uniweld Products Inc.*, 946 F.2d 622, 20 USPQ2d 1698, 1702 n.11 (9th Cir. 1991) (bringing confidential business documents into the public record in violation of the Board's protective order established a cause of action in district court).

4. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42251 (August 1, 2007).

412.04 Filing Confidential Materials with Board

37 C.F.R. § 2.27(d) ***[Pending trademark application index; access to applications.]*** *Except as provided in paragraph (e) of this section, the official records of applications and proceedings relating thereto are available for public inspection and copies of the documents may be furnished upon payment of the fee required by § 2.6.*

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

37 C.F.R. § 2.126(c) ***[Form of submissions to the Trademark Trial and Appeal Board.]*** *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.*

Excerpt from Board's Standard Protective Order:

12) Redaction; Filing Material with Board

When a party or attorney must file protected information with the Board, or a motion or final brief that discusses such information, the protected information or portion of the motion/brief discussing the same should be redacted from the remainder. Redactions are subject to a rule of reasonableness.

Redaction can entail merely covering or omitting a portion of a page of material when it is copied or printed in anticipation of filing but can also entail the more extreme measure of simply filing the entire page under

seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied, or omitting the material, would be appropriate.

In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be effected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal. ***Occasions when a whole document or motion/brief must be submitted under seal should be very rare.***

Protected information, and pleadings, briefs or memoranda that reproduce, discuss or paraphrase such information, shall be filed with the Board under seal. If filed by mail, the envelopes or containers shall be prominently stamped or marked with a legend in substantially the following form:

CONFIDENTIAL
This envelope contains documents or information that are subject to a protective order or agreement. The confidentiality of the material is to be maintained and the envelope is not to be opened, or the contents revealed to any individual, except by order of the Board.

If filed electronically by employing the Board's Electronic System for Trademark Trial and Appeals ("ESTTA"), the filing party should comply with the redaction guidelines set forth above and click the "confidential filing" option prior to transmitting the documents electronically. In all situations, a redacted copy must also be filed for public view.

Except for materials filed under seal pursuant to a protective order or designated as confidential in ESTTA, 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 inspection and copying on TTABVUE. [Note 1.] To be handled as confidential pursuant to the Board's standard protective order or the parties' individualized protective order, and kept out of the public record, confidential materials must be so designated at the time of filing. [Note 2.] Electronic submissions in Board proceedings, and paper submissions, where appropriate, which are not properly designated as confidential will be placed in the Board's public records, available on the Internet. Only the particular discovery responses, exhibits, deposition transcript pages, or those portions of a brief, pleading, or motion that disclose confidential information should be electronically designated as "CONFIDENTIAL" in ESTTA or, where permitted, filed by paper under seal pursuant to a protective order.

If a party submits any brief, pleading, motion, or other such filing containing confidential information, either electronically via ESTTA or, where permitted, by paper under seal, the party must also submit for the public record a redacted version of said submission. [Note 3.] Thus, for confidential submissions filed either via ESTTA or, where permitted, by paper, two versions are required – a confidential version as well as a redacted version available for public view.

For any confidential unredacted version of a submission, the parties are strongly encouraged to enclose the confidential information in brackets so as to facilitate a better comparison between the public and confidential versions of the filing when the Board is issuing an order or preparing a final decision. A rule of reasonableness dictates what information should be redacted, and only in very rare instances should an entire submission

be deemed confidential. [Note 4.] In cases where a redacted version has not been provided, the confidentiality of the information may be deemed waived. [Note 5.]

Electronic filing using ESTTA is required for all submissions, including those containing confidential material. [Note 6.] When using ESTTA, the filer should select "CONFIDENTIAL Opposition, Cancellation or Concurrent Use" under "File Documents in a Board Proceeding." Filings made using this option will not be made available for public viewing, although entries will be made on the publicly available docket sheet in TTABVUE indicating the Board's receipt of such filings. These materials may be inspected only by those individuals who are entitled, under the terms of the protective order, to have access to the protected information. However, the redacted copy of the submission which must be submitted separately and concurrently with the confidential filing will be made available for public viewing.

For further information regarding the use of ESTTA for confidential filings, see TBMP § 110 and TBMP § 120.02.

Where appropriate, paper submissions of material designated as confidential should be filed in a separate sealed envelope or other sealed container prominently marked with the word "CONFIDENTIAL." [Note 7.] Many attorneys also like to attach to the sealed envelope or other sealed container a statement, such as the following:

FILED UNDER SEAL SUBJECT TO PROTECTIVE ORDER.

> The materials contained in this envelope have been designated
> confidential, pursuant to a protective order, and are not to be
> disclosed or revealed except to the Trademark Trial and Appeal
> Board and counsel for the parties, or by order of a court.

The envelope or other container must also bear information identifying the proceeding in connection with which it is filed (i.e., the proceeding number and name) [Note 8], and an indication of the nature of the contents of the container (i.e., "Applicant's Answers to Opposer's Interrogatories 8 and 19," "Pages 22-26 From the Discovery Deposition of John Doe," "Opposer's Exhibits 3-5 to the Discovery Deposition of John Smith," etc.).

NOTES:

1. 37 C.F.R. § 2.27(d). *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014) (documents which are designated confidential do not appear in the electronic docket, TTABVUE); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1084 n.8 (TTAB 2014) (TTABVUE is the Board's public online database that contains the electronic case file for the proceeding, available at the USPTO website), *aff'd* 112 F.Supp. 3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *vacated and remanded on other grounds*, 709 F. App'x 182 (mem.) (4th Cir. Jan. 18, 2018).

2. *See* 37 C.F.R. § 2.116(g).

3. *See* 37 C.F.R. § 2.27(d); 37 C.F.R. § 2.27(e); 37 C.F.R. § 2.126(c); *Duke University v. Haggar Clothing Inc.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

4. *See, e.g., Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1460-61 (TTAB 2014) (discussing improper designation as confidential of testimony and exhibits submitted in Board

proceeding); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 (TTAB 2012) (party submitted all evidence under seal, and was ordered to resubmit copies of evidence in which only truly confidential material was redacted); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402-03 (TTAB 2010) (discussing improper designation as confidential testimony and exhibits submitted in Board proceeding); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009) (opposer ordered to file redacted brief in which only information which is truly confidential is deleted); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495, n.5 (TTAB 2005) (where entirety of the briefs were deemed "confidential," Board subsequently requested and received redacted copies).

5. *See, e.g., Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1633 n.6 (TTAB 2007). *See also Ayoub, Inc. v. ACS Ayoub Carpet Service*, 118 USPQ2d 1392, 1398 n.39 (TTAB 2016) (parties electronically filed documents marked as confidential on their face but did not select the "confidential" designation in ESTTA and did not file redacted public versions; parties allowed time from the date of the decision to file redacted copies, failing which the documents would be treated as part of public record).

6. 37 C.F.R. § 2.126(c).

7. *See* 37 C.F.R. § 2.126(c). *See also* 37 C.F.R. § 2.126(b) (paper filing available only in limited circumstances).

8. *See* 37 C.F.R. § 2.126(c).

412.05 Handling of Confidential Materials by the Board

A confidential filing submitted via ESTTA, and properly designated as confidential, will not be made available for public viewing, although an entry will be made on the publicly-available docket sheet in TTABVUE, indicating the Board's receipt of such filing. If a confidential filing is not properly designated as confidential when submitted via ESTTA, the submission will be placed in the Board's public records, available on the Internet. The Board will retain electronic versions of all submissions, including confidential filings, pursuant to USPTO document retention policies. Thus, confidential matter submitted via ESTTA is retained in the Board's electronic records and will not be deleted from the electronic records after the proceeding is finally determined.

Confidential materials submitted, where appropriate, in non-electronic, i.e, paper or physical form (including trade secret information), and filed under seal subject to a protective order are stored by the Board in a secure location, and are disclosed only to the Board and to those people specified in the protective order as having the right to access. Confidential paper submissions, made only when appropriate, are scanned into TTABVUE and designated "confidential." After scanning and designation as "confidential," the Board retains the confidential paper submissions for a short period of time before disposing of the confidential paper submissions in an appropriate manner. Following the conclusion of a proceeding, including any appeal period, any physical confidential materials submitted will be disposed of by the Board in an appropriate manner. *See*TBMP § 806 (Termination of Proceeding).

For further information regarding the handling of paper, physical materials, and confidential materials by the Board, see TBMP § 119.03 and TBMP § 120.02. For information concerning access to protective order materials during an appeal from the decision of the Board, see TBMP § 904.

412.06 Protective Orders Limiting Discovery

37 C.F.R. § 2.120(g) ***Motion for a protective order.*** *Upon motion by a party obligated to make initial disclosures or expert testimony disclosure or from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (A) through (H), inclusive, of Rule 26(c)(1) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party comply with disclosure obligations or provide or permit discovery.*

Fed. R. Civ. P. 26(c)(1) In General. *A party or any person from whom discovery is sought may move for a protective order in the court where the action is pending — or as an alternative on matters relating to a deposition, in the court for the district where the deposition will be taken. The motion must include a certification that the movant has in good faith conferred or attempted to confer with other affected parties in an effort to resolve the dispute without court action. The court may, for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the following:*

(A) *forbidding the disclosure or discovery;*

(B) *specifying terms, including time and place or the allocation of expenses, for the disclosure or discovery;*

(C) *prescribing a discovery method other than the one selected by the party seeking discovery;*

(D) *forbidding inquiry into certain matters, or limiting the scope of disclosure or discovery to certain matters;*

(E) *designating the persons who may be present while the discovery is conducted;*

(F) *requiring that a deposition be sealed and opened only on court order;*

(G) *requiring that a trade secret or other confidential research, development, or commercial information not be revealed or be revealed only in a specified way; and*

(H) *requiring that the parties simultaneously file specified documents or information in sealed envelopes, to be opened as the court directs.*

(2)Ordering Discovery. *If a motion for a protective order is wholly or partly denied, the court may, on just terms, order that any party or person provide or permit discovery.*

Although it is generally inappropriate to respond to a request for discovery by filing a motion for a protective order, in certain situations, on motion pursuant to 37 C.F.R. § 2.120(g), a party may properly move for a protective order that the disclosure or discovery not be had, or be had only on specified terms and conditions. [Note 1.]

A party must establish good cause to obtain a protective order. [Note 2.] To establish good cause, a movant must provide "a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements." [Note 3.] The existence of good cause for a protective order is a factual matter to be determined from the nature and character of the information sought by deposition or interrogatory request or request for production or request for admission weighed in the balance of the factual issues involved in the Board proceeding. The moving party seeking a protective order bears the burden of showing good cause. The movant must demonstrate that its ability to litigate will be prejudiced, not merely that the difficulty of managing the litigation will increase. [Note 4.]

When the Board grants a motion for a protective order it may direct either the disclosing party, or the parties together, to prepare an order with terms that are mutually agreeable to them, [Note 5] may approve the protective order proffered by a party, may order the parties to adhere to the Board's standard protective order, or may provide whatever relief the Board deems appropriate.

The parties should confer in good faith before seeking Board intervention for a protective order. [Note 6.] A motion for protective order may be denied on the basis of a lack of good faith effort to resolve the issues regarding the discovery requests. [Note 7.]

For additional information regarding motions for protective order, see TBMP § 412 and TBMP § 526.

NOTES:

1. *See, e.g., Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (granting protective order, in part because many of requests not appropriately tailored to elicit discoverable information); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013) (protective order granted with regard to duplicative requests for admissions and admissions directed to opposer's unpleaded registrations); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1764 (TTAB 1999) (protective order against taking deposition of high level executive granted); *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (protective order granted where party who was served with discovery (assignor) is not and was not at the time of commencement of proceeding the real party in interest).

2. 37 C.F.R. § 2.120(g); Fed. R. Civ. P. 26(c)(1). *See Andrew R. Flanders v. DiMarzio, Inc.*, 2020 USPQ2d 10671, at *5 (TTAB 2020) (Board found no good cause for a protective order requiring that respondent's Fed. R. Civ. P. 30(b)(6) witness be deposed in Bozeman, Montana where he resides instead of respondent's principal place of business in New York City).

3. *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2152-53 (TTAB 2013); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999).

4. *A. Hirsh, Inc. v. United States*, 657 F. Supp. 1297, 1305 (C.I.T. 1987); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2153 (TTAB 2013).

5. *See, e.g., Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719 (TTAB 1989); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974).

6. Fed. R. Civ. P. 26(c)(1). *See e.g., Andrew R. Flanders v. DiMarzio, Inc.*, 2020 USPQ2d 10671, at *2 (TTAB 2020) (parties made good faith effort prior to filing motion for protective order where the parties had previously conferenced with the assigned interlocutory attorney to attempt to resolve dispute regarding location for taking deposition of respondent's designated Fed. R. Civ. P. 30(b)(6) witness); *Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1386 (TTAB 2016) (lack of good faith effort); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2152 (TTAB 2013) (finding good faith effort to resolve the discovery dispute prior to filing the motion for protective order). *Cf. Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014) (good faith effort in connection with motion to compel should be directed to understanding differences and investigating ways in which to resolve dispute); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (quoting *Dondi Properties Corp. v. Commerce Savings and Loan Ass'n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988) ("[t]he purpose of the conference requirement is to promote a frank exchange between counsel to

resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought.”)).

7. *Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1386 (TTAB 2016) (“the Board’s finding of a lack of good faith effort, alone, is sufficient to deny the motion for a protective order.”).

412.06(a) Depositions

Although issuance of a protective order totally prohibiting a deposition occurs only in extraordinary circumstances, the Board has the discretion to limit a deposition or order a deposition not to be had if it determines that the discovery sought is obtainable from other sources that are more convenient and less burdensome or duplicative. [Note 1.] The party seeking a protective order to limit a deposition or for a deposition not to be had bears the burden to show good cause therefor. [Note 2.] To establish good cause, the movant must submit “a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements.” [Note 3.]

As a general rule, a lack of personal knowledge is an insufficient basis for obtaining a protective order that a discovery deposition not be had, as a party seeking discovery may test a witness’ asserted lack of knowledge. [Note 4.] On the other hand, a motion for protective order may be granted if it is shown that the party has no unique or superior personal knowledge of the facts and that discovery may be obtained from other individuals with equivalent or greater knowledge. [Note 5.] A party may file a motion for a protective order (or alternatively, a motion to quash) if, for example, absent a stipulation of the parties or leave of the Board, the notice of deposition would result in the inquiring party exceeding the permitted number of ten discovery depositions or if it would result in a second deposition of an individual or if the notice would result in a deposition being taken outside the discovery period. An assertion that the deponent is too busy, or that the examination would cause undue labor, expense or delay is generally an insufficient basis for obtaining a protective order. [Note 6.] For information on how and when the limit on the number of discovery depositions may be exceeded, see TBMP § 404.10. For information on filing a motion for leave to serve additional depositions over the ten deposition limit, see TBMP § 519.

If a party moves for a protective order to prohibit the deposition of a very high-level official or executive of a large corporation, the movant must demonstrate through an affidavit or other evidence that the high-level official has no direct knowledge of the relevant facts or that there are other persons with equal or greater knowledge of the relevant facts. [Note 7.]

If the movant meets this initial burden, then the burden shifts to the party seeking the deposition to show that the official has unique or superior personal knowledge of relevant facts. [Note 8.] If the party seeking the deposition does not satisfy this showing, then the Board will grant the motion for protective order and require the party seeking the deposition to attempt to obtain discovery through less intrusive methods. [Note 9.] Depending upon the circumstances of the case, these methods should include the depositions of lower-level employees, Fed. R. Civ. P. 30(b)(6) depositions, requests for admissions, or interrogatories and requests for production of documents directed to the corporation. [Note 10.]

If, after making a good faith effort to utilize less intrusive methods of discovery, the party is unable to obtain the information it seeks, a party may file a motion to vacate or modify the protective order. Such a motion should include a showing (1) that there is a reasonable indication that the high-level official’s deposition may or will lead to the discovery of admissible evidence, and (2) that the less intrusive methods of discovery are unsatisfactory, insufficient or inadequate. [Note 11.] In granting the motion to vacate or modify the protective order, the Board may limit the topics and duration of the deposition. [Note 12.]

A party moving for a protective order to delay, limit or prevent a deposition on the basis of medical grounds or health concerns has the burden of making a specific and documented factual showing. [Note 13.]

A party opposing a motion for protective order with respect to taking the deposition of a non-testifying or consulting expert on notice alone has the burden of establishing exceptional circumstances. [Note 14.]

Please Note: The Board has no jurisdiction over depositions by subpoena, and in such a case, a motion for protective relief would be filed in the district court for which the subpoena issued and not with the Board.

NOTES:

1. Fed. R. Civ. P. 26(c)(1); 37 C.F.R. § 2.120(g); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1674 (TTAB 2005); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761-62 (TTAB 1999).

2. Fed. R. Civ. P. 26(c)(1); 37 C.F.R. § 2.120(g).

3. *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2152 (TTAB 2013) (citing *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999)).

4. 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2037 (3d ed. 2020).

5. *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1675 (TTAB 2005).

6. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1762 (TTAB 1999).

7. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1763 (TTAB 1999).

8. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1763 (TTAB 1999).

9. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1763 (TTAB 1999).

10. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1763 (TTAB 1999).

11. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1763 (TTAB 1999).

12. *Cf. Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1677 (TTAB 2005) (denying a motion for protective order that depositions not be had with regard to certain individuals but limiting the depositions to three hours in duration and to one particular topic).

13. 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2037 (3d ed. 2020) and cases cited therein.

14. Fed. R. Civ. P. 26(b)(4)(D)(ii); *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1568 (TTAB 2014) (motion to take deposition of consulting expert denied because opposer did not establish exceptional circumstances).

412.06(b) Other Discovery

Except in those cases where it is readily apparent that propounded discovery requests are so oppressive as to constitute clear harassment, it is generally improper to respond to a request for discovery by filing a motion for protective order. [Note 1.] *See*TBMP § 405 and TBMP § 406, for proper responses to discovery and TBMP § 412 and TBMP § 526 regarding motions for protective orders. It is also improper to move for a protective order for the purpose of delaying responses to discovery or for purposes of harassment of one's adversary. [Note 2.] The remedy for excessive interrogatories, requests for production, or requests for admissions is service of a general objection, rather than a motion for protective order. [Note 3.] For more information regarding excessive discovery depositions, see TBMP §404.01; for excessive interrogatories, see TBMP § 405.03; for excessive requests for production, see TBMP § 406.05; for excessive requests for admissions, see TBMP § 407.05.

Where appropriate, the Board may under Fed. R. Civ. P. Rule 26(c)(1) order that the discovery requested not be had with regard to interrogatories, requests for production, or requests for admission. [Note 4.] The Board must determine whether there is a need for protection against a particular interrogatory or request for admission or production of a particular document or category of documents due to their nature that renders them harassing and oppressive. [Note 5.] The parties are expected to take into account the principles of proportionality with regard to discovery depositions such that the number of depositions sought is proportional to the needs of the case and truly necessary [Note 6], and also with respect to interrogatory requests, document requests, and requests for admission such that the requests are not rendered harassing and oppressive. [Note 7.] The parties are expected to consider the scope of the requests as well as confer in good faith about the proper scope of discovery pursuant to 37 C.F.R. § 2.120(a) and Fed. R. Civ. P. 26(f) so as to minimize the need for these motions. *See*TBMP § 402 and TBMP § 408 regarding the scope of discovery, the parties' discovery conference obligations and the duty to cooperate.

NOTES:

1. *Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385, 1387 (TTAB 2016); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984).

2. *Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016); *Fort Howard Paper Co. v. G.V. Gambina Inc.*, 4 USPQ2d 1552, 1553 (TTAB 1987).

3. 37 C.F.R. § 2.120(d); 37 C.F.R. § 2.120(e); 37 C.F.R. § 2.120(i).

4. *See, e.g., Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (granting protective order, based in part on many of the requests not appropriately tailored to elicit discoverable information); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013) (granting protective order with regard to 94 duplicative requests for admissions and those that sought admissions as to unpleaded registrations); Fed. R. Civ. P. 36 Notes of Advisory Committee on Rules – 1970 Amendment ("requests to admit may be ... framed that the answering party finds the task of identifying what is in dispute and what is not unduly burdensome. If so, the responding party may obtain a protective order under Rule 26(c)"). *Cf. Spliethoff's Bevrachtingskantoor B.V. v. United Yacht Transport LLC dba United Yacht Transport*, 2020 USPQ2d 10605, at *9 (TTAB 2020) (after considering whether movant made "particularized showing" of why the requested discovery is necessary, motion for leave to exceed deposition limit denied).

5. *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (when only one registration was at issue in cancellation, granting protective order, based in part on requests not being properly tailored to claims

before the Board); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013) (granting protective order with regard to duplicative requests for admissions and those that sought admissions as to unpleaded registrations but denying protective order with regard to requests for admissions that were relevant to allegations and claims as pleaded, where opposer made broad claims of ownership of twenty-six registered and common law marks in its notice of opposition, and applicant's admission requests related only to fourteen of opposer's pleaded marks); *Weatherford/Lamb Inc. v. C&J Energy Services, Inc.*, 96 USPQ2d 1834, 1836 n.3 (TTAB 2010) (noting that during discovery and prior to service of petitioner's discovery responses, the Board granted motion for protective order that petitioner need only produce limited or representative samples of responsive documents); *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1613 (TTAB 1991) (granting motion for protective order with respect to discovery relating to foreign activities; denying motion for protective order with respect to applicant's use in commerce in U.S.); *Fort Howard Paper Co. v. G.V. Gambina Inc.*, 4 USPQ2d 1552, 1554 (TTAB 1987) (denying motion for protective order with respect to nineteen discovery requests which were suitably tailored to the issues in the opposition); *C. H. Stuart Inc. v. S.S. Sarna, Inc.*, 212 USPQ 386, 387 (TTAB 1980) (granting protective order due to oppressive and harassing discovery requests where the requests served were "boiler-plate" requests designed for use in an infringement action, discovery was not tailored to issues in Board proceeding, and requests sought included those seeking information regarding whether officers of applicant had been convicted of a crime or subject to a proceeding before the U.S. government). *See also Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (protective order granted where obligation to respond to discovery requests rested with assignee nor assignor).

6. *Spliethoff's Bevrachtingskantoor B.V. v. United Yacht Transport LLC dba United Yacht Transport*, 2020 USPQ2d 10605, at *3 (TTAB 2020) ("Before noticing any deposition, a party should assess whether it would be proportional to the needs of the case and truly necessary, taking into account the time and expense involved for even one deposition.").

7. 37 C.F.R. § 2.120(a)(1); *Wisconsin Cheese Group, LLC v. Comercializadora de Lacteos y Derivados S.A. de C.V.*, 118 USPQ2d 1262, 1267 n.10 (TTAB 2016) ("The Board has applied the principle of proportionality to define the proper subjects of and expanse of inquiry in inter partes proceedings under various circumstances."); *Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1386 (TTAB 2016) (the Board expects parties to take into account the principles of proportionality); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951, 69970 (October 7, 2016).

413 Telephone and Pretrial Conferences

413.01 Telephone Conferences for Motions Relating to Discovery

37 C.F.R. § 2.120(j)(1) *Whenever it appears to the Trademark Trial and Appeal Board that a stipulation or motion filed in an inter partes proceeding is of such nature that a telephone conference would be beneficial, the Board may, upon its own initiative or upon request made by one or both of the parties, schedule a telephone conference.*

37 C.F.R. § 2.127(a) . . . *Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within twenty days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board.* * * * *

When beneficial, a motion or stipulation relating to discovery may be resolved by telephone conference involving the parties and/or their attorneys and a Board attorney or judge. [Note 1.] Motions relating to discovery include, but are not limited to, motions to compel, motions to quash, and motions for protective orders. Telephone conferences with regard to discovery motions allow for expedient resolution of disputes and encourage greater cooperation amongst the parties by requiring the parties to discuss with a Board professional the issues in dispute. In appropriate cases, the Board may indicate that the filing of a responsive brief to a motion is not necessary since the non-moving party will have an opportunity to present its arguments during the telephone conference. [Note 2.] The Board may in its discretion also require the parties to contact the attorney assigned to a case prior to filing any motion relating to discovery, and the Board attorney may hold a conference to determine whether filing of a motion is warranted. [Note 3.]

The telephone conference procedure is not limited to motions or stipulations relating to discovery. A telephone conference may be sought by a party or initiated by a Board professional under any circumstances where a telephone conference would be beneficial, and a Board professional may sua sponte participate in the parties' discovery conference if it would be useful. [Note 4.] Phone conferences are not to be recorded. [Note 5.] For more information concerning the conduct and arrangement of telephone conferences, see TBMP § 502.06.

NOTES:

1. 37 C.F.R. § 2.120(j). *See, e.g., Weatherford/Lamb Inc. v. C &J Energy Services, Inc.*, 96 USPQ2d 1834, 1836 n.3 (TTAB 2010) (motion for protective order decided by teleconference); *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d1175, 1177 (TTAB 2010) (motion to compel decided by teleconference).

2. *See* 37 C.F.R. § 2.127(a). *See e.g., Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1177 n.7 (TTAB 2010).

3. *See* 37 C.F.R. § 2.120(j). *See also International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1603 n.24 (TTAB 2002) (party prohibited from filing further motions to compel without first obtaining Board permission).

4. *See* 37 C.F.R. § 2.120(a)(2)(i); 37 C.F.R. § 2.120(j); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951 (October 7, 2016).

5. 37 C.F.R. § 2.120(j)(3).

413.02 Pretrial Conferences

37 C.F.R. § 2.120(j)(2) *Whenever it appears to the Trademark Trial and Appeal Board that questions or issues arising during the interlocutory phase of an inter partes proceeding have become so complex that their resolution by correspondence or telephone conference is not practical and that resolution would likely be facilitated by a conference in person of the parties or their attorneys with an Administrative Trademark Judge or an Interlocutory Attorney of the Board, the Board may, upon its own initiative, direct that the parties and/or their attorneys meet with the Board for a disclosure, discovery or pretrial conference on such terms as the Board may order.*

While rarely utilized, the Board has the discretion to order the parties to meet in person at the Board's offices or by video conference to resolve complex disputes surrounding disclosures and discovery for a pretrial conference. [Note 1.] The rule is limited to exercise only by the Board, upon the Board's initiative. [Note

2.] Conferences are not to be recorded. [Note 3.] For further information concerning pretrial conferences, see TBMP § 502.06(b).

NOTES:

1. *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1634 (TTAB 2011) (Board exercised its authority under 37 C.F.R. § 2.120(i)(2), effective January 14, 2017 redesignated by amendment to 37 C.F.R. § 2.120(j)(2), and ordered the parties to appear in person at the office of the Board); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.5 (TTAB 2011) ("where the Board identifies overly contentious advocacy or the potential for the creation of excessive records, it may in the future exercise its authority under Trademark Rule 2.120(j)(2) to order a pretrial conference in person at the office of the Board"), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Amazon v. Wax*, 95 USPQ2d 1865, 1869 (TTAB 2010) ("under Trademark Rule 2.120(j)(2), where resolution of discovery or other interlocutory issues 'would likely be facilitated by a conference in person of the parties or their attorneys,' the Board may 'request that the parties or their attorneys … meet with the Board at its offices' for a conference. If the parties remain unwilling or unable to work together cooperatively and efficiently, the Board will not hesitate to invoke this Rule in the future.").

2. 37 C.F.R. § 2.120(j)(2); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951 (October 7, 2016).

3. 37 C.F.R. § 2.120(j)(3).

414 Selected Discovery Guidelines

Fed. R. Civ. P. 26(b) Discovery Scope and Limits.

(1) ***Scope in General.*** *Unless otherwise limited by court order, the scope of discovery is as follows: Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit. Information within this scope of discovery need not be admissible in evidence to be discoverable.*

37 C.F.R. § 2.120 ***Discovery.***

(a) ***In general.*** *(1) Except as otherwise provided in this section, and wherever appropriate, the provisions of the Federal Rules of Civil Procedure relating to disclosure and discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings. The provisions of Rule 26 of the Federal Rules of Civil Procedure relating to required disclosures, the conference of the parties to discuss settlement and to develop a disclosure and discovery plan, the scope, proportionality, timing and sequence of discovery, protective orders, signing of disclosures and discovery responses, and supplementation of disclosures and discovery responses, are applicable to Board proceedings in modified form, as noted in these rules and as may be detailed in any order instituting an inter partes proceeding or subsequent scheduling order.* * * * *

Listed below are a variety of discovery determinations, with case citations, relating to the discoverability of various matters in Board inter partes proceedings. This list is illustrative, not exhaustive.

(1) The identification of discovery documents (as opposed to their substance) is not privileged or confidential. [Note 1.]

(2) In those cases where complete compliance with a particular request for discovery would be unduly burdensome, the Board, upon motion, may permit the responding party to comply by providing a representative sampling of the information sought, or some other reduced amount of information which is nevertheless sufficient to meet the propounding party's discovery needs. [Note 2.]

(3) The classes of customers for a party's involved goods or services are discoverable. In contrast, the names of customers (including dealers) constitute confidential information, and generally are not discoverable, even under protective order. [Note 3.] However, the name of the first customer for a party's involved goods or services sold under its involved mark, and, if there is a question of abandonment, the names of a minimal number of customers for the period in question, may be discoverable under protective order. [Note 4.]

(4) Information concerning a party's selection and adoption of its involved mark is generally discoverable (particularly of a defendant). [Note 5.]

(5) Information concerning a party's first use of its involved mark is discoverable. [Note 6.]

(6) Search reports are discoverable, but the comments or opinions of attorneys relating thereto are privileged and not discoverable (unless the privilege is waived). [Note 7.]

(7) A party is required, in its pretrial disclosures, to name the witnesses it expects will testify, or may testify if the need arises, by oral testimony or affidavit and must provide general identifying information about the witness(es), as well as the witness(es)' telephone number and address. [Note 8.] In addition, a party must provide a general summary or list of subjects about which the witness(es) are expected to testify and a general summary or list of documents and things that may be introduced during the testimony of the witness(es). [Note 9.] If a party expects to call no witnesses during its assigned testimony period, it must so state in its pretrial disclosures. [Note 10.] Consequently, the identity of such witnesses is discoverable. [Note 11.] Such witnesses may have been named in a party's initial or supplemental initial disclosures, but a party is not required to supplement or correct its initial disclosures to provide identifying information about a witness listed in pretrial disclosures if that information previously has been made known to the other party in writing or during the discovery process. [Note 12.] *See* TBMP § 408.03. The January 14, 2017 amendments to the Board's rules of practice are applicable to the few remaining pending proceedings that were commenced prior to November 1, 2007. [Note 13.] A party is not required, in advance of trial, to disclose each document or other exhibit it plans to introduce. [Note 14].

(8) A party's plans for expansion may be discoverable under protective order. [Note 15.]

(9) Information concerning a party's awareness of third-party use and/or registration of the same or similar marks for the same or closely related goods or services as an involved mark, is discoverable to the extent that the responding party has actual knowledge thereof (without performing an investigation) and that the information appears to be reasonably calculated to lead to the discovery of admissible evidence. [Note 16.]

(10) Information concerning litigation and controversies including settlement and other contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable. [Note 17.] However, the only information which must be provided with respect to a legal proceeding is the names of the parties thereto, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision (if published). [Note 18.]

(11) A party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto. However, the information that a party sells the same goods or services as the propounding party, even if under a different mark, is relevant to the issue of likelihood of confusion for purposes of establishing the relationship between the goods or services of the parties. [Note 19.]

(12) The names and addresses of a party's officers are discoverable. However, if a party has a large number of officers, it need only provide the names and addresses of those officers most knowledgeable of its involved activities. [Note 20.]

(13) Although information concerning a party's foreign use of its involved mark is usually irrelevant to the issues in a Board proceeding, and thus not discoverable, exceptions may arise where, for example, there is an issue as to whether a party's adoption and use of the mark in the United States was made in bad faith for the purpose of forestalling a foreign user's expansion into the United States, or where the foreign mark is "famous," albeit not used, in the United States. [Note 21.]

(14) Generally, the names and addresses of the stockholders of a corporate party or other entities owned or controlled by the party are irrelevant, and not discoverable, unless there is a question as to whether that party and another entity are "related companies" within the meaning of Trademark Act § 5, 15 U.S.C. § 1055. [Note 22.]

(15) The locations of those places of business where a party manufactures its involved goods, or conducts its involved services, under its involved mark, are discoverable. [Note 23.]

(16) Information relating to the areas of distribution for a party's involved goods or services sold under its involved mark is discoverable. [Note 24.]

(17) The identity of any advertising agency engaged by a party to advertise and promote the party's involved goods or services under its involved mark is discoverable, as is the identity of the advertising agency employees having the most knowledge of such advertising and promotion. [Note 25.]

(18) Annual sales and advertising figures, stated in round numbers, for a party's involved goods or services sold under its involved mark are proper matters for discovery; if a responding party considers such information to be confidential, disclosure may be made under protective order. [Note 26.]

(19) Information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's involved mark, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable. [Note 27.]

(20) Information concerning the technical expertise of the purchasers of a party's products is relevant to the issue of likelihood of confusion, and is discoverable. [Note 28.]

(21) A request for discovery is not necessarily objectionable merely because it requires a party or a witness to give an opinion or contention that relates to fact or the application of law to fact. [Note 29.]

(22) The mere taking of discovery on matters concerning the validity of a pleaded registration, under any circumstances, is not objectionable on the basis that it constitutes a collateral attack on the registration. [Note 30.]

(23) Where it is asserted that the mark or term is generic, or merely descriptive and without acquired distinctiveness, the following categories of information and documents are discoverable: 1) those assessing, evaluating, or considering any methods of describing the "product category"; 2) those relating to the decision to offer the product at issue to the extent such information and documents refer to the "product category" or any marks used or considered for use containing the purportedly generic term; 3) those assessing, evaluating, or considering how to categorize, describe or define the product; 4) those reflecting any consumer views or comments about the product offered. [Note 31.]

(24) Where it is asserted that the mark or term is generic, or merely descriptive and without acquired distinctiveness, information and documents relating to the choice of a particular product name need not be provided unless that name includes the term at issue. [Note 32.]

(25) A party may take discovery as to matters relevant to the claims or defenses raised in the pleadings. [Note 33.] However, parties are expected to take into account the principles of proportionality with regard to discovery. [Note 34.] In addition, a party need not provide its legal research and information regarding its legal strategies. [Note 35.]

(26) Fed. R. Civ. P. 34 does not inherently require production of metadata where neither party has specified the form in which discovery will be provided, or where metadata has not been requested. [Note 36.]

NOTES:

1. *See Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975) (fact that client received legal opinions and identity of documents related thereto, not privileged); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975) (objection to interrogatories on ground of privilege or under Fed. R. Civ. P. 26(b)(3), i.e., material prepared in anticipation of trial, not well taken).

2. *See, e.g., Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1267 (TTAB 2015) (for purposes of that cancellation proceeding, any representative sampling ought to correspond to dates necessary to prove Petitioner's claims); *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1910 (TTAB 2011) (where hundreds of thousands of dollars spent, and tens of thousands of documents produced, opposer required to produce only a representative sample with respect to the specific requests at issue); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720-21 (TTAB 1987) (production of representative sample not appropriate where full production, that is, a total of eleven documents, was clearly not burdensome); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 (TTAB 1985) (allowed to provide representative samples of invoices from each calendar quarter); *J.B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 579-80 (TTAB 1975) (opposer need not identify dollar value and number of units of product held in inventory but may indicate only whether it does in fact carry such products in stock); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 689-90 (TTAB 1975) (sales and advertising figures for six different categories of goods since 1936 limited to five-year period and a statement that there have been sales for the other years); *Van Dyk Research Corp. v. Xerox Corp.*, 181 USPQ 346, 348 (TTAB 1974) (production limited to ten representative samples of documents pertaining to selection of each type of copy machine); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 288 (TTAB 1974) (representative samples of advertisements permitted). *Compare British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (if opposers believed the limited information provided by applicant in response to interrogatories was insufficient and that applicant's objections on grounds that the interrogatories were unduly broad, burdensome, etc., were unfounded, opposers could have moved to compel more complete responses), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *The Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468, 471 (TTAB 1976) (if applicant believed documents produced by opposer were not truly representative, applicant could have filed motion to compel).

3. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (need not reveal names of customers including dealers).

4. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 (TTAB 1985) (need for customer names does not outweigh possible harm, such as harassment of customers); *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 169 (TTAB 1980) (possible harm outweighed where issue is abandonment); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (name and address of first customer may be revealed to verify date of first use); *J.B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 580 (TTAB 1975) (must identify class of customers who purchase products under mark, but not names of customers). *See also Ortho Pharmaceutical Corp. v. Schattner*, 184 USPQ 556, 557 (TTAB 1975); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495 (TTAB 1975); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618, 621 (TTAB 1974); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123-24 (TTAB 1974).

5. *See Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (must identify knowledgeable employees); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975) (whether applicant received opinions concerning adoption of mark is not privileged and applicant must identify person, date and documents relating thereto); *Volkswagenwerk AG v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974) (identification of persons who suggested use of involved mark on involved goods is not improper). *Cf. Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 190 (TTAB 1974) (applicant's request for writings relating to selection of mark to show what third parties' marks may have been considered and extent to which opposer believed its mark conflicted therewith not permitted).

6. *See, e.g., Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 195-96 (TTAB 1976) (dates petitioner's plants first began production of goods bearing mark are pertinent to claim of priority); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495, 496 (TTAB 1975) (must provide name, address and affiliation of persons to whom service was first rendered). *See also Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1613 (TTAB 1991) (use or intended use of applicant's mark in commerce with U.S. is relevant).

7. *See Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170 (TTAB 1980); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975) (fact that an opinion concerning trademark validity or possible conflicts regarding applicant's adoption and use of mark was given to applicant is not privileged); *Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432, 434 (TTAB 1975); *Amerace Corp. v. USM Corp.*, 183 USPQ 506, 507 (TTAB 1974) (attorney comments on search report or prosecution of application are privileged).

8. 37 C.F.R. § 2.121(e).

9. 37 C.F.R. § 2.121(e).

10. 37 C.F.R. § 2.121(e).

11. *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1179 (TTAB 2010) (if opposer serves revised pretrial disclosures naming witness, discovery reopened for applicant only for the limited purpose of allowing applicant to take named witness' discovery deposition).

12. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245-46 (August 1, 2007). *See Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009) (opposer's failure to supplement its initial disclosures to identify foreign non-party witness as a potential witness does not preclude introduction of witness' discovery deposition at trial, even though opposer should have supplemented initial disclosures, because applicant was aware of witness' identity and subject matter of her testimony and was able to cross-examine the witness during the discovery phase).

13. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69954 (October 7, 2016) (Final Rule) and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 19296 (April 4, 2016) (Proposed Rule).

14. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1267 (TTAB 2015) (a responding party need not provide information regarding its legal research and legal

strategies); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002) (interrogatory requesting that opposer "identify each and every fact, document [] in support of its pleaded allegations" was equivalent to a request for identification of [] trial evidence prior to trial, and therefore improper); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (need not disclose entirety of proposed evidence), *aff'd*, *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994).

15. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (opposer's intent to expand business to include manufactured products similar to applicant's is relevant).

16. *See Sheetz of Delaware, Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1348 (TTAB 2013) (a party need not investigate third-party use to respond to discovery requests); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071-72 (TTAB 2011) (a party has no duty to conduct an investigation of third-party uses in response to discovery requests); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1788 (TTAB 2001) (no obligation to search for third-party uses); *Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1864 (TTAB 2001) (investigation not necessary); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (need not investigate); *American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979) (relevant to show mark is weak). *See also Domino's Pizza Inc. v. Little Caesar Enterprises Inc.*, 7 USPQ2d 1359, 1363 n.9 (TTAB 1988) (relevant to show purchaser perception of the marks).

17. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (licensing agreements and arrangements between opposer and third parties and amount of sales thereto are relevant); *American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979) (relevant to show admissions against interest, limitations on rights in mark, course of conduct leading to abandonment, that the mark has been carefully policed, etc.); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 197 (TTAB 1976) (settlement agreements that have avoided litigation may show limitations on party's rights in mark or reveal inconsistent statements); *J.B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 580-81 (TTAB 1975) (identity of all civil and USPTO proceedings involving mark is not objectionable); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975) (contacts with third parties, such as through litigation or agreements, based on pleaded mark for involved goods, are relevant).

18. *See Interbank Card Association v. United States National Bank of Oregon*, 197 USPQ 127, 128 (TTAB 1975) (need not reveal reasons for dismissal of prior opposition against third party); and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975) (need not identify all documents pertaining to such litigation).

19. *See TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990) (where goods of parties differ, determining whether parties market goods of same type is relevant to establishing relationship between goods); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (questions concerning specific goods on which opposer uses mark are proper to extent scope of inquiry is limited to those goods identified in application, or involve goods of type marketed by applicant, or mentioned by opposer during discovery); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 n.2 (TTAB 1985) (information regarding goods other than those in involved application and registration is irrelevant); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 584 (TTAB 1975); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 190 (TTAB 1979) (applicant's use of mark on goods other than those in application irrelevant); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB

1974) (interrogatory too broad, requiring identity of products having no relevance to opposition); *Volkswagenwerk AAG v. Thermo-Chem Corp.*, 176 USPQ 493, 493 (TTAB 1973) (applicant need not provide information as to its other marks or its other products, or as to whether involved mark is used on other products). *See also Wella Corp. v. California Concept Corp.*, 192 USPQ 158, 163 (TTAB 1976) (although the goods are not the same, they are of the type often made by the same manufacturer), *rev'd on other grounds*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977); *Sterling Drug Inc. v. Sebring*, 515 F.2d 1128, 185 USPQ 649, 652 (CCPA 1975) (in the absence of any showing that manufacturers never use same mark on the two involved classes of goods, the fact that the goods are often made by the same manufacturer, even if under different marks, may be relevant).

20. *See J.B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 580 (TTAB 1975) (may identify reasonable number of those most knowledgeable of adoption, selection or day-to-day uses of mark); *Volkswagenwerk AG v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974) (identification of vice-president as most familiar with use held sufficient). *Cf. Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1243 n.10 (TTAB 2012) (plaintiff not faulted for not originally identifying witness in response to an interrogatory because it is unclear from witness' title whether she was an "officer or managing agent," which was the information sought by discovery request).

21. For general rule, see *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991); *Johnson & Johnson v. Salve S.A.*, 183 USPQ 375, 376 (TTAB 1974) (foreign use of mark creates no rights in mark in U.S.). *See also Oland's Breweries [1971] Ltd. v. Miller Brewing Co.*, 189 USPQ 481, 489 n.2 (TTAB 1975) (use or promotion of a mark confined to a foreign country, including Canada, is immaterial to ownership and registration in U.S.), *aff'd, Miller Brewing Co. v. Oland's Breweries*, 548 F.2d 349, 192 USPQ 266 (CCPA 1976). Concerning possible exceptions, see Article 6 *bis* of the Paris Convention; *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1480 (Fed. Cir. 1990) (knowledge of foreign use, in itself, does not preclude good faith adoption and use in U.S.); *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991); *Mastic Inc. v. Mastic Corp.*, 230 USPQ 699, 702 (TTAB 1986) (in view of applicant's knowledge of opposer's claim to mark in foreign countries and of opposer's intention to enter U.S. market, it appears that applicant intended to preclude opposer from entering U.S. market); *Adolphe Lafont, S.A. v. S.A.C.S.E. Societa Azioni Confezioni Sportive Ellera, S.p.A.*, 228 USPQ 589, 595 (TTAB 1985) (presale publicity including providing clothing with mark to competitive skiers insufficient to popularize mark as identifying source to U.S. purchasers and to create priority rights in the U.S.); *Davidoff Extension S.A. v. Davidoff International, Inc.*, 221 USPQ 465, 468 (S.D. Fla. 1983) (foreign corporation with U.S. registration based on foreign registration had rights in mark superior to individual who attempted to use the name in the U.S.); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 77-78 (TTAB 1983) (prior use and advertising in connection with goods marketed in foreign country, whether advertising occurs inside or outside U.S., creates no prior rights in U.S. against one who adopts similar mark prior to foreigner's first use on goods sold in U.S., unless foreign party's mark was famous); *All England Lawn Tennis Club, Ltd. v. Creations Aromatiques, Inc.*, 220 USPQ 1069, 1072 (TTAB 1983) (opposer acquired rights to famous mark in U.S. for competitions held in England prior to adoption of mark by applicant for any goods/services); *Canovas v. Venezia 80 S.R.L.*, 220 USPQ 660, 662 (TTAB 1983) (claim of fame in France and existence of pending U.S. application based on foreign registration insufficient to establish that fame extended to U.S.). *See also Mother's Restaurants, Inc. v. Mother's Other Kitchen, Inc.*, 218 USPQ 1046, 1048 (TTAB 1983); *Johnson & Johnson v. Diaz*, 339 F. Supp. 60, 172 USPQ 35, 37 (C.D. Cal. 1971).

22. *See Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (irrelevant unless the other company has used the mark); *Volkswagenwerk AG v. MTD Products Inc.*, 181 USPQ 471, 472

(TTAB 1974) (no bearing on right to register); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974).

23. *See Varian Associates v. Fairfield-Noble Corp., Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (locations of "all places of business" overly broad); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974).

24. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (relevant areas of inquiry include number of salesmen, locations of sales representatives who market goods bearing the mark, and geographic location of dealers who market and distribute the products under the mark); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 196 (TTAB 1976) (petitioner was required to list all states to which its goods were shipped prior to respondent's claimed first use date and to identify persons who would be knowledgeable about such matters); *J.B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 580 (TTAB 1975) (information regarding geographic areas of distribution of goods is relevant to questions of likelihood of confusion and abandonment); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495, 495 (TTAB 1975) (year by year, state by state break down of numbers of magazines distributed is proper); *Volkswagenwerk AG v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974).

25. *See J.B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 580 (TTAB 1975) (may lead to relevant information concerning circumstances surrounding selection of mark, distinctiveness of mark).

26. *See Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 (TTAB 1985) (relevant to issues of likelihood of confusion and abandonment; response that these figures have been "substantial" is insufficient); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (sales and advertising expenditures have bearing on registrability); *J. B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 579 (TTAB 1975) (relevant to issue of abandonment); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (allowed to provide figures for each of last five years and a statement that there have been sales for the other years); *Volkswagenwerk AG v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974) (money expended in advertising to be confined to goods in application); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123 (TTAB 1974) (required to furnish round figures concerning sales under mark for period of five years as well as advertising expenditures relating thereto). *See also Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1267 (TTAB 2015) (while annual sales and advertising figures, stated in round numbers, for a party's involved goods are proper matters for discovery, indiscriminate requests for financial data, information and documents that offer nothing to further the claims before the Board (e.g., current stock price, projected income for next five years) are not appropriately tailored to the claims in that opposition proceeding and are thus undiscoverable).

27. *See Volkswagenwerk AG v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974) (applicant's knowledge of use by opposer or by the public or the trade, is relevant); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123 (TTAB 1974) (applicant required to go through its files to determine when it acquired actual knowledge of opposer's marks).

28. *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (the sophistication of purchasers a factor in assessing the likelihood of confusion).

29. *See* Fed. R. Civ. P. 33(a)(2); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671,1676 (TTAB 1988); *Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313, 314 (TTAB 1973) (question of whether opposer believes marks to be confusingly similar is relevant).

30. *See Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975) (party is entitled to take discovery to determine whether grounds exist for any affirmative defenses or counterclaims); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974).

31. *See Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1910 (TTAB 2011). *See also Converse, Inc. v. ITC*, 909 F.3d 1110, 128 USPQ2d 1538, 1547 (Fed. Cir. 2018) ("While section 2(f) cannot be read as limiting the inquiry to the five years before the relevant date, it can and should be read as suggesting that this period is the most relevant."); *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1730 (Fed. Cir. 2012) ("Acquired distinctiveness and buyer recognition is to be tested in an opposition proceeding as of the date the issue is under consideration.").

32. *See Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1911 (TTAB 2011).

33. *Mack Trucks, Inc. v. Monroe Auto Equip. Co.*, 181 USPQ 286, 287 (TTAB 1974) (opposer must answer interrogatories concerning allegations in notice of opposition).

34. *See* 37 C.F.R. § 2.120(a)(1); *Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1386 (TTAB 2016) (Board expects parties to take into account the principles of proportionality with regard to discovery); *Wisconsin Cheese Group, LLC v. Comercializadora de Lacteos y Derivados S.A. de C.V.*, 118 USPQ2d 1262, 1267 n.10 (TTAB 2016) ("The Board has applied the principle of proportionality to define the proper subjects of and expanse of inquiry in inter partes proceedings under various circumstances."); *Domond v.37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (Board applied proportionality principle to interrogatories, document requests and requests for admission); *The Phillies v. Philadelphia Consolidated Holding Corp.*,107 USPQ2d 2149, 2153 (TTAB 2013) (discussing principles of proportionality with respect to requests for admissions); *Frito-Lay N. Am. Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1908-10 (TTAB 2011) (Board applied proportionality principles to electronically-stored information).

35. *See Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1267 (TTAB 2015).

36. *Chix Gear, LLC v. Princess Race Wear Corp*., 2019 USPQ2d 455321, at *3 (TTAB 2019).

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501 Stipulations

501.01 In General

Subject to the approval of the Board, parties may stipulate to a wide variety of matters. For example, parties may stipulate: that times be extended or reopened; that the total number of interrogatories or requests for production that one party may serve upon another party in a proceeding may be reduced from the limitation specified in 37 C.F.R. § 2.120(d) or 37 C.F.R. § 2.120(e); that the production of documents and things under the provisions of Fed. R. Civ. P. 34 may be made in a specified place and/or manner [Note 1.]; that protective agreements or provisions different from or in substitution for the Board's standard protective order be used; that the parties agree to the substance or the form of the facts or testimony in the case [Note 2.]; that a deposition may be taken at a particular place, or in a certain manner [Note 3.]; that the proceeding shall be ended in a specified way; or that the proceeding be determined by pretrial disposition on the merits or abbreviated trial on the merits by means of Accelerated Case Resolution (ACR). [Note 4.] *See*TBMP § 403.04 (Extensions of Discovery Period, Time to Respond to Discovery Requests, and Disclosures), TBMP § 412.02 (Modification of Board's Standard Protective Order Upon Stipulation), TBMP § 528.05(a)(2) (Accelerated Case Resolution (ACR)), and TBMP § 605.03 (Settlement Agreements), TBMP § 702.04 (Accelerated Case Resolution), TBMP § 702.04(e) (Utilizing Stipulations in Non-ACR cases), and TBMP § 705 (Stipulated Evidence and Accelerated Case Resolution).

NOTES:

1. 37 C.F.R. § 2.120(e).

2. 37 C.F.R. § 2.123(b). *See, e.g., Board of Regents, University of Texas System v. Southern Illinois Miners LLC*, 110 USPQ2d 1182, 1186 (TTAB 2014) (stipulation to the admission and use of produced documents and waiver of objections based on authenticity or hearsay); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1426 (TTAB 2014) (stipulation to the authenticity of certain documents, retail prices of opposers' goods, the fact that advertisements and news articles refer to opposers, and press clippings are representative of the media in which opposers advertise); *Inter IKEA Systems B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1738 (TTAB 2014) (parties filed joint stipulation that all documents produced in response to a request for production of documents were deemed authentic business records and were admissible subject to any objections other than authenticity); *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (the parties stipulated to the entire record, including business records, public records, marketing materials, Internet materials, and 13 paragraphs of facts, while reserving the right to object to such facts and documents on the bases of relevance, materiality and weight).

3. 37 C.F.R. § 2.123(b).

4. *See, e.g., Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913, 1916 (TTAB 2015) (parties filed ACR stipulation, agreed to forego discovery, waived disclosures, stipulated to facts and attached documents, filed briefs with additional evidence); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 (TTAB 2014) , *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016) (parties' stipulation under ACR provided limitations on discovery, excluded filing of motions for summary judgment and use of expert testimony, streamlined methods for introduction of evidence during trial, stipulated to fact regarding no actual confusion); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d

1949, 1950 (TTAB 2014) (after suggestion by Board in order denying motion for summary judgment, parties stipulated to forego trial and rely on evidence submitted in support of the motions for summary judgment, supplemented by expert declarations, trial briefs and an oral hearing), *vacated on other grounds and remanded*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015); *Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775-76 (TTAB 2013) (approving parties' stipulation to proceed via ACR).

501.02 Filing Stipulations

37 C.F.R. § 2.120(a)(2) ***[Discovery]*** …

(iv) *The parties may stipulate to a shortening of the discovery period, that there will be no discovery, that the number of discovery requests or depositions be limited, or that reciprocal disclosures be used in place of discovery. Limited extensions of the discovery period may be granted upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board... Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board, but the expert disclosure deadline must always be scheduled prior to the close of discovery. ..*

(v) *The parties are not required to prepare or transmit to the Board a written report outlining their discovery conference discussions, unless the parties have agreed to alter disclosure or discovery obligations set forth by these rules or applicable Federal Rules of Civil Procedure, or unless directed to file such a report by a participating Board Interlocutory Attorney or Administrative Trademark Judge.*

37 C.F.R. § 2.120(a)(3) ***[Discovery]*** *A party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board, or by order of the Board. ...*

37 C.F.R. § 2.121(d) ***[Assignment of times for taking testimony and presenting evidence.]*** *When parties stipulate to the rescheduling of a deadline for pretrial disclosures and subsequent testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of subsequent deadlines for pretrial disclosures and testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, shall be submitted to the Board through ESTTA, with the relevant dates set forth and an express statement that all parties agree to the new dates.*

Stipulations that require action or consideration by the Board must be filed with the Board. For example, the following must be filed with the Board: stipulations to extend a defendant's time to file an answer to the complaint; stipulations to alter the length of the discovery period or disclosure obligations occurring during the discovery period; stipulations to waive required initial disclosures; stipulations to reschedule pretrial disclosures and subsequent trial dates; stipulations to extend trial dates; stipulations relating to the form of testimony; stipulations to end a proceeding in a specified way; stipulations to pretrial disposition on the merits or abbreviated trial on the merits by means of Accelerated Case Resolution (ACR). [Note 1.] Some other types of stipulations, such as stipulations to extend a party's time for responding to a request for discovery, do not necessarily have to be filed with the Board. However, even in the case of a stipulation that does not have to be filed, the better practice is to reduce the stipulation to writing, in order to avoid any misunderstanding between the parties as to the existence and terms thereof.

NOTES:

1. 37 C.F.R. § 2.120(a)(2)(iv); 37 C.F.R. § 2.120(a)(3); 37 C.F.R. § 2.121(d). *See, e.g., Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775-76 (TTAB 2013) (approving parties' stipulation to proceed via ACR).

501.03 Form of Stipulations

A stipulation may be signed either by the parties, or by their attorneys or other authorized representatives.

If parties stipulate to extend or reopen a time or times, the stipulation should specify the closing date for each rescheduled time. For example, if parties stipulate to extend or reopen a defendant's time to file an answer to the complaint, the stipulation should specify the new due date for the answer and all subsequent dates that require rescheduling when the due date for the answer is reset, including the deadline for the required discovery conference, disclosures, discovery and trial. If parties stipulate to extend or reopen testimony periods, or the discovery period and testimony periods, the stipulation should be submitted in the form used in a trial order, specifying the closing date for each period to be reset, including relevant disclosure deadlines, such as the deadline for expert disclosures, which occurs 30 days prior to the close of discovery, and pretrial disclosure deadlines, which are tied to each testimony period. [Note 1.] When the parties agree to a new schedule of dates and file for approval using ESTTA "consent motions option," the system will prompt the filer to enter new deadlines in a manner that will generate an appropriate schedule in the proper form. If the calculator provided by ESTTA does not reflect all the deadlines required by the parties' agreed-upon schedule, the filing party should select the "general filings" option and attach or embed in the motion the agreed-upon schedule with an express statement that all parties agree to the new dates.

The resetting, whether by stipulation or otherwise, of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods—such dates will be rescheduled only upon stipulation of the parties being approved by the Board, or upon motion granted by the Board, or by order of the Board. [Note 2.] *See*TBMP § 403.04 (Extensions of Discovery Period, Time to Respond to Discovery Requests, and Disclosures).

NOTES:

1. 37 C.F.R. § 2.121(d).

2. 37 C.F.R. § 2.120(a)(3); 37 C.F.R. § 2.121(a).

502 Motions - In General

502.01 Available Motions

There is a wide range of motions that may be filed in inter partes proceedings before the Board. 37 C.F.R. § 2.116(a), provides that "[e]xcept as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure." Thus, many of the motions available under the Federal Rules of Civil Procedure are also available in proceedings before the Board.

However, because the Board is an administrative tribunal, its rules and procedures, and hence the motions available in proceedings before it, necessarily differ in some respects from those prevailing in the federal district courts. *See*TBMP § 102.03 (General Description of Board Proceedings) and TBMP § 702 (Pretrial Disclosures; Manner of Trial and Introduction of Evidence).

For example, the Board does not preside at the taking of oral testimony. Instead, oral testimony is taken out of the presence of the Board, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. [Note 1.] *See* TBMP § 702. Further, for reasons of administrative economy, it is the

policy of the Board not to read trial testimony or examine other trial evidence prior to final decision. [Note 2.] For this reason, the Board will defer consideration of substantive objections to trial evidence (e.g., on the grounds of hearsay, relevance, or that the evidence constitutes improper rebuttal) until final decision. [Note 3.] *See also* TBMP § 707 (Objections to Evidence).Therefore, except for the motions for involuntary dismissal under 37 C.F.R. § 2.132(a) and 37 C.F.R. § 2.132(b) for failure of the plaintiff to take testimony or offer evidence (other than plaintiff's pleaded registration under 37 C.F.R. § 2.132(b)), the Board will not entertain any motion challenging or otherwise relating to the probative value or sufficiency of a party's trial evidence. For information concerning these motions, see TBMP § 534 (Motion for Judgment for Plaintiff's Failure to Prove Case). Motions that require examination of trial evidence prior to final decision, such as motions in limine, and those under Fed. R. Civ. P. 41(b) for involuntary dismissal and under Fed. R. Civ. P. 50(a) for judgment as a matter of law (formerly known as a motion for directed verdict), are not available in Board proceedings. [Note 4.]

Given the broad range of possible motions that may be filed in an inter partes proceeding before the Board, this chapter discusses only the motions that most commonly arise in Board proceedings.

NOTES:

1. *See* 37 C.F.R. § 2.123(a); 37 C.F.R. § 2.125(d).

2. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1263 (TTAB 2003) (substantive evidentiary issues are deferred until final decision); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) ("The Board does not read testimony and consider substantive objections to evidence, or determine the probative value of evidence, prior to final hearing"); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (Board will not rule on objections pertaining to admissibility prior to final decision).

3. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1263 (TTAB 2003) (substantive evidentiary issues are deferred until final decision); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426 (TTAB 1993) (contested motions to introduce discovery depositions filed with a notice of reliance deferred); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (objection to notice of reliance that the evidence is improper rebuttal evidence will be deferred); *M-Tek Inc. v. CVP Systems, Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (motion to strike documents submitted under a notice of reliance as hearsay and not properly authenticated deferred).

4. *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1178 (TTAB 2010) (applicant's motion to exclude testimony not construed as motion in limine); *Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750-51 (TTAB 1995) (motions in limine not available); *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501, 1504 n.2 (TTAB 1993) (directed verdicts not available); *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co.*, 226 USPQ 718, 718 (TTAB 1985) (to extent motion for summary judgment was intended as one for directed verdict, it is inappropriate); *Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 56 n.7 (TTAB 1983) (motion for involuntary dismissal under Fed. R. Civ. P. 41(b) unavailable), *aff'd*, 737 F.2d 1576, 222 USPQ 665, 668-69 (Fed. Cir. 1984). *Cf. Hunter Industries Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.11 (TTAB 2014) , *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016) (noting that because the Board does not entertain motions in limine, opposer was unable to raise the issue of over-designation of confidential identifying information of declarants until applicant submitted the declarations during its testimony period).

502.02 Form of Motions and Briefs on Motions

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 ... 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. § 2.127(a) *Every motion must be submitted in written form and must meet the requirements prescribed in § 2.126. It shall contain a full statement of the grounds, and shall embody or be accompanied by a brief. Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within twenty days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. If a motion for an extension is denied, the time for responding to the motion remains as specified under this section, unless otherwise ordered. Except as provided in paragraph (e)(1) of this section, a reply brief, if filed, shall be filed within twenty days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended or reopened. The Board will consider no further papers in support of or in opposition to a motion. Neither the brief in support of a motion nor the brief in response to the motion shall exceed twenty-five pages in length in its entirety, including table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. A reply brief shall not exceed ten pages in length in its entirety. Exhibits submitted in support of or in opposition to a motion are not considered part of the brief for purposes of determining the length of the brief. When a party fails to file a*

brief in response to a motion, the Board may treat the motion as conceded. An oral hearing will not be held on a motion except on order by the Board.

* * * *

37 C.F.R. § 2.127(e)(1) ... *If no motion under Rule 56(d) is filed, a brief in response to the motion for summary judgment shall be filed within thirty days from the date of service of the motion unless the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board.*

502.02(a) Form of Motions

Every motion must be submitted via ESTTA, in written form and must meet the general requirements for submissions to the Board set forth in 37 C.F.R. § 2.126. The requirements for electronic submissions are specified in 37 C.F.R. § 2.126(a), the requirements for paper submissions can be found in 37 C.F.R. § 2.126(b), and the requirements for confidential submissions are in 37 C.F.R. § 2.126(c). Additional information regarding electronic submissions made through ESTTA may be found at the USPTO website (http://www.uspto.gov) by accessing the "Trademark Trial and Appeal Board" portion of that site. *See also*TBMP § 106.03.

In addition, a motion should bear the name and number of the inter partes proceeding in connection with which it is being filed and a title describing the nature of the motion. *See*TBMP § 106.01. A party who files a motion that does not bear the correct proceeding number runs the risk that the paper will not be associated with the proceeding for which it is intended (and hence may never be considered by the Board). [Note 1.]

A motion must be signed by the party filing it, or by the party's attorney or other authorized representative. If a motion is unsigned, it will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board. [Note 2.] *See* TBMP § 106.02 (Signature of Submissions). When a motion is filed via ESTTA, it must be signed in conformance with 37 C.F.R. § 2.193(c). As a practical matter, ESTTA will allow the filing party to complete the submission process only after the required electronic signature has been entered. [Note 3.]

Motions may be filed in paper form only when ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. In such exceptional situations, a motion in paper form must include a written explanation of such technical problems or extraordinary circumstances. The explanation must include specific facts rather than mere conclusory statements as to the technical problem or extraordinary circumstance that prevented the use of ESTTA. Paper submissions that do not meet the showing of ESTTA unavailability or extraordinary circumstances will not be considered; however, the parties should consider any such paper filing accepted unless the Board indicates otherwise. [Note 4.] When motions are filed in exceptional paper form, the certificate of mailing by first-class mail procedure provided under 37 C.F.R. § 2.197, and the Priority Mail Express® procedure provided under 37 C.F.R. § 2.198 are both available. [Note 5.] *See*TBMP § 111. Parties are not permitted to file motions via email except at the request of the Board attorney or judge. ESTTA is the only available procedure for electronic filing with the Board.

When a party files a motion electronically through ESTTA, the filing is time-stamped with the official filing date when the ESTTA filing, including any required fee, is received by the Board server. Eastern Time controls the filing date, and the time the transmission began is not a factor in determining the filing date. The official filing date and time are found on the confirmation web screen and the party's email confirmation. Once the electronic filing is submitted, the Board immediately transmits an email filing receipt. If the filing

party does not receive the email filing receipt within 24 hours (or by the next business day), the filing party should contact the Board. For technical assistance with an ESTTA filing, a party may call the Board with questions at (571) 272-8500 or (800) 786-9199 (toll free); or may send an email to ESTTA@uspto.gov. The Board should respond to the inquiry within two (2) business days. When contacting the Board for ESTTA assistance please describe the nature of the problem and include the ESTTA tracking number, which should appear on the computer screen after transmission. *See*TBMP § 106.03.

ESTTA filing is required; it is no longer optional. If ESTTA filing is not possible prior to a deadline because ESTTA is unavailable due to technical problems, or other extraordinary circumstances are present, parties should timely make their submission on paper with the required written explanation. *See*TBMP § 107 and TBMP § 111. The parties should consider any such paper filing accepted unless the Board indicates otherwise.

A party should file only one copy of a motion with the Board. Unless otherwise directed by the Board, it is not necessary to file a paper copy of a motion that has been filed electronically. Every motion filed with the Board must be served upon every other party to the proceeding, and proof of such service ordinarily must be made before the motion will be considered by the Board. [Note 6.] *See*TBMP § 113 (Service of Papers). Service must be made by email unless the parties stipulate otherwise or the serving party shows that email service could not be made due to technical problems or extraordinary circumstances. [Note 7.]

NOTES:

1. *See Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1033 n.3 (TTAB 2007) (applicant did not separately caption her motion to amend the filing basis of the application at issue; rather she incorporated it into her response to opposer's motion for summary judgment. The better practice is either to file such a motion as a separate filing or, at a minimum, to caption it separately).

2. 37 C.F.R. § 2.119(e).

3. *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1927 (TTAB 2005).

4. 37 C.F.R. § 2.126(b). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69966 (Oct. 7, 2016).

5. 37 C.F.R. § 2.197; 37 C.F.R. § 2.198.

6. 37 C.F.R. § 2.119(a); 37 C.F.R. § 2.119(b).

7. 37 C.F.R. § 2.119(b).

502.02(b) Briefs on Motions

Every motion must embody or be accompanied by a brief. [Note 1.]

Briefs on motions, and any exhibits thereto, must meet the general requirements for submissions to the Board set forth in 37 C.F.R. § 2.126. *See*TBMP § 106.03 (Form of Submissions).

Briefs on motions are also subject to page limitations and time requirements. [Note 2.] Briefs in support of and in response to a motion may not exceed 25 pages in length and a reply brief may not exceed 10 pages. [Note 3.] Exhibits submitted with the brief are not counted in determining the length of the brief. However,

because 37 C.F.R. § 2.127(a) does not require an index of cases and authorities or a table of contents, should a party elect to include these items, they will count as part of the page limit for the brief. [Note 4.]

A brief in response to a motion, except a motion for summary judgment, must be filed within 20 days from the date of service of the motion. [Note 5.] When a motion for summary judgment is filed, a brief in response, or a motion for Fed. R. Civ. P. 56(d) discovery must be filed within 30 days from the date of service of the summary judgment motion. [Note 6.] See also TBMP § 528.02 for further information regarding the time for filing a motion for summary judgment. The time for filing a responsive brief may be extended, but the time for filing, in lieu thereof, a motion for Fed. R. Civ. P. 56(d) discovery will not be extended, even upon the parties' consent. [Note 7.] *See*TBMP § 528.06 (Request for Discovery to Respond to Summary Judgment).

These time periods for responding to motions shall apply unless another time is specified by the Board; or the time is extended by stipulation of the parties approved by the Board or by order of the Board on motion for good cause; or the time is reopened by stipulation of the parties approved by the Board or by order of the Board on motion showing excusable neglect. [Note 8.] *See* TBMP § 509. If a motion for an extension of time to respond to a motion is denied, the time for responding to the motion remains as specified under 37 C.F.R. § 2.127(a), unless otherwise ordered. [Note 9.]

A reply brief, if filed, including a reply brief for a summary judgment motion, shall be filed within 20 days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended, even upon the parties' consent. [Note 10.] No further papers (including surreply briefs) will be considered by the Board. [Note 11.] The filing of reply briefs is discouraged, as the Board generally finds that reply briefs have little persuasive value and are often a mere reargument of the points made in the main brief. [Note 12.] If the nonmoving party does not file a responsive brief, a reply brief should not be filed.

In general, all motions should be filed separately, or at least be captioned separately, to ensure they receive attention. A party should not embed a motion in another filing that is not routinely reviewed by the Board upon submission. [Note 13.]

NOTES:

1. 37 C.F.R. § 2.127(a). *See Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1541 n.15 (TTAB 2010) (citing 37 C.F.R. § 2.127(a)).

2. 37 C.F.R. § 2.127.

3. 37 C.F.R. § 2.127(a). *See also Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1141 (TTAB 2011) (reply brief not considered because it exceeded the page limit); *Cooper Technologies Co. v. Denier Electric Co.*, 89 USPQ2d 1478, 1479 (TTAB 2008) (the page limitation for a "brief in response to a motion" applies to a brief in which an opposition to a motion and a cross-motion are combined but address the same issues; in other words, one cannot exceed the page limitation for a brief by combining an opposition brief and cross-motion addressing the same issue); *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009, 2010 (TTAB 2002) (reply brief was untimely and exceeded page limit); *Estate of Shakur v. Thug Life Clothing Co.*, 57 USPQ2d 1095, 1096 (TTAB 2000) (respondent improperly attempted to circumvent the page limitations in 37 C.F.R. § 2.127(a) by "dissect[ing] what is a single motion to compel into two motions separately addressing the interrogatories and document requests in order to file briefs totaling 50 pages").

4. *Saint-Gobain Corp. v. Minnesota Mining and Manufacturing Co.*, 66 USPQ2d 1220, 1222 (TTAB 2003). *See also Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1141 (TTAB) (over-length reply brief included a table of contents and a table of authorities).

5. 37 C.F.R. § 2.127(a). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69960 (Oct. 7, 2016) ("provision adding five days to the prescribed period for action after service by the postal service or overnight courier" removed, "[a]ll fifteen-day response dates initiated by a service date are amended to twenty days.").

6. 37 C.F.R. § 2.127(e)(1). *See McDonald's Corp. v. Cambrige Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013) (extension of Fed. R. Civ. P. 56(d) motion prohibited by 37 C.F.R. § 2.127(e)(1)).

7. *See McDonald's Corp. v. Cambrige Overseas Development Inc.* , 106 USPQ2d 1339, 1340 (TTAB 2013) (extending filing deadline of a Rule 56(d) motion, even by consent, is in contravention of the provisions of 37 C.F.R § 2.127 and, therefore, prohibited).

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

9. 37 C.F.R. § 2.127(a).

10. 37 C.F.R. § 2.127(a) and 37 C.F.R. § 2.127(e)(1). *See McDonald's Corp. v. Cambrige Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013) (denying parties' stipulation to provide for additional five days, noting that such a stipulation would violate the provisions of 37 C.F.R. § 2.127, which do not allow for extensions of time to file reply briefs); *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009, 2010 (TTAB 2002) (approval of consented motion to extend time to file reply brief vacated).

11. 37 C.F.R. § 2.127(a) and 37 C.F.R. § 2.127(e)(1); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1677 (TTAB 2005) (because 37 C.F.R. § 2.127(a) prohibits the filing of surreply briefs, opposer's surreply to applicant's motion was not considered); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000).

12. *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) ("The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto"); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1223 n.4 (TTAB 1987) (reply brief, constituting mere reargument given no consideration).

13. *See Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1541 (TTAB 2010); and *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1033 n.3 (TTAB 2007).

502.02(c) Confidential Information

The Board's standard protective order is automatically in place for inter partes proceedings unless the Board approves a stipulation or motion to use an alternative order. [Note 1.] Except for materials filed under seal pursuant to a protective order or designated as confidential in ESTTA, the files of applications and registrations that are the subject matter of pending proceedings before the Board and all pending proceeding files and exhibits thereto are available for public inspection and copying on TTABVUE, http://ttabvue.uspto.gov (docket information and full images of Board files). [Note 2.] Therefore, only the particular portion of a

motion that discloses confidential information should be electronically designated as "CONFIDENTIAL" in ESTTA or when filed exceptionally by paper under seal pursuant to a protective order. Parties should avoid over-designation of non-confidential information as confidential. To the extent a party has improperly designated information as confidential, the Board may disregard the confidential designation when appropriate. [Note 3]. If a party submits a motion containing confidential information either electronically via ESTTA or by paper under seal, the party must also submit for the public record a redacted version of the motion. [Note 4.]

Confidential information filed without appropriate designation in accordance with the Board's standard protective order or one adopted by the parties as a substitute for the standard order is not regarded as confidential, will not be kept confidential by the Board and will be placed in the Board's public records available on the Internet. [Note 5.] To be handled as confidential and kept out of the public record, submissions to the Board must be filed using the "Confidential" selection available in ESTTA, or filed under a separate cover with a showing by written explanation accompanying the submission that ESTTA was unavailable due to technical problems or that extraordinary circumstances justify the paper submission. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission with the confidential portions redacted must also be submitted concurrently for public viewing. [Note 6.]

When filing confidential documents electronically through ESTTA, the party must use the "File Documents in a Board Proceeding" option, select "CONFIDENTIAL Opposition, Cancellation or Concurrent Use," enter the proceeding number and click "Start." The documents filed in this manner will not be viewable in the publicly available electronic proceeding file. The party filing the confidential document electronically must also file concurrently a separate redacted version of the confidential filing for public viewing.

Any confidential filing must include redacted versions for the public record. *See* 37 C.F.R. § 2.126(c). For any confidential unredacted version of a submission for which a redacted version must be filed, the parties are encouraged to enclose the confidential information in brackets so as to facilitate a better comparison between the public and confidential versions of the filing when the Board is issuing an order or preparing a final decision.

Disclosure of an individual's personally identifiable information (e.g., social security number, financial account numbers, or home address) is not necessary. Such information should always be redacted from any submission.

For further information regarding protective orders, see TBMP § 412 and TBMP § 412.01. For further information regarding confidential materials, see TBMP § 120.02 ("Access to Files – Confidential Material"), TBMP § 703.01(p) ("Oral Testimony Depositions - Confidential or Trade Secret Material"), and TBMP § 801.03 ("Form and Content of Briefs").

NOTES:

1. 37 C.F.R. § 2.116(g).

2. 37 C.F.R. § 2.27(d); 37 C.F.R. § 2.27(e), and 37 C.F.R. § 2.126(c); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

3. 37 C.F.R § 2.116(g) ("[t]he Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party."); *see also Kohler Co. v. Honda*

Giken K.K., 125 USPQ2d 1468, 1475 (TTAB 2017) (citing *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2016)); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014). *Cf. Uniloc 2017 LLC v. Apple, Inc.*, 964 F.3d 1351, 2020 USPQ2d 10757 (Fed. Cir. 2020) (discussing the treatment of over-designation of confidential material in a patent infringement case).

4. 37 C.F.R. § 2.27(e) and 37 C.F.R. § 2.126(c); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

5. *Cf. Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) (Board was not bound by parties' overdesignation of testimony and evidence as confidential); and *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1714 (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 (D.D.C. 2003).

6. 37 C.F.R. § 2.126(c). *See also Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

502.03 Oral Hearings on Motions

A formal oral hearing at the Board is not held on a motion except by order of the Board. [Note 1.] It is the practice of the Board to deny a request for an oral hearing on a motion unless, in the opinion of the Board, an oral hearing is necessary to clarify the issues to be decided. Ordinarily, arguments on a motion are, and should be, adequately presented in the briefs thereon, and therefore the Board rarely grants a request for an oral hearing on a motion. [Note 2.] In contrast, a telephone conference with a Board attorney or judge may be used in lieu of a brief to present arguments in support of or against a motion. [Note 3.] *See*TBMP § 413.01 and TBMP § 502.06 for further information regarding telephone conferences on motions.

NOTES:

1. 37 C.F.R. § 2.127(a).

2. *The Scotch Whiskey Association v. United States Distilled Products Co.*, 13 USPQ2d 1711 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240 (TTAB 1990), *dismissed*, 18 USPQ2d 1391, 1391 n.3 (TTAB 1991) (issues on motion to dismiss not so extraordinary to warrant an oral hearing), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 n.3 (TTAB 1989) (exception to usual practice is not warranted). *Cf. Federal Trade Commission v. Formica Corp.*, 200 USPQ 182, 186 (TTAB 1978) (oral hearing on motion allowed in view of importance and novelty of issue).

3. 37 C.F.R. § 2.127(a). *See, e.g., Byer California v. Clothing for Modern Times*, 95 USPQ2d 1175, 1176 (TTAB 2010).

502.04 Determination of Motions

37 C.F.R. § 2.127(a) ... *When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded. ...*

37 C.F.R. § 2.127(c) *Interlocutory motions, requests, conceded matters, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Administrative Trademark Judge of the Trademark Trial and Appeal Board or by an Interlocutory Attorney or Paralegal of the Board to whom authority to act has been delegated, or by ESTTA. Motions disposed of by orders entitled "By the Trademark Trial and Appeal Board" have the same legal effect as orders by a panel of three Administrative Trademark Judges of the Board.*

Motions fall into three categories: consented, uncontested, and contested. If the nonmoving party has consented to a motion, the motion may be filed either as a stipulation with the signature of both parties, or as a consented motion in which the moving party states that the nonmoving party has given its oral consent thereto (unless written consent is required under the provisions of 37 C.F.R. § 2.106(c), 37 C.F.R. § 2.114(c), 37 C.F.R. § 2.134(a), or 37 C.F.R. § 2.135). Ordinarily, the Board will grant a consented motion.

If the nonmoving party has not given its consent to a motion, but does not file a brief in opposition thereto during the time allowed therefor, the Board, in its discretion, may grant the motion as conceded. [Note 1.] However, the Board, in its discretion, may also decline to treat an uncontested motion as conceded, and may grant or deny the motion on its merits. [Note 2.]

A motion that does not expressly state that the nonmoving party has consented to the motion will not be granted as conceded until after passage of sufficient time for filing and receipt by the Board of a brief in response. If a motion is contested by the nonmoving party by filing an acceptable opposition brief or presenting a responsive argument in a telephone conference, the Board will decide the motion on its merits. When determining a motion, the Board need not address every argument raised by the parties, it need only specify the basis supporting its determination. [Note 3.]

Interlocutory motions that are not actually or potentially dispositive of a proceeding may be acted upon by a single Board judge, attorney, or paralegal to whom such authority has been delegated, or by ESTTA. [Note 4.] *See*TBMP § 102.03 (General Description of Board Proceedings). A panel of at least three Board judges determines contested motions that are actually or potentially dispositive of a proceeding. *See*TBMP § 102.03 (General Description of Board Proceedings). Stipulations or consented (or uncontested) motions to dispose of the proceeding in a certain manner may be determined under the authority of the Board.

For information concerning the remedies available to a party that is dissatisfied with a decision on a motion, see TBMP § 518 (Motion for Reconsideration of Decision on Motion). *See also*TBMP § 905 (Petition to the Director).

A party should not presume that the Board will automatically reset discovery, disclosure deadlines and/or trial dates when it determines a pending motion. When the Board determines a pending motion, and there is no motion to extend discovery, disclosure deadlines and/or trial dates, the Board, in the exercise of its discretion, may or may not reset relevant dates. A party that wishes to have particular deadlines or periods reset upon the determination of a particular motion should file a motion requesting such action and specifying the deadlines or periods it wishes to have reset. [Note 5.] Alternatively, a moving or responding party may request the resetting of deadlines or periods in its pending motion or response thereto, where such pending motion is not otherwise one seeking an enlargement of time. In other words, a party may incorporate a motion to extend as part of another motion, and should caption the motion accordingly.

The filing of a request for reconsideration under 37 C.F.R. § 2.127(b) or the filing of a petition under 37 C.F.R. § 2.146(e)(2) will not, in the usual case, result in a stay of proceedings. Any discovery, trial dates, or other deadlines set by the Board will ordinarily remain as set, notwithstanding the request for

reconsideration or petition. The Board may, however, reset dates, as appropriate, if either a request for reconsideration or a petition is granted.

NOTES:

1. 37 C.F.R. § 2.127(a); *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888, 891 (CCPA 1980) (treating motion for summary judgment as conceded was proper); *Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1541 n.16 (TTAB 2010) (Board will generally treat unopposed motion as conceded); *Central Manufacturing Inc. v. Third Millennium Technology, Inc.*, 61 USPQ2d 1210, 1211 (TTAB 2001) (motion to dismiss treated as conceded); *Boston Chicken Inc. v. Boston Pizza International Inc.*, 53 USPQ2d 1053, 1054 (TTAB 1999).

2. *See, e.g., Promgirl Inc. v. JPC Co.*, 94 USPQ2d 1759, 1760 n.1 (TTAB 2009) (Board exercised discretion to consider motion on merits even though late brief in opposition to motion was not considered); *Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2018 (TTAB 2003) (motion to suspend for civil action not treated as conceded where potentially dispositive motion was pending when motion to suspend was filed); *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1599 (TTAB 2002) (motion to retroactively suspend proceeding and deny applicant's motion for summary judgment decided on merits); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000) (cross-motion for judgment not treated as conceded in view of its potentially dispositive nature); *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990) (uncontested motion to dismiss decided on merits). *Cf. Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 n.6 (TTAB 1990) (even if the Board not considered plaintiff's late responsive brief, defendant's motion would not have been treated as conceded under the circumstances).

3. *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019-20 (TTAB 2015) (reconsideration denied because no requirement that Board repeat or address irrelevant arguments when determining a motion).

4. 37 C.F.R. § 2.127(c).

5. 37 C.F.R. § 2.120(a)(3). *But see* 37 C.F.R. § 2.121(a) ("The resetting of the closing date for discovery will result in the rescheduling of pretrial disclosure deadlines and testimony periods without action by any party. The resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party.").

502.05 Attorneys' Fees, etc., on Motions

The Board will not hold any person in contempt, or award attorneys' fees, other expenses, or damages to any party. [Note 1.]

NOTES:

1. 37 C.F.R. § 2.127(f); *NSM Resources Corp. v. Microsoft Corp.* , 113 USPQ2d 1029, 1035 n.10 (TTAB 2014) (Board cannot assess monetary damage awards); *General Mills Inc. v. Fage Dairy Processing Industries SA* , 100 USPQ2d 1584, 1591 (TTAB 2011) (no authority to determine damages), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC* , 88 USPQ2d 1541, 1544 n.6 (2008); *Central Manufacturing Inc. v. Third Millennium Technology Inc.* , 61 USPQ2d 1210, 1213 (TTAB 2001) ("although the Board does not impose monetary sanctions or award attorneys' fees or other expenses, the Board has the authority to enter other

appropriate sanctions"); *Duke University v. Haggar Clothing Co.* , 54 USPQ2d 1443, 1445 n.3 (TTAB 2000). *See also* 37 C.F.R. § 2.120(g) and 37 C.F.R. § 2.120(h)(1). Note, however, that conduct in violation of the Disciplinary Rules set forth in 37 C.F.R. Part 11 may be referred to the Office of Enrollment and Discipline (OED) for appropriate action. *See* 37 C.F.R. § 11.19 *et seq.*

502.06 Telephone and Pretrial Conferences

502.06(a) Telephone Conferences

37 C.F.R. § 2.120(j)(1) *Whenever it appears to the Trademark Trial and Appeal Board that a stipulation or motion filed in an inter partes proceeding is of such nature that a telephone conference would be beneficial, the Board may, upon its own initiative or upon request made by one or both of the parties, schedule a telephone conference.*

37 C.F.R. § 2.127(a) . . . *Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within twenty days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. ...*

When it appears to the Board that a motion filed in an inter partes proceeding may be resolved by a telephone conference call involving the parties or their attorneys and a Board judge or attorney, the Board may, upon its own initiative or upon request made by a party, convene a conference to hear arguments on and to resolve the motion by telephone conference. [Note 1.] Immediately after the resolution of a motion by telephone conference, the Board normally will issue a written order confirming its decision on the motion. Immediate issuance of an order may be deferred, however, if the conference raises issues that require research or additional briefing before they can be resolved.

Board judges and attorneys retain discretion to decide whether a particular matter can and should be heard or disposed of by telephone. The Board may therefore deny a party's request to hear a matter by telephone conference. There is no formal limit as to the type of matters that can be handled through telephone conferences [Note 2.], but the Board will not decide by telephone conference any motion that is potentially dispositive, that is, a motion which, if granted, would dispose of a Board proceeding. The telephone conference procedure is particularly useful for resolving motions where time is of the essence, such as a motion to quash a notice of deposition, as well as numerous discovery motions. [Note 3.] See TBMP § 521 regarding motions to quash a notice of deposition, TBMP § 401.01 and TBMP § 408.01(a) regarding discovery conferences with Board participation, andTBMP § 413.01 regarding telephone conferences for motions relating to discovery. The telephone conference procedure may also be beneficial in instances where the parties are required to provide a progress report on the status of settlement negotiations as a prerequisite for filing a stipulation or consented motion to further suspend or extend proceedings.

Trademark Rule 2.191, 37 C.F.R. § 2.191, which requires all business with the USPTO be transacted in writing, is waived to the extent that Board attorneys or judges may accept from parties, or direct parties to present, oral recitations of procedural facts and presentations of argument. In addition, Trademark Rule 2.119(b), 37 C.F.R. § 2.119(b), which specifies the acceptable methods for forwarding service copies of papers filed with the Board, is waived to the extent necessary to facilitate telephone conferencing. [Note 4.]

Telephone conferences are not a substitute for written consented motions or stipulations. Parties should file consented motions or stipulations via ESTTA rather than call the Board for an order that can otherwise be agreed upon without Board involvement. Moreover, telephone conferences may not be used as a means to

supplement a motion or a related brief, and are not an opportunity to present oral arguments in support of fully briefed written motions unless requested by the Board.

Requesting a telephone conference: A party may request a telephone conference from the assigned Board attorney before it files the underlying motion. The initial contact will be limited to a simple statement of the nature of the issues proposed to be decided by telephone conference, with no discussion of the merits. A party served with a written motion may request a telephone conference by contacting the assigned Board attorney soon after it receives the service copy of the motion so that the responding party will have sufficient time to respond to the motion in the event the request for a telephone conference is denied. A party may not request a telephone conference at or near the end of its time to respond to the motion when its purpose in doing so is to avoid or delay its response to the motion.

During the initial contact, the Board attorney will decide whether any party must file a motion or brief or written agenda to frame the issues for the conference and will issue instructions.

When the Board grants a party's request for a telephone conference, the requesting party is responsible for scheduling the conference at a time agreeable to all parties and the assigned Board attorney. The requesting party must arrange the conference call. In order to facilitate the scheduling of a telephone conference, parties are required to provide a telephone number and email address where they can be reached during business hours when filing their respective pleadings with the Board. When the Board initiates a telephone conference, the Board attorney will schedule the conference.

The Board may in its discretion require additional written briefing of the motion or decide that additional written briefing is unnecessary. The Board has the discretion to decide the motion by telephone conference prior to the expiration of the written briefing period for filing a response or reply. [Note 5.] If a response to a pending motion has not yet been filed, the nonmoving party should be prepared to make an oral response to the motion during the telephone conference. Similarly, if a reply in support of a pending motion has not yet been filed, the moving party should be prepared to make its reply during the telephone conference. Any other instructions regarding filing of briefs or serving copies will be provided at the time the Board schedules the conference. To expedite matters, the moving party should call the Board attorney to request a telephone conference shortly after it files its motion via ESTTA. This procedure is useful when time is of the essence. Calling the Board attorney after filing a motion via ESTTA is the most efficient way to get a motion to the attention of the Board attorney. Filing by facsimile is prohibited. [Note 6.]

Denial of a request for a telephone conference is without prejudice on the merits of the motion or other matter sought to be heard by telephone. If the request is denied, the Board attorney will provide instructions to the party or parties regarding requirements for filing the motion or briefs required to have the matter decided on the written record.

For information on requesting Board participation in the settlement and discovery conference required under 37 C.F.R. § 2.120(a)(2)(i), see TBMP § 401.01.

Conduct of conference. Unless otherwise specified, the telephone conference will be limited to the issues defined by the Board prior to, or at the commencement of, the conference. During the conference, the Board has discretion to consider new oral motions regarding issues that arise during the conference. The Board will not record the conference nor may the parties record the telephone conference. [Note 7.] The Board attorney may make rulings at the conclusion of the conference or may take the parties' arguments under advisement. If the Board attorney determines during the telephone conference that the motion or matter should be decided on the written record, the Board attorney may halt the telephone conference and direct the filing of a written motion or response to a motion, or both.

Parties must conduct themselves with appropriate decorum. Interruptions are to be avoided. The Board attorney conducting the conference generally will signal that a party may make an argument or presentation by inviting the party to do so or by inviting a response to an argument or presentation made by another.

Participation. The conference will involve the parties or their attorneys, and a Board judge or attorney. The Board may permit attendance by others, including Board staff and corporate representatives of the parties. If the Board permits a party to have more than one person in attendance, that party must designate a lead person to represent the party in the conference. Failure to participate in a scheduled telephone conference may result in the motion being denied with prejudice, the motion being treated as conceded, issuance of an order to show cause why judgment should not be entered against the non-participating party for loss of interest in the case, or the imposition of sanctions pursuant to the Board's inherent authority. *See*TBMP § 527.03 (Inherent Authority to Sanction).

Issuance of Rulings. The Board attorney may make rulings at the conclusion of a telephone conference or may take the parties' arguments under advisement. In every instance, after the resolution of a motion or matter by telephone conference, the Board attorney will issue a written order containing all rulings. In most instances, the Board's written order will consist of only a brief summary of the issues and the resulting decision; generally, the order will not include a recitation of the parties' arguments. The decision will be forwarded to the parties by mail or email, and will be available for the parties to view on the Board's section of the USPTO website, specifically within the electronic proceeding file for the case (i.e., TTABVUE).

NOTES:

1. 37 C.F.R. § 2.120(j)(1). *See Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1446 (TTAB 2000); *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1775 (TTAB 1999); *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1552 (TTAB 1991); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990); *Teleconferencing on Cases Before the TTAB*, O.G. Notice (June 20, 2000). The Official Gazette Notice describing the telephone conference procedures may be found at the Board home page of the USPTO website under TTAB Phone Conferencing in the Policy and Procedure section.

2. *See, e.g., Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239 (TTAB 2012) (motions to strike pretrial disclosures, quash, and reopen testimony); *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175 (TTAB 2010) (motions to compel and quash); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1446 (TTAB 2000) (consented request to stay opposer's rebuttal testimony period pending ruling on opposer's motion to quash); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1775 (TTAB 1999) (motions to quash and for discovery sanctions); *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1552 (TTAB 1991) (motion to attend testimony deposition by telephone); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990) (uncontested motion to extend testimony period and motion for a protective order).

3. *See, e.g., Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1655 (TTAB 2007) (party could have requested phone conference to quickly determine whether notice of deposition was reasonable); *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999) (to the extent time was of the essence, party could have contacted the Board and requested that the motion to extend discovery be resolved on an expedited basis or by telephone conference); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1775 (TTAB 1999); and cases cited in previous note 2.

4. Teleconferencing on Cases Before the TTAB, O.G. Notice (June 20, 2000).

5. 37 C.F.R. § 2.127(a). *See, e.g., Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1176 (TTAB 2010).

6. 37 C.F.R. § 2.126(a); 37 C.F.R. § 2.195(d)(3).

7. 37 C.F.R. § 2.120(j)(3)

502.06(b) Pretrial Conferences

37 C.F.R. § 2.120(j)(2) *Whenever it appears to the Trademark Trial and Appeal Board that questions or issues arising during the interlocutory phase of an inter partes proceeding have become so complex that their resolution by correspondence or telephone conference is not practical and that resolution would likely be facilitated by a conference in person of the parties or their attorneys with an Administrative Trademark Judge or an Interlocutory Attorney of the Board, the Board may, upon its own initiative direct that the parties and/or their attorneys meet with the Board for a disclosure, discovery or pretrial conference on such terms as the Board may order.*

Because the pretrial conference procedure necessarily involves expense for the parties, it is rarely used by the Board. However, it may be advantageous in cases where numerous complex motions are pending, or where the Board has identified the case as being, or having the potential to be, overly contentious and/or involve creation of excessive records by the parties, or where attorneys or parties are unable to work out a resolution of any of their differences. [Note 1.] The Board may direct the parties and/or their attorneys to appear on such terms as the Board may order for such a conference. [Note 2.]

For information concerning discovery conferences, see TBMP § 401.01 and TBMP § 408.01(a).

NOTES:

1. 37 C.F.R. § 2.120(j)(2). *See Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1634 (TTAB 2011).

2. *See General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1592 n.5 (TTAB 2011) (the Board may exercise its authority to order a pretrial conference in person at the Board's offices in Alexandria, VA), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1634 (TTAB 2011) (Board exercised its authority to require parties to attend a pretrial conference at the Board's offices in Alexandria, VA); *Amazon Technologies Inc. v. Wax*, 95 USPQ2d 1865, 1869 (TTAB 2010) ("under Trademark Rule 2.120(i)(2), where resolution of discovery or other interlocutory issues 'would likely be facilitated by a conference in person of the parties or their attorneys,' the Board may 'request that the parties or their attorneys … meet with the Board at its offices' for a conference. If the parties remain unwilling or unable to work together cooperatively and efficiently, the Board will not hesitate to invoke this Rule in the future."). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69952 (Oct. 7, 2016) ("Correlative to electronic ... communication, the Board also has made it possible for parties ... and members of the Board to attend hearings remotely through video conference.").

502.07 Fed. R. Civ. P. 11 Applicable

For information concerning the applicability of the provisions of Fed. R. Civ. P. 11 to motions filed in proceedings before the Board, see TBMP § 527.02.

503 Motion to Dismiss for Failure to State a Claim

Fed. R. Civ. P. 12(b)How to Present Defenses. *Every defense to a claim for relief in any pleading must be asserted in the responsive pleading if one is required. But a party may assert the following defenses by motion:*

(6) *failure to state a claim upon which relief can be granted;*

A motion asserting any of these defenses must be made before pleading if a responsive pleading is allowed. If a pleading sets out a claim for relief that does not require a responsive pleading, an opposing party may assert at trial any defense to that claim. No defense or objection is waived by joining it with one or more other defenses or objections in a responsive pleading or in a motion.

503.01 Time for Filing

When the defense of failure to state a claim upon which relief can be granted is raised by means of a motion to dismiss, the motion must be filed before, or concurrently with, the movant's answer. [Note 1.] When the motion is directed to an amended pleading, it must be filed before, or concurrently with, the movant's answer to the amended pleading. [Note 2.]

The filing of a motion to dismiss for failure to state a claim upon which relief can be granted tolls the time for filing an answer. [Note 3.] If the motion is filed before the movant's answer, and is denied, the Board will reset the time for filing an answer. As a result, the filing of a motion to dismiss for failure to state a claim upon which relief can be granted also effectively stays the time for the parties to conduct their required discovery conference because the pleadings must be complete and issues joined before the conference is held. *See*TBMP § 316. When a motion to dismiss is denied, or is granted but the plaintiff is given leave to serve an amended pleading, the Board will not only reset the time for the defendant to answer but will also reset the discovery conference deadline and other appropriate dates or deadlines. [Note 4.]

The defense of failure to state a claim upon which relief can be granted may be raised after an answer is filed, provided that it is raised by some means other than a motion to dismiss. For example, the defense may be raised, after an answer is filed, by a motion for judgment on the pleadings, by a motion for summary judgment, or at trial. [Note 5.]

NOTES:

1. Fed. R. Civ. P. 12(b); *Hollowform Inc. v. Delma Aeh*, 180 USPQ 284, 285 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975). *Cf. Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 n.1 (TTAB 1998) (although a Fed. R. Civ. P. 12(b)(6) motion should be filed prior to, or concurrently with the answer, untimeliness waived where Fed. R. Civ. P. 12(b)(6) motion filed three weeks after answer, but plaintiff responded to motion on the merits).

2. *William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870, 1872 (TTAB 1994) ("Just as a motion to dismiss can be interposed in response to an original pleading, so too can it be interposed in response to an amended pleading").

3. *Hollow form, Inc. v. Delma Aeh*, 180 USPQ 284, 285 (TTAB 1973) (motion for default judgment for failure to answer denied), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975).

4. *Cf.* 37 C.F.R. § 2.120(a)(2) and 37 C.F.R. § 2.127(d). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (Aug. 1, 2007) ("Because disclosure is tied to claims and defenses, in general, a defendant's default or the filing of various pleading motions under Federal Rule 12 will effectively stay the parties' obligations to conference and, subsequently, make initial disclosures.").

5. Fed. R. Civ. P. 12(h)(2); *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1436 (TTAB 1995); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990) (construed as motion for judgment on the pleadings); 5B C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL §§ 1357, 1367 (3d ed. 2020). *Cf. Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995) (Fed. R. Civ. P. 12(b)(6) permits defendant to assert in answer a "defense" of failure to state a claim thereby allowing plaintiff to test sufficiency of defense by moving under Fed. R. Civ. P. 12(f) to strike the defense). *Cf. NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1039 n.19 (TTAB 2014) (Board may sua sponte dismiss any insufficiently pleaded pleading).

503.02 Nature of Motion

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. [Note 1.] In order to withstand such a motion, a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has an entitlement to a statutory cause of action to bring the proceeding (formerly referred to as "standing"), *see* TBMP § 309.03(b), and (2) a valid ground exists for denying the registration sought (in the case of an opposition), or for canceling the subject registration (in the case of a cancellation proceeding). [Note 2.] To survive a motion to dismiss, a complaint must "state a claim to relief that is plausible on its face." [Note 3.] In particular, the claimant must allege well-pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements." [Note 4.]

Therefore, a plaintiff served with a motion to dismiss for failure to state a claim upon which relief can be granted need not, and should not respond by submitting proofs in support of its complaint. Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions. [Note 5.]

In Board proceedings, there are certain facts not subject to proof – such as the filing date, filing basis, publication date and applicant's name in an application that is the subject of an opposition proceeding – that the Board may consider when a party has filed a motion to dismiss under Fed. R. Civ. P. 12(b)(6). [Note 6.]

Whenever the sufficiency of any complaint has been challenged by a motion to dismiss, it is the duty of the Board to examine the complaint in its entirety, construing the allegations therein so as to do justice, as required by Fed. R. Civ. P. 8(e), to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought. [Note 7.]

For a further discussion regarding the elements of a complaint, see TBMP § 309.03(a)(2).

NOTES:

1. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 (TTAB 2014); *Corporacion*

Habanos SA v. Rodriguez, 99 USPQ2d 1873, 1874 (TTAB 2011); *Bayer Consumer Care Ag v. Belmora LLC*, 90 USPQ2d 1587, 1590 (TTAB 2009), (quoting, *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007)); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1218 (TTAB 1990); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 753 (TTAB 1985).

2. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 188 (CCPA 1982); *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1874 (TTAB 2011); *Bayer Consumer Care Ag v. Belmora LLC*, 90 USPQ2d 1587, 1590 (TTAB 2009); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theaters*, 56 USPQ2d 1538, 1539 (TTAB 2000); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1462 (TTAB 1992); *Hartwell Co. v. Shane*, 17 USPQ2d 1569, 1570 (TTAB 1990); *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); *Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S.*, 222 USPQ 512, 514 (TTAB 1984).

3. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007) (retiring the pleading standard set forth in *Conley v. Gibson*, 355 U.S. 41 (1957) that dismissal for failure to state a claim is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim). *See also Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (plausibility standard applies to all federal civil claims); *Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1522 (TTAB 2013) (considering plausibility); *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1926 (TTAB 2014) (considering plausibility); *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012) (citing *Ashcroft v. Iqbal*, 556 U.S. 662 (2009); *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1874 (TTAB 2011) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007)).

4. *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (citing *Twombly*, 550 U.S. at 555). *See, e.g., Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1926 (TTAB 2014) (motion to dismiss applicant's fraud, non-use and abandonment counterclaims granted); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 (TTAB 2014).

5. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 n.3 (TTAB 2014).

6. *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1256 (TTAB 2009). In *Compagnie*, the Board noted the difference between the above-noted objective facts, not subject to proof, and the allegations made in an application, such as dates of first use and first use in commerce, and allegations relative to acquired distinctiveness, that are not objective facts, but are subject to proof in an inter partes proceeding.

7. *IdeasOne Inc. v. Nationwide Better Health*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1539 (TTAB 2007) ("under the notice pleading rules applicable to this proceeding opposer is only required to state a valid claim."); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theaters*, 56 USPQ2d 1538, 1539 (TTAB 2000); *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1205 (TTAB 1997); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1711 (TTAB 1993); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1462 (TTAB 1992); *Delta Tire Corp. v. Sports Car Club of America, Inc.*, 186 USPQ 431, 432 (TTAB 1975); *National Semiconductor Corp. v. Varian Associates*, 184 USPQ 62, 64 (TTAB 1974).

503.03 Leave to Amend Defective Pleading

A plaintiff may amend its complaint within 21 days after service of a motion under Fed. R. Civ. P. 12(b)(6) or with the written consent of every adverse party, or by leave of the Board, which is freely given when justice so requires. [Note 1.] See TBMP § 507.02 for further information about the timing for amending a pleading in Board proceedings. Thus, plaintiffs to proceedings before the Board ordinarily can, and often do, respond to a motion to dismiss by filing, inter alia, an amended complaint. If a timely amended complaint is submitted, the original motion to dismiss normally will be moot. [Note 2.]

If no amended complaint is submitted in response to a motion to dismiss for failure to state a claim upon which relief can be granted, and the Board finds, upon determination of the motion, that the complaint fails to state a claim upon which relief can be granted, the Board generally will allow the plaintiff an opportunity to file an amended pleading. [Note 3.]

However, in appropriate cases, that is, where justice does not require that leave to amend be given, the Board, in its discretion, may refuse to allow an opportunity, or a further opportunity, for amendment. [Note 4.] *See*TBMP § 507.02 (regarding motions to amend pleadings).

NOTES:

1. *See* Fed. R. Civ. P. 15(a); *see, e.g., Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1521 (TTAB 2013).

2. *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1926 (TTAB 2014) (finding first motion to dismiss moot in view of filing of amended pleading; considering amended pleading filed in response to second motion to dismiss); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1537 (TTAB 2007) (considering amended pleading, filed in response to motion to dismiss, in connection with the motion to dismiss).

3. *Wise F&I, LLC, et al. v. Allstate Insurance Co.*, 120 USPQ2d 1103, 1110 (TTAB 2016) (allowed time to cure defective pleading); *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1208 (TTAB 1997) (allowed time to perfect fraud claim); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993) ("the Board freely grants leave to amend pleadings found, upon challenge under Fed. R. Civ. P. 12(b)(6), to be insufficient, particularly where challenged pleading is the initial pleading"); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156 (TTAB 1985) (allowed time to file an amended opposition setting forth a statutory ground). *See also Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151, 154 (TTAB 1983) ("Although it is the general practice of the Board to allow a party an opportunity to correct a defective pleading, in the instant case leave to amend the pleading would serve no useful purpose"), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984).

4. Fed. R. Civ. P. 15(a)(2); *Major League Soccer, L.L.C. v. F.C. Internazionale Milano S.p.A.*, 2020 USPQ2d 11488, at *7 (TTAB 2020) (Board did not grant leave to replead opposer's Trademark Act § 2(d) claim due to futility where opposer twice failed to plead prior proprietary rights or a legitimate interest in preventing a likelihood of confusion); *Lacteos de Honduras S.A. v. Industrias Sula, S. De R.L. de C.V.*, 2020 USPQ2d 10087 (TTAB 2020) (motion to dismiss counterclaim based on Article 8 of the Pan-American Convention granted with no leave to amend due to futility of any proposed amendment to pleading); *Sun Hee Jung v. Magic Snow, LLC*, 124 USPQ2d 1041, 1044 (TTAB 2017) (Board did not grant leave to replead opposer's Trademark Act § 2(d) claim due to futility where opposer twice failed to plead prior use); *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1929 n.10 (TTAB 2014) (Board did not grant leave to replead

fraud claim due to futility and lack of plausibility based on recited facts); *Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587, 1590-91 (TTAB 2009) (because petitioner twice failed to properly allege prior use, petitioner's Trademark Act § 2(d) claim was dismissed with prejudice); *Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998) (amendment would be futile because opposers cannot prevail on claim as a matter of law); *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 48 (TTAB 1985) (plaintiff had already been allowed two opportunities to perfect its pleading, therefore, the Board did not find that it was in the interests of justice to grant plaintiff an additional opportunity to amend the complaint); *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151, 154 (TTAB 1983) (amendment would serve no useful purpose), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). *Cf. Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001) (where proposed pleading of dilution was legally insufficient, leave to re-plead not allowed in view of delay in moving to amend); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987) (motion to amend to add claim or defense which is legally insufficient will be denied); *American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855, 859 (TTAB 1986) (would serve no useful purpose).

503.04 Matters Outside the Pleading Submitted on Motion to Dismiss

The circumstances in which the Board will treat a motion to dismiss relying on matters outside the pleadings as a motion for summary judgment are very limited. A party may not file a motion for summary judgment until it has made its initial disclosures, unless the motion is based on issue or claim preclusion or lack of Board jurisdiction. [Note 1.] Treatment of a motion to dismiss under Fed. R. Civ. P. 12(b)(6) as a motion for summary judgment generally would result in a premature motion for summary judgment. [Note 2.] Accordingly, when a motion for summary judgment would be premature, the Board will not consider a motion to dismiss including matter outside the pleading to be a motion for summary judgment, even if the parties treat it as such. [Note 3.]

Where a motion to dismiss is based on issue or claim preclusion or lack of Board jurisdiction, the Board may treat the motion as one for summary judgment, in which case, the parties will be given reasonable opportunity to present all material that is pertinent to the motion. [Note 4.]

NOTES:

1. 37 C.F.R. § 2.127(e)(1). *See Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1522 n.2 (TTAB 2013) (motion to dismiss amended counterclaim accompanied by evidence was not treated as a motion for summary judgment as there was nothing in the record which indicated that initial disclosures were served by opposer); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1108 n.4 (TTAB 2011) (motion to dismiss considered as one for summary judgment where it asserts claim preclusion); *Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment denied as premature where movant had yet to serve initial disclosures). *Cf. Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1873-74 n.2 (TTAB 2011) (Board may consider matters outside the pleading on a motion to dismiss for lack of subject matter jurisdiction under Fed. R. Civ. P. 12(b)(1) without converting to a summary judgment motion).

2. 37 C.F.R. § 2.127(e)(1); *Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009) (motion to dismiss not converted to motion for summary judgment).

3. *See* Fed. R. Civ. P. 12(d); *Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1028 (TTAB 2015) (motion to dismiss that included matters outside of the pleadings not considered as motion for summary judgment because motion was filed before the parties' initial disclosures were due and initial disclosures had not been served); *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 n.2 (TTAB 1998)

(matters excluded); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1436 (TTAB 1996) (matters excluded).

Ordinarily, the parties to the proceeding will be notified when a motion to dismiss is being treated as a motion for summary judgment, and the responding party will be given reasonable opportunity to present all material made pertinent to such a motion by Fed. R. Civ. P. 56. *See* Fed. R. Civ. P. 12(d); *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1044 (Fed. Cir. 1993) ("A movant's challenge to the sufficiency of the complaint as a matter of law, brought under 12(b)(6), is not sufficient notice that the nonmovant must respond as if to a motion for summary judgment, and place material facts in dispute"); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 646 (Fed. Cir. 1983) (Board erred in treating motion to dismiss as a motion for summary judgment without notifying adverse party); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1596 (TTAB 1992), *summary judgment granted*, 24 USPQ2d 1376 (TTAB 1992); *Wells Fargo & Co. v. Lundeen & Associates*, 20 USPQ2d 1156, 1156 (TTAB 1991) (not an appropriate case to treat as summary judgment; extrinsic matters excluded); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1042 n.2 (TTAB 1985); *Exxon Corp. v. National Foodline Corp.*, 196 USPQ 444, 445 (TTAB 1977), *aff'd*, 579 F.2d 1244, 198 USPQ 407, 408 (CCPA 1978). In such a case, notice may be dispensed with as unnecessary, however, where the parties themselves clearly have treated a motion to dismiss as a motion for summary judgment, and the nonmoving party has responded to the motion on that basis. *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1876 n.1 (TTAB 1998) (both parties submitted evidentiary materials outside the pleadings). *Cf. Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 646 (Fed. Cir. 1983) (nonmoving party expected only that sufficiency, not merits of case would be decided).

4. Fed. R. Civ. P. 12(d). *Chutter, Inc. v. Great Concepts, LLC*, 119 USPQ2d 1865, 1870 n.9 (TTAB 2016) (Board sua sponte entered summary judgment in favor of non-movant where parties were previously informed that Board would entertain question of whether res judicata applied to the proceeding and parties were given opportunity to present evidence and argument on that question); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1108 (TTAB 2011) (Board previously informed parties that motions to dismiss in consolidated case would be treated as motions for summary judgment).

504 Motion for Judgment on the Pleadings

504.01 Time for Filing

After the pleadings are closed, but within such time as not to delay the trial, any party to an inter partes proceeding before the Board may file a motion for judgment on the pleadings. [Note 1.] In Board inter partes proceedings, the submission of notices of reliance, declarations and affidavits, as well as the taking of testimony depositions during the assigned testimony periods corresponds to the trial in court proceedings, and the trial period commences with the opening of the first testimony period. [Note 2.] Under the Board's disclosure regime, a party is required to make pretrial disclosures fifteen days prior to the opening of its testimony period. [Note 3.] Thus, in order to avoid a disruption or delay in the trial phase of a Board proceeding, a motion for judgment on the pleadings must be filed before the day of the deadline for pretrial disclosures for the first testimony period, as originally set or as reset. [Note 4.]

When a motion to dismiss for failure to state a claim upon which relief can be granted is filed after the answer, but before the day of the deadline for plaintiff's pretrial disclosures, the Board may construe the motion as a motion for judgment on the pleadings. [Note 5.] *Cf.*TBMP § 503.01 (Time for Filing Motion to Dismiss).

NOTES:

1. Fed. R. Civ. P. 12(c).

2. 37 C.F.R. § 2.116(e); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376, 1377 (TTAB 1986) (the opening of the plaintiff's testimony period marks the beginning of the trial period); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976) (the testimony periods assigned by the Board correspond to a trial in a court proceeding).

3. 37 C.F.R. § 2.121(e); Fed. R. Civ. P. 26(a)(3).

4. *Shared, LLC v. SharedSpaceofAtlanta, LLC* , 125 USPQ2d 1143, 1144 (TTAB 2017) ("[A] motion for judgment on the pleadings must also be filed before the day of the deadline for pretrial disclosures for the first testimony period, as originally set or as reset."). *Cf.* 37 C.F.R. § 2.127(e)(1); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 82 Fed. Reg. 33804 (July 21, 2017) ("The USPTO now amends the rules of practice to make clear that such motions, [i.e., motions to compel, motions to test the sufficiency of responses or objections to requests for admission, or motions for summary judgment], must be filed before the day of the deadline for pretrial disclosures for the first testimony period as originally set or as reset"); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951 (Oct. 7, 2016) ("Under the amended rules motions for summary judgment also have to be filed prior to the deadline for plaintiff's pretrial disclosures for the first testimony period. This avoids disruption of trial planning and preparation through the filing, as late as on the eve of trial, of motions for summary judgment."); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376, 1377 (TTAB 1986) (summary judgment must be filed prior to the opening of plaintiff's testimony period); *Lukens Inc. v. Vesper Corp.*, 1 USPQ2d 1299, 1300 n.2 (TTAB 1986), *aff'd*, 831 F.2d 306 (Fed. Cir. 1987); *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co.*, 226 USPQ 718, 718 (TTAB 1985); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428, 428 n.2 (TTAB 1985); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976) (summary judgment must not delay trial); *Peterson's Ltd. v. Consolidated Cigar Corp.*, 183 USPQ 559, 560 (TTAB 1974); *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 182 USPQ 572, 572-73 (Comm'r 1974).

5. Fed. R. Civ. P. 12(h)(2)(B); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1438 (TTAB 1996); *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1436 (TTAB 1995); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990) (since motion based on defense that petition fails to state claim, standard for adjudicating motion for judgment on pleading is same as Fed. R. Civ. P. 12(b)(6)).

504.02 Nature of Motion

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice. [Note 1.]

For purposes of the motion, all well pleaded factual allegations of the nonmoving party must be accepted as true, while those allegations of the moving party that have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(b)(6), because no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted. [Note 2.] All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. [Note 3.]

A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment, on the substantive merits of the controversy, as a matter of law. [Note 4.]

A party may not obtain a judgment on the pleadings if the nonmoving party's pleading raises issues of fact, which, if proved, would establish the nonmoving party's entitlement to judgment. [Note 5.]

NOTES:

1. *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009), *dismissed in favor of a cancellation proceeding*, slip op. Opposition No. 91185033 (TTAB September 15, 2011); *Land O'Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1958 (TTAB 2008); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008); *Ava Enterprises Inc. v. P.A.C. Trading Group, Inc.*, 86 USPQ2d 1659, 1660 (TTAB 2008); *The Scotch Whisky Association v. United States Distilled Products Co.*, 13 USPQ2d 1711, 1713 n.1 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240 (TTAB 1990), *dismissed*, 18 USPQ2d 1391 (TTAB 1991), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

2. *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009), *dismissed in favor of a cancellation proceeding*, slip op. Opposition No. 91185033 (TTAB September 5, 2011); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008); *Ava Enterprises Inc. v. P.A.C. Trading Group, Inc.*, 86 USPQ2d 1659, 1660 (TTAB 2008); *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1049 (TTAB 1992); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1368 (3d ed. 2020).

3. *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009), *dismissed in favor of a cancellation proceeding*, slip op. Opposition No. 91185033 (TTAB September 5, 2011); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008); *Ava Enterprises Inc. v. P.A.C. Trading Group, Inc.*, 86 USPQ2d 1659, 1660 (TTAB 2008); *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1049 (TTAB 1992); *CBS Inc. v. Mercandante*, 23 USPQ2d 1784, 1787 (TTAB 1992); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1368 (3d ed. 2020).

4. *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009), *dismissed in favor of a cancellation proceeding*, slip op. Opposition No. 91185033 (TTAB September 5, 2011); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008); *Ava Enterprises Inc. v. P.A.C. Trading Group, Inc.*, 86 USPQ2d 1659, 1660 (TTAB 2008); *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1049 (TTAB 1992); *CBS Inc. v. Mercandante*, 23 USPQ2d 1784, 1787 (TTAB 1992); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1367 et seq. (3d ed. 2020).

5. *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1049 (TTAB 1992); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1368 (3d ed. 2020).

504.03 Matters Outside the Pleadings Submitted on Motion for Judgment on Pleadings

The Board is unlikely to treat a motion for judgment on the pleadings, filed prior to the moving party's service of initial disclosures and relying on matters outside the pleadings, as a motion for summary judgment. Treatment of a motion for judgment on the pleadings as a motion for summary judgment generally would result in a premature motion for summary judgment if the moving party had not served its initial disclosures prior to filing the motion. [Note 1.]

If, on a motion for judgment on the pleadings, matters outside the pleading are submitted and not excluded by the Board, the motion will be treated as a motion for summary judgment under Fed. R. Civ. P. 56. [Note 2.] Ordinarily, the parties to the proceeding will be notified that the motion for judgment on the pleadings is being treated as a motion for summary judgment, and they will be given a reasonable opportunity to present all material made pertinent to such a motion by Fed. R. Civ. P. 56. [Note 3.]

Such notice may be unnecessary, however, in those cases where the parties themselves clearly have treated a motion for judgment on the pleadings as a motion for summary judgment, and the nonmoving party has responded to the motion on that basis. [Note 4.]

NOTES:

1. 37 C.F.R. § 2.127(e)(1). *Cf. Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009) (motion to dismiss not converted to motion for summary judgment).

2. *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 n.2 (TTAB 1998) (matters outside the pleading excluded); *DAK Industries Inc. v. Daiichi Kiosho Co.*, 35 USPQ2d 1434, 1436 (TTAB 1995) (exhibits excluded); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 n.5 (TTAB 1990); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983) (because no matters outside the pleading were included with the motion, it was treated as a motion for judgment on the pleadings, not summary judgment).

3. Fed. R. Civ. P. 12(d). *Cf. Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 646 (Fed. Cir. 1983) (Board erred in treating motion to dismiss as motion for summary judgment without notifying nonmoving party); *Chutter, Inc. v. Great Concepts, LLC*, 119 USPQ2d 1865, 1870 n.9 (TTAB 2016) (Board sua sponte entered summary judgment in favor of non-movant after parties were informed that Board would entertain question of res judicata and were given opportunity to present evidence and argument on that question); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 n.5 (TTAB 1990) (did not convert to a summary judgment because the clear thrust of the motion is that petitioner failed to state a claim upon which relief can be granted); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1042 n.2 (TTAB 1985); *Exxon Corp. v. National Foodline Corp.*, 196 USPQ 444, 445 (TTAB 1977), *aff'd*, 579 F.2d 1244, 198 USPQ 407 (CCPA 1978).

4. *Cf. Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 646 (Fed. Cir. 1983) (nonmoving party did not expect Fed. R. Civ. P. 12(b)(6) motion to be treated as one for summary judgment); *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1876 n.1 (TTAB 1998) (both parties submitted evidentiary materials outside the pleadings in support of and in opposition to a Fed. R. Civ. P. 12(b)(6) motion).

505 Motion for a More Definite Statement

Fed. R. Civ. P. 12(e) Motion for a More Definite Statement. *A party may move for a more definite statement of a pleading to which a responsive pleading is allowed but which is so vague or ambiguous that the party cannot reasonably prepare a response. The motion must be made before filing a responsive pleading and must point out the defects complained of and the details desired. If the court orders a more definite statement and the order is not obeyed within 14 days after notice of the order or within the time the court sets, the court may strike the pleading or issue any other appropriate order.*

505.01 Nature of Motion

If, in an inter partes proceeding before the Board, a pleading to which a responsive pleading must be made is so vague or ambiguous that a party cannot reasonably be required to frame a responsive pleading, the responding party may move for a more definite statement. [Note 1.] The motion must point out the defects complained of, specify the details which the movant desires to have pleaded, and indicate that the movant is unable to frame a responsive pleading without the desired information. [Note 2.]

A motion for a more definite statement is appropriate only in those cases where the pleading states a claim upon which relief can be granted, but is so vague or ambiguous that the movant cannot make a responsive pleading in good faith or without prejudice to itself. [Note 3.] If the movant believes that the pleading does not state a claim upon which relief can be granted, its proper remedy is a motion under Fed. R. Civ. P. 12(b)(6) to dismiss for failure to state a claim upon which relief can be granted, not a motion for a more definite statement. [Note 4.]

A motion for a more definite statement may not be used to obtain discovery. The only information that a movant may obtain by this motion is that which it needs to make its responsive pleading. [Note 5.]

NOTES:

1. Fed. R. Civ. P. 12(e); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1377 (3d ed. 2019). *Cf. Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1700 (TTAB 2014) (after considering a motion to dismiss, Board denied motion, but required petitioner to provide a more definite statement of its request for a § 18 modification or restriction to registrant's registration); *CBS Inc. v. Mercandante*, 23 USPQ2d 1784, 1787 n.8 (TTAB 1992) (answer to a counterclaim is not a pleading to which a responsive pleading is permitted).

2. Fed. R. Civ. P. 12(e); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1378 (3d ed. 2019).

3. *See* 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL §§ 1376-77 (3d ed. 2019).

4. *See* 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1376 (3d ed. 2019).

5. *See* 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL §§ 1376-77 (3d ed. 2019).

505.02 Time for Filing

A motion for a more definite statement, if filed, must be filed within the time for, and before, the moving party's responsive pleading. [Note 1.] An extension of time to file a responsive pleading automatically extends the time to file a motion for a more definite statement, unless the Board orders otherwise.

Because a motion for a more definite statement raises issues regarding the complaint of such a nature that the responding party cannot reasonably be required to frame a responsive pleading, generally a party filing such a motion has not filed an answer. Consequently, the time for the parties to conduct their required discovery conference and all subsequent dates are effectively stayed because the pleadings must be complete and issues joined before the conference is held. [Note 2.]

NOTES:

1. Fed. R. Civ. P. 12(e). *Cf. Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1700 (TTAB 2014) (Board required petitioner to provide a more definite statement of its request for a § 18 modification or restriction to registrant's registration, failing which, petition to cancel would be dismissed).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007) ("Because disclosure is tied to claims and defenses, … the filing of various pleading motions under Federal Rule 12 will effectively stay the parties' obligation to conference and, subsequently, make initial disclosures.").

505.03 Failure to Obey Order for More Definite Statement

If the Board, upon motion, issues an order for a more definite statement, and the order is not obeyed within the time specified by the Board, the Board may strike the pleading to which the motion was directed, or make such order as it deems just. [Note 1.]

NOTES:

1. Fed. R. Civ. P. 12(e).

506 Motion to Strike Matter From Pleading

Fed. R. Civ. P. 12(f) Motion to Strike. *The court may strike from a pleading an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. The court may act: (1) on its own; or (2) on motion made by a party either before responding to the pleading or, if a response is not allowed, within 21 days after being served with the pleading.*

506.01 Nature of Motion

Upon motion, or upon its own initiative, the Board may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. [Note 1.] The Board also has the authority to strike an impermissible or insufficient claim or portion of a claim from a pleading. [Note 2.]

Motions to strike are not favored, and matter usually will not be stricken unless it clearly has no bearing upon the issues in the case. [Note 3.] The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. [Note 4.] *See* TBMP § 309.03 (Substance

of Complaint) and TBMP § 311.02 (Substance of Answer). Thus, the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. [Note 5.] A defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. [Note 6.]

Nevertheless, the Board grants motions to strike in appropriate cases. [Note 7.]

NOTES:

1. Fed. R. Civ. P. 12(f); *See Lacteos de Honduras S.A. v. Industrias Sula, S. De R.L. de C.V.*, 2020 USPQ2d 10087 (TTAB 2020) (motion to strike affirmative defense of priority based on Article 7 of the Pan-American Convention granted because such defense is unavailable in an opposition proceeding where opposer has pleaded registrations); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013) (insofar as during briefing of petitioner''s motion for summary judgment, respondent stated that it took no issue with the striking of respondent's affirmative defenses, the Board struck these defenses), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1438 (TTAB 1996) (on its own initiative, the Board struck paragraph Nos. 8 and 9 of the notice of opposition).

2. *Finanz St. Honore, B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1480 (TTAB 2007) (motion to strike counterclaim ground that portion of mark is generic asserted against registration over five years old granted); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999) (motion to strike certain allegations in the counterclaim); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990) (motion to strike allegations of geographic descriptiveness asserted against registration over five years old granted).

3. *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 USPQ 401, 402 (TTAB 1973); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1380 (3d ed. 2020).

4. *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988); *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 47 (TTAB 1985).

5. *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (amplification of applicant's denial of opposer's claims); *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (applicant's affirmative defense amplifies denial of likelihood of confusion); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988) (reasonable latitude permitted in statement of claims).

6. 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1381 (3d ed. 2020).

7. *Finanz St. Honore, B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1480 (TTAB 2007) (counterclaim ground stricken as time-barred); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292, 1295 n.16 (TTAB 1999) (estoppel may not be asserted as a defense against claims of mere descriptiveness or geographic descriptiveness; laches may not be maintained against fraud); *Order of Sons of Italy in America*

v. Profumi Fratelli Nostra AG, 36 USPQ2d 1221, 1223 (TTAB 1995) (defense stricken as redundant, that is, as nothing more than a restatement of a denial in the answer and does not add anything to that denial); *American VitaminProducts, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992) (insufficient affirmative defenses stricken); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990) (ground for cancellation not available for registration over five years old); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571-72 (TTAB 1988) (immaterial allegation stricken); *Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822, 825 (TTAB 1984) (affirmative defense stricken because identical to counterclaim); *W. R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670, 671 (Comm'r 1977) (affirmative defenses stricken as redundant because same allegations formed basis for counterclaim); *Isle of Aloe, Inc. v. Aloe Creme Laboratories, Inc.*, 180 USPQ 794, 794 (TTAB 1974) (complaint stricken for failure to comply with requirement of Fed. R. Civ. P. 10(b) that each numbered paragraph be limited to a single set of circumstances).

506.02 Time for Filing

A motion to strike matter from a pleading should be filed within the time for, and before, the moving party's responsive pleading. [Note 1.] If no responsive pleading is required, the motion should be filed within 21 days after service upon the moving party of the pleading that is the subject of the motion. [Note 2.] However, a motion to strike matter from a pleading will not relieve the defendant from filing its responsive pleading. The issues raised in a motion to strike may be discussed in the discovery conference in the event the parties request Board participation therein; and the non-movant need not file a responsive brief in such a case. A Board attorney will participate in the discovery conference when timely requested to ensure the resolution of the matter. The parties are required to contact the assigned Board attorney to arrange the date and time of the conference. The parties are, of course, encouraged to resolve the issue prior to the case conference. Alternatively, and particularly in the event the parties do not request Board participation in a discovery conference, the parties may fully brief a motion to strike matter from a pleading and the Board will issue a written determination.

However, the Board, upon its own initiative, and at any time, including during a discovery conference, may order stricken from a pleading any insufficient claim or defense or any redundant, immaterial, impertinent, or scandalous matter. [Note 3.] Thus, the Board, in its discretion, may entertain an untimely motion to strike matter from a pleading. [Note 4.] If a motion to strike is filed after the discovery conference, it will be decided like any other pretrial motion.

NOTES:

1. Fed. R. Civ. P. 12(f)(2); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990).

2. Fed. R. Civ. P. 12(f); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992).

3. Fed. R. Civ. P. 12(f); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995).

4. *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); *Western*

Worldwide Enterprises Group Inc. v. Qinqdao Brewery, 17 USPQ2d 1137, 1139 (TTAB 1990); 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1380 (3d ed. 2020).

506.03 Exhibits Attached to Pleadings

The Board usually will not strike exhibits submitted with pleadings since they are clearly contemplated by 37 C.F.R. § 2.122(c) and Fed. R. Civ. P. 10(c). However, except for status and title copies or current printouts from the USPTO's electronic database records containing status and title information of a plaintiff's pleaded registrations filed by the plaintiff with its complaint pursuant to 37 C.F.R. § 2.122(d)(1), exhibits attached to pleadings are not evidence on behalf of the party to whose pleading they are attached unless they are identified and introduced in evidence as exhibits during the testimony period. [Note 1.] *See*TBMP § 317 (Exhibits to Pleadings).

NOTES:

1. 37 C.F.R. § 2.122(c).

507 Motion to Amend Pleading

507.01 In General

Fed. R. Civ. P. 15.

(a) ***Amendments Before Trial.***

(1) ***Amending as a Matter of Course.*** *A party may amend its pleading once as a matter of course within:*

(A) *21 days after serving it, or*

(B) *if the pleading is one to which a responsive pleading is required, 21 days after service of a responsive pleading or 21 days after service of a motion under Rule 12(b), (e), or (f), whichever is earlier.*

(2) ***Other Amendments.*** *In all other cases, a party may amend its pleading only with the opposing party's written consent or the court's leave. The court should freely give leave when justice so requires.*

(3) ***Time to Respond.*** *Unless the court orders otherwise, any required response to an amended pleading must be made within the time remaining to respond to the original pleading or within 14 days after service of the amended pleading, whichever is later.*

(b) ***Amendments During and After Trial.***

(1) ***Based on an Objection at Trial.*** *If, at trial, a party objects that evidence is not within the issues raised in the pleadings, the court may permit the pleadings to be amended. The court should freely permit an amendment when doing so will aid in presenting the merits and the objecting party fails to satisfy the court that the evidence would prejudice that party's action or defense on the merits. The court may grant a continuance to enable the objecting party to meet the evidence.*

(2) ***For Issues Tried by Consent.*** *When an issue not raised by the pleadings is tried by the parties' express or implied consent, it must be treated in all respects as if raised in the pleadings. A party may move – at any time, even after judgment – to amend the pleadings to conform them to the evidence and to raise an unpleaded issue. But failure to amend does not affect the result of the trial of that issue.*

37 C.F.R. § 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 C.F.R. § 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.*

The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. [Note 1.] *See*TBMP § 309.03(a) (Substance of Complaint - In General), TBMP § 311.02 (Substance of Answer), TBMP § 506.01 (Nature of Motion to Strike Matter from Pleading), and cases cited in the foregoing sections. The Board will not entertain claims or defenses that are not asserted in the pleadings as originally filed, or as amended or deemed amended. *See*TBMP § 314 (Unpleaded Matters).

Amendments to pleadings in inter partes proceedings before the Board are governed by Fed. R. Civ. P. 15. [Note 2.] Amendments in general are governed by Fed. R. Civ. P. 15(a). Amendments to conform the pleadings to trial evidence are governed by Fed. R. Civ. P. 15(b).

As a general rule, pleadings in an inter partes proceeding before the Board may be amended in the same manner and to the same extent as in a civil action in a United States district court. There are some exceptions to this rule: (1) after the close of the time for filing an opposition, the notice of opposition may not be amended to add to the goods or services opposed or to add a joint opposer [Note 3.]; (2) an opposition against an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), may not be amended to add a new ground for opposition, goods or services opposed, or a joint opposer [Note 4.]; (3) the scope of the opposed goods and services for an opposition against an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), is limited to the goods and services listed in the ESTTA cover sheet [Note 5.]; (4) the scope of the grounds for an opposition against an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), is limited to the grounds set out in the ESTTA cover sheet, notwithstanding what is set forth in the supporting pleading, [Note 6.]; and (5) the named opposers for an opposition against an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), is limited to those opposers set out in the ESTTA cover sheet [Note 7.]. Thus, an opposition against a Trademark Act § 66(a) application may not be amended to add an entirely new claim; a claim based on an additional registration in support of an existing Trademark Act § 2(d), 15 U.S.C. § 1052(d) claim; a joint opposer; or additional goods and services. [Note 8.] Other amendments, such as those that would amplify or clarify the grounds for opposition, are not prohibited by this rule. [Note 9.]

A signed copy of the proposed amended pleading should accompany a motion for leave to amend a pleading.

The Board recommends submission of a red-lined copy showing the proposed changes along with a clean copy of the proposed amended pleading.

NOTES:

1. *See Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1539 (TTAB 2007) ("... under the notice pleading rules applicable to this proceeding opposer is only required to state a valid claim.").

2. 37 C.F.R. § 2.107, 37 C.F.R. § 2.115, and 37 C.F.R. § 2.116(a).

3. 37 C.F.R. § 2.107(a). *See also Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1436 (TTAB 2007).

4. 37 C.F.R. § 2.107(b). *See also O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1330 (TTAB 2010).

5. *See Prosper Business Development Corp. v. International Business Machines, Corp.*, 113 USPQ2d 1148, 1151-52 (TTAB 2014); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561-62 (TTAB 2011).

6. *See Prosper Business Development Corp. v. International Business Machines, Corp.*, 113 USPQ2d 1148, 1151-52 (TTAB 2014); *CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1962-63 (TTAB 2011). *Cf. Destileria Serralles, Inc. v. Kabushiki Kaisha Donq*, 125 USPQ2d 1463, 1467-68 (TTAB 2017) (granting motion to strike evidence related to opposer's purported common law rights insofar as they were not identified in the ESTTA cover sheet) , *appeal voluntarily dismissed*, No. 18-1608 (Fed. Cir. Aug. 10, 2018).

7. 37 C.F.R. § 2.107(b). *Cf. Prosper Business Development Corp. v. International Business Machines Corp.*, 113 USPQ2d 1148, 1151-52 (TTAB 2014) (USPTO must notify International Bureau of certain required information found in Rule 17 of the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (as in force on Jan. 1, 2013), which includes, inter alia, name of opponent).

8. 37 C.F.R. § 2.107(b).

9. RULES OF PRACTICE FOR TRADEMARK-RELATED FILINGS UNDER THE MADRID PROTOCOL IMPLEMENTATION ACT, 68 Fed. Reg. 55748, 55757 (September 26, 2003).

507.02 Amendments – General Rule – Fed. R. Civ. P. 15(a)

Pursuant to Fed. R. Civ. P. 15(a), a party to an inter partes proceeding before the Board may amend its pleading once as a matter of course within 21 days after serving it. If the pleading is one to which a responsive pleading is required, the pleading may be amended once as a matter of course at any time within 21 days after the responsive pleading is served, or 21 days after service of a motion under Rule 12(b), (e), or (f), whichever is earlier. [Note 1.] As a practical matter, because the time to answer set by the Board's institution order is greater than 21 days, a plaintiff may amend its complaint once as a matter of course beyond the initial 21 days from serving it until the defendant files either an answer or a Rule 12(b), (e) or (f) motion. If proceedings are suspended during this period and later resumed with the time to answer reset, a plaintiff may amend its complaint once as a matter of course until the defendant files an answer or a Rule 12(b), (e) or (f) motion. An amendment filed as a matter of course need not be accompanied by a motion for leave to amend, although it should be captioned as an amended pleading. [Note 2.]

Thereafter, a party may amend its pleading only by written consent of every adverse party or by leave of the Board; and leave must be freely given when justice so requires. [Note 3.] In view thereof, the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. [Note 4.] This is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint, [Note 5.], including a claim based on a registration issued to or acquired by plaintiff after the filing date of the original complaint. [Note 6.] However, the plaintiff in an opposition against a Trademark Act § 66(a), 15 U.S.C. § 1141f(a), application (i.e., a Madrid Protocol application) may not amend the pleading to add an entirely new claim, seek to rely on an additional registration in support of an existing Trademark Act § 2(d), 15 U.S.C. § 1052(d) claim, or after the time for filing an opposition has expired, add a joint opposer or goods or services to the proceeding. [Note 7.] *See*TBMP § 507.01 for a further discussion on limitation to amendments in a notice of opposition against a Madrid application.

A proposed amendment need not set forth a new claim or defense; a proposed amendment may serve simply to amplify allegations already included in the moving party's pleading. [Note 8.] However, where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend. [Note 9.] *Cf.*TBMP § 503.03 (Leave to Amend Defective Pleading). On the other hand, whether or not the moving party can actually prove the allegation(s) sought to be added to a pleading is a matter to be determined after the introduction of evidence at trial or in connection with a proper motion for summary judgment, and the nonmoving party should not argue against granting the moving party leave to amend merely because the nonmoving party believes the moving party will not be able to prove the additional claim or allegations at trial. [Note 10.]

Generally, an amended pleading, if allowed, will supersede any prior pleadings, particularly an amended pleading that is complete in itself and does not adopt or make any reference to the earlier pleadings. [Note 11.]

NOTES:

1. Fed. R. Civ. P. 15(a).

2. Fed. R. Civ. P. 15(a).

3. Fed. R. Civ. P. 15(a). *See also Embarcadero Technologies, Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1523 (TTAB 2016) ("Trademark Rule 2.115, 37 C.F.R. § 2.115, and Fed. R. Civ. P. 15(a) encourage the Board to look favorably on motions to amend pleadings, stating that 'leave shall be freely given when justice so requires.'").

4. *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1414-15 (TTAB 2016) (motion to amend petition after close of trial denied where defendant did not know or agree that the newly asserted claim was being tried, and where plaintiff unduly delayed in moving to amend); *Embarcadero Technologies, Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1523 (TTAB 2016) ("In deciding whether to grant leave to amend, the Board may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings."); *ChaCha Search Inc. v. Grape Technology Group Inc.*, 105 USPQ2d 1298, 1300 (TTAB 2012); *Zanella Ltd. v. Nordstrom Inc.*, 90 USPQ2d 1758, 1759 (TTAB 2008); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007) ("the Board does not grant such leave [to amend the pleading] when entry of the proposed amendment would be prejudicial to the right of the adverse party"); *Hurley International L.L.C. v. Volta*, 82 USPQ2d

1339, 1341 (TTAB 2007); *Karsten Manufacturing Corp. v. Editoy AG*, 79 USPQ2d 1783, 1786 (TTAB 2006); *Polaris Industries v. DC Comics*, 59 USPQ2d 1798, 1799 (TTAB 2001); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1702 (TTAB 2000); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1383 (TTAB 1991); *Huffy Corp. v. Geoffrey, Inc.*, 18 USPQ2d 1240, 1242 (Comm'r 1990); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 n.1 (TTAB 1990); *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732, 1733-34 (TTAB 1990); *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843, 1844 (TTAB 1989); *See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ2d 1395, 1397 (TTAB 1989); *Flatley v. Trump*, 11 USPQ2d 1284, 1286 (TTAB 1989); *Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36, 39-40 (TTAB 1986), *recon. denied*, 1 USPQ2d 1304 (TTAB 1986).

5. *Ashland Licensing & Intellectual Prop. LLC v. Sunpoint International Group USA Corp.*, 119 USPQ2d 1125 (TTAB 2016) (petition to cancel filed when the subject registration is less than five years old tolls the five-year bar set forth in Trademark Act Section 14, 15 U.S.C. § 1064, for the purpose amending the petition to add new claims.); *Hurley International L.L.C. v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007) (fraud claim added); *Karsten Manufacturing Corp. v. Editoy AG*, 79 USPQ2d 1738, 1785-86 (TTAB 2006) (new claim asserts that the requirements of Trademark Act § 44 had been violated); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1702 (TTAB 2000). *See also Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843, 1844 (TTAB 1989); *Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36, 39-40 (TTAB 1986), *recon. denied*, 1 USPQ2d 1304 (TTAB 1986); *American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855, 858-59 (TTAB 1986); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1044 (TTAB 1985); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428, 430-31 (TTAB 1985); *Gemini Engine Co. v. Solar Turbines Inc.*, 225 USPQ 620, 621 n.3 (TTAB 1985). *But see Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1414-15 (TTAB 2016) (motion to amend petition after close of trial denied where defendant did not know or agree that the newly asserted claim was being tried, and where plaintiff unduly delayed in moving to amend).

6. *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866, 1867 (Fed. Cir. 1991) (amendment to add later-acquired registration to tack on prior owner's use); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 (TTAB 1990) (notice of opposition amended during testimony period to add claim of ownership of newly issued registration); *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843, 1844 (TTAB 1989); *Cudahy Co. v. August Packing Co.*, 206 USPQ 759, 759-60 nn. 2-3 (TTAB 1979); *Huffy Corp. v. Geoffrey, Inc.*, 18 USPQ2d 1240, 1241-43 (Comm'r 1990) (opposer's motion to amend to join party and claim ownership of registration granted). *But see UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1045 n.12 (TTAB 2009) (if a party pleads a pending application in the notice of opposition, it may make the resulting registration of record at trial without having to amend its pleading to assert reliance on the registration).

7. 37 C.F.R. § 2.107(b). *See Prosper Business Development Corp. v. International Business Machines, Corp.*, 113 USPQ2d 1148, 1151-52 (TTAB 2014) (because opposer identified Sections 2(d) and 43(c) as grounds for opposition in the ESTTA electronic opposition form, opposer is limited to those grounds for opposition against Madrid application; however, because those grounds were not limited in the form to any particular class or classes, opposer may seek leave to amend to assert those grounds against all of the three international classes in the involved application).

8. *Avedis Zildjian Co. v. D. H. Baldwin Co.*, 180 USPQ 539, 541 (TTAB 1973) (allegations amplified). *Cf. ChaCha Search Inc. v. Grape Technology Group Inc.*, 105 USPQ2d 1298, 1301 (TTAB 2012) (proposed

alleged failure to function as a mark is a new ground, not an amplification of the existing ground that the mark is merely descriptive).

9. *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1785 (Fed. Cir. 1990) (motion to amend to restrict goods would serve no purpose); *Embarcadero Technologies, Inc. v. Dephix Corp.*, 117 USPQ2d 1518, 1523 (TTAB 2016) (because proposed claims are untimely and futile, the motion for leave to amend denied); *The North Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1221-22 (TTAB 2015) (motion for leave to amend answer to add affirmative defense that if the Board should find applicant not entitled to registration of the opposed mark with respect to some but not all goods or services listed in applications, then Applicant should be allowed to amend applications to conform to Board's findings denied for failure to identify goods or services to be deleted); *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1309 (TTAB 2007); *Hurley International L.L.C. v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007); *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 62 USPQ2d 1857, 1858 (TTAB 2002) (amendment denied because Board has no jurisdiction to decide issues arising under state dilution laws), *aff'd*, 300 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003); *Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702-03 (TTAB 2002) (proposed amended pleading of abandonment insufficient and leave to amend denied as futile where opposer asserted applicant's lack of exclusive rights in the mark but failed to include allegation that mark had lost all capacity to act as a source indicator for applicant's goods); *Polaris Industries v. DC Comics*, 59 USPQ2d 1798, 1800 (TTAB 2001) (where proposed pleading of dilution was legally insufficient, leave to re-plead allowed); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1541-42 (TTAB 2001) (where proposed pleading of dilution was legally insufficient, leave to re-plead not allowed in view of delay in moving to amend); *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057, 1059 (TTAB 2000) (motion to add counterclaim denied where mere allegation that opposer did not submit copy of foreign registration at time of examination is insufficient to state claim); *Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998) (opposers could not prevail on res judicata claim as a matter of law); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1506 (TTAB 1993) (claim of lack of bona fide intent to use found legally sufficient); *CBS Inc. v. Mercandante*, 23 USPQ2d 1784, 1786-87 (TTAB 1992) (opposer's attempt to amend answer to add counterclaim denied as inconsistent with notice of opposition).

10. *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992); *Flatley v. Trump*, 11 USPQ2d 1284, 1286 (TTAB 1989).

11. *Jet Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854, 1858 (Fed. Cir. 2000) (citing, inter alia, *Kelley v. Crosfield Catalysts*, 135 F.3d 1202 (7th Cir. 1998)). *See, e.g., Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1136 n.10 (TTAB 2000).

507.02(a) Timing of Motion to Amend Pleading – In General

The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. [Note 1.] A long and unexplained delay in filing a motion to amend a pleading (when there is no question of newly discovered evidence) may render the amendment untimely. [Note 2.]

In order to avoid any prejudice to the adverse party when a motion for leave to amend under Fed. R. Civ. P. 15(a) is granted, the Board may, in its discretion, reopen the discovery period to allow the adverse party to take discovery on the matters raised in the amended pleading. [Note 3.] Exercise of such discretion to reopen discovery, however, may not be necessary when the proposed additional claim or allegation concerns a subject on which the nonmoving party can be expected to have relevant information in hand. This is

especially true when the factual basis for the motion to amend was obtained by the moving party through discovery taken from the nonmoving party.

NOTES:

1. *Ashland Licensing & Intellectual Prop. LLC v. Sunpoint International Group USA Corp.*, 119 USPQ2d 1125 (TTAB 2016) (motion to amend petition granted where delay in filing motion was due to multiple intervening suspensions and, when not actually suspended, reason to believe proceedings would be suspended); *Prosper Business Development Corp. v. International Business Machines, Corp.*, 113 USPQ2d 1148, 1152 (TTAB 2014) (motion for leave to amend to file second amended notice of opposition granted where case was in pleading stage and nonmoving party could point to no specific prejudice in allowing the amendment); *ChaCha Search Inc. v. Grape Technology Group Inc.*, 105 USPQ2d 1298, 1301 (TTAB 2012) (motion for leave to amend counterclaim denied on the bases of undue delay and prejudice to counterclaim defendant where brought after counterclaim plaintiff's pretrial disclosures were served, months after summary judgment motions involving the counterclaim, and months after settlement discussions ceased); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008) (motion for leave to amend to add claims of descriptiveness and fraud denied; petitioner unduly delayed in adding claims which were based on facts within petitioner's knowledge at time petition to cancel was filed); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007) (opposer unduly delayed in filing motion for leave to amend during testimony period); *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002) (motion denied where although discovery still open, movant provided no explanation for two-year delay in seeking to add new claim); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1541 (TTAB 2001) (motion to amend opposition denied where it was filed eight months after filing of notice of opposition, with no explanation for the delay, and appeared to be based on facts within opposer's knowledge at the time opposition was filed); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1703-04 (TTAB 2000) (no undue delay because motion to add claim of dilution was promptly filed after such claim became available, albeit over two years after commencement of proceeding); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286-87 (TTAB 1998) (request raised for the first time in reply brief on counterclaim to further restrict pleaded registration denied since opposer had no notice of this issue); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C., Inc.*, 41 USPQ2d 1030, 1033 (TTAB 1996) (motion to add claim of fraud denied where petitioner was fully aware of all the facts it needed to add such claim over three years before filing motion to amend); *Metromedia Steakhouses Inc. v. Pondco II Inc.*, 28 USPQ2d 1205, 1206-07 (TTAB 1993) (motion filed after close of discovery to assert claim of res judicata based on a judgment entered in another case after the filing of opposition permitted since applicant was afforded adequate notice and no further discovery would be necessary); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505-06 (TTAB 1993) (no undue delay in view of pending motion for summary judgment and discovery was still open when motion was filed); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993) (proceeding still in pretrial stage and discovery had been extended); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992) (motion to amend filed prior to opening of petitioner's testimony period permitted); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 n.1 (TTAB 1990) (opposer's motion to amend its pleading during its testimony period granted in the interests of justice and judicial economy and since any prejudice could be mitigated by reopening discovery solely for applicant); *Marshall Field & Co. v. Mrs. Field's Cookies*, 11 USPQ2d 1355, 1359 (TTAB 1989) ("concept of 'undue delay' is inextricably linked with the concept of prejudice to the nonmoving party"); *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732, 1733-34 (TTAB 1990) (proceeding still in the discovery stage and no undue prejudice shown).

2. *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008) (motion for leave to amend to add claims of descriptiveness and fraud denied; petitioner unduly delayed in adding claims which were based on facts within petitioner's knowledge at time petition to cancel was filed); *Black & Decker*

Corp. v. Emerson Electric Co., 84 USPQ2d 1482, 1486 (TTAB 2007) (opposer unduly delayed in filing motion for leave to amend during testimony period); *Karsten Manufacturing Corp. v. Editoy AG*, 79 USPQ2d 1783, 1786 (TTAB 2006) (motion for leave to amend pleading granted because grounds for new claim was learned during discovery); *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002) (motion denied where although discovery still open, movant provided no explanation for two-year delay in seeking to add new claim); *M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984) (plaintiff should plead any registrations it wishes to introduce as soon as possible after the omission, or newly issued registration, comes to plaintiff's attention).

3. *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2008) ("the only way the Board could avoid prejudice to applicant would be by reopening the trial phase of this proceeding so that applicant could submit evidence addressing this ground [whether applicant had a *bona fide* intent to use its mark]"); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1703-04 (TTAB 2000) (reopened for limited purpose of conducting discovery on new claim); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 n.1 (TTAB 1990) (reopened solely for applicant's benefit); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428, 431 (TTAB 1985) (applicant to advise whether it would need additional discovery).

507.02(b) Timing of Motion to Amend to Add Counterclaim

Counterclaims to cancel pleaded registrations in Board proceedings are governed by 37 C.F.R. § 2.106(b)(3)(i) and 37 C.F.R. § 2.114(b)(3)(i). As provided therein, a defense attacking the validity of a pleaded registration is a compulsory counterclaim if the grounds for the counterclaim exist at the time the answer is filed or are learned during the course of the proceeding. [Note 1.] A motion for leave to amend an answer to assert a counterclaim is governed by Fed. R. Civ. P. 15(a). [Note 2.] If, during the proceeding, the defendant learns of grounds for a counterclaim to cancel a registration pleaded by the plaintiff, the counterclaim should be pleaded promptly after the grounds therefor are learned. [Note 3.] TBMP § 313.04 (Compulsory Counterclaims).

NOTES:

1. *Jive Software, Inc. v. Jive Communications, Inc.* , 125 USPQ2d 1175, 1175-80 (TTAB 2017) (motions to amend to assert a compulsory counterclaim should be examined in combination with Fed. R. Civ. P. 15(a), overruling *TBC Corp. v. Grand Prix* , 12 USPQ2d 1311 (TTAB 1989), *Turbo Sportswear Inc. v. Marmot Mountain Ltd.* , 77 USPQ2d 1152, 1154 (TTAB 2005), and other precedent to the extent they interpreted 37 C.F.R § 2.106 or 37 C.F.R § 2.114(b)(3)(1) as barring an amendment to add a compulsory counterclaim unless such motion is based on newly-acquired evidence).

2. 37 C.F.R § 2.106(b)(3)(1) and 37 C.F.R § 2.114(b)(3)(i); *Jive Software, Inc. v. Jive Communications, Inc.*, 125 USPQ2d 1175, 1177 (TTAB 2017).

3. *Jive Software, Inc. v. Jive Communications, Inc.* , 125 USPQ2d 1175, 1180 (TTAB 2017) ("[W]hile our rules require application of the liberal standard for amendment set out in the Federal Rules, it is important to emphasize that all claims, including counterclaims and defenses, should be pleaded promptly, and that an unexplained delay in filing a motion to amend a pleading may result in a finding that the amendment is untimely."). **Please note:** motions to amend to assert compulsory counterclaims decided prior to *Jive Software, Inc. v. Jive Communications, Inc.* , 125 USPQ2d 1175 (TTAB 2017) may have been decided under a more stringent standard which no longer may be controlling.37 C.F.R. § 2.106(b)(3)(i) and 37 C.F.R. § 2.114(b)(3)(i); *Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989) (asserting claim as separate petition to cancel rather than counterclaim does not obviate timeliness requirements of 37 C.F.R. § 2.114(b)(2)(i)) redesignated § 2.114(b)(3)(i); *Zanella Ltd. v. Nordstrom Inc.*,

90 USPQ2d 1758, 1759 (TTAB 2008); *Turbo Sportswear Inc. v. Marmot Mountain Ltd.*, 77 USPQ2d 1152, 1154 (TTAB 2005) ("we must determine whether applicant knew of the grounds at the time it filed its answers and, if not, whether applicant filed its counterclaims promptly upon learning of those grounds"); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1033 (TTAB 1996); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1596 (TTAB 1992) (filing of an answer is not a condition precedent to operation of 37 C.F.R. § 2.106(b)(2)(i), redesignated § 2.106(b)(3)(i) where grounds are learned during course of proceeding), *summary judgment granted*, 24 USPQ2d 1376 (TTAB 1992); *Marshall Field & Co. v. Mrs. Field's Cookies*, 11 USPQ2d 1355, 1359 (TTAB 1989) (counterclaim was pleaded promptly after defendant obtained information through discovery concerning possible fraud).

507.03 Amendments to Conform to the Evidence - Fed. R. Civ. P. 15(b)

Fed. R. Civ. P. 15(b) Amendments During and After Trial.

(1) Based on an Objection at Trial. *If, at trial, a party objects that evidence is not within the issues raised in the pleadings, the court may permit the pleadings to be amended. The court should freely permit an amendment when doing so will aid in presenting the merits and the objecting party fails to satisfy the court that the evidence would prejudice that party's action or defense on the merits. The court may grant a continuance to enable the objecting party to meet the evidence.*

(2) For Issues Tried by Consent. *When an issue not raised by the pleadings is tried by the parties' express or implied consent, it must be treated in all respects as if raised in the pleadings. A party may move — at any time, even after judgment — to amend the pleadings to conform them to the evidence and to raise an unpleaded issue. But failure to amend does not affect the result of the trial of that issue.*

507.03(a) During Trial After Objection to Trial Evidence

If evidence is objected to at trial on the ground that it is not within the issues raised by the pleadings, the Board, upon motion, may allow the pleadings to be amended (except as prohibited by 37 C.F.R. § 2.107) and will do so freely when the presentation of the merits of the case will be served thereby and the objecting party fails to satisfy the Board that the admission of such evidence would prejudice it in maintaining its action or defense upon the merits. [Note 1.] *See*TBMP § 315 (Amendment of Pleadings). See also TBMP § 507.01 regarding amendment of pleadings in an opposition against a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) application.

The motion for leave to amend should be filed promptly by the party offering the evidence after the objection is made by an adverse party. If the motion is granted, the Board may extend the objecting party's testimony period, or reopen discovery for that party, if necessary, to enable the objecting party to meet the evidence that was the subject of the objection. [Note 2.]

NOTES:

1. Fed. R. Civ. P. 15(b); *Ercona Corp. v. JENAer Glaswerk Schott & Gen.*, 182 USPQ 573, 574 (TTAB 1974).

2. Fed. R. Civ. P. 15(b). *Cf. Buffett v. Chi Chi's, Inc.*, 226 USPQ 428, 431 (TTAB 1985); *Anheuser-Busch, Inc. v. Martinez*, 185 USPQ 434, 435 (TTAB 1975); *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471, 473 (TTAB 1971).

507.03(b) To Add Issues Tried by Express or Implied Consent

When issues not raised by the pleadings are tried by the express or implied consent of the parties, unless prohibited by 37 C.F.R. § 2.107, the Board will treat them in all respects as if they had been raised in the pleadings. [Note 1.] *See*TBMP § 315 and TBMP § 507.01 regarding amendment of pleadings in an opposition against a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) application. Any amendment of the pleadings necessary to cause them to conform to the evidence and to raise the unpleaded issues may be made upon motion of any party at any time, even after judgment, but failure to so amend will not affect the result of the trial of these issues. [Note 2.]

Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. [Note 3.] Fairness dictates whether an issue has been tried by consent – there must be an absence of doubt that the nonmoving party is aware that the issue is being tried. [Note 4.]

Inasmuch as the Board does not read trial testimony or examine other trial evidence prior to final hearing, it is the practice of the Board, when confronted with a Fed. R. Civ. P. 15(b) motion to amend the pleadings to include an issue assertedly tried by express or implied consent, to defer determination of the motion until final hearing. [Note 5.] *Cf.*TBMP § 502.01 (Available Motions).

NOTES:

1. *See e.g.*, *Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1186 (TTAB 2014) (prior to opening of the testimony period, leave to amend granted to add counterclaim to partially cancel registrations on basis of abandonment; parties briefed the counterclaim as a Section 18 restriction, and at oral hearing, party expressly consented to trying counterclaim in that manner; Board deemed pleadings amended under Fed. R. Civ. P. 15(b)(2)); *Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1306 (TTAB 2014) (nonownership claim tried by implied consent under Fed. R. Civ. P. 15(b)(2)); *Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828-29 (TTAB 2013) (answer deemed amended to include a Section 18 affirmative defense); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009).

2. Fed. R. Civ. P. 15(b); *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185, 187 (Fed. Cir. 1984) (motion to amend to add abandonment submitted after filing of trial briefs denied because the issue had not been tried); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1650, 1655-56 (TTAB 2010) (Board deemed unpleaded affirmative defense of tacking by prior use of an unpleaded mark to have been tried by implied consent pursuant to Fed. R. Civ. P. 15(b)), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Nextel Communications, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1399 (TTAB 2009) (although opposer did not plead issue preclusion as a ground for opposition, because applicant did not object to opposer's assertion of that ground in its brief and, in fact, addressed the issue in its brief, the Board deemed the pleadings to be amended pursuant to Fed. R. Civ. P. 15(b)); *DC Comics v. Pan American Grain Manufacturing Co.*, 77 USPQ2d 1220, 1223 (TTAB 2005) (opposer introduced into evidence two unpleaded registrations and applicant did not object and treated them as of record, therefore, the Board deemed the pleading amended pursuant to Fed. R. Civ. P. 15(b)); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1653 n.2 (TTAB 2002) (opposition deemed amended to include opposer's claim of ownership of previously unpleaded registrations where opposer filed notice of reliance on those registrations at trial and applicant did not object thereto); *Linville v. Rivard*, 41 USPQ2d 1731, 1735 n.9 (TTAB 1996) (certain abandonment issues while not pleaded were clearly tried by the parties and argued in their trial briefs), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Kasco Corp. v. Southern Saw Service*

Inc., 27 USPQ2d 1501, 1504 (TTAB 1993) (functionality was tried by implied consent, such consent having been given by defendant prior to trial).

3. *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1414-15 (TTAB 2016) (motion to amend petition after close of trial denied where defendant did not know or agree that the newly asserted claim was being tried, and where plaintiff unduly delayed in moving to amend); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1872 n.3 (TTAB 2011) (although opposer did not properly plead its fame for purposes of dilution, the Board deemed the dilution claim amended by implied consent); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1924-27 (TTAB 2011) (1. petitioner's rights in unpleaded marks tried by implied consent, and Board deemed pleadings to be amended to conform to the evidence, where plaintiff stated the relevance of the submissions under notices of reliance, emphasized its intention to rely on such marks through testimony, and where respondent did not object to the testimony at the time, was afforded an opportunity to cross-examine, and raised an untimely objection; and 2. unpleaded tacking and prior registration defense were not tried by implied consent where petitioner not fully appraised of respondent's reliance on use and registration of another mark), *aff'd*, 188 F. Supp. 3d 22 (D.D.C. 2016), *appeal docketed*, No. 17-17075 (D.C. Cir. May 3, 2017); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720-21 (TTAB 2008) (opposer objected to the testimony and argument regarding applicant's use of an unpleaded mark and therefore applicant's priority based on the use of that mark was not tried by implied consent), *on appeal*, No. 1:11-cv-01623-RC (D.D.C.); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1653 n.2 (TTAB 2002) (where opposer, during trial, filed notice of reliance on seven unpleaded registrations and where applicant did not object thereto, Board found parties had tried by implied consent, any issues arising from those registrations); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 (TTAB 1998) (applicant did not object to testimony but was not fairly apprised that evidence, which also related to existing claim, was being offered in support of unpleaded claim); *Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 28 USPQ2d 1464, 1471 n.11 (TTAB 1993), *recon. denied*, 36 USPQ2d 1328 (TTAB 1994) (party was not fairly apprised that evidence used for a pleaded claim of descriptiveness was also being offered in support of unpleaded Trademark Act § 2(d) claim); *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ 2d 1501, 1504 (TTAB 1993) (defendant raised no objection to evidence on unpleaded issue but was fairly apprised of its purpose).

4. *Wise F&I, LLC v. Allstate Ins. Co.*, 120 USPQ2d 1103, 1107 (TTAB 2016) ("A plaintiff must plead ownership of a family of marks in its complaint in order to rely on the marks as a family as a basis for sustaining the opposition at trial or in a motion for summary judgment."); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1927 (TTAB 2011) (petitioner's "family of marks" claim, raised for the first time in its brief not considered because it was neither pleaded nor tried by the parties), *aff'd*, 188 F. Supp.3d 22, (D.D.C. 2016), *appeal docketed*, No. 17-17075 (D.C. Cir. May 3, 2017); *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1034-35 (TTAB 2010) (applicant was not aware opposer intended to rely on registration to prove likelihood of confusion until opposer filed rebuttal notice of reliance); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1139 (TTAB 2009).

5. *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 (TTAB 1998) (consistent with its practice, the Board deferred ruling on the motion until final hearing); *Devries v. NCC Corp.*, 227 USPQ 705, 708 n.7 (TTAB 1985); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 1861-62 (TTAB 1981); *New York State Office of Parks and Recreation v. Atlas Souvenir & Gift Co.*, 207 USPQ 954, 956, 959 (TTAB 1980); *Plus Products v. Redken Laboratories, Inc.*, 199 USPQ 111, 117 (TTAB 1978).

508 Motion for Default Judgment for Failure to Answer

If a defendant fails to file an answer to a complaint during the time allowed therefor, the Board, on its own initiative, may issue a notice of default allowing the defendant time 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.] *See*TBMP § 312.

The issue of whether default judgment should be entered against a defendant when it fails 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 concurrently filed late answer be accepted. However the issue is raised, the standard for determining whether default judgment should be entered against the defendant for its failure to file a timely answer to the complaint is the Fed. R. Civ. P. 55(c) standard, which requires that the defendant show good cause why default judgment should not be entered against it. *See*TBMP § 312.

If a plaintiff files a motion for default judgment for failure of the defendant to file a timely answer to the complaint, and the defendant fails to file a brief in opposition to the plaintiff's motion, default judgment may be entered against defendant. [Note 2.]

If a defendant files an answer after the due date therefor, but before the issuance by the Board of a notice of default, and also files a motion asking that the late-filed answer be accepted, and the plaintiff fails to file a brief in opposition to the defendant's motion, the motion may be granted as conceded. [Note 3.] *See*TBMP § 502.02(b).

Whenever a defendant is in default, and regardless of whether the issue is raised by notice of default from the Board, or one of the referenced motions addressing the issue, a defendant's failure to file a timely answer tolls all deadlines including the time for the parties to conduct the required discovery conference. When the Board addresses the default in a way that obviates the default, for example, by denying plaintiff's motion for a default judgment or by granting defendant's motion for acceptance of its late-filed answer, the Board will reset appropriate dates, including the deadline for the parties to conduct the discovery conference. [Note 4.]

For further information concerning default judgment for failure of the defendant to file a timely answer to the complaint, see TBMP § 312.

NOTES:

1. 37 C.F.R. § 2.106(a) and 37 C.F.R. § 2.114(a); Fed. R. Civ. P. 55(a) and 55(b); *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1480 (TTAB 2007) (Board entered notice of default in consolidated cancellation, allowing defendant 30 days to show cause why judgment should not be entered for failure to file an answer); *DeLorme Publishing Co. v. Eartha's, Inc.*, 60 USPQ2d 1222, 1223-24 (TTAB 2000) (good cause not shown where failure to answer was based on belief that notice of opposition was "incomplete").

2. Fed. R. Civ. P. 55(b) and 55(c); 37 C.F.R. § 2.127(a) (the Board may treat the motion as conceded).

3. 37 C.F.R. § 2.127(a).

4. 37 C.F.R. § 2.106(a) and 37 C.F.R. § 2.114(a).

509 Motion to Extend Time; Motion to Reopen Time

Fed. R. Civ. P. 6(b) Extending Time.

(1) ***In General.*** *When an act may or must be done within a specified time, the court may, for good cause, extend the time:*

(A) *with or without motion or notice if the court acts, or if a request is made, before the original time or its extension expires; or*

(B) *on motion made after the time has expired if the party failed to act because of excusable neglect.*

(2) ***Exceptions.*** *A court must not extend the time to act under Rules 50(b) and (d), 52(b), 59(b), (d), and (e), and 60(b), except as those rules allow.*

37 C.F.R. § 2.120(a) ***Discovery.***

(a) ***In general.***

(1) *… The Board will specify the deadline for a discovery conference, the opening and closing dates for the taking of discovery and the deadlines within the discovery period for making initial disclosures and expert disclosure. The trial order setting these deadlines and dates will be included within the notice of institution of the proceeding.*

(2)(i) *The discovery conference shall occur no later than the opening of the discovery period, …. The discovery period will be set for a period of 180 days.*

(ii) *Initial disclosures must be made no later than thirty days after the opening of the discovery period.*

(iii) *Disclosure of expert testimony must occur in the manner and sequence provided in Rule 26(a)(2) of the Federal Rules of Civil Procedure, unless alternate directions have been provided by the Board in an institution order or any subsequent order resetting disclosure, discovery or trial dates. If the expert is retained after the deadline for disclosure of expert testimony, the party must promptly file a motion for leave to use expert testimony. Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the Board, either on its own initiative or on notice from either party of the disclosure of expert testimony, may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert.*

(iv) *The parties may stipulate to a shortening of the discovery period, that there will be no discovery, that the number of discovery requests or depositions be limited, or that reciprocal disclosures be used in place of discovery. Limited extensions of the discovery period may be granted upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If the motion for an extension is denied, the discovery period may remain as originally set or as reset. Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board, but the expert disclosure deadline must always be scheduled prior to the close of discovery. If a stipulation or motion for modification is denied, disclosure deadlines may remain as originally set or reset and obligations may remain unaltered.*

***

(3) *A party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board, or by order of the Board. Discovery depositions must be properly noticed and taken during the discovery period. Interrogatories, requests for production of documents and things, and requests for admission must be served*

early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses will be due no later than the close of discovery. Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within thirty days from the date of service of such discovery requests. The time to respond may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board, but the response may not be due later than the close of discovery. The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

37 C.F.R. § 2.121 ***Assignment of times for taking testimony and presenting evidence.***

(a) *The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's required pretrial disclosures and assigning to each party its time for taking testimony and presenting evidence ("testimony period"). No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion granted by the Board, or by order of the Board. The deadlines for pretrial disclosures and the testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion to reschedule any pretrial disclosure deadline and/or testimony period is denied, the pretrial disclosure deadline or testimony period and any subsequent remaining periods may remain as set. The resetting of the closing date for discovery will result in the rescheduling of pretrial disclosure deadlines and testimony periods without action by any party. The resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party.*

* * * *

(c) *A testimony period which is solely for rebuttal will be set for fifteen days. All other testimony periods will be set for thirty days. The periods may be shortened or extended by stipulation of the parties approved by the Trademark Trial and Appeal Board, or may be extended upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the testimony periods and their associated pretrial disclosure deadlines may remain as set.*

(d) *When parties stipulate to the rescheduling of a deadline for pretrial disclosures and subsequent testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of subsequent deadlines for pretrial disclosures and testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, shall be submitted to the Board through ESTTA, with the relevant dates set forth and an express statement that all parties agree to the new dates.*

(e) *A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. However, no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises., … If a party does not plan to take testimony from any witness, it must so state in its pretrial disclosure. When a party fails to make required pretrial disclosures, any adverse party or parties may have a remedy by way of a motion to the Board to delay or reset any subsequent pretrial disclosure deadlines and/or testimony periods. ...*

37 C.F.R. § 2.127(a) ***[Motions]*** *... Except as provided in paragraph (e)(1) of the section, a brief in response to a motion shall be filed within twenty days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. If a motion for*

an extension is denied, the time for responding to the motion remains as specified under this section, unless otherwise ordered. Except as provided in paragraph (e)(1) of this section, a reply brief, if filed, shall be filed within twenty days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended or reopened. ...

509.01 Nature of Motions

Pursuant to Fed. R. Civ. P. 6(b), made applicable to Board proceedings by 37 C.F.R. § 2.116(a), a party may file a motion for an extension of the time in which an act may or must be done. [Note 1.] If the motion is filed prior to the expiration of the period as originally set or previously extended, the motion is one to extend a period that has not yet closed (often referred to as a motion to "extend"), and the moving party need only show good cause for the requested extension. If, however, the motion is not filed until after the expiration of the period as originally set or previously extended, the motion is one to extend a period that has closed (often referred to as a motion to "reopen"), and the moving party must show that its failure to act during the time allowed therefor was the result of excusable neglect. [Note 2.] An exception to the usual requirement for showing excusable neglect when the period for taking an action has expired arises when a defendant is in default because its time to answer has expired. In such circumstances, the showing required is good cause to excuse the default. *See*TBMP § 312 and TBMP § 508.

NOTES:

1. *Compare* 37 C.F.R. § 2.127(a) ("The time for filing a reply brief [on a motion] will not be extended or reopened.") *with* 37 C.F.R. § 2.127(e)(1) ("The time for filing a motion under [Fed. R. Civ. P.] 56(d) will not be extended").

2. Fed. R. Civ. P. 6(b). *See also Vital Pharmaceuticals, Inc. v. Kronholm*, 99 USPQ2d 1708, 1710 n.10 (TTAB 2011) ("The Board construes a motion to extend an expired period as a motion to reopen such period.").

509.01(a) Motions to Extend Time

A motion to extend must set forth with particularity the facts said to constitute good cause for the requested extension; mere conclusory allegations lacking in factual detail are not sufficient. [Note 1.]

Moreover, a party moving to extend time must demonstrate that the requested extension of time is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor. [Note 2.] The Board will "scrutinize carefully" any motion to extend time, to determine whether the requisite good cause has been shown. [Note 3.]

For further information concerning good cause for a motion to extend, see the cases cited in the note below. [Note 4.]

If a motion to extend the time for taking action is denied, the time for taking such action may remain as previously set. [Note 5.] If a motion to extend trial dates is filed after the deadline for discovery but prior to the deadline for pretrial disclosures and the motion is granted by the Board, all deadlines beginning with the pretrial disclosure deadline, and including the time for filing a motion for summary judgment, will be extended. [Note 6.] If a defendant's motion to extend its time to file an answer is granted, the order granting the motion will usually include a resetting of all subsequent deadlines or dates, including the discovery conference, disclosures, discovery and testimony periods.

The time for filing a reply brief on a motion will not be extended, even upon the parties' consent. In addition, while the time for filing a brief in response to a motion for summary judgment may be extended, the time for filing, in lieu thereof, a motion for discovery under Fed. R. Civ. P. 56(d) will not be extended. [Note 6.] *See*TBMP § 528.06.

NOTES:

1. *SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372, 1373 (TTAB 2001) (opposers had not come forward with "detailed facts" required to carry their burden explaining their inaction); *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducali SCRL*, 59 USPQ2d 1383, 1384 (TTAB 2001) ("Opposer's counsel, in his declaration, has set forth the facts relating to his other litigation matters in sufficient detail to warrant a finding that good cause exists for at least a limited extension of opposer's testimony period"); *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000) (motion denied where party failed to provide detailed information regarding apparent difficulty in identifying and scheduling its witnesses for testimony and where sparse motion, containing vague reference to possibility of settlement, demonstrated no expectation that proceedings would not move forward during any such negotiations); *Instruments SA Inc. v. ASI Instruments Inc.*, 53 USPQ2d 1925, 1927 (TTAB 1999) (cursory or conclusory allegations that were denied unequivocally by the nonmovant and were not otherwise supported by the record did not constitute a showing of good cause); *Luemme, Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1760-61 (TTAB 1999) (sparse motion contained insufficient facts on which to find good cause); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) ("The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto.").

2. *National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1854 (TTAB 2008) ("the Board is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith and the privilege of extension is not abused" and the moving party has the burden of persuading the Board that it was diligent in meeting its responsibilities; motion denied because opposer failed to make the minimum showing necessary to establish good cause to extend discovery); *Luemme, Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1760-61 (TTAB 1999) (diligence not shown; discovery requests not served until last day of the discovery period); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (applicant's motion to extend discovery denied when counsel knew of unavailability of witness a month before, yet delayed until last day to seek an agreement on an extension of time).

3. *Luemme, Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1760-61 (TTAB 1999).

4. *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888, 891 (CCPA 1980) (an attorney has no right to assume that extensions of time will always be granted, and there appears no reason why a brief was not timely filed); *Trans-High Corp. v. JFC Tobacco Corp.*, 127 USPQ2d 1175, 1176-77 (TTAB 2018) (good cause found to extend close of discovery even though extension served to "reopen" time to serve discovery requests); *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1383-84 (TTAB 2001) (the press of other litigation may constitute good cause to extend but alleged deficiencies in discovery responses not good cause to extend discovery where timely motion to compel was not filed); *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.*, 61 USPQ2d 1542, 1543-44 (TTAB 2001) (petitioner failed to explain how activity of rearranging its laboratory facilities during relevant time period prevented taking testimony; no detailed information regarding petitioner's apparent difficulty in preparing and submitting its evidence or why petitioner waited until the last day of its testimony period to request the extension); *SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372, 1373 (TTAB 2001) (attorney's unwarranted and untimely

request for permission to withdraw from representation of party viewed as bad faith attempt to obtain an extension of time); *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000) (mere existence of settlement negotiations or proposals, without more, would not justify delay in proceeding with testimony); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (while maternity leave may constitute good cause, in this case defendant's counsel knew that defendant would not be able to comply with deadline, yet waited until penultimate day of response period to file unconsented motion to extend time); *Instruments SA Inc. V. ASI Instruments, Inc.*, 53 USPQ2d 1925, 1927 (TTAB 1999) (plaintiff's claim of ongoing bilateral settlement negotiations was rebutted by defendant, and no other reason for plaintiff's failure to proceed with discovery was shown); *Luemme, Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1760-61 (TTAB 1999) (plaintiff failed to set forth detailed facts concerning the circumstances - plaintiff's allegedly busy travel schedule - which necessitated the extension, and record showed that need for extension in fact resulted from plaintiff's delay and lack of diligence during previously-set discovery period).

5. 37 C.F.R. § 2.120(a)(2)(iv) (discovery period); 37 C.F.R § 2.121(a) (testimony period); 37 C.F.R. § 2.127(a) (time for responding to a motion); 37 C.F.R. § 2.127(e)(1) (time for responding to a summary judgment motion); *National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008) (in view of the denial of opposer's motion to extend discovery, "discovery dates remain as originally set and as a result, the discovery period is closed"); *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.*, 61 USPQ2d 1542, 1544 (TTAB 2001) (petitioner's testimony period consequently expired where motion to extend testimony period was denied and dates were left as originally set); *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1479 (TTAB 2000); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000); *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1760-61 (TTAB 1999). *Cf. C.H. Stuart Inc. v. Carolina Closet, Inc.*, 213 USPQ 506, 507 (TTAB 1980) (three-day testimony period for opposer reset "putting opposer in the same position it would have been in had no motion to compel been filed."). *See also* NOTICE OF FINAL RULEMAKING, 63 Fed. Reg. 48081, 48091 (September 9, 1998).

6. *Covidien LP v. ERBE Elektromedizin GmbH*, 2019 USPQ2d 265006 (TTAB 2019) (unrestricted consented motion to extend deadlines filed prior to deadline for plaintiff's pretrial disclosure, once granted, was effective before the deadline and motion for summary judgment was timely).

7. 37 C.F.R. § 2.127(a) and 37 C.F.R. § 2.127(e)(1). *See McDonald's Corp. v. Cambrige Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013) (parties' stipulation to add five days to service by email was improper agreement to automatically extend time to file reply brief or a motion under Fed. R. Civ. P. 56(d)).

509.01(b) Motions to Reopen Time

509.01(b)(1) In General

Where the time for taking required action, as originally set or as previously reset, has expired, a party desiring to take the required action must file a motion through ESTTA to reopen the time for taking that action. The movant must show that its failure to act during the time previously allotted therefor was the result of excusable neglect. *See* Fed. R. Civ. P. 6(b)(1)(B). But see discussion in TBMP § 508 regarding requirement only to show good cause to obtain reopening of time for defendant to file an answer to a complaint.

The analysis to be used in determining whether a party has shown excusable neglect was set forth by the Supreme Court in *Pioneer Investment Services Co. v. Brunswick Associates L.P.* , 507 U.S. 380 (1993),

adopted by the Board in *Pumpkin Ltd. v. The Seed Corps* , 43 USPQ2d 1582 (TTAB 1997). These cases hold that the excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay, including (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith. [Note 1.] See also cases cited throughout this section and in TBMP § 534.02 regarding motions to dismiss under 37 C.F.R. § 2.132, and TBMP § 544 regarding motions for relief from final judgment.

The "prejudice to the nonmovant" contemplated under the first *Pioneer* factor must be more than the mere inconvenience and delay caused by the movant's previous failure to take timely action, and more than the nonmovant's loss of any tactical advantage that it otherwise would enjoy as a result of the movant's delay or omission. Rather, "prejudice to the nonmovant" is prejudice to the nonmovant's ability to litigate the case, e.g., where the movant's delay has resulted in a loss or unavailability of evidence or witnesses that otherwise would have been available to the nonmovant. [Note 2.]

It has been held that the third *Pioneer* factor, i.e., "the reason for the delay, including whether it was within the reasonable control of the movant," may be deemed to be the most important of the *Pioneer* factors in a particular case. [Note 3.] Additionally, although many excusable neglect decisions which were issued prior to the Board's 1997 *Pumpkin* decision may no longer be controlling under the somewhat more flexible excusable neglect standard set out in *Pioneer* and *Pumpkin* (e.g., decisions holding that a failure to act due to counsel's docketing errors is, per se, not the result of excusable neglect), they nonetheless may be directly relevant to the Board's analysis under the third *Pioneer* excusable neglect factor. [Note 4.] For additional cases involving the excusable neglect standard, see TBMP § 534 (Motion for Judgment for Plaintiff's Failure to Prove Case) and TBMP § 544 (Motion for Relief from Final Judgment).

A party moving to reopen its time to take required action must set forth with particularity the detailed facts upon which its excusable neglect claim is based; mere conclusory statements are insufficient. [Note 5.]

In addition, for purposes of making the excusable neglect determination, it is irrelevant that the failure to timely take the required action was the result of counsel's neglect and not the neglect of the party itself. Under our system of representative litigation, a party must be held accountable for the acts and omissions of its chosen counsel. [Note 6.]

NOTES:

1. *Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507 U.S. 380, 395 (1993); *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997). *See, e.g., Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1892-93 (TTAB 2010) (weighing all four factors together, motion to reopen discovery denied; opposer's "oversight" in failing to timely serve initial disclosures and seek an extension of the discovery period does not constitute excusable neglect).

2. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1587 (TTAB 1997) (citing *Pratt v. Philbrook*, 109 F.3d 18 (1st Cir. 1997)); *Paolo's Associates L.P. v. Bodo*, 21 USPQ2d 1899, 1904 (Comm'r 1990).

3. *See FirstHealth of the Carolinas Inc. v. CareFirst of Maryland Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1921-22 (Fed. Cir. 2007) (Court affirmed finding of no excusable neglect based on second and third factors, with third weighed heavily in the analysis); *Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1879 (TTAB 2012) (applicant made a calculated strategic decision, within its control, not to take discovery in the hope opposer had lost interest in the case, even though the parties held settlement discussions and opposer requested an extension of the discovery period before it closed); *Old Nutfield Brewing Co. v. Hudson Valley*

Brewing Co., 65 USPQ2d 1701, 1702 (TTAB 2002); *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 n.7 (TTAB 1997). *See also Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307-08 (TTAB 2007) (respondent's mistaken belief that counsel for petitioner would agree to an extension request did not relieve respondent of its duty to adhere to appropriate deadlines); *Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000) (failed to provide specific reasons for former counsel's inaction); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (counsel's press of other business, docketing errors and misreading of relevant rule are circumstances wholly within counsel's control); *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998) (failed to provide evidence linking the reason for the delay with the expiration of movant's testimony period); *Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858, 1859-60 (TTAB 1998) (failure to timely move to extend testimony period was due to counsel's oversight and mere existence of settlement negotiations did not justify party's inaction or delay).

4. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586-87 n.8 (TTAB 1997). Such pre- *Pioneer* cases include, *e.g.*, *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1712 (Fed. Cir. 1991) (no excusable neglect where plaintiff's counsel unreasonably relied on defendant's counsel to sign and file plaintiff's proposed stipulated motion to extend trial dates); *American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1315-16 (TTAB 1992) (defendant's desire to take follow-up discovery and its uncertainty regarding status of plaintiff's pending motion to strike affirmative defenses did not excuse respondent's neglect in failing to file timely motion to extend discovery); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (no excusable neglect where defendant's failure to timely respond to certain discovery requests was due to defendant's oversight or lack of care in reading discovery requests); *Consolidated Foods Corp. v. Berkshire Handkerchief Co.*, 229 USPQ 619, 621 (TTAB 1986) (no excusable neglect where defendant's failure to timely respond to summary judgment motion was due to counsel's press of other litigation); *Coach House Restaurant, Inc. v. Coach and Six Restaurants, Inc.*, 223 USPQ 176 (TTAB 1984) (same).

5. *See Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000) (no specific reasons for former counsel's inaction); *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998) (no factual details as to the date of counsel's death in relation to plaintiff's testimony period or as to why other lawyers in deceased counsel's firm could not have assumed responsibility for the case).

6. *Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507 U.S. 380, 396 (1993) (citing *Link v. Wabash R. Co.*, 370 U.S. 626 (1962) and *United States v. Boyle*, 469 U.S. 241 (1985)); *Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1373 (TTAB 2000); *CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1302-03 (TTAB 1999); *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997).

509.01(b)(2) To Introduce Newly Discovered Evidence

If a party files a motion to reopen its testimony period to introduce newly discovered evidence, the moving party must show not only that the proposed evidence has been newly discovered, but also that the evidence could not have been discovered earlier through the exercise of reasonable diligence. [Note 1.] However, even if a sufficient showing of due diligence has been made, the Board will not automatically reopen a party's testimony period for introduction of the new evidence. The Board must also consider such factors as the nature and purpose of the evidence sought to be brought in, the stage of the proceeding, and prejudice to the nonmoving party. [Note 2.]

NOTES:

1. *Harjo v. Pro-Football, Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998); *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354, 360-61 n.11 (TTAB 1984); *Rowell Laboratories, Inc. v. Canada Packers Inc.*, 215 USPQ 523, 529 n.2 (TTAB 1982) (improper to attempt to introduce newly discovered evidence by way of rebuttal testimony rather than moving to reopen testimony period); *Oxford Pendaflex Corp. v. Rolodex Corp.*, 204 USPQ 249, 254 n.5 (TTAB 1979); *Tektronix, Inc. v. Daktronix, Inc.*, 187 USPQ 588, 589 n.1 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Wilson Sporting Goods Co. v. Northwestern Golf Co.*, 169 USPQ 510, 511-12 (TTAB 1971); *Chemetron Corp. v. Self-Organizing Systems, Inc.*, 166 USPQ 495, 499 n.6 (TTAB 1970); *United States Plywood Corp. v. Modiglass Fibers, Inc.*, 125 USPQ 144, 145 (TTAB 1960).

2. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886-87 (TTAB 2008) (the Board declined to reopen applicant's testimony period after the briefs had been filed because (1) the newspaper article sought to be introduced into evidence was not probative of opposer's intent to abandon its mark and (2) an abandonment claim could only be entertained through a counterclaim to cancel opposer's registration which would be prejudicial to opposer at such a late date); *Harjo v. Pro-Football, Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998) (newly discovered evidence was cumulative and redundant and did not have significant probative value to justify further delay of case) (newly discovered evidence was hearsay in nature and pertained to unpleaded defense) (citing *Canadian Tire Corp. Ltd. v. Cooper Tire & Rubber Co.*, 40 USPQ2d 1537, 1539 (Comm'r 1996)).

509.02 Form and Determination of Motions to Extend or Reopen

If a motion to extend or a motion to reopen is made with the consent of the nonmoving party, the motion may be filed either as a stipulation with the signature of both parties, or as a consented motion in which the moving party states that the nonmoving party has given its consent thereto. Parties may file a motion solely to extend or reopen, or caption and incorporate such a motion into another motion, e.g. to compel, strike, etc.

Ordinarily, a consented motion to extend or reopen will be granted by the Board. However, after an answer has been filed, the Board is unlikely to grant even a consented motion to extend the deadline for the parties to conduct the required discovery conference when the basis for the motion is the existence of settlement discussions. [Note 1.] Similarly, because all written discovery must be completed during the discovery period, the Board will not grant a motion to extend time to respond to discovery requests beyond the close of discovery, even upon consent or stipulation. If a party wishes to extend time to respond to discovery requests, and such an extension contemplates a date after the close of discovery, a party should concurrently move to extend the close of discovery. [Note 2.]

If the parties file a stipulation or consented motion to extend or reopen a defendant's time to file an answer to the complaint, the stipulation should specify the new due date for the answer, and all subsequent dates that require rescheduling when the due date for the answer is reset, including the deadline for the required discovery conference, disclosures, discovery and trial. A consented motion to extend or reopen testimony periods and the deadlines for pretrial disclosures, or the discovery period, testimony periods and deadlines for disclosures must be filed with the Board through ESTTA and should be submitted in the form used in a trial order, specifying the closing date for each period to be reset. [Note 3.] If a consented motion to extend or reopen testimony periods, or the discovery period and testimony periods, specifies only the closing date for the first period to be reset, and the motion is approved, the Board will automatically reschedule the subsequent periods as well, including the dates for remaining disclosures. [Note 4.] However, receipt by the

parties of the Board's action on the motion will be delayed, because the Board will have to prepare an order specifying the closing date for each period being rescheduled.

When the parties agree to a new schedule of dates and file for approval using the "consent motions" option in ESTTA, the system will prompt the filer to enter new deadlines in a manner that will automatically generate an appropriate schedule in the proper form. If the calculator provided by ESTTA does not reflect all or the correct deadlines required by the parties' agreed-upon schedule, the filing party should select the "general filings" option in ESTTA and attach or embed in the motion the agreed-upon schedule.

When the Board notes that a consented or stipulated motion to extend time is based on the asserted existence of the parties' settlement negotiations, the Board may suspend proceedings, sua sponte, for any suitable period of time, including up to six months, to enable the parties to concentrate on settlement and to obviate the filing of numerous extension requests. Such suspension shall be made subject to either party's right to request resumption of proceedings at any time. *See*TBMP § 510.03(a). However, after a period of time of extensions or suspension, the parties may be required to report on the progress of their settlement discussions; and periodically thereafter. While settlement is encouraged, the Board also has an interest in seeing its cases conclude in a timely manner. [Note 5.]

When a motion to extend, or a motion to reopen, is filed without the consent of the nonmoving party, the Board normally will defer action on the motion until after the expiration of the nonmoving party's time to file a brief in opposition to the motion. If the nonmoving party fails to file a brief in opposition thereto, the Board will normally grant the motion as conceded. [Note 6.] A motion not stated to be consented will not be granted as conceded until after passage of sufficient time for filing and receipt by the Board of a brief in response. In the case of a telephone conference, the responding party may be excused from filing a responsive brief. *See*TBMP § 502.06(a). If the nonmoving party contests a motion by filing a responsive brief or by presenting responsive arguments in a telephone conference, the Board will decide the motion on its merits. *See*TBMP § 502.02(b) (Briefs on Motions) and TBMP § 509.01 regarding the standards to be applied in deciding contested motions to extend or reopen time.

A party must not assume that its motion to extend (much less a motion to reopen) made without the consent of the adverse party will always be granted as a matter of course. [Note 7.] Moreover, while the Board attempts, where possible, to notify the parties of its decision on an unconsented motion to extend, or a motion to reopen, prior to expiration of the enlargement sought, the Board is under no obligation to do so, and in many cases cannot. [Note 8.] *Cf.*TBMP § 202.01. Therefore, it is preferable, at least where an unconsented motion seeks an extension or a reopening of a testimony period or periods and pretrial disclosures, or of the discovery period and testimony periods and disclosures, that the motion request that the new period or periods be set to run from the date of the Board's decision on the motion. However, in the event that the motion to extend or reopen time is denied, the time for taking required action may remain as previously set. [Note 9.]

When the Board resets the closing date for discovery, the expert disclosure deadline, which is 30 days prior to the close of the discovery period, and the testimony periods, including pretrial disclosure deadlines, will automatically be reset. However, the resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods-such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. [Note 10.]

A party should not presume that the Board will automatically reset discovery, disclosure and/or trial dates when it determines the pending motion. When the Board determines a pending motion, and there is no motion to extend discovery, disclosure and/or trial dates, the Board, in the exercise of its discretion, may or

may not reset relevant dates. A party that wishes to have particular deadlines or periods reset upon the determination of a particular motion should file a motion requesting such action, or caption and include a request to reset the dates in its pending motion, further specifying the deadlines or periods that it wishes to have reset. [Note 11.]

Extensions of time to seek judicial review of a final decision of the Board (whether by way of appeal to the Court of Appeals for the Federal Circuit or by way of a civil action) may be granted by the Director upon written request, which should be directed to the Office of the Solicitor, not the Board. [Note 12.] *See*TBMP § 902.02 (Time for Filing Notice of Appeal) and TBMP § 903.04 (Time for Filing Civil Action).

NOTES:

1. *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767 n.1 (TTAB 2008) ("It is unlikely the Board will find good cause for a motion to extend or suspend for settlement if the motion is filed after answer but prior to the discovery conference, precisely because the discovery conference itself provides an opportunity to discuss settlement.") (citing MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007)).

2. 37 C.F.R. § 2.120(a)(3).

3. 37 C.F.R. § 2.121(d).

4. 37 C.F.R. § 2.121(a).

5. 37 C.F.R. § 2.117(c). *Cf. Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 n.2 (Fed. Cir. 2004) ("RHL's applications languished at the United States Patent and Trademark Office ("PTO") for nearly two decades as the result of the parties' failure to move the applications and corresponding oppositions forward.").

6. 37 C.F.R. § 2.127(a).

7. *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888, 891-92 (CCPA 1980) (after granting numerous extensions of time to respond to motion for summary judgment, last request denied and motion for summary judgment granted as conceded).

8. *Luemme, Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999) (waiting for Board approval of previous extension request insufficient to justify resetting of dates); *see also Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888, 891 (CCPA 1980). *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273, 275-76 (Fed. Cir. 1984); and *In re L.R. Sport Inc.*, 25 USPQ2d 1533, 1534 (Comm'r 1992).

9. *See* 37 C.F.R. § 2.120(a), 37 C.F.R. § 2.120(a)(1), 37 C.F.R. § 2.121(c), 37 C.F.R. § 2.127(a) and 37 C.F.R. § 2.127(e)(1). *See also Luemme, Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1760 (TTAB 1999).

10. 37 C.F.R. § 2.120(a)(2)(iv), 37 C.F.R. § 2.121(a) and 37 C.F.R. § 2.121(a)(3).

11. *See, e.g.*, 37 C.F.R. § 2.120(a)(3); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 n.6 (TTAB 2013) (party should not presume that Board will automatically reset discovery when it determines a pending motion, where motion filed one day prior to the closing date of the discovery period).

12. 37 C.F.R. § 2.145(e).

510 Motion to Suspend; Motion to Resume

37 C.F.R. § 2.117 ***Suspension of proceedings.***

(a) *Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.*

(b) *Whenever there is pending before the Board both a motion to suspend and a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered regardless of the order in which the motions were filed.*

(c) *Proceedings may also be suspended sua sponte by the Board, or, for good cause, upon motion or a stipulation of the parties approved by the Board. Many consented or stipulated motions to suspend are suitable for automatic approval by ESTTA, but the Board retains discretion to condition approval on the party or parties providing necessary information about the status of settlement talks, discovery activities, or trial activities, as may be appropriate.*

37 C.F.R. § 2.120(f)(2) *When a party files a motion for an order to compel initial disclosures, expert testimony disclosure, or discovery, the case will be suspended by the Board with respect to all matters not germane to the motion. After the motion to compel is filed and served, no party should file any paper that is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of a motion to compel any disclosure or discovery shall not toll the time for a party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. If discovery has closed, however, the parties need not make pretrial disclosures until directed to do so by the Board.*

37 C.F.R. § 2.127(d) *When any party timely files a potentially dispositive motion, including, but not limited to, a motion to dismiss, a motion for judgment on the pleadings, or a motion for summary judgment, the case is suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise may be specified in Board's suspension order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.*

37 C.F.R. § 2.146(g) *The mere filing of a petition to the Director will not act as a stay in any ... inter partes proceeding that is pending before the Trademark Trial and Appeal Board ... except when a stay is specifically requested and is granted ...*

37 C.F.R. § 2.124(d)(2) *... Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written questions.*

510.01 In General

Flowing from the Board's inherent power to schedule disposition of the cases on its docket is the power to stay proceedings, which may be exercised by the Board upon its own initiative, upon motion, or upon

stipulation of the parties approved by the Board. [Note 1.] Some of the most common reasons for suspension are discussed below.

NOTES:

1. *See* 37 C.F.R. § 2.117; *Schering-Plough Animal Health Corp. v. Aqua Gen AS*, 90 USPQ2d 1184, 1185 (TTAB 2009); *Carrini, Inc. v. Carla Carini, S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000); *Opticians Association of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021, 2029 (D.N.J. 1990) ("The power to stay a cancellation proceeding resides only in the Board itself.") (citing *The Other Tel. Co. v. Conn. National Tel. Co.*, 181 USPQ 779, 782 (Comm'r 1974)), *rev'd on other grounds*, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).

510.02 Suspension Pending Outcome of Another Proceeding; Resumption

510.02(a) Suspension

Whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action that may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action. [Note 1.]

Most commonly, a request to suspend pending the outcome of another proceeding seeks suspension because of a civil action pending between the parties in a federal district court. Although the Supreme Court held that issue preclusion can be based on a decision by the Board in a case in which the ordinary elements of issue preclusion are met, the Board's policy to suspend in favor of a civil action has not changed. A civil action may involve other matters outside Board jurisdiction and may consider broader issues beyond right to registration and, therefore, judicial economy is usually served by suspension. [Note 2.]

Further, pursuant to 37 C.F.R. § 2.117(a), the Board may also, in its discretion, suspend a proceeding pending the final determination of another Board proceeding in which the parties are involved [Note 3.], or a civil action pending between the parties in a state court [Note 4.], or a foreign action between the parties, wherein one party challenges the validity of a foreign registration upon which the other party's subject application is based [Note 5.], or an arbitration pending between the parties [Note 6], or even another proceeding in which only one of the parties is involved. [Note 7.]

Unless there are unusual circumstances, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board. [Note 8.]

The Board seldom grants a motion to suspend a particular proceeding pending disposition of other opposition or cancellation proceedings brought by unrelated plaintiffs against the same application or registration, and asserting unrelated claims, absent the consent of the other parties. [Note 9.] An exception may be made for purposes of consistency and economy where there are common claims in the separate proceedings. The Board may then order suspension of the other proceedings pending disposition of the proceeding that appears closest to issuance of a final decision. [Note 10.] If the multiple proceedings are at the same stage of litigation and plead the same claims, the Board may order consolidation. [Note 11.]

Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board; the court in which a civil action is pending has no power to suspend proceedings in a case before the Board [Note 12.], nor do parties or their attorneys. [Note 13.] However, if, as sometimes happens, the court before which a civil action is pending elects to suspend the civil action to await

determination of the Board proceeding and the Board is so advised, the Board will go forward with its proceeding. [Note 14.]

When a motion to suspend pending the outcome of a civil action is filed, the Board normally will require that a copy of the operative pleadings from the civil action be submitted, so that the Board can ascertain whether the final determination of the civil action may have a bearing on the issues before the Board. [Note 15.] This requirement ordinarily is waived if all parties consent to the suspension. *See* TBMP § 502. When the suspension is consented to by all parties, the filer should use the "consent motions" option in ESTTA, which requires that the filer certify that the adverse party has consented to the suspension. If an adverse party has not consented, the filing must still be made via ESTTA, but the filer should select the "general filings" option from the drop-down menu instead of the "consent motions" option. *See* 37 C.F.R. § 2.126(a), TBMP § 110 and http://estta.uspto.gov for information regarding filing via ESTTA.

The Board does not usually require that an issue be joined (i.e., that an answer be filed) in one or both proceedings before the Board will consider suspending a Board proceeding pending the outcome of another proceeding. [Note 16.] Such a requirement is made only in those cases where there is no stipulation to suspend and it is not possible for the Board to ascertain, prior to the filing of an answer in one or both proceedings, whether the final determination of the other proceeding may have a bearing on the issues before the Board.

If there is pending, at the time when the question of suspension of proceedings before the Board is raised, a motion that is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered. [Note 17.] The purpose of this rule is to prevent a party served with a potentially dispositive motion from escaping the motion by filing a civil action and then moving to suspend before the Board has decided the potentially dispositive motion. However, the Board, in its discretion, may elect to suspend without first deciding the potentially dispositive motion.

NOTES:

1. 37 C.F.R. § 2.117(a). *See General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1936-37 (TTAB 1992); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689, 692 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125, 126-27 (TTAB 1974); *petition denied*, 181 USPQ 779 (Comm'r 1974); *Tokaido v. Honda Associates Inc.*, 179 USPQ 861, 862 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 806-07 (TTAB 1971).

2. *See, e.g., B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 U.S. 1293, 135 S. Ct. 1293, 113 USPQ2d 2045, 2048, 2053, 2056 (2015) ("[A] court should give preclusive effect to TTAB decisions if the ordinary elements of issue preclusion are met." (2048); "When a district court, as part of its judgment, decides an issue that overlaps with part of the TTAB's analysis, the TTAB gives preclusive effect to the court's judgment." (2053); and "So long as the other ordinary elements of issue preclusion are met, when the usages adjudicated by the TTAB are materially the same as those before the district court, issue preclusion should apply." (2056)); *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988) (doctrine of primary jurisdiction might be applicable if a district court action involved only the issue of registrability, but would not be applicable where court action concerns infringement where the interest in prompt adjudication far outweighs the value of having the views of the USPTO); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F. Supp. 563, 2 USPQ2d 1208, 1211 (D. Minn. 1986) (primary jurisdiction should not be invoked where, inter alia, a stay of the district court action is more likely to prolong the dispute than lead to its economical disposition and where the district court action includes claims which cannot be raised before the Board); *Zachry Infrastructure LLC v. American Infrastructure Inc.*, 101 USPQ2d

1249, 1253-54 (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 focus on right to registration; issue preclusion based on district court determination found); *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (decision by district court may be binding on the Board, but determination by the Board of a defendant's right to obtain or maintain a registration would not be ... res judicata in the court proceeding); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689, 692 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977).

Cf. Piano Wellness, LLC v. Williams, 126 USPQ2d 1739, 1741 (TTAB 2018) (district court's direction to the Commissioner of Trademarks to "transfer the application" to plaintiff exceeds the court's statutory authority to rectify the register under Section 37 of the Trademark Act, which is limited to registrations, not pending applications).

Cf. Zachry Infrastructure LLC v. American Infrastructure Inc., 101 USPQ2d 1249, 1253 n.6 (TTAB 2011) (district court may have lacked jurisdiction to entertain a counterclaim to refuse registration because the involved mark was the subject of an application, not a registration); *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840, 1844-45 (TTAB 1995) (district court finding concerning priority of use not binding in view of differences in interpretation of Trademark Act § 7(c) by Board and court, and finding regarding priority of secondary meaning not binding because said issue was not involved in the Board proceeding).

3. *Cf. The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (suspended pending outcome of ex parte prosecution of opposer's application).

4. *See Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394, 395 (Fed. Cir. 1983) (noting stay based in part on state court infringement action); *Professional Economics Incorporated v. Professional Economic Services, Inc.*, 205 USPQ 368, 376 (TTAB 1979) (decision of state court, although not binding on the Board, was considered persuasive on the question of likelihood of confusion); *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366, 367 (TTAB 1975) (state court action to determine ownership of applicant's mark and authority of applicant to file application).

5. *See Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905, 1909 (TTAB 2014) (Board suspended proceedings pending receipt of pleadings and other documentation to determine whether proceeding in the United Kingdom may have a bearing in Board proceeding); *Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792, 1793-94 (TTAB 1993) (opposition suspended pending decision of German court on validity of foreign registration which is the basis of the U.S. application involved in the opposition).

6. *See Hu v. TJ Food Services, LLC*, 123 USPQ2d 1777, 1781 (TTAB 2017) (maintaining suspension to afford parties the opportunity to commence arbitration).

7. *See Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905, 1909 (TTAB 2014) (Board suspended proceedings pending receipt of pleadings and other documentation to determine whether proceeding in the United Kingdom may have a bearing in Board proceeding); *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366, 367 (TTAB 1975) (state court action between applicant and third party to determine ownership of applicant's mark).

8. 37 C.F.R. § 2.117(a). *See, e.g., New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (civil action need not be dispositive of Board proceeding, but only needs to have a bearing on issues before the Board); *General Motors Corp v. Cadillac Club Fashions, Inc.*, 22 USPQ2d 1933, 1936-37 (TTAB 1992) (relief sought in federal district court included an order directing Office to cancel registration involved in cancellation proceeding); *Other Telephone Co. v. Connecticut National*

Telephone Co., 181 USPQ 125, 126-27 (TTAB 1974) (decision in civil action for infringement and unfair competition would have bearing on outcome of Trademark Act § 2(d) claim before Board), *pet. denied*, 181 USPQ 779 (Comm'r 1974). *See also Tokaido v. Honda Associates Inc.*, 179 USPQ 861, 862 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 806-07 (TTAB 1971); *Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568, 570 (TTAB 1971).

But see Boyds Collection Ltd. v. Herrington & Co., 65 USPQ2d 2017, 2018-19 (TTAB 2003) (petitioner's motion to suspend filed after trial denied as untimely, and in any event, petition was dismissed since petitioner's only proffered evidence had been stricken); *E.I. du Pont de Nemours & Co. v. G.C. Murphy Co.*, 199 USPQ 807, 808 n.3 (TTAB 1978); *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429, 430 (TTAB 1973) (in each case, a motion to suspend filed after the conclusion of testimony and briefing periods, when the Board proceeding was ready for decision, was denied).

9. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1551 (TTAB 2011).

10. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011).

11. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011).

12. *See Opticians Association of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990) (district court has no control over Board docket and no power to stay Board proceedings), *rev'd on other grounds*, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).

13. *See Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568, 570 (TTAB 1971).

14. *See Tigercat International, Inc. v. Caterpillar, Inc.*, 127 USPQ2d 1132 (D. Del. 2018) (district court granted motion to stay its action in lieu of pending Board proceeding finding it to be a case of "tactical gamesmanship;" party filed district court action only ten days before the close of three years of contentious discovery and two months before the start of trial in Board proceeding).

15. *See Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905, 1909 (TTAB 2014) (party ordered to submit status of and pleadings from a foreign action between the parties so Board may ascertain whether final determination of that proceeding may have a bearing on the issues before the Board); *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (Board will scrutinize pleadings in civil action to determine if the issues before the court may have a bearing on the Board's decision); *Forest Laboratories Inc. v. G.D. Searle & Co.*, 52 USPQ2d 1058, 1060 (TTAB 1999) (parties required to submit a copy of the complaint in the civil action so that Board may determine whether suspension is warranted); *SCOA Industries Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411, 415 (TTAB 1975), *appeal dismissed*, 189 USPQ 15 (CCPA 1976).

16. *See Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125, 126-27 (TTAB 1974).

17. *See* 37 C.F.R. § 2.117(b). *See also Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2018-19 (TTAB 2003) (motion to strike petitioner's notice of reliance, its only evidence in the case, decided before motion to suspend, and granted).

510.02(b) Resumption

When a proceeding before the Board has been suspended pending the outcome of another proceeding, and that other proceeding has been finally determined, the interested party should promptly notify the Board in writing of the disposition of the other proceeding, and request that further appropriate action be taken in the Board proceeding. Usually, the interested party requests, as a result of the decision in the other proceeding, that judgment be entered in its behalf on one or more issues in the Board proceeding. [Note 1.] A copy of the decision in the other proceeding should accompany the notification. The Board will then issue a show cause order as to why judgment on the identified issues should not be entered in favor of the moving party. Absent any such notification as to the final determination of the civil action, cases that have been suspended pending civil action will usually remain in a suspended status for one year before the Board will issue an order requiring the parties to provide the status of the civil action.

A proceeding is considered to have been finally determined when an order or ruling that ends litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has expired. The expiration of any further review includes the time for petitioning for rehearing or U.S. Supreme Court review. The Board does not resume its proceedings until after the time for seeking such review has expired, a decision denying or granting such review has been rendered, and any further review has been completed.

NOTES:

1. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) ("Within twenty days after the final determination of the civil action, opposer must so notify the Board so that this case may be called up for appropriate action.").

510.03 Suspension for Other Reasons; Resumption

510.03(a) Suspension

The Board suspends proceedings in cases before it for a wide variety of reasons including those discussed below.

Upon motion or upon stipulation. Proceedings may be suspended for good cause upon motion or stipulation of the parties approved by the Board. [Note 1.] For example, proceedings may be suspended, upon motion or stipulation under 37 C.F.R. § 2.117(c), for purposes of settlement negotiations, subject to the right of either party to request resumption at any time. [Note 2.] However, the Board generally will not approve a motion or stipulation to suspend filed after answer and before the discovery conference without a sufficient showing of good cause. The mere desire to engage in settlement discussions is unlikely to constitute good cause for a suspension of the deadline for the discovery conference because the discovery conference itself provides the parties an opportunity to discuss settlement. [Note 3.] In addition, if, during the course of the proceedings, a motion to extend time indicates that the parties are negotiating for settlement, the Board may, in lieu of granting the requested extension, suspend proceedings for a specified time, usually six months, subject to resumption by either party at any time. *See* TBMP § 509.02.

Note, however, that the Board will not suspend proceedings indefinitely upon allegations of settlement talks, discovery activities, or trial activities. After a period of time, the Board may require the parties to file a detailed report on the progress of their settlement, discovery, or trial activities. Further, the Board may, in its discretion, deny further suspension when the parties have already been granted a reasonable time to

engage in settlement, discovery, or trial activities. While parties are encouraged to settle their cases and have a duty to cooperate in the discovery process, the Board has an interest in seeing its cases conclude in a timely manner. [Note 4.]

The parties may also agree to suspend proceedings for consideration of a matter by an examining attorney, including the disposition of a party's application before the examining attorney. [Note 5.]

Bankruptcy. The Board will issue an order suspending proceedings if it comes to the attention of the Board that the defendant has filed a petition for bankruptcy. [Note 6.] Under the automatic stay provisions of Section 362 of the United States Bankruptcy Code, 11 U.S.C. § 362, a petition for bankruptcy (filed under Section 301, 302, or 303 of the Code, 11 U.S.C. § 301, 302, or 303) operates as a stay, inter alia, of the commencement or continuation of a judicial, administrative, or other action or proceeding against the debtor that was or could have been commenced before the commencement of the bankruptcy case. However, if it is the plaintiff in the Board proceeding, rather than the defendant, who has filed a petition for bankruptcy, the automatic stay provisions do not mandate the suspension of the Board proceeding unless there is a counterclaim in the Board proceeding for cancellation of the plaintiff's registration(s). Nonetheless, for good cause shown, the Board may suspend a proceeding based upon a plaintiff's bankruptcy.

Withdrawal of counsel. If, in a Board proceeding, a party's attorney or other authorized representative files a request to withdraw as counsel for the party, and the request is granted, the Board will suspend proceedings and allow the party a stated period of time (usually 30 days) in which to appoint a new attorney or, if a U.S.-domiciled party, to file a paper stating that it intends to represent itself (i.e., proceed pro se), failing which the Board may issue an order to show cause why default judgment should not be entered against the party. [Note 7.] *See*, with respect to withdrawal of counsel, TBMP § 116.02-TBMP § 116.05 and TBMP § 513.01. For information concerning action by the Board after expiration of the time allowed in the suspension order, see TBMP § 510.03(b). A party may inform the Board of the appointment of new counsel either by filing written notification thereof (as, for example, by filing a copy of the new appointment), or by having new counsel make an appearance on the party's behalf in the proceeding. *See*TBMP § 114.03 (Representation by Attorney). *See also*TBMP § 114.04 (Representation by Non-Lawyer) and TBMP § 114.05 (Representation by Foreign Attorney).

Potentially dispositive motion. When a party to a Board proceeding timely files a motion that is potentially dispositive of the proceeding, such as a motion to dismiss, [Note 8.] a motion for judgment on the pleadings, or a motion for summary judgment, the case is considered automatically suspended by operation of 37 C.F.R. § 2.127(d) with respect to all matters not germane to the motion. [Note 9.]

The timely filing of such a potentially dispositive motion itself operates to suspend a case. When issuing its suspension order or subsequent order on the motion, the Board will ordinarily treat the proceeding as if it had been suspended as of the filing date of the potentially dispositive motion. [Note 10.] In addition to tolling the time to respond to outstanding discovery requests, suspension of proceedings tolls the time for parties to make required disclosures. On a case-by-case basis, however, the Board may find that the filing of a potentially dispositive motion does not provide a party with good cause for failing to comply with an otherwise outstanding obligation. [Note 11.]

Once a timely filed potentially dispositive motion operates to suspend proceedings in a case, no party should file any paper that is not germane to the motion, except as otherwise may be specified in a Board order. [Note 12.]

Motion to compel. Pursuant to 37 C.F.R. § 2.120(f) when a party files a motion to compel initial disclosures, expert disclosures or discovery, the Board will issue an order suspending the proceeding with respect to all

matters not germane to the motion, [Note 13.] and no party should file any paper that is not germane to the discovery dispute, except as otherwise specified in the Board's suspension order. However, neither the filing of a motion to compel nor the Board's resulting suspension order tolls the time for parties to respond to any outstanding discovery requests that had been served prior to the filing of the motion to compel, nor does it excuse a party's appearance at any discovery deposition that had been duly noticed prior to the filing of the motion to compel, nor does it excuse a party from making any required discovery disclosures. When the motion to compel is filed after discovery has closed, the parties need not make pretrial disclosures until directed to do so by the Board. [Note 14.] *See*TBMP § 523 regarding motions to compel.

Motion to divide. A registration or application that is the subject of a Board inter partes proceeding may be divided into two or more separate applications or registrations. Any request to divide out the unopposed goods or services will routinely be granted. A request to divide generally will not result in suspension of the proceeding. For more information on motions to divide, see TBMP § 516.

Petition to the Director. In general, the mere filing of a petition to the Director seeking review of an interlocutory decision or order of the Board will not act as a stay of the Board proceeding pending disposition of the petition. *See generally*TBMP § 905. Such a stay must be specifically requested of the Board and granted by the Board. [Note 15.] The decision as to whether to grant such a stay is within the Board's discretion. Unless and until the Board issues a suspension order, all times continue to run as previously set or reset by the Board.

Testimonial depositions on written questions. Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions pursuant to 37 C.F.R. § 2.124, the Board will suspend or reschedule other deadlines or time periods in the case to allow for the orderly completion of the depositions upon written questions. [Note 16.] *See*TBMP § 703.02(c).

Discovery depositions on written questions. Upon receipt of written notice that one or more discovery depositions are to be taken upon written questions pursuant to 37 C.F.R. § 2.124(b)(2), the Board may suspend or reschedule other deadlines or time periods in the case to allow for the orderly completion of the depositions upon written questions. *See*TBMP § 404.07(e).

To conduct discovery of expert witness: The Board may suspend proceedings to provide for the taking of any necessary discovery of a proposed expert witness, and to allow the adverse party or parties to determine whether it will be necessary to rely on a rebutting expert. [Note 17.] *See*TBMP § 408.01(b). For further information regarding expert disclosures, see TBMP § 401.03

NOTES:

1. 37 C.F.R. § 2.117(c).

2. *See Instruments SA Inc. v. ASI Instruments Inc.*, 53 USPQ2d 1925, 1927 (TTAB 1999) (it may be the safest course of action for parties engaged in settlement to file a consented motion or stipulation to suspend proceedings); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979) (order suspending proceedings for settlement vacated once it came to Board's attention that adverse party objected to suspension on such basis). *See also Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1704 (TTAB 2002) (proceedings are not suspended automatically when parties are discussing settlement and a party that fails to timely move for extension or suspension of dates on the basis of settlement does so at its own risk).

3. *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767 n.1 (TTAB 2008).

4. 37 C.F.R. § 2.117(c). *Cf. Shen Manufacturing Co. v. Ritz Hotel Ltd*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 n.2 (Fed. Cir. 2004) ("RHL's applications languished at the United States Patent and Trademark Office ("PTO") for nearly two decades as the result of the parties' failure to move the applications and corresponding oppositions forward."); *Guthy-Renker Corp. v. Boyd*, 88 USPQ2d 1701, 1704 (TTAB 2008) ("The Board has adopted the practice of discovery conferences to avoid needless disputes and motions and to facilitate a smooth and timely conclusion to Board proceedings.").

5. *See, e.g., The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (suspended pending consideration of consent agreement by examining attorney).

6. *See, e.g., In re Checkers of North America Inc.*, 23 USPQ2d 1451, 1452 (Comm'r 1992) (noting that case was previously suspended where debtor's (petitioner's) pleaded registration was the subject of a counterclaim) *aff'd sub nom. Checkers Drive-In Restaurants, Inc. v. Comm'r*, 51 F.3d 1078, 34 USPQ2d 1574 (D.C. Cir. 1995).

7. *See, e.g., University Games Corp. v. 20Q.net Inc.*, 87 USPQ2d 1465, 1468-69 (TTAB 2008) (request to withdraw as counsel granted, proceedings suspended, and party allowed time to either appoint new counsel or file submission stating it will represent itself).

8. The filing of a motion to dismiss for failure to state a claim upon which relief can be granted tolls the time for filing an answer. *See* Fed. R. Civ. P. 12(b); *Hollow form Inc. v. Delma Aeh*, 180 USPQ 284, 285 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975).

9. 37 C.F.R. § 2.127(d); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69962, 69967 (Oct. 7, 2016) ("[A]n amendment to § 2.127(d) specifies that a case 'is suspended' when a party timely files a potentially dispositive motion."; "The Office is amending § 2.127(d) to clarify that a case is suspended when a party timely files any potentially dispositive motion."). *Cf. Electronic Industries Association. v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999) (suspended pending disposition of motion for discovery sanctions that included request for entry of judgment); *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1438 (TTAB 1995) (suspended pending disposition of motion for judgment on the pleadings); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1044 n.7 (TTAB 1985) (suspended pending motion for summary judgment, and subsequent motion to suspend for civil action deferred until after decision on summary judgment); *Nestle Co. v. Joyva Corp.*, 227 USPQ 477, 478 n.4 (TTAB 1985) (cross motion for summary judgment is germane to a pending motion for summary judgment). *Cf. SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1708 (TTAB 1994) (motion for leave to amend a notice of opposition is not a potentially dispositive motion that would warrant suspension under 37 C.F.R. § 2.127(d)).

10. *See Leeds Technologies Ltd. v. Topaz Communications Ltd.*, 65 USPQ2d 1303, 1305-06 (TTAB 2002); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999).

11. *See Leeds Technologies Ltd v. Topaz Communications Ltd.*, 65 USPQ2d 1303, 1306, 1307-08 (TTAB 2002) (time for opposer to serve discovery responses reset following decision on opposer's motion for judgment on pleadings). *But see Super Bakery Inc. v. Benedict*, 96 USPQ2d 1134, 1136 (TTAB 2010) (filing of motion for summary judgment one day before Board ordered discovery responses were due did not establish good cause for failure to comply with discovery obligations under Board order granting discovery sanctions), *clarified*, 665 F.3d 1263, 101 USPQ2d 1089, 1092 (Fed. Cir. 2011) (however, entry of judgment as a sanction for a party's failure to abide by the Board's practice regarding suspension is not supported).

12. 37 C.F.R. § 2.127(d); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1044 n.7 (TTAB 1985) (motion to suspend for civil action not considered); *Nestle Co. v. Joyva Corp.*, 227 USPQ 477, 478 n.4 (TTAB 1985) (cross-motion for summary judgment germane to pending summary judgment motion).

13. *See, e.g., Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1430 (TTAB 1998) (proceedings deemed suspended as of the filing of the motion).

14. 37 C.F.R. § 2.120(f).

15. 37 C.F.R. § 2.146(g).

16. 37 C.F.R. § 2.124(d)(2).

17. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See, e.g., Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1564-65 (TTAB 2014); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011).

510.03(b) Resumption

Settlement negotiations. When proceedings are suspended for purposes of settlement negotiations, the Board normally sets a specific period of suspension (up to six months) and provides a new trial schedule that will take effect upon resumption. Each party has the right to request resumption at any time during the suspension period. [Note 1.] If no word is heard from either party prior to the expiration of the suspension period, the new trial schedule automatically goes into effect when the suspension period expires, and if a fully briefed motion was pending before the Board suspended proceedings, the Board ordinarily will decide the motion after the suspension period expires. In addition to, or instead of, resetting trial dates, the Board may reset the time for the parties to take other appropriate action in the case.

Matter before the examining attorney. If proceedings have been suspended for consideration of a matter by the examining attorney, including the disposition of a party's application before the examining attorney, and the matter does not resolve the case, the Board will issue an order resuming proceedings and taking further appropriate action. [Note 2.]

Bankruptcy. When the Board has suspended proceedings because a defendant in a Board proceeding or plaintiff whose registration is the subject of a counterclaim has filed a petition for bankruptcy, the Board periodically (normally, once a year) inquires as to the status of the bankruptcy case. In order to expedite matters, however, when the bankruptcy case has been concluded, or the involved application or registration of the bankrupt party has been transferred to some other person, the interested party should immediately file a paper notifying the Board thereof. Once the Board has been notified of the outcome of the bankruptcy case, and/or of the disposition of the bankrupt's involved application or registration, the Board will resume proceedings and take further appropriate action.

Withdrawal of counsel. If proceedings have been suspended in order to allow a party, whose attorney has withdrawn, a period of time in which to either appoint new counsel (and inform the Board thereof) or, if a U.S.-domiciled party, file a paper stating that it desires to represent itself (i.e., proceed "pro se"), and that party so informs the Board, the Board will resume proceedings, and go forward with the party proceeding pro se or with the newly-appointed counsel representing the party. *See* TBMP § 510.03(a). A party proceeding pro se may employ a new attorney any time thereafter. If the party fails, during the time allowed, to either

appoint new counsel (and inform the Board thereof) or file a paper stating that it desires to represent itself, the Board may issue an order noting that the party appears to have lost interest in the case, and allowing the party time in which to show cause why default judgment should not be entered against it. [Note 3.] If the party, in turn, files a response indicating that it has not lost interest in the case, default judgment will not be entered against it. If the party fails to file a response to the show cause order, default judgment may be entered against it.

Potentially dispositive motion. When proceedings have been suspended pending determination of a potentially dispositive motion, and the determination of the motion does not dispose of the case, the Board, in its decision on the motion, will issue an order resuming proceedings and taking further appropriate action including resetting appropriate dates. [Note 4.]

NOTES:

1. *See The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (proceedings suspended subject to the right of either party to request resumption).

2. *See, e.g., The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (proceedings to be resumed if consent agreement did not overcome examining attorney's Trademark Act § 2(d) refusal).

3. *See, e.g., Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1224-25 (TTAB 1993).

4. *See* 37 C.F.R. § 2.127(d). *See also e.g., Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999) (dates reset beginning with the period that was running when the potentially dispositive motion was filed).

511 Motion to Consolidate

Fed. R. Civ. P. 42(a) Consolidation. *If actions before the court involve a common question of law or fact, the court may: (1) join for hearing or trial any or all matters at issue in the actions; (2) consolidate the actions; or (3) issue any other orders to avoid unnecessary cost or delay.*

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. [Note 1.] In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby. [Note 2.] Although identity of the parties is another factor considered by the Board in determining whether consolidation should be ordered [Note 3.], it is not always necessary. [Note 4.] Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. [Note 5.]

Generally, the Board will not consider a motion to consolidate until an answer has been filed (i.e., until issue has been joined) in each case sought to be consolidated. However, the Board may, in its discretion, order cases consolidated prior to joinder of issue. [Note 6.] *See*TBMP § 305 (Consolidated and Combined Complaints).

When cases have been ordered consolidated, they may be presented on the same record and briefs. [Note 7.] Papers should only be filed in the "parent" case of the consolidated proceedings unless otherwise advised by the Board, but the caption of each paper filed with the Board should reference the individual proceeding

numbers with the parent case listed first. [Note 8.] Ordinarily, the lowest numbered opposition of the consolidated cases is treated as the "parent" case when an opposition is involved, and the lowest numbered cancellation is the parent if there are only cancellations.

When actions by different plaintiffs are consolidated, and the plaintiffs are represented by different counsel, the plaintiffs may be required to appoint one lead counsel to supervise and coordinate the conduct of the plaintiffs' cases and to provide one point of contact with the Board. *See*TBMP § 117.02.

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires the filing of separate pleadings and entry of a separate judgment. [Note 9.] Upon consolidation, the Board will reset dates for the consolidated proceeding, usually by adopting the dates as set in the most recently instituted of the cases being consolidated.

Where a final disposition has been entered as to some, but not all, of the cases in a consolidated proceeding, the remaining cases will no longer be considered consolidated with the cases for which a final disposition has been entered. [Note 10.]

NOTES:

1. *See* Fed. R. Civ. P. 42(a); *Wise F&I, LLC, et al. v. Allstate Insurance Co.*, 120 USPQ2d 1103, 1105 (TTAB 2016) (sua sponte consolidation due to common questions of law and fact); *Prosper Business Development Corp. v. International Business Machines, Corp.*, 113 USPQ2d 1148, 1149 (TTAB 2014) (Board ordered consolidation of opposition and cancellation proceedings because cancellation was "effectively a compulsory counterclaim"); *M.C.I. Foods Inc. v. Bunte*, 86 USPQ2d 1044, 1046 (TTAB 2008) (proceeding involved identical parties, identical registrations and related issues); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997) (both proceedings involved the same mark and virtually identical pleadings); *Ritchie v. Simpson*, 41 USPQ2d 1859, 1860 (TTAB 1996) (cases consolidated despite variations in marks and goods), *rev'd on other grounds*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1424 n. 1 (TTAB 1993) (opposition and cancellation consolidated); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1156 (TTAB 1991) (opposition and cancellation consolidated); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1384 n.3 (TTAB 1991). (opposition and cancellation consolidated).

See also Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618, 1619 n.1 (TTAB 1989) (stipulation to consolidate); *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444, 1445 (TTAB 1987) (proceedings consolidated pursuant to joint motion); *Federated Department Stores, Inc. v. Gold Circle Insurance Co.*, 226 USPQ 262, 263 (TTAB 1985); (oppositions consolidated); *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1201 (TTAB 1981), *set aside on other grounds and new decision entered*, 217 USPQ 464 (TTAB 1983) (three oppositions consolidated).

2. *See, e.g., Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010) (motion to consolidate granted); *Lever Brothers Co. v. Shaklee Corp.*, 214 USPQ 654, 655 (TTAB 1982) (consolidation denied where one case was just in pleading stage, and testimony periods had expired in other); *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 726 (TTAB 1981) (consolidation denied as possibly prejudicial to defendant where defendant's involved marks were not all the same); *World Hockey Association v. Tudor Metal Products Corp.*, 185 USPQ 246, 248 (TTAB 1975) (consolidation ordered where issues were substantially the same and consolidation would be advantageous to both parties); *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440, 441-42 (TTAB 1973) (consolidation denied where issues differed).

3. *See Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d 1241, 1242 (TTAB 1989) (consolidation ordered in view of identity of parties and similarity of issues); *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444, 1445 (TTAB 1987) (consolidation ordered in view of identity of parties and similarity of issues).

4. *See New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (if multiple oppositions brought by different opposers are at the same stage of litigation and plead the same claims, the Board may consolidate for consistency and economy); 9A C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL §§ 2382, 2384 (3d ed. 2020).

5. *See, e.g., Wisconsin Cheese Group, LLC v. Comercializadora de Lacteos y Derivados S.A. de C.V.*, 118 USPQ2d 1262, 1264 (TTAB 2016) (motion to consolidate granted); *Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010) (same); *Venture Out Properties LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1889 (TTAB 2007) (consolidation ordered sua sponte); *8440 LLC v. Midnight Oil Co.*, 59 USPQ2d 1541, 1541 n.1 (TTAB 2001) (opposition and cancellation proceedings consolidated on Board's own initiative); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997) (motion); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1424 n.2 (TTAB 1993) (stipulation); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1156 (TTAB 1991) (Board's initiative); *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989) (stipulation).

6. *Cf.* 37 C.F.R. § 2.106(b); 37 C.F.R. § 2.114(b).

7. *See Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, n.2 (TTAB 1996); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1424 n.1 (TTAB 1993); *Helene Curtis Industries, Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989).

8. *See, e.g., S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 n.4 (TTAB 1997) and *Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237, 1238 n.2 (TTAB 1993).

9. *See Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010).

10. *See Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1300 (TTAB 2016) (two cases no longer consolidated after final disposition entered in one); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1115 (TTAB 2011) (because two of three cancellations dismissed, remaining cancellation no longer considered to be consolidated and shall proceed as a single proceeding).

512 Motion to Join or Substitute

512.01 Assignment of Mark

When there has been an assignment of a mark that is the subject of, or relied upon in, an inter partes proceeding before the Board, the assignee may be joined or substituted, as may be appropriate, upon motion granted by the Board, or upon the Board's own initiative. [Note 1.]

When a mark that is the subject of a Federal application or registration has been assigned, together with the application or registration, in accordance with Trademark Act § 10, 15 U.S.C. § 1060, any action with respect

to the application or registration that may or must be taken by the applicant or registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded with the USPTO or that proof of the assignment has been submitted in the Board proceeding record. [Note 2.]

Please Note: Trademark Act § 10, 15 U.S.C. § 1060, and part 3 of 37 C.F.R. are not applicable to Trademark Act § 66(a), 15 U.S.C. § 1141f(a), applications and registrations. [Note 3.] Except in limited circumstances, [Note 4.] requests to record assignments of § 66(a) applications and registrations must be filed directly with the International Bureau. [Note 5.] The International Bureau will notify the USPTO of any changes in ownership recorded in the International Register. The USPTO will record only those assignments, or other documents of title, that have been recorded with the International Bureau. [Note 6.]

If the mark in an application or registration that is the subject matter of an inter partes proceeding before the Board is assigned, together with the application or registration, the assignee may be joined as a party (as a party defendant, in the case of an opposition or cancellation proceeding; or as a junior or senior party, as the case may be, in an interference or concurrent use proceeding) upon the filing with the Board of a copy of the assignment. When the assignment is recorded in the Assignment Recordation Branch of the USPTO [Note 7.], the assignee may be substituted as a party if the assignment occurred prior to the commencement of the proceeding [Note 8.], the assignor is no longer in existence, the plaintiff raises no objections to substitution, or the discovery and testimony periods have closed; otherwise, the assignee will be joined, rather than substituted, to facilitate discovery. [Note 9.]

If a mark pleaded by a plaintiff is assigned and a copy of the assignment is filed with the Board, the assignee ordinarily will be substituted for the originally named party if the assignment occurred prior to the commencement of the proceeding, if the discovery and testimony periods have closed, if the assignor is no longer in existence, or if the defendant raises no objection to substitution; otherwise, the assignee will be joined, rather than substituted, to facilitate the taking of discovery and the introduction of evidence. [Note 10.] *See*TBMP § 303.05(b) (Opposition Filed by Privy). The assignment does not have to be recorded with respect to a plaintiff's pleaded application or registration before substitution or joinder (whichever is appropriate) is made. However, recordation in the Assignment Recordation Branch of the USPTO is advisable because it will aid the assignee in its effort to prove ownership of the application or registration at trial. [Note 11.]

If the mark of an excepted common law user (that is not the owner of an involved application or registration) in a concurrent use proceeding is assigned, the assignee will be joined or substituted as party defendant upon notification to the Board of the assignment. [Note 12.]

Alternatively, if there has been an assignment of a mark that is the subject of, or is relied upon in, a proceeding before the Board, and the Board does not order that the assignee be joined or substituted in the proceeding, the proceeding may be continued in the name of the assignor. [Note 13.]

Further, the fact that a third party related to the plaintiff, such as a parent or licensor of the plaintiff, may also have an interest in a mark relied on by the plaintiff does not mean that the third party must be joined as a party plaintiff. [Note 14.]

A joint applicant may assign an intent-to-use application for registration of a mark to a second joint applicant without violating Trademark Act § 10(a)(1), 15 U.S.C. § 1060(a)(1). [Note 15.]

NOTES:

1. *See, e.g., NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1031 (TTAB 2014) (finding joinder rather than substitution appropriate where assignment of pleaded mark was executed one year after proceeding commenced and nothing in the record indicated petitioner or business connected with mark no longer in existence); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 n.1 (TTAB 2008) (Board will not add or substitute an opposition applicant without motion and submission of either proof of name change assignment or proof of recordation of same with the USPTO). *See also Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1910 n.1 (TTAB 2000) (assignee joined at final decision).

2. *See* 37 C.F.R. § 3.71; 37 C.F.R. § 3.73(b).

3. *See* 37 C.F.R. § 7.22 *et seq.* for information on recording changes to Trademark Act § 66(a),15 U.S.C. § 1141f(a), applications and registrations.

4. *See* 37 C.F.R. § 7.23; 37 C.F.R. § 7.24.

5. *See* Trademark Act § 72, 15 U.S.C. § 1141l; 37 C.F.R. § 7.22. *See also*TMEP § 1904.06 (Assignment of Extension of Protection to the United States).

6. *See*TMEP § 501.07 (Assignment of Extension of Protection of International Registration to the United States); TMEP § 1904.06 (Assignment of Extension of Protection to the United States).

7. With respect to Trademark Act § 66(a), 15 U.S.C. § 1141f (a), applications and registrations, the USPTO will record only those assignments, or other documents of title, that have been recorded in the International Register. *See*TMEP § 501.07; TMEP § 1904.06

8. *Cf. Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1434 n.1 (TTAB 2007) (opposition captioned in name of new opposer where assignment of pleaded registrations recorded prior to filing of notice of opposition).

9. *See, e.g.*, 37 C.F.R. § 2.113(c)(1), 37 C.F.R. § 2.113(d), 37 C.F.R. § 3.71(d), and 37 C.F.R. § 3.73(b); Fed. R. Civ. P. 17 and 25; *NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1031 (TTAB 2014) (finding joinder rather than substitution appropriate where assignment of pleaded mark was executed one year after proceeding commenced and nothing in the record indicated petitioner or business connected with mark no longer in existence); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1434 n.2 (TTAB 2007) (applicant's motion to join another defendant granted where assignment of application occurred after commencement of proceeding); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1229 (TTAB 1993) (joinder after assignment); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1138 n.4 (TTAB 1990) (assignee joined after filing copy of an assignment which occurred subsequent to commencement of proceeding); *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857, 857 n.1 (TTAB 1986) (assignee joined where papers filed by parties indicated registration had been assigned). *See also Huffy Corp. v. Geoffrey Inc.*, 18 USPQ2d 1240, 1242 (Comm'r 1990) (joinder); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1222 n.2 (TTAB 1987) (joinder after assignment); *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 nn.2-3 (TTAB 1985) (substitution due to reincorporation and merger); *E.E. Dickinson Co. v. T.N. Dickinson Co.*, 221 USPQ 713, 715 n.1 (TTAB 1984) (joinder of successor-in-interest); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.1 (TTAB 1982) (substitution resulting from partnership incorporating under the same name).

10. *See, e.g.,* 37 C.F.R. § 2.113(c); 37 C.F.R. § 2.113(d); 37 C.F.R. § 3.71(d); 37 C.F.R. § 3.73(b); Fed. R. Civ. P. 17 and 25; 37 C.F.R. § 2.102(b); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1434 n.1 (TTAB 2007) (opposition captioned in name of new opposer where assignment of pleaded registrations recorded prior to filing of notice of opposition); *William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870, 1872-73 (TTAB 1994) (substitution of opposer appropriate where assignment occurred prior to commencement); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1225 (TTAB 1993) (motion to substitute filed during testimony period granted to the extent that successor was joined); *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1079-80 (TTAB 1992) (opposer's motion to substitute granted where copy of assignment was filed and applicant did not object); *Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034, 1035 n.2 (TTAB 1988) (survivor of merger substituted at final decision).

See also Binney & Smith Inc. v. Magic Marker Industries, Inc., 222 USPQ 1003, 1004 n.1 (TTAB 1984) (substitution as party defendant after recordation of chain of title in the Office); *Electronic Realty Associates, Inc. v. Extra Risk Associates, Inc.*, 217 USPQ 810, 812 n.3 (TTAB 1982) (substitution after testimony periods had expired; assignment document showing nunc pro tunc assignment to the day preceding the filing date of the application); *Liberty & Co. v. Liberty Trouser Co.*, 216 USPQ 65, 66 n.1 (TTAB 1982) (substitution of party defendant as reflected in assignment records in the Office); *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (joinder of defendant instead of substitution; upon filing of assignment with the Assignment Recordation Branch, substitution may occur due to transfer of ownership prior to institution of cancellation); *Aloe Creme Laboratories, Inc. v. Aloe 99, Inc.*, 188 USPQ 316, 322 n.12 (TTAB 1975) (reference to applicant in decision refers to both applicant of record and successor-in-interest in view of testimony regarding transfer of ownership of mark). *Cf. SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1708-09 (TTAB 1994) (motion to join licensee as "co-opposer" denied since right to oppose may be transferred but not shared unless timely opposition is filed); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1076-77 (TTAB 1993) (substitution of proper party in interest not permitted in view of misidentification of original party).

11. With respect to Trademark Act § 66(a), 15 U.S.C. § 1141f(a), applications and registrations, the USPTO will record only those assignments, or other documents of title, that have been recorded in the International Register. *See*TMEP §501.07;TMEP § 1904.06.

12. *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1225 (TTAB 1993) (joinder); *Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133, 1134 n.3 (TTAB 1982) (substitution of successor-in-interest as party defendant).

13. *See* Fed. R. Civ. P. 25(c); *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1311 n.1 (TTAB 1999) (decision will be binding upon the assignee); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.1 (TTAB 1982) (same).

14. *See Avia Group International Inc. v. Faraut* , 25 USPQ2d 1625, 1626-27 (TTAB 1992) (respondent's motion to join petitioner's licensor as party plaintiff denied). *Cf.* 37 C.F.R. § 2.107(a) and 37 C.F.R. § 2.107(b) (if no assignment of a pleaded mark, opposition may not be amended to add a joint opposer after close of time for filing opposition).

15. *Amazon Technologies Inc. v. Wax*, 95 USPQ2d 1865, 1871 (TTAB 2010).

512.02 Change of Name

If the name of a party to an inter partes proceeding before the Board is changed, the title of the Board proceeding may be changed, upon motion or upon the Board's own initiative, to reflect the change of name, provided that appropriate evidence thereof is made of record in the proceeding. Such evidence may consist, for example, of a copy of the name change document, or the reel and frame numbers at which such document is recorded in the Assignment Recordation Branch of the USPTO. [Note 1.] If no such evidence is made of record in the proceeding, the proceeding may be continued in the party's old name. [Note 2.] See note to TBMP § 512.01 regarding assignments of Trademark Act § 66(a), 15 U.S.C. § 1141f(a) applications and registrations.

A name change document does not have to be recorded in the Assignment Recordation Branch of the USPTO with respect to a defendant's involved application or registration, or a plaintiff's pleaded application or registration, in order for the Board proceeding title to be changed to reflect the new name. However, recordation is advisable because it facilitates proof of ownership of the application or registration, and because filing for recordation is one of the 37 C.F.R. § 3.85 requirements for an applicant that desires, if it prevails in the proceeding, to have its registration issue in its new name. [Note 3.] *See*TBMP § 512.03 (Issuance of Registration to Assignee, or in New Name).

NOTES:

1. *See, e.g., Spirits International B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi*, 99 USPQ2d 1545, 1546 n.1 (TTAB 2011) (changing caption to reflect change of corporate entity after conversion; best practice is to file a separate submission with the Board advising of the change); *WMA Group Inc. v. Western International Media Corp.*, 29 USPQ2d 1478, 1479 n.3 (TTAB 1993) (changing caption to reflect change of corporate name of party); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1135 n.1 (TTAB 1992) (caption to be changed if document evidencing change of name is submitted); *NutraSweet Co. v. K & S Foods Inc.*, 4 USPQ2d 1964, 1964 n.2 (TTAB 1987) (although no request to substitute was filed, where the change of name was recorded and there was no dispute as to facts and circumstances surrounding name change, opposer under new name was substituted as plaintiff); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1004 n.1 (TTAB 1984) (substitution of defendant due to recordation of merger, assignment and change of name in Office). *Cf. In re Brittains Tullis Russell Inc.*, 23 USPQ2d 1457, 1458 n.1 (Comm'r 1991) (in petition to Commissioner to accept Trademark Act §§ 8 & 15 affidavit, registration file evidenced change of registrant's name and claim of ownership accepted).

2. *See, e.g., Maine Savings Bank v. First Banc Group of Ohio, Inc.*, 220 USPQ 736, 737 n.3 (TTAB 1983) (caption was not changed to reflect name change where no supporting documents submitted); *National Blank Book Co. v. Leather Crafted Products*, 218 USPQ 827, 827 n.2 (TTAB 1983) (opposer's change of name). *Cf.* Fed. R. Civ. P. 25(c).

3. *See*TMEP § 502.03. *Cf.*TMEP § 1906.01(a) and TMEP § 1906.01(c) for assignments and changes of names involving international registrations on the International Register.

512.03 Issuance of Registration to Assignee, or in New Name

37 C.F.R. § 3.85 ***Issue of registration to assignee.*** *The certificate of registration may be issued to the assignee of the applicant, or in a new name of the applicant, provided that the party files a written request in the trademark application by the time the application is being prepared for issuance of the certificate of*

registration, and the appropriate document is recorded in the Office. If the assignment or name change document has not been recorded in the Office, then the written request must state that the document has been filed for recordation. The address of the assignee must be made of record in the application file.

Even where the assignee of an application that is the subject matter of a Board inter partes proceeding has been joined or substituted as a party to the proceeding, *see* TBMP § 512.01, any registration issued from the application may issue in the name of the assignor unless the assignee complies with the requirements of 37 C.F.R. § 3.85. Specifically, to ensure that the registration will issue in its name, the assignee must file a written request in the application (or in the Board proceeding, if that proceeding has not yet ended), by the time the application is being prepared for issuance of the certificate of registration that the registration be issued in its name. [Note 1.] In addition, an appropriate document must be of record in the Assignment Recordation Branch of the USPTO, or the written request must state that the document has been filed for recordation. Finally, the address of the assignee must be made of record in the application file.

Similarly, even though the title of an inter partes proceeding before the Board may have been changed to reflect a name change of an applicant whose application is the subject of the proceeding, any registration issued from the application may issue in the applicant's original name unless the applicant complies with the requirements of 37 C.F.R. § 3.85. [Note 2.] If an assignment or change of name document is recorded in the Assignment Recordation Branch well prior to the time the subject application is prepared for issuance of a registration, the registration may issue in the name of the assignee, or in the new name, even if no 37 C.F.R. § 3.85 request is filed. However, the registration may issue in the name of the assignor or in the old name. The purpose of the written request is to call the attention of the USPTO to the assignment or change of name and thus to ensure that the registration issues in the name of the assignee or in the new name. Accordingly, it is sufficient for the purpose if applicant files a paper referring to the assignment or change of name and the assignment or change of name document has either been recorded, or applicant states that the document has been submitted for recording. [Note 3.]

Please Note: Trademark Act § 10, 15 U.S.C. § 1060, and part 3 of 37 C.F.R. are not applicable to Trademark Act § 66(a), 15 U.S.C. § 1141f(a), applications and registrations. [Note 4.] Except in limited circumstances [Note 5], requests to record assignments of § 66(a) applications and registrations must be filed directly with the International Bureau. [Note 6.] The International Bureau will notify the USPTO of any changes in ownership recorded in the International Register. The USPTO will record only those assignments, or other documents of title, that have been recorded in the International Register. [Note 7.]

NOTES:

1. *Smart Inventions Inc. v. TMB Products LLC*, 81 USPQ2d 1383, 1384 n.3 (TTAB 2006) (new owner can help ensure issuance of registration in its name by recording assignment in USPTO and filing request that registration issue in new owner's name).

2. *See Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1134 n.1 (TTAB 1992).

3. *See* 37 C.F.R. § 2.171 for procedures to receive a new certificate of registration on change of ownership or when ownership with respect to some, but not all, of the goods and/or services has changed.

4. *See* 37 C.F.R. § 7.22 *et seq.* for information on recording changes to Trademark Act § 66(a), 15 U.S.C. § 1141f(a), applications and registrations.

5. *See* 37 C.F.R. § 7.23; 37 C.F.R. § 7.24.

6. *See* Trademark Act § 72, 15 U.S.C. § 1141l; 37 C.F.R. § 7.22, TMEP § 501.07, and TMEP § 1904.06.

7. *See*TMEP § 501.07 and TMEP § 1904.06.

512.04 Misidentification

Fed. R. Civ. P. 15(a) Amendments Before Trial.

(1) ***Amending as Matter of Course.*** *A party may amend its pleading once as a matter of course within: (A) 21 days after serving it, or (B) if the pleading is one to which a responsive pleading is required, 21 days after service of a responsive pleading or 21 days after service of a motion under Rule. 12(b), (e), or (f), whichever is earlier.*

(2) ***Other Amendments.*** *In all other cases, a party may amend its pleading only with the opposing party's written consent or the court's leave. The court should freely give leave when justice so requires.*

15 U.S.C. § 1063(a) … *An opposition may be amended under such conditions as may be prescribed by the Director.*

When the plaintiff in a Board inter partes proceeding misidentifies itself or the mark or registration upon which it relies in the complaint, if the plaintiff can establish to the Board's satisfaction that this misidentification was merely a non-substantive mistake, the Board may allow amendment of the complaint, pursuant to Fed. R. Civ. P. 15(a), to correct the misidentification and/or to substitute the proper party in interest. [Note 1.] *See*TBMP § 303.05(c) (Misidentification of Opposer).

When the plaintiff in a Board inter partes proceeding misidentifies an application or registration number that is the subject of the Board proceeding, and the plaintiff can establish, in a timely manner and to the Board's satisfaction that this misidentification was a non-substantive mistake, the Board may allow amendment of the complaint (and of the Board proceeding title) to correct the misidentification of the subject application or registration. [Note 2.] However, if a notice of opposition misidentifies the application number(s) against which the opposition is intended, and the defect is not corrected within the time for filing an opposition against the intended application(s) under Trademark Act § 13(a), 15 U.S.C. § 1063(a), this defect cannot be cured. The opposition against the misidentified application will be dismissed and an opposition against the intended application will not be instituted because it would be untimely. [Note 3.] *See also*TBMP § 306.04. Similarly, if a petition to cancel misidentifies the registration number against which the cancellation is intended, and the defect is not corrected within the time for petitioning to cancel the intended registration under Trademark Act § 14, 15 U.S.C. § 1064, this defect cannot be cured. The petition to cancel the misidentified registration will be denied and a petition to cancel the intended registration will not be instituted because it would be untimely.

An applicant may correct a defect in identifying itself by name or legal entity in the application where it is a single, continuing commercial entity and was the owner of the mark as of the filing date of the application and that entity in fact filed the application. [Note 4.] Also, where a merger occurred prior to filing an application, but the pre-merger corporation and owner of the mark has ceased to exist and is identified as the applicant, the corporation that remains after the merger may correct this defect by identifying itself as applicant. [Note 5.]

NOTES:

1. *See Mason Engineering & Design Corp. v. Mateson Chemical Corp.* , 225 USPQ 956, 957 n.3 (TTAB 1985) (deeming pleadings amended to recite opposer's correct name; *Arbrook, Inc. v. La Citrique Belge,*

Naamloze Vennootschap , 184 USPQ 505, 505-06 (TTAB 1974) (amendment granted to reflect proper party in interest); *Lone Star Manufacturing Co. v. Bill Beasley, Inc.* , 176 USPQ 426, 426 (TTAB 1972) (amendment granted to correct corporate title), *rev'd on other grounds* , 498 F.2d 906, 182 USPQ 368 (CCPA 1974); *Davidson v. Instantype, Inc.* , 165 USPQ 269, 270-71 (TTAB 1970) (amendment granted to substitute proper party in interest); *Pyco, Inc. v. Pico Corp.* , 165 USPQ 221, 221-22 (TTAB 1969) (amendment granted to substitute real party in interest; *Raker Paint Factory v. United Lacquer Manufacturing Corp.* , 141 USPQ 407, 408-09 (TTAB 1964) (amendment granted to substitute proper party; *Textron, Inc. v. Gillette Co.* , 177 USPQ 530, 531-32 (Comm'r 1973) (name of party in interest may be corrected by amendment. *Cf.* 37 C.F.R. § 2.102(b); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1076-77 (TTAB 1993) (amendment to correct misidentification and substitute proper party in interest not permitted).

2. *See Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443, 1445-46 (TTAB 1996) (applicant's misidentification of itself as a corporation was harmless mistake); *Argo & Co. v. Springer*, 198 USPQ 626, 635 (TTAB 1978) (Board allowed substitution of three individuals for a legally defective corporate applicant finding no mistake as to the true owner of the mark but rather only a mistake as to legal form or identity of that owner); *Argo & Co. v. Springer, et al.*, 189 USPQ 581, 582 (TTAB 1976); *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613, 614 (Comm'r 1974) (deletion of "company" was correctable mistake). *Cf.*TMEP § 803.06, TMEP § 1201.02(b), and TMEP § 1201.02(c); *Huang v. Tzu Wei Chen Food Co.*, 849 F.2d 1458, 7 USPQ2d 1335, 1335-36 (Fed. Cir. 1988) (application filed by individual void where owner was corporation, even though individual was affiliated with corporation).

Compare to the following ex parte decisions involving mistakes as to applications and renewals, *e.g.*, *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1690-91 (TTAB 1991) (correction of application not permitted where joint venture owned the mark but the application was filed by a corporation which was one member of the joint venture); *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078, 1078 (Comm'r 1990)(correction of declaration under Sections 8 and 15 of the Trademark Act, 15 U.S.C. §§ 1058 & 1065); *In re Techsonic Industries, Inc.*, 216 USPQ 619, 619-20 (TTAB 1982); *In re Eucryl Ltd.*, 193 USPQ 377, 378 (TTAB 1976).

3. *Yahoo! Inc. v. Loufrani*, 70 USPQ2d 1735, 1736 (TTAB 2004).

4. *Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443, 1444-45 (TTAB 1996) (corporation formed by merger of four separate companies which did not survive the merger, was proper person to file even if corporation did not exist at time of filing). *Cf. Great Seats Ltd. v. Great Seats Inc.*, 84 USPQ2d 1235, 1240 (TTAB 2007) (application void ab initio where two separate commercial entities were in existence on application filing date and application was filed in name of wrong entity).

5. *Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443, 1444-45 (TTAB 1996).

513 Motion to Withdraw as Representative; Petition to Disqualify

513.01 Motion to Withdraw as Representative

37 C.F.R. § 2.19(b) ***Withdrawal of Attorney.*** *If the requirements of § 11.116 of this chapter are met, a practitioner authorized to represent an applicant, registrant or party to a proceeding in a trademark case may withdraw upon application to and approval by the Director or, when applicable, upon motion granted by the Trademark Trial and Appeal Board. ...*

37 C.F.R. § 11.116 ***Declining or terminating representation.***

(a) *Except as stated in paragraph (c) of this section, a practitioner shall not represent a client, or where representation has commenced, shall withdraw from the representation of a client if:*

(1) *The representation will result in violation of the USPTO Rules of Professional Conduct or other law;*

(2) *The practitioner's physical or mental condition materially impairs the practitioner's ability to represent the client; or*

(3) *The practitioner is discharged.*

(b) *Except as stated in paragraph (c) of this section, a practitioner may withdraw from representing a client if:*

(1) *Withdrawal can be accomplished without material adverse effect on the interests of the client;*

(2) *The client persists in a course of action involving the practitioner's services that the practitioner reasonably believes is criminal or fraudulent;*

(3) *The client has used the practitioner's services to perpetrate a crime or fraud;*

(4) *A client insists upon taking action that the practitioner considers repugnant or with which the practitioner has a fundamental disagreement;*

(5) *The client fails substantially to fulfill an obligation to the practitioner regarding the practitioner's services and has been given reasonable warning that the practitioner will withdraw unless the obligation is fulfilled;*

(6) *The representation will result in an unreasonable financial burden on the practitioner or has been rendered unreasonably difficult by the client; or*

(7) *Other good cause for withdrawal exists.*

(c) *A practitioner must comply with applicable law requiring notice to or permission of a tribunal when terminating a representation. When ordered to do so by a tribunal, a practitioner shall continue representation notwithstanding good cause for terminating the representation.*

(d) *Upon termination of representation, a practitioner shall take steps to the extent reasonably practicable to protect a client's interests, such as giving reasonable notice to the client, allowing time for employment of other counsel, surrendering papers and property to which the client is entitled and refunding any advance payment of fee or expense that has not been earned or incurred. The practitioner may retain papers relating to the client to the extent permitted by other law.*

A practitioner who wishes to withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board must file a request with the Board for permission to do so. The request to withdraw must be based upon one of the grounds for mandatory or permissive withdrawal listed in 37 C.F.R. § 11.116(a) and 37 C.F.R. § 11.116(b).

Moreover, the practitioner must comply with the requirements of 37 C.F.R. § 11.116(c) and 37 C.F.R. § 11.116(d). [Note 1.] In accordance with that rule, a request for permission to withdraw should include: (1) a specification of the basis for the request; (2) a statement that the practitioner has notified the client of the desire to withdraw from employment, and has allowed time for employment of another practitioner; (3) a statement that all papers and property that relate to the proceeding and to which the client is entitled have been delivered to the client; (4) a statement that any advance payment of fees or expenses that have not been earned or incurred have been refunded or, if appropriate, a statement that no fees or expenses have been paid in advance and not refunded; and (5) proof of service of the request upon the client itself and upon every other party to the proceeding. [Note 2.] The facts establishing these elements should be set out in detail. [Note 3.] Moreover, a request to withdraw from representation may not be used as a subterfuge to obtain an extension or reopening of time that a party would not otherwise be entitled to. [Note 4.]

If the request to withdraw is granted, the Board will suspend proceedings and allow the party a stated period of time (usually 30 days) in which to appoint a new attorney (and inform the Board thereof), or, for a U.S.-domiciled party, to file a paper stating that it desires to represent itself. Foreign-domiciled parties must be represented by U.S. counsel. [Note 5.] If the party fails to take such action, the Board may issue an order to show cause why default judgment should not be entered against the party based on the party's apparent loss of interest in the case. [Note 6.]

A request for permission to withdraw as counsel in an application that is the subject of a potential opposition (i.e., an application as to which a request for extension of time to file an opposition is pending) is determined by the Board, not the Trademark Operation, and it should be filed with the Board to insure prompt processing. *See*TBMP § 212.01.

A party may inform the Board of the appointment of new counsel either by filing written notification thereof (as, for example, by filing a copy of the new appointment), or by having new counsel make an appearance in the party's behalf in the proceeding. *See*TBMP § 114.03. *See also*TBMP § 114.04.

For information concerning action by the Board after expiration of the time allowed in the suspension order, see TBMP § 510.03(b). For further information concerning withdrawal of counsel, see TBMP § 116.02, TBMP § 116.03, TBMP § 116.04, and TBMP § 116.05. *Cf.*TMEP § 607.

Effective May 3, 2013, the United States Patent and Trademark Office adopted new USPTO Rules of Professional Conduct that are based on the American Bar Association's Model Rules of Professional Conduct. Prior to this date, the requirements for withdrawing as an attorney were set forth in 37 C.F.R. § 10.40. They are now set forth in 37 C.F.R. § 11.116. Cases decided prior to May 3, 2013 refer to the USPTO Rules of Professional Responsibility that were in effect at that time. These earlier cases continue to be instructive.

NOTES:

1. *See* 37 C.F.R. § 2.19(b) and 37 C.F.R. § 11.116; *University Games Corp. v. 20Q.net Inc.*, 87 USPQ2d 1465, 1468 (TTAB 2008) (request to withdraw granted); *SFW Licensing Corp. v. Di Pardo Packing Limited*, 60 USPQ2d 1372, 1373-74 (TTAB 2001) (request to withdraw denied as prejudicial to client where it was filed on last day of client's testimony period, although grounds for withdrawal were known months earlier).

Cf. In re Slack , 54 USPQ2d 1504, 1507 (Comm'r 2000) (request to withdraw during ex parte prosecution granted where requirements of 37 C.F.R. § 10.40 [removed and replaced with 37 C.F.R. § 11.116] were satisfied and attorney filed the request within a reasonable time after notifying applicant of his intent to withdraw).

2. 37 C.F.R. § 11.116. *Cf.*TMEP §607 (Withdrawal of Attorney of Record [during ex parte examination]).

3. *See* 37 C.F.R. § 2.127(a) (motions must contain a "full statement of the grounds"). *Cf. SFW Licensing Corp. v. Di Pardo Packing Limited*, 60 USPQ2d 1372, 1373-74 (TTAB 2001).

4. *Cf. SFW Licensing Corp. v. Di Pardo Packing Limited*, 60 USPQ2d 1372, 1373-74 (TTAB 2001).

5. 37 C.F.R. § 2.11 (a).

6. *See University Games Corp. v. 20Q.net Inc.*, 87 USPQ2d 1465, 1468-69 (TTAB 2008) (request to withdraw as counsel granted, proceedings suspended, and party allowed time to either appoint new counsel

or file submission stating it will represent itself); *CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1302-03 (TTAB 1999) (motion to set aside judgment denied since opposer is as equally accountable as attorney who failed to withdraw from case for lack of attention to case); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1224-25 (TTAB 1993) (discharging order to show cause that issued for loss of interest after withdrawal of counsel).

513.02 Petition to Disqualify

37 C.F.R. § 11.19(c) *Petitions to disqualify a practitioner in ex parte or inter partes matters in the Office are not governed by §§ 11.19 through 11.60 and will be handled on a case-by-case basis under such conditions as the USPTO Director deems appropriate.*

If a party to an inter partes proceeding before the Board believes that a practitioner representing another party to the proceeding should be disqualified (due, for example, to a conflict of interest, or because the practitioner should testify in the proceeding as a witness on behalf of his client), the party may file a petition to disqualify the practitioner. [Note 1.]

Petitions to disqualify are not disciplinary proceedings and hence are not governed by 37 C.F.R. § 11.19–37 C.F.R. § 11.60. Rather, petitions to disqualify are governed by 37 C.F.R. § 11.19(c) and are determined in the manner specified in that rule.

When a petition to disqualify is filed in connection with a proceeding pending before the Board, the Board immediately issues an action suspending proceedings in the case and advising the parties that no additional papers should be filed by the parties until further notice, pending consideration of the petition. After the petition has been determined or dismissed, the Board issues an action resuming proceedings in the case and taking further appropriate action therein. Petitions to disqualify in matters before the Board are currently determined by the Chief Administrative Trademark Judge under authority delegated by the Director. The Chief Administrative Trademark Judge may further delegate his/her responsibility to a Board judge or Board attorney for signature.

For examples of cases involving petitions to disqualify, see the decisions cited in TBMP § 114.08.

NOTES:

1. With respect to disqualification where the attorney is a witness in the case, such as giving testimony on behalf of the client, *see* 37 C.F.R. § 11.307; *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1317 (TTAB 1992); *Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ 2d 1663, 1663 nn.4-5 (TTAB 1988) (generally not prudent for an attorney to verify answers to interrogatories since it could expose him or her to additional discovery and even disqualification); *Little Caesar Enterprises Inc. v. Domino's Pizza Inc.*, 11 USPQ2d 1233 (Comm'r 1989) (petition to disqualify counsel on basis that counsel would be called as adverse witness denied). *Cf. In re Gray*, 3 USPQ2d 1558, 1560 (TTAB 1987) (no weight given to counsel's affidavit concerning secondary meaning because it would impermissibly make him a witness in the case).

514 Motion to Amend Application or Registration

37 C.F.R. § 2.133 ***Amendment of application or registration during proceedings.***

(a) *An application subject to an opposition may not be amended in substance nor may a registration subject to a cancellation be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or upon motion granted by the Board.*

(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 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.*

(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.*

(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.*

514.01 In General

The amendment of any application or registration that is the subject of an inter partes proceeding before the Board is governed by 37 C.F.R. § 2.133. Thus, an application that is the subject of a Board inter partes proceeding may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board. [Note 1.] An unconsented motion to amend in substance is generally deferred until final decision or until the case is decided upon summary judgment. [Note 2.] However, if the proposed amendment limits the identification of goods or services and the applicant consents to the entry of judgment on the grounds for opposition with respect to the broader identification, it may be approved, even where an opposer objects. [Note 3.]

A registration that is the subject of a Board inter partes proceeding may not be amended or the mark disclaimed in part, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board. [Note 4.] Additionally, under 37 C.F.R. § 2.173(b), a request to amend an involved registration must (a) include the fee required by 37 C.F.R. § 2.6(a)(11), (b) be verified and signed in accordance with 37 C.F.R. § 2.193(e)(6); and (c) if the amendment involves a change of the mark, the request must include (1) one new specimen per class showing the mark as used on or in connection with the goods, services, or collective membership organization, (2) a verified statement that the specimen was in use in commerce at least as early as the filing date of the amendment, and (3) a new drawing of the amended mark.

For information regarding amendments to applications that are subject to a pending request for an extension of time to oppose, see TBMP § 212. For information concerning amendments to delete one or more classes from a multiple-class application or registration subject to an inter partes proceeding, see TBMP § 602.01.

The Board recommends submission of a red-lined copy of the proposed amendment clearly showing the proposed changes followed by a clean copy of the proposed amendment. Such a submission will assist Board personnel in determination and, should the motion be granted, entry of the amendment. [Note 5.]

A proposed amendment to any application or registration that is the subject of an inter partes proceeding must also comply with all other applicable rules and statutory provisions. [Note 6.] These include 37 C.F.R. § 2.71-37 C.F.R. § 2.75, in the case of a proposed amendment to an application; 37 C.F.R. § 2.173 and Trademark Act § 7(e), 15 U.S.C. § 1057(e), in the case of a proposed amendment to a registration. Thus, for example, a proposed amendment that involves an addition to the identification of goods or services, or that materially alters the character of the subject mark, will not be approved by the Board. However, an

otherwise appropriate amendment to an application will ordinarily not be rejected by the Board solely on the basis that the amendment would require republication of the mark. [Note 7.] Republication may not be available for applications filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), due to the time requirements of the Madrid Protocol. [Note 8.]

A proposed amendment to an intent-to-use application involved in an opposition to seek registration on the Supplemental Register cannot be entertained by the Board until a statement of use has been filed and approved. *See*TMEP § 1102.03. Because a notice of allowance will not issue unless and until the opposition is dismissed, a statement of use filed during the pendency of an opposition will be rejected as premature. If the parties agree that such an amendment would resolve the issues in the opposition, they may file a consented motion to dismiss the opposition without prejudice, and applicant may file a use-based application on the Supplemental Register. *See*TBMP § 219.

A request to amend an application or registration that is the subject of a Board inter partes proceeding should bear at its top both the number of the subject application or registration, and the Board proceeding number and title. In addition, the request should include proof of service of a copy thereof upon every other party to the proceeding. [Note 9.] *See*TBMP § 113. A request to amend an application involved in a Board proceeding must be filed with the Board, not with the Trademark Operation. Similarly, a request to amend a registration involved in a Board proceeding must be filed with the Board, not with the Post Registration Section or, in the case of a § 66(a) registration when only the registration extension of protection to the United States is to be amended, not with the International Bureau. Failure to file such a request with the Board will result in unnecessary delay and may result in the loss or misplacement of the amendment request. The Board will act on the amendment and, if appropriate, enter it into the application or registration file and into the record for the Board proceeding. [Note 10.]

Occasionally WIPO will inform the USPTO that the international registration forming the basis of a § 66(a) application or registration is amended during a proceeding. This can happen for a number of reasons, including corrections, restriction of the basic application in the country of origin (either by voluntary amendment or by a "central attack"), or by voluntary amendment of the extension filed with WIPO. The circumstances under which an amendment, or request to amend, a § 66(a) application or registration arise will dictate whether the amendment must or may be entered and whether the Board has discretion to disallow or defer that amendment until final decision or until the case is decided upon summary judgment. For example, WIPO controls the classification, which can only be amended upon receipt of correction from the International Bureau. [Note 11.] Similarly, cancellation in part of the goods and services of an international registration due to the ceasing of effect of the basic registration must be entered. [Note 12.] However, if the holder of an international registration voluntarily limits its list of goods and services, and such limitation affects the extension of protection to the United States, the USPTO may declare that the limitation has no effect. [Note 13.] Similarly, if the proposed amendment affects only the extension of protection to the United States, the proposed amendment may be considered. [Note 14.] Where the Board is not able to act on a proposed amendment, or defer the proposed amendment until final decision or until the case is decided upon summary judgment, as appropriate, the Board will issue an order requiring the defendant to show cause why the Board should not enter judgment as to any goods that were deleted by the amendment and then ask the plaintiff whether it wants to continue with the proceeding. [Note 15.] For a further discussion involving deletions of goods and services in § 66(a) registrations, see TBMP § 602.02(a). For a further discussion involving amendments to § 66(a) applications and registrations, see TMEP § 1904.02(c), TMEP § 1904.02(e), TMEP § 1904.02(j), TMEP § 1904.13, TMEP § 1904.14, and TMEP § 1904.15.

When the Board grants a request to amend a registration that is the subject of a Board inter partes proceeding, the file is forwarded to the Post Registration Section of the Office for entry of the amendment of the

registration. The action by the Post Registration Section is limited to the ministerial duty of ensuring that the authorized change to the registration is made. [Note 14.]

NOTES:

1. *See, e.g., Gallagher's Restaurants, Inc. v. Gallagher's Farms, Inc.*, 3 USPQ2d 1864, 1866 (TTAB 1986) (amendment to named excepted users in a concurrent use application); *Giant Food Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 631 (TTAB 1986) (amendment to identification of goods); *Greyhound Corp. and Armour and Co. v. Armour Life Insurance Co.*, 214 USPQ 473, 475 (TTAB 1982) (amendment to dates of use).

2. *See Zachry Infrastructure LLC v. American Infrastructure, Inc.*, 101 USPQ2d 1249, 1255-56 (TTAB 2011) (unconsented motion to amend to Supplemental Register deferred until summary judgment or final hearing); *Enbridge Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1539 n.3 (TTAB 2009) (motion to amend identification of goods and dates of use deferred until final hearing); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1219 (TTAB 1990) (motion to amend identification of goods deferred); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1554 (TTAB 1987) (motion to amend dates of use deferred); *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB 1985) (same).

3. *Wisconsin Cheese Group, LLC v. Comercializadora de Lacteos y Derivados S.A. de C.V.*, 118 USPQ2d 1262, 1266-67 (TTAB 2016) (approving applicant's motion to amend identifications where applicant consented to judgment and amendments served to change the nature and character of the goods so as to introduce a substantially different issue for trial); *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1080 (TTAB 2013) (approving applicant's motion to amend the identification of goods in its application and accepting applicant's consent to judgment with respect to the broader identification of goods, entering judgment as to broader identification of goods); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007) (proposed amendment not approved because applicant did not consent to entry of judgment as to the broader recitation of services; in addition, specimens of record must support the amended identification of goods, and the applicant must introduce evidence during its testimony period to use of its mark on the amended goods or services prior to the relevant date determined by the basis of the application); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 963-64 (TTAB 1986) (discussing Board's adoption of practice of permitting limiting amendments to the identification of goods and/or services made prior to trial even when opposer objects if applicant consents to judgment on the question of likelihood of confusion between the parties' marks and the broader identification of goods).

4. *See* Trademark Act § 7(e), 15 U.S.C. § 1057(e); 37 C.F.R. § 2.173.

5. *See* 37 C.F.R. § 2.74(a)

6. *See* Trademark Act §7(e), 15 U.S.C. § 1057(e); 37 C.F.R. § 2.71; 37 C.F.R. § 2.72; 37 C.F.R. § 2.173; *Couture v. Playdom, Inc.*, 113 USPQ2d 2042, 2044 (Fed. Cir. 2015) (amendment to substitute basis under 37 C.F.R. § 2.35(b) contemplates substitution of basis during the pendency of the application, not after registration; no error in denial of amendment); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1435-36 (TTAB 2007) (amendment to identification not supported by specimens of use); *Vaughn Russell Candy Co. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635, 1636 (TTAB 1998) (material alteration); *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, 1749 (TTAB 1992) (summary judgment granted in part), 26 USPQ2d 1926, 1930 (TTAB 1993) (expansion of scope of goods); *Mason Engineering and Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB 1985) (amendment to dates of use not supported by affidavit or declaration).

7. *See*TMEP § 1505.03(a) (When Republication Is Required) and TMEP § 1505.03(b) (When Republication Is Not Required).

8. *See* Trademark Act § 68, 15 U.S.C. § 1141h and Trademark Act § 69, 15 U.S.C. § 1141i.

9. 37 C.F.R. § 2.119(a); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007) (an unconsented motion to amend an application should be made prior to trial, in order to give the other party fair notice thereof.)

10. *See Hachette Filipacchi Presse v. Elle Belle LLC*, 85 USPQ2d 1090, 1095 (TTAB 2007) (Board has jurisdiction to determine propriety of amendment; subsequent attempt by registrant to delete goods on which mark has never been used through the Post Registration Section Branch is irrelevant); *In re Pamex Foods, Inc.*, 209 USPQ 275, 277 (Comm'r 1980) (Trademark Examining Operation acted beyond its authority in denying amendment to registration which Board had already approved).

11. 37 C.F.R. § 2.85(d), TMEP § 1402.03(d); and TMEP § 1904.03(b).

12. *See*TMEP § 1904.03(g) and TMEP § 1904.15.

13. *See*TMEP § 1904.03(g) and TMEP § 1904.15.

14. *See*TMEP § 1904.02(c), TMEP § 1904.02(e) and TMEP § 1904.13(a).

15. *Cf.* 37 C.F.R. § 2.134(b).

16. *See* 37 C.F.R. § 7.22.

514.02 Amendment With Consent

When a request to amend an application or registration that is the subject of a Board inter partes proceeding is made with the consent of the other party or parties, and the proposed amendment is in accordance with the applicable rules and statutory provisions, the request ordinarily will be approved by the Board. However, if the application or registration is the subject of other inter partes proceedings, the consent of the other parties in each of those other proceedings must be of record before the amendment may be approved. [Note 1.]

When a consented motion to amend the application or registration that is the subject of a Board inter partes proceeding is filed in lieu of an answer, the parties should not file a subsequent scheduling motion until the Board determines the motion to amend. In such a situation, when a consented motion to amend is pending, the Board will not issue a notice of default. [Note 2.]

NOTES:

1. *See Vaughn Russell Candy Co. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635, 1636 (TTAB 1998) (proposed amendment not approved when no consent from opposers in two other oppositions against the application). *See also New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1550-51 (TTAB 2011) (where one application subject to multiple, unrelated oppositions, any amendment to opposed application would have to be made with the consent of all opposers).

2. *Cf.*TBMP § 312.01.

514.03 Amendment Without Consent

The Board, in its discretion, may grant a motion to amend an application or registration that is the subject of an inter partes proceeding, even if the other party or parties do not consent thereto. [Note 1.]

When a motion to amend an application or registration in substance is made without the consent of the other party or parties, it ordinarily should be made prior to trial, in order to give the other party or parties fair notice thereof. An unconsented motion to amend that is not made prior to trial, and which, if granted, would affect the issues involved in the proceeding, normally will be denied by the Board unless the matter is tried by express or implied consent of the parties pursuant to Fed. R. Civ. P. 15(b). [Note 2.] *Cf.*TBMP § 314 (Unpleaded Matters) and TBMP § 507 (Motion to Amend Pleading).

The Board generally will defer determination of a timely filed (i.e., pretrial) unconsented motion to amend in substance until final decision, or until the case is decided upon summary judgment. [Note 3.]

If a defendant, whose application or registration is the subject of a Board inter partes proceeding, wishes to defend by asserting that it is at least entitled to a registration with a particular restriction, the defense should be raised either in the defendant's answer to the complaint, or by way of a timely motion to amend the application or registration to include the restriction. [Note 4.] A request by a defendant to restrict its identification of goods or services under Trademark Act § 18, 15 U.S.C. § 1068, may be made by way of a motion under 37 C.F.R. § 2.133 or raised as an affirmative defense in the answer (as originally filed, as amended, or as deemed amended) by alleging that the restriction will avoid a likelihood of confusion, and alleging that plaintiff is not using the mark on the products or services being excluded from the registration. [Note 5.] *See*TBMP § 311.02(b). The proposed restriction should be described in sufficient detail to give the plaintiff fair notice thereof. [Note 6.] *See*TBMP § 311.02(b).

If the Board ultimately finds that a defendant is not entitled to registration in the absence of a restriction that was timely proposed by the defendant, the proposed restriction will be approved and entered. [Note 7.] If a further refinement thereof is found necessary by the Board, and is within the scope of the notice given to plaintiff by defendant, or was tried with the express or implied consent of plaintiff, defendant will be allowed time in which to file a request that its application or registration be amended to conform to the findings of the Board, failing which judgment will be entered against the party. [Note 8.] If, on the other hand, the Board ultimately finds that defendant is entitled to registration even without the proposed restriction, defendant will be allowed time to indicate whether it still wishes to have the restriction entered.

Geographic limitations will be considered and determined by the Board only in the context of a concurrent use proceeding. [Note 9.] *See* TBMP § 1101.02. Moreover, Trademark Act § 7, 15 U.S.C. § 1057(e), and 37 C.F.R. § 2.173 cannot be used to impose concurrent use restrictions on registrations. [Note 10.] However, an applicant whose geographically unrestricted use-based application is the subject of an opposition proceeding may file a motion to amend its application to one for a concurrent use registration, with the opposer being recited as the exception to the applicant's right to exclusive use. If the proposed amendment is otherwise appropriate, and is made with the consent of the opposer, the opposition will be dismissed without prejudice in favor of a concurrent use proceeding. If the opposer does not consent to the amendment, the amendment may nevertheless be approved and entered, and a concurrent use proceeding instituted, provided that applicant agrees to accept entry of judgment against itself in the opposition with respect to its request for a geographically unrestricted registration. [Note 11.] *See*TBMP § 1113.

An amendment that is actually a correction is to be submitted to the Board for an application or registration that is the subject matter of an inter partes proceeding. The proposed amendment must meet the standards for a correctable mistake. The consent of the adverse party is not required. Ordinarily an amendment seeking to correct a mistake addresses errors in how the applicant or registrant is identified. [Note 12.]

NOTES:

1. 37 C.F.R. § 2.133(a). *See Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007) (noting principle that an acceptable amendment to the identification may be permitted despite opposer's objection if amendment limits identification and applicant consents to entry of judgment on the question of likelihood of confusion as to the broader identification). *See also, e.g., Wisconsin Cheese Group, LLC v. Comercializadora de Lacteos y Derivados S.A. de C.V.*, 118 USPQ2d 1262, 1266-67 (TTAB 2016) (applicant consented to judgment on the grounds for opposition with respect to the broader identifications of goods); *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1080 (TTAB 2013) (applicant willing to accept judgment with respect to broader identification of goods); *International Harvester Co. v. International Telephone and Telegraph Corp.*, 208 USPQ 940, 941 (TTAB 1980) (where applicant was willing to accept judgment with respect to the broader identification of goods); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1229 (TTAB 1993) (where applicant consented to entry of judgment against itself with respect to a geographically unrestricted registration).

2. *See, e.g., Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433, 1435-36 (TTAB 2007) (amendment denied, specimens did not support proposed amendment and applicant did not consent to judgment; but applicant may file renewed motion with appropriate documentation); *Personnel Data Systems, Inc. v. Parameter Driven Software, Inc.*, 20 USPQ2d 1863, 1865 (TTAB 1991) (defendant's motion to restrict identification of goods in involved registration, filed with brief on case, denied); *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320, 321 n.2 (TTAB 1985) (same); *International Harvester Co. v. International Telephone and Telegraph Corp.*, 208 USPQ 940, 941 (TTAB 1980) (amendment to identification may be permitted if made before trial, if it serves to limit the scope of goods, and if applicant consents to judgment with respect to the broader identification of goods). *Cf. Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1128 (TTAB 1990) (amendment after trial permitted to allege new defense allowed, but defense rejected on the merits).

3. *See Zachry Infrastructure LLC v. American Infrastructure Inc.*, 101 USPQ2d 1249, 1255-56 (TTAB 2011) (unconsented motion to amend to Supplemental Register deferred to summary judgment or final hearing); *Enbridge Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1539 n.3 (TTAB 2009) (motion to amend identification of goods and dates of use deferred until final hearing); *Leeds Technologies Ltd. v. Topaz Communications Ltd.*, 65 USPQ2d 1303, 1307 (TTAB 2002) (motion to amend to substitute a basis deferred to final hearing); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1219 (TTAB 1990) (motion to amend identification of goods deferred); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1554-55 (TTAB 1987) (motion to amend dates of use deferred); *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB 1985) (same). *But see Wisconsin Cheese Group, LLC v. Comercializadora de Lacteos y Derivados S.A. de C.V.*, 118 USPQ2d 1262, 1266-67 (TTAB 2016) (contested motion to amend granted where applicant consented to judgment on the grounds for opposition with respect to the broader identifications of goods); *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1080 (TTAB 2013) (same); *Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007) (same).

4. *See Ayoub, Inc. v. ACS Ayoub Carpet Service*, 118 USPQ2d 1392, 1394 (TTAB 2016) (applicant's motion to amend to Supplemental Register filed for first time in its main brief on the case deemed untimely where issue was neither raised prior to or during trial nor tried by implied consent).

5. *See* 37 C.F.R. § 2.133(a) and 37 C.F.R. § 2.133(b); *The Brooklyn Brewery Corporation v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, at *4-5 (TTAB 2020) (applicant's timely motion to amend its application under Section 18 deferred until trial); *Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828 (TTAB 2013) (ideally, Section 18 affirmative defense should be made in answer to put plaintiff on notice followed by a motion to amend the application or registration); *Personnel Data Systems Inc. v. Parameter Driven Software Inc.*, 20 USPQ2d 1863, 1864-65 (TTAB 1991) (due to lack of notice to plaintiff, Board would not entertain request to restrict defendant's identification of goods made for first time in trial brief); *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970, 1972-73 (TTAB 1991) (although applicant filed no motion or amendment to narrow its identification, after granting summary judgment on identification of goods as published, the Board allowed applicant time to file a request to amend identification to accurately reflect goods sold under the mark); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1220-21 n.5 (TTAB 1990) (applicant may make a request to restrict goods set forth in its own application by way of affirmative pleading in answer, an amended pleading, or by way of motion).

6. *See Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828-29 (TTAB 2013) (Section 18 affirmative defense, and corresponding motion to amend the application or registration, should be made early to put plaintiff on notice); *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (TTAB 2007) (proposed restriction must be stated with precision); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1220-21 n.5 (TTAB 1990) (request for relief under Section 18 may be made by way of an affirmative pleading or by motion). *See also Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970, 1972-73 (TTAB 1991) (Board allowed applicant time to amend identification to restrict goods after entry of summary judgment on original identification).

7. *See Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1841 (TTAB 2013) (Section 18 defense raised in alternative is relevant, motion to amend involved applications is granted, oppositions are dismissed). *But see Southwestern Management, Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1031 n.152 (TTAB 2015) (applicant not allowed time to amend application where no specific restriction was suggested or tried by any party), *aff'd*, 652 F. App'x 971 (mem.) (Fed. Cir. 2016).

Please Note: Except in limited circumstances, requests to record changes to a Trademark Act § 66(a) registration must be filed with the International Bureau. *See* 37 C.F.R. § 7.22. *See also*TMEP § 1904.06 andTMEP § 1904.13.

8. *See* 37 C.F.R. § 2.133(b). *See also* Trademark Act § 18, 15 U.S.C. § 1068.

9. *See* 37 C.F.R. § 2.133(c); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1106 n.3 (TTAB 2007) (counterclaim for partial cancellation by limiting geographic area denied); *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815, 1815 (TTAB 1990) (allegations of abandonment in a particular geographic location constitute an insufficient pleading).

10. *See In re Forbo*, 4 USPQ2d 1415, 1416 (Comm'r 1984) (petition to Commissioner to territorially restrict a registration denied); and *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383, 1384 (Comm'r 1987).

11. *See Faces, Inc. v. Face's, Inc.*, 222 USPQ 918, 919-20 (TTAB 1983).

12. *See, e.g.,*TMEP §1201.02(c) (Correcting Errors in How the Applicant is Identified) and TMEP §1609.10 (Correction to Mistake in Registration).

514.04 Amendment to Allege Use; Statement of Use

For information concerning the handling of an amendment to allege use, or a statement of use, filed during an opposition proceeding in an intent-to-use application that is the subject of the opposition, see TBMP § 219.

515 Motion to Remand Application to Examining Attorney

37 C.F.R. § 2.130 ***New matter suggested by the trademark examining attorney.*** *If, while an inter partes proceeding involving an application under section 1 or 44 of the Act is pending, facts appear which, in the opinion of the examining attorney, render the mark in the application unregistrable, the examining attorney should request that the Board remand the application. The Board may suspend the proceeding and remand the application to the trademark examining attorney for an ex parte determination of the question of registrability. A copy of the trademark examining attorney's final action will be furnished to the parties to the inter partes proceeding following the final determination of registrability by the trademark examining attorney or the Board on appeal. The Board will consider the application for such further inter partes action as may be appropriate.*

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 pendency 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, the examining attorney learns of facts that, in their opinion, render the mark of the involved application unregistrable, the examining attorney may file a request that the Board suspend the inter partes proceeding and remand the application to the examining attorney for further ex parte examination. [Note 1.] An application under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), may not be remanded under 37 C.F.R. § 2.130 or 37 C.F.R. § 2.131. [Note 2.]

There is no provision under which such a remand may be made upon motion by a party to the proceeding. Moreover, a request to amend an application that is the subject of an inter partes proceeding before the Board is not remanded to the examining attorney for consideration, but rather is considered and determined by the Board. [Note 3.] *See*TBMP § 514.

However, 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 that 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 in the proceeding, will, in addition to determining the pleaded matters, include a statement that in the event applicant ultimately prevails in the inter partes proceeding, the examining attorney shall reexamine the application in light of the disclosed facts. [Note 4.]

A 37 C.F.R. § 2.131 remand may be made by the Board upon its own initiative, or upon request granted by the Board. Thus, if a party to the proceeding believes that the facts disclosed therein appear to render the mark of an 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, at oral hearing, or by separate motion. An application under § 66(a) may not be remanded under 37 C.F.R. § 2.130 or 37 C.F.R. § 2.131. [Note 5.]

NOTES:

1. 37 C.F.R. § 2.130.

2. *See* 37 C.F.R. § 2.130 and 37 C.F.R. § 7.25 (Sections of part 2 applicable to extension of protection).

3. *See generally* 37 C.F.R. § 2.133(a).

4. *See, e.g.,* 37 C.F.R. § 2.131; *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1636 n.6 (TTAB 1988) (remand for consideration of evidence regarding applicant's date of first use); *West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.*, 2 USPQ2d 1306, 1309 n.5 (TTAB 1987) (remand for determination of status of underlying foreign registration); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 686 n.10 (TTAB 1984) (remand for consideration of evidence regarding applicant's use of mark prior to application filing date); *Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.*, 222 USPQ 1012, 1014-15 n.6 (TTAB 1984) (if applicant ultimately prevails, Board recommends that registration be withheld pending reexamination for clarification as to whether applicant has abandoned the mark as to certain goods as well as deletion from the identification of any goods for which applicant has non-use); *Color Key Corp. v. Color 1 Associates, Inc.*, 219 USPQ 936, 941, 944-45 n.11 (TTAB 1983) (if applicant ultimately prevails, registration should be deferred pending reexamination of the application under Trademark Rule 2.131); *Antillian Cigar Corp. v. Benedit Cigar Corp.*, 218 USPQ 187, 189 n.2 (TTAB 1983) (if applicant ultimately prevails, Board recommends registration be withheld pending reexamination of Section 2(a) ground for refusal).

5. *See* 37 C.F.R. § 7.25.

516 Motion to Divide Application or Registration

An application that is the subject of an inter partes proceeding before the Board may be divided into two or more separate applications upon motion granted by the Board, and payment of the required fee. [Note 1.]

For example, if an application that is the subject of an opposition includes multiple classes, not all of which have been opposed, the applicant may file a motion to divide out the unopposed classes. If applicant seeks to divide out an entire class or classes, a fee for dividing the application must be submitted for each new application to be created by the division. [Note 2.]

Similarly, if an application which is the subject of an opposition includes more than one item of goods, or more than one service, in a single class, and the opposition is not directed to all of the goods or services, the applicant may file a motion to divide out the unopposed goods or services. [Note 3.] Applicant must submit both a fee for dividing the application, and an application filing fee, for each new application to be created by the division. [Note 4.]

In both cases, when the motion to divide is granted, notification is sent to the USPTO's ITU/Divisional Unit for processing of the divisional request. After the applications have been divided, each new application created by the division will be forwarded to issue or, in the case of an intent to use application filed under Trademark Act § 1(b), 15 U.S.C. § 1051(b), for issuance of a notice of allowance. The Board will be notified when division of the original application containing the opposed classes has occurred, and the original application will remain the subject of the opposition proceeding. [Note 5.]

Any request to divide an application that is the subject of a Board inter partes proceeding will be construed by the Board as a motion to divide, and every other party to the proceeding will be allowed an opportunity to file a brief in opposition thereto. Nonetheless, the circumstances under which the Board will deny a request to divide are extremely rare.

A registration that is the subject of an inter partes proceeding before the Board may be divided into two or more separate registrations upon motion granted by the Board, and payment of the required fee, when ownership has changed with respect to some, but not all, of the goods and/or services. [Note 6.]

For further information concerning division of an application, see TMEP § 1110.

NOTES:

1. 37 C.F.R. § 2.87. *Cf. In re Little Caesar Enterprises Inc.*, 48 USPQ2d 1222 (Comm'r 1998) (regarding request to divide filed during pendency of request to extend time to oppose but prior to commencement of opposition).

2. *See* 37 C.F.R. § 2.87(a) and 37 C.F.R. § 2.87(b).

3. *Cf. Spirits International B.V. v. S. S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi*, 99 USPQ2d 1545, 1547, n.3 (TTAB 2011) (if applicant believes opposer's objection to registration is limited to some, but not all, of the goods in a single class, applicant could avail itself of the divisional procedure to avoid the opposition being sustained against the entire class, should opposer prevail).

4. *See* 37 C.F.R. § 2.87(a) and 37 C.F.R. § 2.87(b).

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

6. 37 C.F.R. § 2.171(b).

517 Motion to Strike Brief on Motion

Specific provision is made in the Trademark Rules of Practice for the filing of a brief in support of a motion, a brief in opposition to a motion, and a reply brief in further support of the motion. No further papers will be considered regarding the motion. [Note 1.] *See*TBMP § 502.02(b).

Subject to the provisions of Fed. R. Civ. P. 11, a party is entitled to offer in its brief any argument it feels will be to its advantage. Accordingly, when a moving brief, an opposition brief, or a reply brief on a motion has been regularly filed, the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party that simply objects to the contents thereof. Rather, any objections that an adverse party may have to the contents of such a brief will be considered by the Board in its determination of the original motion, and any portions of the brief that are found by the Board to be improper will be disregarded. When

filing trial briefs pursuant to 37 C.F.R. § 2.128, a party has the option of making evidentiary objections in a main brief or in a separate statement, as may be done in a responsive brief. The Board will not strike an entire brief based on evidentiary objections. [Note 2.] *See*TBMP § 801.

If a brief in opposition to a motion, or a reply brief in support of the motion, is not timely filed, it may be stricken, or given no consideration, by the Board. [Note 3.] Whether the Board decides to grant a motion as conceded or consider the motion on its merits is a matter of discretion. [Note 4.] Surreply briefs will be given no consideration by the Board. [Note 5.] Accordingly, it is not necessary to file (and the Board discourages the filing of) a motion to strike a surreply brief or any other briefs beyond a reply brief filed on a motion, since such papers will not be considered whether or not a motion to strike is filed. Furthermore, the Board may sua sponte strike or give no consideration to any briefs on a motion that exceed the page limit set forth in 37 C.F.R. § 2.127. [Note 6.] *See*TBMP § 502.02(b).

NOTES:

1. *See* 37 C.F.R. § 2.127(a).

2. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753-54 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.) (denying motion to strike trial brief based on appendix being "a subterfuge to avoid page limit;" appendix was devoted solely to evidentiary objections); *Corporacion Habanos S.A. v. Guantanamera Cigars*, 86 USPQ2d 1473, 1474 (TTAB 2008) (motion to strike reply brief that included a separate statement of evidentiary objections denied as party has option of making evidentiary objections in a separate statement).

3. *See, e.g., Consolidated Foods Corp. v. Berkshire Handkerchief Co., Inc.*, 229 USPQ 619, 620 (TTAB 1986).

4. *See, e.g., DaimlerChrysler Corp. v. Maydak*, 86 USPQ2d 1945, 1947 n.3 (TTAB 2008) (late opposition brief considered where motion raised claim and issue preclusion, distinguishing other cases in which briefs are not considered due to tardiness); *Consolidated Foods Corp. v. Berkshire Handkerchief Co., Inc.*, 229 USPQ 619, 620 (TTAB 1986).

5. *See* 37 C.F.R. § 2.127(a).

6. *See* 37 C.F.R. § 2.127(a) (opposition briefs limited to 25 pages, reply briefs to 10 pages). *See also Cooper Technologies Co. v. Denier Electric Co.*, 89 USPQ2d 1478 (TTAB 2008); *Saint-Gobain Corp. v. Minnesota Mining and Manufacturing Co.*, 66 USPQ2d 1220, 1222 (TTAB 2003).

518 Motion for Reconsideration of Decision on Motion

37 C.F.R. § 2.127(b) *Any request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date thereof. A brief in response must be filed within twenty days from the date of the service of the request.*

A request for reconsideration or modification of an order or decision issued on a motion must be filed within one month from the date of the order or decision. [Note 1.] Unless the Director, upon petition, waives the time requirement of 37 C.F.R. § 2.127(b), the Board need not consider a request for reconsideration or modification filed more than one month from the date of the order or decision complained of. [Note 2.] Nor does the rule contemplate a second request for reconsideration of the same basic issue. [Note 3.] However,

the Board may, on its own initiative, reconsider and modify one of its orders or decisions if it finds error therein, and the Board may also, in its discretion, consider an untimely request for reconsideration or modification. [Note 4.]

Any brief in response to a request for reconsideration or modification of an order or decision issued on a motion must be filed within 20 days from the date of service of the request. [Note 5.]

When a party upon which a motion has been served fails to file a brief in response, and the Board grants the motion as conceded pursuant to 37 C.F.R. § 2.127(a), the non-responding party cannot use a request for reconsideration as a second opportunity to file a brief in opposition to the motion. [Note 6.]

Generally, the premise underlying a motion for reconsideration, modification or clarification under 37 C.F.R. § 2.127(b) is that, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued. Such a motion may not be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on the original motion. [Note 7.] Rather, the motion should be limited to a demonstration that based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change. [Note 8.] *Cf.*TBMP § 543 (Motion for Reconsideration of Final Decision).

An interlocutory motion, request, or other matter that is not actually or potentially dispositive of a proceeding, may be acted upon by a single Board judge, attorney, or paralegal to whom authority so to act has been delegated, or by ESTTA. [Note 9.] *See also* TBMP § 502.04. When one or more parties is dissatisfied with the Board action, they may seek review thereof by requesting reconsideration under 37 C.F.R. § 2.127(b), and/or by filing a petition to the Director for review of the decision under 37 C.F.R. § 2.146(e)(2). *See*TBMP § 905. A request that the action of a single Board judge, or attorney be reviewed by one or more other judges of the Board is improper and will be denied. However, at final hearing, the Board panel to which the case is assigned for decision may review an interlocutory ruling and reverse it, if appropriate. [Note 10.]

NOTES:

1. 37 C.F.R. § 2.127(b). *See The United States Olympic Committee v. Tempting Brands Netherlands B.V.*, 2021 USPQ2d 164, at *4 (TTAB 2021) (applicant's request in its trial brief that the Board reconsider previously issued interlocutory orders denied as untimely); *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000).

2. *See Avedis Zildjian Co. v. D. H. Baldwin Co.*, 181 USPQ 736, 736 (Comm'r 1974).

3. *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 631 n.11 (TTAB 1986); *Avedis Zildjian Co. v. D.G. Baldwin Co.*, 181 USPQ 736, 736 (Comm'r 1974).

4. *See Avedis Zildjian Co. v. D. H. Baldwin Co.*, 181 USPQ 736, 736 (Comm'r 1974).

5. *See* 37 C.F.R. § 2.127(b).

6. *See Joy Manufacturing Co. v. Robbins Co.*, 181 USPQ 408, 409 (TTAB 1974). *Cf. General Tire & Rubber Co. v. Gendelman Rigging & Trucking Inc.*, 189 USPQ 425, 427 (TTAB 1975).

7. *See The Scotch Whisky Association Ltd. v. ASW Distillery, LLC*, 2021 USPQ2d 179, at *3 (TTAB 2021).

8. *See The Scotch Whisky Association Ltd. v. ASW Distillery, LLC*, 2021 USPQ2d 179, at *7 (TTAB 2021) (applicant's request for reconsideration of Board order denying applicant's motion to dismiss the notice of opposition under Fed. R. Civ. P. 12(b)(6) granted; opposer allowed time to file an amended notice of opposition alleging properly pleaded Trademark Act Sections 2(a) and 2(e)(3) claims); *Asustek Computer Inc. v. Chengdu Westhouse Interactive Entertainment Co.*, 128 USPQ2d 1470 (TTAB 2018) (reconsideration of Board order denying untimely motion to compel filed on deadline for pretrial disclosures denied); *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019-20 (TTAB 2015) (reconsideration denied because there is no requirement that Board repeat or address irrelevant arguments in entertaining a motion); *Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005) (reconsideration denied because Board did not err in considering disputed evidence).

9. *See* 37 C.F.R. § 2.127(c).

10. *See, e.g., AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1832 (TTAB 2013) (reviewing interlocutory ruling striking certain testimonial exhibits, but denying reversal of decision); *Harley-Davidson Motor Co. v. Pierce Foods Corp.*, 231 USPQ 857, 859 n.13 (TTAB 1986) (although an interlocutory decision had excluded certain documentary evidence, opposer did not object to its admission by applicant at trial and the Board deemed the evidence as stipulated to by the parties).

519 Motion for Leave to Serve Additional Interrogatories, Requests for Production of Documents, or Requests for Admission, or to Exceed Discovery Deposition Limits

37 C.F.R. § 2.120(d) ***Interrogatories.*** *The total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional interrogatories upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. A motion for leave to serve additional interrogatories must be filed and granted prior to the service of the proposed additional interrogatories and must be accompanied by a copy of the interrogatories, if any, which have already been served by the moving party, and by a copy of the interrogatories proposed to be served. ...*

37 C.F.R. § 2.120(e) ***Requests for production.*** *The total number of requests for production which a party may serve upon another party pursuant to Rule 34 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional requests upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. A motion for leave to serve additional requests must be filed and granted prior to the service of the proposed additional requests and must be accompanied by a copy of the requests, if any, which have already been served by the moving party, and by a copy of the requests proposed to be served. ...*

37 C.F.R. § 2.120(i) ***Requests for admission.*** *The total number of requests for admission which a party may serve upon another party pursuant to Rule 36 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional requests upon motion therefor showing good cause, or upon stipulation of the parties, approved by the Board. A motion for leave to serve additional requests must be filed and granted prior to the service of the proposed additional requests and must be accompanied by a copy of the requests, if any, which have already been served by the moving party, and by a copy of the requests proposed to be served. ...*

519(a) Interrogatories, Requests for Production and Admissions

A motion under 37 C.F.R. § 2.120(d) for leave to serve additional interrogatories, 37 C.F.R. § 2.120(e) for leave to serve additional requests for production, or 37 C.F.R. § 2.120(i) for leave to serve additional requests for admission must be filed and granted prior to service of the proposed additional interrogatories, requests for production, or requests for admission; and must be accompanied both by a copy of any interrogatories, requests for production, or requests for admission which have already been served by the moving party, and by a copy of the interrogatories, requests for production, or requests for admission proposed to be served. [Note 1.]

Good cause for the service of additional interrogatories, requests for production, or requests for admission will generally be found only where it is shown that there is a legitimate need for further written discovery. [Note 2.] The mere fact that the additional interrogatories, requests for production, or requests for admission may be relevant and narrowly drawn to a single issue, or that they may be easy to answer is insufficient, in and of itself, to show good cause for the service of the additional written discovery. [Note 3.]

For further information concerning good cause for a motion to serve additional interrogatories, requests for production, and requests for admission, see TBMP § 405.03(c), TBMP § 406.05(c) and TBMP § 407.05(c), respectively. For information concerning the interrogatory, document request, and request for admission limit, specified in 37 C.F.R. § 2.120(d), 37 C.F.R. § 2.120(e)3, and 37 C.F.R. § 2.120(i), see TBMP § 405.03, TBMP § 406.05, and TBMP § 407.05.

NOTES:

1. 37 C.F.R. § 2.120(d); 37 C.F.R. § 2.120(f); and 37 C.F.R. § 2.120(i). *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1467 (TTAB 1990); *Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398, 1398 (TTAB 1990); *Chicago Corp. v. North American Chicago Corp.*, 16 USPQ2d 1479, 1480 (TTAB 1990); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990); NOTICE OF FINAL RULEMAKING, 56 Fed. Reg. 46376 (September 12, 1991), as corrected at 56 Fed. Reg. 54917 (October 23, 1991).

2. *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1466-67 n.5 (TTAB 1990). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69962 (Oct. 7, 2016) ("[E]xamples that may support a showing of good cause [for additional requests for admission] include cases involving foreign parties from whom oral discovery may be unavailable, or requests intended to narrow the issues in dispute in proceedings involving multiple marks and applications or registrations with lengthy identifications of goods and services.").

3. *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1466-67 n.5 (TTAB 1990) (fact that interrogatories are relevant and narrowly drawn to a single issue does not in and of itself demonstrate good cause for additional interrogatories); *Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398, 1399 (TTAB 1990) (fact that interrogatories are easy to answer does not in and of itself constitute good cause for additional interrogatories); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990) (fact that the interrogatories are relevant to the proceeding does not in and of itself constitute good cause for additional interrogatories).

519(b) Discovery Depositions

The Trademark Rules do not specify a limit on the number of discovery depositions. Therefore, the deposition limit of the Federal Rules of Civil Procedure applies in Board proceedings which limit parties to ten oral

depositions each, but a party may seek leave to conduct additional depositions. [Note 1.] *See*TBMP § 404.02. If a party seeks leave, without the consent of the adverse party, to take additional discovery depositions beyond the ten-deposition limit, such party must make a particularized showing of why the discovery is necessary. [Note 2.] In determining whether to allow a party to take additional discovery depositions beyond the ten-deposition limit, the Board may consider the necessity of each deposition previously taken without leave of the Board. [Note 3.] Before noticing any deposition, a party should assess whether it would be proportional to the needs of the case and truly necessary, taking into account the time and expense involved for even one deposition. In considering whether additional depositions are proportional to the needs of the case, the following may be taken into consideration: the importance of the issues, the parties' relative access to relevant information, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit. *See* TBMP § 404.09. These considerations should be balanced against the factors set forth in Fed. R. Civ. P. 26(b)(2)(C)(i)-(iii), i.e., (1) whether the discovery sought is unreasonably cumulative or duplicative, or can be obtained from some other source that is more convenient, less burdensome, or less expensive; (2) whether the party seeking discovery has had ample opportunity to obtain the information by discovery in the action; or (3) whether the proposed discovery is outside the scope permitted by Fed. R. Civ. P. 26(b)(1). [Note 4]. See TBMP § 404.02 and TBMP § 404.09.

Given the Board's limited jurisdiction and the generous number of interrogatories, requests for production, requests for admission, or discovery depositions provided under the Rules or under the Federal Rules of Civil Procedure made applicable to Board proceedings, such motions for leave to serve additional written discovery or to take discovery depositions that exceed the ten-deposition limit are disfavored.

For information concerning discovery deposition limits specified in Fed. R. Civ. P. 30(a)(2), *see*TBMP § 404.

NOTES:

1. Fed. R. Civ. P. 30(a)(2)(A)(i); 37 C.F.R. § 2.116(a). *See Spliethoff's Bevrachtingskantoor B.V. v. United Yacht Transport LLC dba United Yacht Transport*, 2020 USPQ2d 10605, at *2-3 (TTAB 2020).

2. *Spliethoff's Bevrachtingskantoor B.V. v. United Yacht Transport LLC dba United Yacht Transport*, 2020 USPQ2d 10605, at *2-3 (TTAB 2020) and cases cited therein.

3. *Spliethoff's Bevrachtingskantoor B.V. v. United Yacht Transport LLC dba United Yacht Transport*, 2020 USPQ2d 10605, at *3 (TTAB 2020).

4. *Spliethoff's Bevrachtingskantoor B.V. v. United Yacht Transport LLC dba United Yacht Transport*, 2020 USPQ2d 10605, at *3-4 (TTAB 2020); *see also* Fed. R. Civ. P. 26(b)(1) and 26(b)(2).

520 Motion to Take Foreign Deposition Orally

37 C.F.R. § 2.120(c)(1) *The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by §2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.*

37 C.F.R. § 2.123(a)(2) *Testimony taken in a foreign country shall be taken: by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness.*

Ordinarily, the discovery deposition of a natural person who resides in a foreign country, and who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party, must, if taken in a foreign country, be taken upon written questions in the manner described in 37 C.F.R. § 2.124. [Note 1.] *See also*TBMP § 404.03(b). Moreover, the Board will not order a natural person residing in a foreign country to come to the United States for the taking of a discovery deposition. [Note 2.] *See*TBMP § 404.03(b).

However, the parties may stipulate, or the Board, upon motion for good cause, may order, that the discovery deposition, when taken in a foreign country, may be taken by oral examination provided that the taking of said deposition complies with Convention on the Taking of Evidence Abroad in Civil or Commercial Matters ("Hague Convention") if the foreign country is a signatory thereto. *See*TBMP § 404.03(b). The Board will also, upon a showing of good cause, permit the deposition to be taken by telephone pursuant to Fed. R. Civ. P. 30(b)(4) [Note 3], so long as the deposition complies with the procedures set forth in the Hague Convention and local laws.

The Hague Convention provides two procedures through which parties to a proceeding in one country may obtain evidence from a witness in another: (1) by letter of request (or a letter rogatory) sent to the contracting state's Central Authority (Chapter I of the Hague Convention), or (2) by taking evidence through diplomatic officers and consular agents of the requesting country or through a commissioner appointed by a court of the foreign state where the parties seek the evidence (Chapter II). [Note 4.]

A discovery deposition taken in a foreign country must be taken upon written questions in the manner described in 37 C.F.R. § 2.124, unless the Board, upon motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination, which is to be in compliance with local laws. Trial testimony in a foreign country may be taken either (1) upon written questions in the manner described in 37 C.F.R. § 2.124, unless the Board, upon motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination (which is to be in compliance with local laws), or (2) by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination upon written questions of that witness. [Note 5.]

In determining whether good cause exists for a motion to take a foreign deposition orally, the Board weighs the equities, including the advantages of an oral deposition and any financial hardship that the nonmoving party might suffer if the deposition were taken orally in the foreign country. [Note 6.] *See*TBMP § 521 (Motion to Quash) and TBMP § 531 (Motion that Deposition Upon Written Questions Be Taken Orally).

NOTES:

1. 37 C.F.R. § 2.120(c)(1). *Cf. Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *2-3 (TTAB 2019) (witness located in the United States whose testimony was submitted by affidavit or declaration under Trademark Rule 2.123(a)(1) may only be cross-examined orally and not by written questions).

2. *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998). *See also Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises Ltd.*, 511 F.3d 437, 85 USPQ2d 1385, 1391 (4th Cir. 2007) (a district court could issue a subpoena for the deposition of a foreign party in the United States in connection with a Board case).

3. *Hewlett-Packard Co. v. Healthcare Personnel, Inc.*, 21 USPQ2d 1552, 1152-53 (TTAB 1991).

4. *See* 37 C.F.R. § 2.120(c)(1); *Orion Group Inc. v. Orion Ins. Co. P.L.C.*, 12 USPQ2d 1923, 1925-26 (TTAB 1989) (good cause to take oral deposition of witness in England); and *Jonergin Co. v. Jonergin Vermont Inc.*, 222 USPQ 337, 340 (Comm'r 1983) (stipulation to take oral deposition in Canada).

5. 37 C.F.R. § 2.123(a)(2). *See Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680 (TTAB 2019) (motion to allow oral cross-examination of foreign witness who provided direct testimony by declaration denied); *Jain v. Ramparts*, 49 USPQ2d 1429, 1431 (TTAB 1998).

6. *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998) (discovery depositions of foreign-resident witnesses may be taken only by way of written questions, unless the parties stipulate otherwise or unless the Board, upon motion for good cause shown, orders that the deposition be taken orally in the foreign country); *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1925-26 (TTAB 1989) (good cause found in view of circumstances and since fares to England were not that much greater than fares within the U.S. and no translation was required). *Cf. Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990) (applicant would be prejudiced by rebuttal testimonial deposition on written questions of opposer's survey expert who was present in U.S.), *corrected*, 19 USPQ2d 1479 (TTAB 1990).

521 Motion to Quash Notice of Deposition

A party to an inter partes proceeding before the Board may file a motion, prior to the taking of a noticed discovery or testimonial deposition, to quash the notice of deposition. Alternatively, in the case of a notice of discovery deposition and under appropriate circumstances, the party may file a motion for a protective order. *See*TBMP § 410.

A motion to quash may be filed on a variety of grounds. For example, a party may move to quash a notice of deposition on the ground that: (1) the proposed deposition is untimely [Note 1]; (2) the proposed deposition constitutes harassment or is without proper basis [Note 2]; (3) in the case of a discovery deposition to be taken in the United States, the deposition is not scheduled to be taken in the federal judicial district where the proposed deponent resides or is regularly employed, or at another place agreed upon by the parties in writing [Note 3]; (4) in the case of a deposition to be taken in a foreign country, the deposition is scheduled to be taken orally in violation of 37 C.F.R. § 2.120(c) or 37 C.F.R. § 2.123(a)(2) [Note 4]; (5) the deposing party has noticed depositions for more than one place at the same time, or so nearly at the same time that reasonable opportunity for travel from one place of examination to another is not available [Note 5]; (6) there was not due (i.e., reasonable) notice in writing of the proposed deposition [Note 6], *see*TBMP § 404.05 and TBMP § 703.01(e); (7) the taking of the deposition should be deferred until after determination of a certain motion pending before the Board, such as a motion for summary judgment; (8) the deposing party improperly seeks to force a foreign natural person to come to the United States for the taking of a deposition [Note 7], *see*TBMP § 404.03(b); (9) a testimonial deposition scheduled to be taken upon written questions should be taken orally (usually, this motion is titled as a motion that a deposition be taken orally) [Note 8]; (10) the deposing party's pretrial disclosures are insufficient, untimely or otherwise technically deficient [Note 9]; (11) the deposing party seeks to take the testimonial deposition of a witness who was not identified or who was improperly identified in that party's pretrial disclosures [Note 10] or (12) in the case of a testimonial deposition, the deposition is not scheduled to be taken in a reasonable time and place. [Note 11.]

However, the Board has no jurisdiction over nonparty depositions, or adverse witness depositions, taken by subpoena, and thus has no authority to quash such subpoenas. [Note 12.] *See*TBMP § 404.03(a)(2) and TBMP § 703.01(f).

A motion to quash a notice of deposition should be filed promptly after the grounds therefor become known to the moving party. In the situation where a party becomes aware that a noticed testimonial deposition is of a party not identified in the pretrial disclosures, the preferred practice is to file a motion to quash rather than a motion to strike the deposition after the testimonial deposition has occurred. When time is of the essence, the moving party should telephone the Board attorney to whom the case is assigned and ask that the motion be resolved by telephone conference call. [Note 13.] The Board has discretion to decide a motion by telephone conference prior to the expiration of the written briefing period for a response and reply. Telephone conference procedures on motions are fully discussed in TBMP § 413 and TBMP § 502.06(a).

NOTES:

1. *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008) (notice for deposition to be taken outside discovery period quashed when served on last day of discovery); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1298 (TTAB 1997) (notice was reasonable and timely; no scheduling conflict with depositions in civil action); *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652, 1652 (TTAB 1990) (notices of 13 depositions on written questions served eight months after original opening of testimony period, but within ten days of latest extension, were timely); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978) (deposition noticed during discovery but scheduled for date after discovery closed was untimely).

2. *See Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2049 (TTAB 1988) (notice to take deposition of CEO merely to discuss settlement was found baseless); *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (written discovery requests directed to assignor need not be answered where assignment occurred prior to institution of proceeding). *Cf. Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1565 (TTAB 2014) (motion for protective order to take deposition of non-testifying expert granted where no showing of "exceptional circumstances" has been made).

3. *See* 37 C.F.R. § 2.120(b); *Cf. Andrew R. Flanders v. DiMarzio, Inc.*, 2020 USPQ2d 10671, at *5 (TTAB 2020) (construed motion seeking protective order that respondent's Rule 30(b)(6) designee be deposed at a location other than respondent's principal place of business denied where movant did not present sufficient justification).

4. *See Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373-74 (TTAB 1978).

5. *See* 37 C.F.R. § 2.123(c).

6. *See* 37 C.F.R. § 2.123(c); Fed. R. Civ. P. 30(b) and 31(a); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 (TTAB 2007) (six days' notice reasonable); *Gaudreau v. American Promotional Events, Inc.*, 82 USPQ2d 1692, 1695 (TTAB 2007) (two days' notice unreasonable); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000) (whether notice is reasonable depends upon the circumstances of each case; one and two-day notices were not reasonable without compelling need for such haste, but three-day notice was reasonable).

See also, where objection to notice was raised by other means, *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 (TTAB 1999) (two-day notice unreasonable and failure of opposing counsel to

attend was excused); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998) (one-day notice for deposition of expert witness was short but not prejudicial where party gave notice "as early as possible" and moreover offered to make witness again available at a future date); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1074 (TTAB 1990) (24 hours not sufficient time for applicant to prepare for deposition but opposer allowed time to recall witness for purpose of cross-examination and redirect); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (two-day notice of deposition, although short, was not unreasonable where deposition was held a short distance from applicant's attorney's office and where no specific prejudice was shown).

7. *Cf. Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1430-31 (TTAB 1998) (issue raised by motion to compel). *See also Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises Ltd.*, 511 F.3d 437, 85 USPQ2d 1385, 1391 (4th Cir. 2007) (a district court could issue a subpoena for the deposition of a foreign party in the U.S. in connection with a Board case).

8. *See* 37 C.F.R. § 2.123(a)(1); *Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990) (good cause shown for oral deposition), *corrected*, 19 USPQ2d 1479 (TTAB 1990); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 590-91 (TTAB 1980) (good cause shown for oral deposition).

9. *See Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1242-43 (TTAB 2012) (witness first identified in pretrial disclosure not previously identified in initial disclosures, discovery responses, or any disclosure or discovery supplements).

10. 37 C.F.R. § 2.121(e). *Cf. Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1328 (TTAB 2011) (motion to quash and exclude testimony of witnesses identified for first time in amended and supplemental pretrial disclosures granted); *Jules Jurgenson/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444-45 (TTAB 2009) (motion to strike testimony of witness not identified in pretrial disclosures).

11. *See USPS v. RPost Communication Ltd.*, 124 USPQ2d 1045, 1046-47 (TTAB 2017) (motion to quash granted where oral cross-examination of declarants of testimony declarations noticed for California while declarants reside and work in the vicinity of Washington, D.C.).

12. *See Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1565 n.5 (TTAB 2014) (if subpoena accompanies notice of deposition, motion to quash would be filed in district court for which subpoena issued, not with the Board); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 n.3 (TTAB 1987) (Board has no jurisdiction over third-party subpoenas). *See also Highbeam Marketing LLC v. Highbeam Research, LLC*, 85 USPQ2d 1902, 1906-07 (TTAB 2008) (failure to have subpoena for discovery deposition quashed resulted in sanction precluding party from using survey evidence at trial).

13. *See* 37 C.F.R. § 2.120(i)(1). *See also Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1240 (TTAB 2012) (judicial economy served by promptly filing a motion to quash).

522 Motion for Order re Manner or Place of Document Production

37 C.F.R. § 2.120(e) ... *The time, place, and manner for production of documents, electronically stored information, and tangible things shall comport with the provisions of Rule 34 of the Federal Rules of Civil Procedure, or be made pursuant to agreement of the parties, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.*

In an inter partes proceeding before the Board, the place where documents and things are to be produced is governed by 37 C.F.R. § 2.120(e). The responding party is obligated to make the documents and materials responsive to the requests available for inspection where the documents and materials are kept in the ordinary course of business. [Note 1.] In Board proceedings, the responding party generally extends the courtesy of copying and sending the documents to the requesting party at the requesting party's expense. [Note 2.] For a discussion of the elements of a request for production and place of production see TBMP § 406.03. [Note 3.]

Accordingly, upon motion, the Board, in its discretion, may make any appropriate order concerning the place and/or manner of production of documents and things. [Note 4.]

NOTES:

1. *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

2. *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

3. *See also M.C.I. Foods Inc. v. Bunte*, 86 USPQ2d 1044, 1048 (TTAB 2008) *(citing No Fear v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000)) (improper to object regarding place of production when ordered to provide responses without objection); *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013, 1014-15 (TTAB 1983) (while normal practice is for party to produce documents at the place where they are kept, Board ordered respondent to make copies and mail to petitioner's attorney at petitioner's expense or hand-deliver the documents to petitioner's attorney); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 195 (TTAB 1976) (documents to be produced as part of a discovery deposition would be produced where they are located).

4. *See Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013, 1014-15 (TTAB 1983). *See also No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000) (applicant ordered to copy responsive documents and forward them to opposer at applicant's expense as discovery sanction); *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1432 (TTAB 1998).

523 Motion to Compel Disclosure or Discovery

523.01 In General

37 C.F.R. § 2.120(f) ***Motion for an order to compel disclosure or discovery.***

(1) *If a party fails to make required initial disclosures or expert testimony disclosure, or fails to designate a person pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, or if a party, or such designated person, or an officer, director or managing agent of a party fails to attend a deposition or fails to answer any question propounded in a discovery deposition, or any interrogatory, or fails to produce and permit the inspection and copying of any document, electronically stored information, or tangible thing, the party entitled to disclosure or seeking discovery may file a motion to compel disclosure, a designation, or attendance at a deposition, or an answer, or production and an opportunity to inspect and copy…*

(2) *When a party files a motion for an order to compel initial disclosures, expert testimony disclosure, or discovery, the case will be suspended by the Board with respect to all matters not germane to the motion. After the motion to compel is filed and served, no party should file any paper that is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of a*

motion to compel any disclosure or discovery shall not toll the time for a party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. If discovery has closed, however, the parties need not make pretrial disclosures until directed to do so by the Board.

In inter partes proceedings before the Board, a motion to compel is available in the event of a failure to provide required disclosures or discovery requested by means of discovery depositions, interrogatories, and requests for production of documents and things. [Note 1.] A motion to compel is also available to compel attendance at a discovery conference [Note 2], or to compel a party to supplement inadequate disclosures [Note 3], or to compel initial disclosures, see 37 C.F.R § 2.120(f). With regard to initial disclosures, however, a party may file a motion for sanctions when the adverse party has expressly stated that it does not intend to meet its obligation to provide initial disclosures. [Note 4.] A motion to compel discovery that has not been propounded through discovery requests, however, should not be filed. [Note 5.] For further information regarding the duty to hold a discovery conference, see TBMP § 408.01(a).

Motions to compel are also available to compel an answer to a deposition question. Because discovery depositions are taken out of the presence of the Board, if a witness being deposed, or the attorney for the witness, believes a question is improper, an objection may be stated, but the question normally should be answered subject to the stated objection. *See*TBMP § 404.08(c). However, if a witness being deposed objects to, and refuses to answer, a particular question, and if the deposition is being taken pursuant to a subpoena, the propounding party may attempt to obtain an immediate ruling on the propriety of the objection, by adjourning the deposition and applying, under 35 U.S.C. § 24, to the federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer. *See*TBMP § 404.09 and TBMP § 411.03. In the absence of a court order compelling an answer, the propounding party's only alternative, if it wishes to compel an answer, is to complete the deposition and then file a motion to compel with the Board. [Note 6.]

Further, a party who fails to provide its initial disclosures will be barred from propounding discovery requests, whether interrogatories, requests for production or requests for admission, and may not file a motion to compel to obtain responses to improperly propounded discovery requests. [Note 7.]

In accordance with 37 C.F.R. § 2.120(f), when a party files a motion to compel disclosures or discovery, the Board will issue an order suspending the proceeding with respect to all matters not germane to the motion, and no party should file any paper that is not germane to the discovery dispute, except as otherwise specified in the Board's suspension order. However, neither the filing of a motion to compel nor the Board's resulting suspension order tolls the time for parties to make required disclosures or respond to any outstanding discovery requests which had been served prior to the filing of the motion to compel, nor does it excuse a party's appearance at any discovery deposition which had been duly noticed prior to the filing of the motion to compel. When the motion to compel is filed after discovery has closed, but before the day of the deadline for pretrial disclosures for the first testimony period, the time period for making pretrial disclosures will be suspended and dates will be reset after the motion to compel is decided. [Note 8.]

37 C.F.R. § 2.120(f) provides that a motion to compel initial disclosures must be filed within thirty days after the deadline therefor, a motion to compel expert testimony disclosure must be filed prior to the close of the discovery period, and a motion to compel discovery must be filed before the day of the deadline for pretrial disclosures for the first testimony period as originally set or as reset. [Note 9.] 37 C.F.R. § 2.120(i)(1) provides that a motion to determine the sufficiency of an answer or objection to a request for admission must be filed before the day of the deadline for pretrial disclosures for the first testimony period, as originally set or as reset. [Note 10.] These rules are designed to ensure that all discovery disputes are resolved prior to the commencement of trial. A motion to compel discovery or to test the sufficiency of an answer or

objection to a request for admission is untimely if filed on or after the day of the deadline for pretrial disclosures for the first testimony period, even if the day of the deadline for pretrial disclosures is subsequently reset. [Note 11.] *See*TBMP § 523.03.

The motion to compel procedure is not applicable to requests for admission. The procedure to be followed in the case of requests for admission is as set forth in 37 C.F.R. § 2.120(i)(1) and Fed. R. Civ. P. 36(a). *See also*TBMP § 411.03 (Requests for Admission) and TBMP § 524 (Motion to Test Sufficiency of Response to Admission Request).

For information concerning the effect of a party's failure to timely respond to interrogatories and document requests, see TBMP § 403.03 (Time for Service of Discovery Responses), TBMP § 405.04(a) (Time for Service of Responses), TBMP § 406.04(a) (Time for Service of Responses), and TBMP § 411 (Remedy for Failure to Provide Disclosures or Discovery); and see TBMP § 523 (Motion to Compel Discovery Responses) and TBMP § 524 (regarding motion to test sufficiency of responses to admission requests).

NOTES:

1. *See* 37 C.F.R. § 2.120(f). *See also, e.g., Johnson and Johnson and Roc International S.A.R.L. v. Obschestvo s Oranitchennoy; Otvetstvenn Ostiu "Wds,"* 95 USPQ2d 1567, 1570 (TTAB 2010) (TTAB 2010) (motion to compel applicant to supplement interrogatory responses granted); *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008) (motion to compel available remedy when adverse party fails to provide initial or expert disclosures); *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1436 (TTAB 1998) (interrogatories and document requests); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1298 (TTAB 1997) (discovery deposition); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979) (interrogatories); *General Sealer Corp. v. H. H. Robertson Co.*, 193 USPQ 384, 384 (TTAB 1976) (motion for sanctions treated as motion to compel); *Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127, 128 (TTAB 1976) (party may file motion to compel if it believes objections to discovery requests to be improper). *See also Spa International, Inc. v. European Health Spa, Inc.*, 184 USPQ 747, 747 (TTAB 1975) (discussing when it is appropriate to file a motion to compel or a motion for discovery sanctions); *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 616 (TTAB 1974) (motion to compel is not untimely simply because it is made after discovery period has expired, merely because it relates back to earlier timely request; motion for discovery sanctions denied because no discovery order has issued); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974) (motion to compel production of documents), *overruled on other grounds by Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171-72 (TTAB 1975); *Dow Corning Corp. v. Doric Corp.*, 183 USPQ 126, 127 (TTAB 1974) (Board can rule on objections to request for production in connection with the filing of a motion to compel). *Cf.* Fed. R. Civ. P. 37(a)(3)(B).

2. *Promgirl Inc. v. JPC Co.* , 94 USPQ2d 1759, 1762-63 (TTAB 2009) (plaintiff's motion for sanctions in the form of judgment for defendant's failure to participate in discovery conference denied, but alternative motion to compel attendance at a discovery conference granted). Note, however, that a motion to compel a party to participate in a discovery conference is not a prerequisite to filing a motion for sanctions under 37 C.F.R. § 2.120(h).

3. *RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1493 (TTAB 2013) (motion to compel available for inadequate expert disclosures); *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1860 n.3 (TTAB 2008) (motion to compel available for inadequate initial disclosures).

4. *Kairos Institute of Sound Healing LLC v. Doolittle Gardens, LLC*, 88 USPQ2d 1541, 1542-43 (TTAB 2008).

5. *Chix Gear, LLC v. Princess Race Wear Corp.*, 2019 USPQ2d 455321 (TTAB 2019) (motion to compel production of metadata denied because propounding party never sought the production of such information/documentation by way of its discovery requests).

6. *See* 37 C.F.R. § 2.120(f)(1); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974) *overruled on other grounds by Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171-72 (TTAB 1975).

7. 37 C.F.R. § 2.120(a)(3); *Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705-06 (TTAB 2009) (a party that wishes to object to discovery on the ground that its opponent failed to make its required initial disclosures prior to serving the discovery must assert that basis for objection to the discovery clearly and specifically); *MySpace, Inc. v. Donnell Mitchell*, 91 USPQ2d 1060, 1060 (TTAB 2009) (defendant's motion to compel denied because defendant had not made the required initial disclosures).

8. *See* 37 C.F.R. § 2.120(f). ("If discovery has closed, however, the parties need not make pretrial disclosures until directed to do so by the Board."). *See also HighBeam Marketing LLC v. Highbeam Research LLC*, 85 USPQ2d 1902, 1907 (TTAB 2008) (motion to compel attendance of employees for depositions granted where moving party made good faith effort to schedule depositions but opposer failed to cooperate).

9. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE 82 Fed. Reg. 33804 (July 21, 2017). *Cf. KID-Systeme GmbH v. Turk Hava Yollari Teknik Anonim*, 125 USPQ2d 1415, 1416-17 (TTAB 2018) (motion for summary judgment must be filed the day before the deadline for pretrial disclosures); *Shared, LLC v. SharedSpaceofAtlanta, LLC*, 125 USPQ2d 1143, 1144 (TTAB 2017) ("[A] motion for judgment on the pleadings must also be filed before the day of the deadline for pretrial disclosures for the first testimony period, as originally set or as reset.").

10. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE 82 Fed. Reg. 33804 (July 21, 2017). *Cf. KID-Systeme GmbH v. Turk Hava Yollari Teknik Anonim*, 125 USPQ2d 1415, 1416-17 (TTAB 2018) (motion for summary judgment must be filed the day before the deadline for pretrial disclosures); *Shared, LLC v. SharedSpaceofAtlanta, LLC*, 125 USPQ2d 1143, 1144 (TTAB 2017) ("[A] motion for judgment on the pleadings must also be filed before the day of the deadline for pretrial disclosures for the first testimony period, as originally set or as reset.").

11. *Cf. La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976) (motion for summary judgment filed during the period for taking testimony untimely).

523.02 Special Requirements for Motion

37 C.F.R. § 2.120(f) ***Motion for an order to compel disclosure or discovery.***

(1) ... *A motion to compel discovery shall include a copy of the request for designation of a witness or of the relevant portion of the discovery deposition; or a copy of the interrogatory with any answer or objection that was made; or a copy of the request for production, any proffer of production or objection to production in response to the request, and a list and brief description of the documents, electronically stored information, or tangible things that were not produced for inspection and copying. A motion to compel initial disclosures, expert testimony disclosure, or discovery must be supported by a showing from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion but the parties were unable to resolve their differences. If issues raised in the motion are subsequently resolved by agreement of the*

parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.

A motion to compel must include a copy of the request for discovery and the response thereto, as specified in 37 C.F.R. § 2.120(f). [Note 1.]

In addition, the motion to compel disclosures or discovery must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement. [Note 2.] The statement should contain a recitation of the communications conducted including dates, a summary of telephone conversations, and where applicable, copies of any correspondence exchanged such as email and letters, or notes to the file. [Note 3.]

In determining whether a good faith effort to resolve the discovery dispute has been made, the Board may consider, among other things, whether the moving party has investigated the possibility of resolving the dispute, whether, depending on the circumstances, sufficient effort was made towards resolution, and whether attempts at resolution were incomplete. [Note 4.]

In the event that issues raised in the motion are subsequently resolved by the parties, the moving party should inform the Board in writing, filed through ESTTA, of the issues in the motion that no longer require determination. [Note 5.]

For information concerning the special requirements for a motion to compel answers to interrogatories, or to produce documents, ESI or tangible things that are the subject of a general objection on the ground of excessive number, see TBMP § 405.03(e) and TBMP § 406.03(e). *Cf.*TBMP § 526.

NOTES:

1. *See Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127, 128 (TTAB 1976) (Board must be able to render a meaningful decision on a motion to compel); *Amerace Corp. v. USM Corp.*, 183 USPQ 506, 506-07 (TTAB 1974); *Helene Curtis Industries, Inc. v. John H. Breck, Inc.*, 183 USPQ 126, 126 (TTAB 1974) (party must submit a copy of actual written objections to interrogatories along with motion to compel).

2. 37 C.F.R. § 2.120(f). *See Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081-82 (TTAB 2014) (discussing generally good faith effort requirement; finding single email exchange between the parties insufficient to establish good faith effort as it was incumbent upon applicant to make at least one additional inquiry); *Amazon Technologies, Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (good faith effort requirement); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1679 n.11 (TTAB 2005) (motion to compel demonstrated good faith effort and included copies of relevant document requests and responses); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 632 (TTAB 1986) (failed to submit documentary evidence of good faith effort); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (parties must narrow disputed requests for discovery to a reasonable number); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (nature and the number of discovery requests clearly demonstrated that no good faith effort had been made); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 450 (TTAB 1979) (good faith effort is required where there has been a complete failure to respond to discovery; telephone call to counsel sufficient); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 954 (TTAB 1979) (same; a statement that discovery has not been responded to is insufficient).

3. *Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014).

4. *Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014).

5. 37 C.F.R. § 2.120(f). *See, e.g., Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 (TTAB 1987) (late responses rendered motion to compel, based on complete non-responsiveness, moot).

523.03 Time for Filing Motion

37 C.F.R. § 2.120(f) ***Motion for an order to compel disclosure or discovery.***

(1) ... *A motion to compel initial disclosures must be filed within thirty days after the deadline therefor and include a copy of the disclosure(s), if any, and a motion to compel an expert testimony disclosure must be filed prior to the close of the discovery period. A motion to compel discovery must be filed before the day of the deadline for pretrial disclosures for the first testimony period as originally set or as reset.* …

A motion to compel initial disclosures must be filed within thirty days after the deadline therefor to allow time for the non-compliant party to conduct discovery after making its disclosures. [Note 1.] A motion to compel expert testimony disclosures must be filed prior to the close of the discovery period. [Note 2.]

A motion to compel discovery does not necessarily have to be filed during the discovery period. [Note 3.] However, the motion should be filed within a reasonable time after the failure to respond to a request for discovery or after service of the response believed to be inadequate and must, in any event, be filed before the day of the deadline for pretrial disclosures for the first testimony period. [Note 4.] A moving party should also wait a reasonable time after the responses are due to file a motion to compel, to allow time for receipt of responses. [Note 5.] If the day before the deadline for pretrial disclosures for the first testimony period is reset before the day of the deadline for pretrial disclosures for the first testimony period passes, a motion to compel filed before the rescheduled or reset day of the deadline for pretrial disclosures for the first testimony period is timely. However, as of the day of the deadline for pretrial disclosures for the first testimony period, a motion to compel filed is untimely, even if it is filed prior to the opening of the day of a rescheduled or reset deadline for pretrial disclosures for the first testimony period. [Note 6.] There is no provision in the rule for Board discretion to consider an untimely motion to compel. Trial schedules include a forty-five day period between the close of discovery and the day of the deadline for pretrial disclosures for the first testimony period to allow time for the filing of any necessary discovery motions.

NOTES:

1. 37 C.F.R. § 2.120(f).

2. 37 C.F.R. § 2.120(f).

3. *See H.D. Lee Co. v. Maidenform, Inc.*, 87 USPQ2d 1715, 1719 n.10 (TTAB 2008); *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 617 (TTAB 1974).

4. 37 C.F.R. § 2.120(e); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 82 Fed. Reg. 33804 (July 21, 2017). *See, e.g., Asustek Computer Inc. v. Chengdu Westhouse Interactive Entertainment Co.*, 128 USPQ2d 1470 (TTAB 2018) (reconsideration of Board order denying untimely motion to compel filed on deadline for pretrial disclosures denied); *Cf. Shared, LLC v. SharedSpaceofAtlanta, LLC*, 125 USPQ2d 1143, 1144 (TTAB 2017) ("[A] motion for judgment on

the pleadings must also be filed before the day of the deadline for pretrial disclosures for the first testimony period, as originally set or as reset.”)..

5. *See* 37 C.F.R. § 2.120(e); *MySpace, Inc. v. Donnell Mitchell*, 91 USPQ2d 1060, 1061 n.2 (TTAB 2009) (because timely-served discovery responses might not arrive until after deadline, receiving party should wait a reasonable time beyond service date before making a motion alleging failure to serve). *See, e.g., Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1383 (TTAB 2001) (deficiencies in applicant’s discovery responses should have been addressed by timely filing of properly-supported motion to compel discovery). **Please Note:** The deadlines for filing motions to compel were changed in the January 14, 2017 revisions to 37 C.F.R. § 2.120(e) renumbered as § 2.120(f). Prior Board decisions may cite to former deadlines no longer applicable in inter partes proceedings.

6. To be clear, if the day of the deadline for pretrial disclosures was reset after the deadline was past, a motion to compel would be untimely. *Cf. La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 234-36 (Comm’r 1976) (motion for summary judgment filed during the period for taking testimony untimely).

523.04 Failure to File Motion to Compel

If a party that served a request for discovery receives a response thereto that it believes to be inadequate, but fails to file a motion to challenge the sufficiency of the response, it may not thereafter be heard to complain about the sufficiency thereof. [Note 1.] *Accord*TBMP § 524.04 (regarding failure to file motion regarding sufficiency of admission responses). *Cf.*TBMP § 527.01(e) (Estoppel Sanction).

NOTES:

1. *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1439 (Fed. Cir. 2012) (Board did not abuse its discretion by refusing to strike plaintiff’s evidence where defendant failed to follow up on plaintiff’s offer to produce the evidence at a mutually agreeable time and place and in view of defendant’s failure to file a motion to compel); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1719 (TTAB 2008) (party that receives response it believes inadequate but fails to file a motion to test sufficiency of response, may not thereafter complain about its insufficiency); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1656 (TTAB 2002) (having failed to file motion to compel, defendant will not later be heard to complain that interrogatory responses were inadequate); *Linville v. Rivard*, 41 USPQ2d 1731, 1733 (TTAB 1996) (objections that discovery requests are, for example, ambiguous or burdensome, are not of a nature which would lead propounding party to believe that the requested information does not exist and party should have filed motion to compel), *aff’d*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue material, evidence introduced by applicant at trial was considered), *aff’d*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *overruled on other grounds, The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720, 723 (TTAB 1984) (Board will not impose sanction of drawing adverse inferences against party based on inconsistent responses to questions asked during discovery deposition without motion to compel complete responses and violation of an order compelling answers). *See also Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1383 (TTAB 2001) (motion to compel time-barred).

524 Motion to Test Sufficiency of Response to Requests for Admission

524.01 In General

Fed. R. Civ. P. 36(a)(3) Time to Respond; Effect of Not Responding.

A matter is admitted unless, within 30 days after being served, the party to whom the request is directed serves on the requesting party a written answer or objection addressed to the matter and signed by the party or its attorney. A shorter or longer time for responding may be stipulated to under Rule 29 or be ordered by the court.

Fed. R. Civ. P. 36(a)(6) Motion Regarding the Sufficiency of an Answer or Objection. *The requesting party may move to determine the sufficiency of an answer or objection. Unless the court finds an objection justified, it must order that an answer be served. On finding that an answer does not comply with this rule, the court may order either that the matter is admitted or that an amended answer be served. ...*

37 C.F.R. § 2.120(i) ***Request for admissions.***

...

(2) *When a party files a motion to determine the sufficiency of an answer or objection to a request for an admission, the case will be suspended by the Board with respect to all matters not germane to the motion. After the motion is filed and served, no party should file any paper that is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of a motion to determine the sufficiency of an answer or objection to a request for admission shall not toll the time for a party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. If discovery has closed, however, the parties need not make pretrial disclosures until directed to do so by the Board.*

If a propounding party is dissatisfied with a responding party's answer or objection to a request for admission, and wishes to obtain a ruling on the sufficiency thereof, the propounding party may file a motion with the Board to determine the sufficiency of the response. [Note 1.] *Cf.* TBMP § 523.01 (Motion to Compel Discovery – In General).

If the Board, upon motion to test the sufficiency of a response to a request for admission, determines that an answer does not comply with the requirements of Fed. R. Civ. P. 36(a), it may order either that the matter is deemed admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that an answer be served. [Note 2.]

Generally, if there is an admission or a denial, the Board will not find the response to be insufficient even if the responding party included an explanation or clarification of the admission or denial, or admitted after first denying. [Note 3.] If no response is timely served to a request for admission, the matter is automatically deemed admitted, and no motion is necessary. [Note 4.] See TBMP § 525 and TBMP § 527.01(d) for further discussion.

NOTES:

1. *See* 37 C.F.R. § 2.120(i); Fed. R. Civ. P. 36(a); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.* , 188 USPQ 690, 691 (TTAB 1975); *Watercare Corp. v. Midwesco-Enterprise, Inc.* , 171 USPQ 696, 698 n.7 (TTAB 1971). *Cf.* 37 C.F.R. § 2.120(f).

2. Fed. R. Civ. P. 36(a).

3. *Cf.* Fed. R. Civ. P. 36(a)(4 – 6) Committee Notes on Rules - 1970 amendment regarding improper responses which may be considered effective admissions.

4. Fed. R. Civ. P. 36(a)(3).

524.02 Special Requirements for Motion

37 C.F.R. § 2.120(i)(1) ***Request for admissions.***

(1) *... The motion shall include a copy of the request for admission and any exhibits thereto and of the answer or objection. The motion must be supported by a written statement from the moving party showing that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.*

A motion to determine the sufficiency of a response to a request for admission must include a copy of the request for admission (and any exhibits thereto) and of the answer or objection. [Note 1.]

In addition, the motion must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement. [Note 2.] *Cf.*TBMP § 523.02.

In the event that issues raised in the motion are subsequently resolved by the parties, the moving party should immediately inform the Board in writing, filed through ESTTA, of the issues in the motion that no longer require determination. [Note 3.]

NOTES:

1. 37 C.F.R. § 2.120(i). *Cf.* 37 C.F.R. § 2.120(f).

2. 37 C.F.R. § 2.120(i). *Cf.* 37 C.F.R. § 2.120(f); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009).

3. 37 C.F.R. § 2.120(i). *Cf.* 37 C.F.R. § 2.120(f).

524.03 Time for Filing Motion

37 C.F.R. § 2.120(i) ***Request for admissions.***

(1) *Any motion by a party to determine the sufficiency of an answer or objection, including testing the sufficiency of a general objection on the ground of excessive number, to a request made by that party for an admission must be filed before the day of the deadline for pretrial disclosures for the first testimony period, as originally set or as reset. ...*

(2) *When a party files a motion to determine the sufficiency of an answer or objection to a request for an admission, the case will be suspended by the Board with respect to all matters not germane to the motion. After the motion is filed and served, no party should file any paper that is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party serve any additional discovery until the period of suspension is lifted or expires by or under order of the Board. The filing of a motion to determine the sufficiency of an answer or objection to a request for admission shall not toll the time for a party to comply with any disclosure requirement or to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. If discovery has closed, however, the parties need not make pretrial disclosures until directed to do so by the Board.*

A motion to test the sufficiency of a response to a request for admission does not necessarily have to be filed during the discovery period, but it should be filed within a reasonable time after service of the response believed to be inadequate and, in any event, must be filed before the day of the deadline for pretrial disclosures for the first testimony period, as originally set or as reset. [Note 1.] As with a motion to compel, a motion to test the sufficiency not filed before the day of the deadline for pretrial disclosures for the first testimony period is untimely, even if the day of the deadline for pretrial disclosures for the first testimony period is subsequently reset. If the day of the deadline for pretrial disclosures for the first testimony period is reset before the day of the deadline for pretrial disclosures for the first testimony period as originally set, a motion to test sufficiency will be timely if it is filed before the day of the rescheduled deadline for the pretrial disclosures for the first testimony period. However, as of the day of the deadline for pretrial disclosures for the first testimony period, a motion to test sufficiency filed thereafter is untimely, even if it is filed prior to the day of the rescheduled or reset deadline for pretrial disclosures for the first testimony period. [Note 2.] There is no provision in the rule for Board discretion to consider an untimely motion to test the sufficiency of a response to a request for admission. Trial schedules include a forty-five-day period between the close of discovery and day of the deadline for pretrial disclosures for the first testimony period to allow time for the filing of any necessary discovery motions. *Cf.*TBMP § 523.03.

NOTES:

1. 37 C.F.R. § 2.120(i)(1); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 82 Fed. Reg. 33804 (July 21, 2017). *Cf. Asustek Computer Inc. v. Chengdu Westhouse Interactive Entertainment Co.*, 128 USPQ2d 1470 (TTAB 2018) (reconsideration of Board order denying untimely motion to compel filed on deadline for pretrial disclosures denied); *Shared, LLC v. SharedSpaceofAtlanta, LLC*, 125 USPQ2d 1143, 1144 (TTAB 2017) ("[A] motion for judgment on the pleadings must also be filed before the day of the deadline for pretrial disclosures for the first testimony period, as originally set or as reset.").

2. To be clear, if the deadline for pretrial disclosures was reset after the deadline was past, a motion to test the sufficiency of request for admission responses would be untimely.37 C.F.R. § 2.120(h)(1); *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696, 697-98 n.7 (TTAB 1971) (opposer's motion at final hearing seeking ruling on propriety of applicant's responses to requests for admission was manifestly untimely; discovery is a pre-trial procedure and all matters pertinent thereto should be resolved prior to trial); *Cf. La Maur, Inc. v. Bagwells Enterprises Inc.*, 193 USPQ 234, 235 (Comm'r 1976) (motion for summary judgment filed during the period for taking testimony untimely). **Please Note:** The deadlines for filing motions to test the sufficiency were changed in the January 14, 2017 revisions to 37 C.F.R. § 2.120. Prior Board decisions may cite to former deadlines no longer applicable in inter partes proceedings.

524.04 Failure to File Motion

If a party that served a request for admission receives a response thereto that it believes to be inadequate, but fails to file a motion to test the sufficiency of the response, it may not thereafter be heard to complain about the sufficiency thereof. [Note 1.] *Cf.*TBMP § 523.04.

NOTES:

1. 37 C.F.R. § 2.120(i)(1); *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696, 697-98 n.7 (TTAB 1971).

525 Motion to Withdraw or Amend Admission

Fed. R. Civ. P. 36(b) Effect of an Admission; Withdrawing or Amending It. *A matter admitted under this rule is conclusively established unless the court, on motion, permits the admission to be withdrawn or amended. ...[T]he court may permit withdrawal or amendment if it would promote the presentation of the merits of the action and if the court is not persuaded that it would prejudice the requesting party in maintaining or defending the action on the merits. An admission under this rule is not an admission for any other purpose and cannot be used against the party in any other proceeding.*

Fed. R. Civ. P 6(b)(1)(B) Extending Time.

(1) ***In General.*** *When an act may or must be done within a specified time, the court may, for good cause, extend the time:*

(B) on motion made after the time has expired if the party failed to act because of excusable neglect.

Any matter admitted under Fed. R. Civ. P. 36 is conclusively established unless the Board, upon motion, permits withdrawal or amendment of the admission. [Note 1.] *See*TBMP § 407.04. This applies both to matters expressly admitted; and to those deemed admitted for failure to timely respond to a request for admission, where there is no persuasive showing that the failure to timely respond was the result of excusable neglect. [Note 2.] *See*TBMP § 407.03(a) and TBMP § 407.04. For this reason, in instances where a party fails to respond to a request for admission, the serving party need not file a motion requesting that the matter be deemed admitted.

In order to avoid admissions resulting from a failure to respond, a responding party may pursue two separate avenues for relief, namely: a party may either (1) move to reopen its time to serve responses to the outstanding admission requests because its failure to timely respond was the result of excusable neglect under Fed. R. Civ. P. 6(b)(1)(B); or (2) the moving party implicitly acknowledges that the responses are late, deemed admitted, and moves to withdraw and amend its admissions pursuant to Fed. R. Civ. P. 36(b). The crucial distinction is that under Fed. R. Civ. P. 6(b)(1)(B), the moving party is seeking to be relieved of the untimeliness of its response, so that the admissions would not be deemed admitted as put. [Note 3.]

Upon motion under Fed. R. Civ. P. 36(b), the Board may permit withdrawal or amendment of an admission when the presentation of the merits of the proceeding will be subserved thereby, and the propounding party fails to satisfy the Board that withdrawal or amendment will prejudice said party in maintaining its action or defense on the merits. [Note 4.] The timing of a motion to withdraw or amend an admission plays a significant role in the Board's determination of whether the propounding party will be prejudiced by withdrawal or amendment. [Note 5.] *Cf.*TBMP § 507.02.

NOTES:

1. *See* Fed. R. Civ. P. 36(b).

2. *See* Fed. R. Civ. P. 6(b)(1)(B) and Fed. R. Civ. P. 36.

3. *Giersch v. Scripps*, 85 USPQ2d 1306, 1307-09 (TTAB 2007) (respondent sought to show both excusable neglect to be relieved of the untimeliness of its responses under Fed. R. Civ. P. 6(b)(2) and, alternatively, to withdraw the effective admissions under Fed. R. Civ. P. 36(b) and have responses accepted; Board granted the motion under Fed. R. Civ. P. 36(b)). **Please Note:** as part of general restyling, effective December 1, 2007, former Fed. R. Civ. P. 6(b)(2) is now Fed. R. Civ. P. 6(b)(1)(B).

4. Fed. R. Civ. P. 36(b); *Giersch v. Scripps Networks, Inc.*, 85 USPQ2d 1306, 1308-09 (TTAB 2007) (motion to withdraw effective admissions granted); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (amendment permitted where the requested admissions were ambiguous and conclusory and possible prejudice avoided by extending discovery period); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989) (presentation of merits of case aided by relieving opposer of admission on relevant issue and prejudice avoided by allowing applicant limited discovery as to the amended answer); *BankAmerica Corp. v. International Travelers Cheque Co.*, 205 USPQ 1233, 1235-36 (TTAB 1979) (motion to withdraw admissions by default denied, but to extent admissions are contradicted by evidence, they will not be relied on for purposes of deciding whether entry of summary judgment is appropriate). *See also American Automobile Association (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144-45 (5th Cir. 1991) (court may not sua sponte withdraw or ignore admissions without a motion to withdraw or amend).

5. *See Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (motion to withdraw admissions granted when propounding party's testimony period had not yet opened); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989) (motion to withdraw admissions granted when case was still in pretrial stage).

526 Motion for a Protective Order

37 C.F.R. § 2.120(g) ***Motion for a protective order.*** *Upon motion by a party obligated to make initial disclosures or expert testimony disclosure or from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (A) through (H), inclusive, of Rule 26(c)(1) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party comply with disclosure obligations or provide or permit discovery.*

In inter partes proceedings before the Board, motions for a protective order are governed by 37 C.F.R. § 2.120(g).

It is generally inappropriate for a party to respond to a request for discovery by filing a motion attacking it, such as a motion to strike, or a motion for a protective order. Rather, the party ordinarily should respond by providing the information sought in those portions of the request that it believes to be proper, and stating its objections to those which it believes to be improper. [Note 1.] *See*TBMP § 410 (Asserting Objections

to Requests for Discovery; Motions Attacking Requests for Discovery) and TBMP § 412.06 (Protective Orders Limiting Discovery).

Moreover, if a party upon which interrogatories, requests for production, or request for admission have been served believes that the number of interrogatories, requests for production, or requests for admission served exceeds the limitation specified in 37 C.F.R. § 2.120(d),37 C.F.R. § 2.120(e), or 37 C.F.R. § 2.120(i), and is not willing to waive this basis for objection, the party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, requests for production, or requests for admission, or a motion for a protective order, serve a general objection on the ground of their excessive number, leaving the inquiring party with the burden of filing a motion to compel if it believes that the objection is not well taken. For a discussion regarding excessive discovery requests, *see*TBMP § 405.03(e), TBMP § 406.05(e) and TBMP § 407.05(e). *Cf.*TBMP § 523.02. [Note 2.]

Nevertheless, there are certain situations (such as, for example, when a request for discovery constitutes clear harassment, or when a party has not provided its initial disclosures, or when a defendant upon which a request for discovery has been served is not and was not, at the time of the commencement of the proceeding, the real party in interest) in which a party may properly respond to a request for discovery by filing a motion for a protective order that the discovery not be had, or be had only on specified terms and conditions. [Note 3.]

Except in situations such as those described above, a motion for a protective order ordinarily should be filed in a Board proceeding only in response to a motion to compel where, for example, matter sought to be discovered assertedly constitutes trade secret or confidential information, or cannot be provided without undue burden or expense. [Note 4.]

Under appropriate circumstances, the Board has the discretion to order a deposition not be had or to limit a deposition. [Note 5.] **Please Note:** The Board does not have jurisdiction to grant protective relief for depositions noticed under subpoena.

Please Note: There is a distinction between a motion for a protective order to address over-reaching discovery, and a motion for a protective order relating to facilitating the exchange of discovery in connection with the Board's standard protective order, which provides tiers of protection to confidential information.

For a detailed discussion concerning motions for protective orders and the Board's standard protective order, see TBMP § 412.

NOTES:

1. *See Luemme Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999).

2. *See* 37 C.F.R. § 2.120(e); 37 C.F.R § 2.120(d); *Hewlett Packard Enterprises Development LP v. Arroware Industries, Inc.*, 2019 USPQ2d 158663, at *2-3 (TTAB 2019) (Trademark Rule 2.120(d) clearly provides that a party should serve general objection on ground that discovery requests are excessive in number and not lodge specific objections and answers to each discovery request).

3. *See, e.g.*, 37 C.F.R. § 2.120(g); Fed. R. Civ. P. 26(c); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (protective order granted against 707 requests for admission, 247 document requests, and 26 enumerated interrogatories); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013) (protective order granted as to 94 requests for admissions which were either duplicative

or sought admissions regarding unpleaded registrations); *Weatherford/Lamb Inc. v. C&J Energy Services, Inc.*, 96 USPQ2d 1834, 1836 n.3 (TTAB 2010) (protective order granted that petitioner need only produce limited or representative samples of responsive documents); *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1613 (TTAB 1991) (protective order granted as to discovery relating to foreign activities); *C.H. Stuart Inc. v. S.S. Sarna, Inc.*, 212 USPQ 386, 387 (TTAB 1980) (protective order granted as to discovery not tailored to issues in Board proceeding, including those seeking information regarding whether officers of applicant had been convicted of a crime or subject to a proceeding before the U.S. government); *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (protective order granted where obligation to respond to discovery requests rested with assignee).

4. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1674-77 (TTAB 1988).

For other examples of cases involving a motion for a protective order relating to discovery, see generally *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1611-12 (TTAB 1991) (request for protective order that discovery be governed by the Hague Convention) and *Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd.*, 188 USPQ 141, 144 (TTAB 1975) (motion for protective order that discovery not be taken pending Board's determination of motion to dismiss).

5. *See, e.g., Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1568 (TTAB 2014) (protective order granted with regard to taking noticed deposition of expert after redesignation by party as non-testifying expert); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1673-77 (TTAB 2004) (protective order granted to prevent the taking of additional depositions as to three of six employees); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1764 (TTAB 1999) (protective order against taking deposition of high level executive granted); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (granting protective relief in connection with a deposition on written questions in that party is free to object and refuse to answer those questions that it believes are not relevant; denying protective relief to the extent that the Board will review questions at issue to determine if they are relevant to the proceeding).

527 Motion for Sanctions

527.01 Motion for Discovery Sanctions

527.01(a) For Failure to Comply With Board Discovery Order

37 C.F.R. § 2.120(h) ***Sanctions.***

(1) *If a party fails to participate in the required discovery conference, or if a party fails to comply with an order of the Trademark Trial and Appeal Board relating to disclosure or discovery, including a protective order, the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board will not hold any person in contempt or award expenses to any party. The Board may impose against a party any of the sanctions provided in Rule 37(b)(2) in the event that said party or any attorney, agent, or designated witness of that party fails to comply with a protective order made pursuant to Rule 26(c) of the Federal Rules of Civil Procedure. A motion for sanctions against a party for its failure to participate in the required discovery conference must be filed prior to the deadline for any party to make initial disclosures.*

If a party fails to comply with an order of the Board relating to discovery, including a protective order or an order compelling discovery, the Board may enter appropriate sanctions, as defined in 37 C.F.R. §

2.120(h)(1). [Note 1.] In the case of a protective order, the Board may enter these sanctions against a party if the party or any attorney, agent, or designated witness of the party fails to comply with the protective order. [Note 2.]

Sanctions may also be appropriate when a party refuses to participate in a discovery conference under 37 C.F.R. § 2.120, without the need for the moving party to first file a motion to compel its adversary's attendance at a discovery conference. [Note 3]. *See* TBMP § 401.01 and TBMP § 408.01(a) for further information on discovery conferences and the duty to cooperate. If the deadline for the required discovery conference passes and a party informs the Board of the opposing party's failure to participate in a discovery conference, the non-cooperating party may be warned that it may be subject to a motion for sanctions under 37 C.F.R. § 2.120(h)(1). The Board may impose any of the sanctions provided in Fed. R. Civ. P. 37(b)(2) for failure to participate in a discovery conference, including judgment. [Note 4.] *See* TBMP § 408.01(a). While a motion to compel a party to participate in a discovery conference is not a prerequisite to filing a motion for sanctions under 37 C.F.R. § 2.120(h)(1), the moving party must provide evidence of a good faith effort to schedule the conference in order to prevail on a motion for sanctions. [Note 5.]

The sanctions that may be entered by the Board include, inter alia, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party. [Note 6.] Default judgment is a harsh remedy, but may be justified where no less drastic remedy would be effective and there is a strong showing of willful evasion. [Note 7.] However, the Board will not hold any person in contempt, or award any expenses, including attorneys' fees, to any party. [Note 8.] *See*TBMP § 502.05.

The motion for sanctions for failure to comply with an order of the Board lies only when the Board has entered an order relating to discovery (i.e., an order compelling discovery or a protective order) and the order has been violated. [Note 9.] Unlike a motion to compel discovery, there is no requirement to make a good faith effort to resolve the parties' dispute prior to filing a motion for discovery sanctions. [Note 10.] Sanctions are not available under 37 C.F.R. § 2.120(h)(1) with respect to initial disclosures unless a Board order granting a prior motion to compel initial disclosures has been violated, or a party has expressly stated to its adversary that it does not intend to meet its obligation. [Note 11.] *See also* TBMP § 403.03. The notice of institution of the proceeding does not constitute an order of the Board relating to disclosures within the contemplation of 37 C.F.R. § 2.120(h)(1). [Note 12.]

The motion for sanctions for failure to comply with an order of the Board relating to discovery does not apply in situations involving requests for admission. Sanctions in those situations are governed by Fed. R. Civ. P. 36, except that the Board will not award any expenses, including attorneys' fees, to any party. [Note 13.] *See*TBMP § 502.05. For information concerning sanctions for failure to respond, or respond properly, to requests for admission, see TBMP § 527.01(d).

NOTES:

1. 37 C.F.R. § 2.120(h)(1). *See Fifth Generation Inc. v. Titomirov Vodka LLC*, 2019 USPQ2d 418666 (TTAB 2019) (judgment as a sanction granted under Trademark Rule 2.120(h) for failure to comply with Board orders); *SFM, LLC v. Corcamore, LLC*, 129 USPQ2d 1072, 1075-79 (TTAB 2018) (motion for judgment under Trademark Rule 2.120(h)(1) granted as sanction for discovery abuses and egregious conduct). *Cf. Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448, 1450-51 (Fed. Cir. 1988) (question of proper sanction committed to sound discretion of the court); *Busy Beauty, Inc. v. JPB Group, LLC*, 2019 USPQ2d 338392 (TTAB 2019) (motion for sanctions in the form of judgment based on spoliation of electronically stored information ("ESI") denied, but granted to the extent that nonmoving party is precluded from relying

upon any information subject to the spoliated ESI at trial); *Optimal Chemical Inc. v. Srills LLC*, 2019 USPQ2d 338409 (TTAB 2019) (construed motion for sanctions for spoliation of evidence under Fed. R. Civ. P. 37(e)(1) granted to the extent that spoliated evidence given no consideration in likelihood of confusion analysis); *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008) (sanction of dismissal denied as premature when no Board order compelling discovery present); *Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300, 1303 (TTAB 2003) (trial evidence not stricken as discovery sanctions when no order to compel discovery had been violated).

2. 37 C.F.R. § 2.120(h)(1).

3. *Cf. Promgirl, Inc., v. JPC Co., Ltd.*, 94 USPQ2d 1759, 1762 (TTAB 2009).

4. 37 C.F.R. § 2.120(h)(1). *See Promgirl Inc. v. JPC Co., Ltd.*, 94 USPQ2d 1759, 1762 n.8 (TTAB 2009) (sanction for failure to comply with discovery conference rules should relate to that failure); *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 n.4 (TTAB 2008) ("when a party fails to participate in the required discovery conference, an adverse party may move for entry of sanctions under Trademark Rule 2.120(g)(1) even in the absence of a Board order compelling participation"). **Please Note:** effective January 14, 2017, former 37 C.F.R. § 2.120(g)(1) was redesignated 37 C.F.R. § 2.120(h)(1).

5. *See, e.g., Promgirl, Inc. v. JPC Co., Ltd.*, 94 USPQ2d 1759, 1762 (TTAB 2009) (opposer's motion for sanctions in the form of judgment denied where parties were engaged in settlement discussions and opposer did not broach the subject of scheduling the discovery conference until the deadline date, and only after opposer's settlement offer was rejected); *Guthy-Renker Corp. v. Boyd*, 88 USPQ2d 1701, 1704 (TTAB 2008) (motion for sanctions denied; moving party could have made additional efforts with adverse party to schedule conference, including requesting Board participation in the discovery conference, but failed to do so).

6. *See Benedict v. Superbakery Inc.*, 665 F.3d 1263, 101 USPQ2d 1089, 1093 (Fed. Cir. 2011) (affirming Board's entry of judgment as a discovery sanction for repeated failures to comply with Board's reasonable orders), *aff'g* 96 USPQ2d 1134 (TTAB 2010); *M.C.I. Foods Inc. v. Bunte*, 86 USPQ2d 1044, 1048 (TTAB 2008) (documents produced following sanctions will be accepted as admissible and authentic at trial if offered by non-sanctioned party; sanctioned party prohibited from relying on documents it produced only after sanctions entered); *HighBeam Marketing LLC v. HighBeam Research LLC*, 85 USPQ2d 1902, 1905 (TTAB 2008) (opposer may not rely at trial on discovery materials disclosed only after entry of sanctions against it); *MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG*, 59 USPQ2d 1477, 1478-79 (TTAB 2000) (repeated failure to comply with orders and unpersuasive reasons for delay resulted in entry of judgment); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000) (pattern of dilatory conduct indicated willful disregard of Board order and resulted in entry of judgment); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (applicant ordered to copy and forward documents to opposer at applicant's expense); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1778 (TTAB 1999) (where applicant, in violation of order, served objections to discovery requests, judgment was denied as too harsh but applicant was ordered to provide new and complete responses without objection, to copy documents and forward to opposer, and to study sections of TBMP and certify completion to the Board).

See also Unicut Corp. v. Unicut, Inc., 222 USPQ 341, 344 (TTAB 1984) (respondent's continued refusal to obey Board orders sanctioned by entry of judgment) and *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013, 1014-15 (TTAB 1983) (respondent sanctioned by order to produce documents by mailing them to petitioner's attorney at petitioner's expense); *Caterpillar Tractor Co. v. Catfish Anglers Together, Inc.*, 194 USPQ 99, 100 (TTAB 1976) (judgment entered where applicant provided no reason for not complying with Board

order compelling discovery). *Cf. Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448, 1451-52 (Fed. Cir. 1988) (failure to comply based on confusion or sincere misunderstanding of court's order does not warrant dismissal); *Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300, 1303 (TTAB 2003) (petitioner failed to file motion to compel discovery; thus, there is no procedural basis for petitioner's motion for sanctions); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720, 723 (TTAB 1984) (sanction of presuming substantial actual confusion best left to situations where witness fails or refuses to answer during testimonial as opposed to discovery deposition).

7. *See Benedict v. Superbakery Inc.*, 665 F.3d 1263, 101 USPQ2d 1089, 1093 (Fed. Cir. 2011) (entry of judgment warranted in view of repeated failures to comply with reasonable orders of the Board and no lesser sanction would be effective), *aff'g* 96 USPQ2d 1134 (TTAB 2010); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000); and other cases cited in previous note.

8. *See* 37 C.F.R. § 2.120(h)(1) and 37 C.F.R. § 2.127(f).

9. *See, e.g., Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300, 1303 (TTAB 2003) (request to preclude party from submitting trial evidence as a sanction for its alleged failure to comply with discovery obligations was procedurally baseless where no discovery order was violated or even issued); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953-54 (TTAB 1979) (Board did not issue order compelling discovery but had only resumed proceedings after apparent failure of settlement negotiations and reset time to respond to discovery); *General Sealer Corp. v. H. H. Robertson Co.*, 193 USPQ 384, 384 (TTAB 1976) (motion for summary judgment on basis of petitioner's failure to answer interrogatories denied); *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 616 (TTAB 1974) (motion for judgment denied).

10. *See HighBeam Marketing LLC v. HighBeam Research LLC*, 85 USPQ2d 1902, 1904 (TTAB 2008).

11. 37 C.F.R. § 2.120(h)(2) *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008).

12. *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008).

13. *See* 37 C.F.R. § 2.120(i).

527.01(b) If Party Says It Will Not Respond to Discovery Request or Make Required Disclosures

37 C.F.R. § 2.120(h)(2) *If a party fails to make required initial disclosures or expert testimony disclosure, and such party or the party's attorney or other authorized representative informs the party or parties entitled to receive disclosures that required disclosures will not be made, the Board may make any appropriate order, as specified in paragraph (h)(1) of this section. If a party, or an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or 31(a) of the Federal Rules of Civil Procedure to testify on behalf of a party, fails to attend the party's or person's discovery deposition, after being served with proper notice, or fails to provide any response to a set of interrogatories or to a set of requests for production of documents and things, and such party or the party's attorney or other authorized representative informs the party seeking discovery that no response will be made thereto, the Board may make any appropriate order, as specified in paragraph (h)(1) of this section.*

The motion for sanctions under 37 C.F.R. § 2.120(h)(2) is available for discovery depositions, interrogatories, and requests for production of documents and things, and lies where the responding party (1) has failed to respond, and (2) has informed the party seeking discovery that no response will be made. A motion for sanctions for failure to provide initial disclosures may be made when a party has expressly stated to its adversary that it does not intend to meet its obligation. [Note 1.] Similarly, a motion for sanctions for failure to provide expert disclosures may be made when a party has expressly stated to its adversary that required disclosures will not be made. Parties should not file a motion for sanctions under 37 C.F.R. § 2.120(h)(2) where the Board has previously entered an order compelling discovery or disclosures. The appropriate remedy is rather a motion for sanctions pursuant to 37 C.F.R. § 2.120(h)(1), discussed in TBMP § 527.01(a).

The sanctions that may be entered by the Board include, inter alia, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party. However, the Board will not hold any person in contempt, or award any expenses, including attorneys' fees, to any party. [Note 2.] *See*TBMP § 502.05.

The motion for sanctions under 37 C.F.R. § 2.120(h)(2) does not apply in situations involving requests for admission. For information concerning sanctions for failure to respond, or respond properly, to requests for admission, see TBMP § 527.01(d).

NOTES:

1. *Kairos Institute of Sound Healing LLC v. Doolittle Gardens, LLC*, 88 USPQ2d 1541, 1542-43 (TTAB 2008).

2. *See* 37 C.F.R. § 2.120(h)(1); 37 C.F.R. § 2.120(h)(2); and 37 C.F.R. § 2.127(f).

527.01(c) Untimely Response to Discovery Requests

A party that fails to respond to a request for discovery (except for a request for admission) during the time allowed therefor, and that is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery request on its merits. [Note 1.] *See*TBMP § 403.03. Objections going to the merits of a discovery request include claims that the information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead to the discovery of admissible evidence. [Note 2.] Objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but instead to a characteristic of the information sought. [Note 3.]

NOTES:

1. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (stating that the Board has great discretion in determining whether such forfeiture should be found); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 (TTAB 1987) (circumstances do not justify waiver of right to object in view of confusion regarding time to respond); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 449-50 (TTAB 1979) (excusable neglect not shown where opposer was out of the country and, upon return, failed to ascertain that responses were due); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 954 (TTAB 1979) (even where there is complete failure to respond to discovery, party seeking such discovery is required to make good faith effort to determine why no response has been made before filing motion to compel); *Crane*

Co. v. Shimano Industrial Co., 184 USPQ 691, 691-92 (TTAB 1975) (waived right to object by refusing to respond to interrogatories, claiming that they served "no useful purpose").

2. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000).

3. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (party will generally not be found to have waived the right to make objections on the basis of privilege, confidentiality, or attorney work product).

527.01(d) In the Case of Requests for Admission

The entry of sanctions for failure to respond, or respond properly, to requests for admission is governed by 37 C.F.R. §2.120(i) and Fed. R. Civ. P. 36, except that the Board will not award expenses to any party. [Note 1.] *See*TBMP § 502.05.

If a party upon which requests for admission have been served fails to serve a timely response thereto, the requests will stand admitted (automatically), and may be relied upon by the propounding party pursuant to 37 C.F.R. § 2.120(k)(3)(1), unless the party upon which the requests were served is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b), and granted by the Board. *See* Fed. R. Civ. P. 6(b) and 36(a) and TBMP § 407.03(a). When no response has been served, it is not necessary or appropriate for the propounding party to file a motion to deem the requests admitted. For information concerning motions to withdraw or amend admissions, see TBMP § 525.

If a party upon which requests for admission have been served responds by serving answers and/or objections thereto, and the propounding party believes that one or more of the answers and/or objections is insufficient, the propounding party may file a motion with the Board to determine the sufficiency of the answers and/or objections believed to be insufficient. [Note 2.] If the Board determines that an answer does not comply with the requirements of Fed. R. Civ. P. 36(a), it may order either that the matter is deemed admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that an answer be served. [Note 3.] For information concerning motions to determine the sufficiency of answers or objections to requests for admission, see TBMP § 524.

NOTES:

1. *See* 37 C.F.R. § 2.120(i).

2. *See* 37 C.F.R. § 2.120(i); Fed. R. Civ. P. 36(a); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 188 USPQ 690, 691 (TTAB 1975); *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696, 698 n.7 (TTAB 1971).

3. *See* Fed. R. Civ. P. 36(a).

527.01(e) Estoppel Sanction

A party that responds to a request for discovery by indicating that it does not have the information sought, or by stating objections thereto, may be barred by its own action from later introducing the information sought in the request as part of its evidence on the case, [Note 1.] provided that the propounding party raises the matter by objecting to the evidence in question on that ground, and preserves the objection in its brief on the case (it is not necessary that the objecting party file a motion asking for application of this sanction).

[Note 2.] A party that fails to provide information, or provides an untimely supplement, may be precluded from using that information or witness at trial unless the failure to disclose was substantially justified or is harmless. [Note 3.] In instances where a party does not "unequivocally refuse" to provide information in response to discovery requests, the preclusion sanction under Fed. R. Civ. P. 37(c)(1) may not apply. [Note 4.] *See*TBMP § 523.04 (Failure to File a Motion to Compel).

Supervision of discovery, and in particular the application of the preclusion sanction, lies within the Board's discretion. [Note 5.]

NOTES:

1. *See Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1792-93 (TTAB 2009) (documents not produced until after the start of trial stricken).

2. *See, e.g., General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1593-94 (TTAB 2011) (trial testimony and exhibits stricken where applicant waited over two years to supplement responses and opposer lodged objection and cross-examined under protest, but no waiver of privilege), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448, 1455 (Fed. Cir. 1988); *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 828-29 (CCPA 1980) (applicant's representations in objecting to interrogatories that facts other than those already litigated in prior proceedings were irrelevant and not discoverable gave rise to equitable estoppel preventing applicant from introducing testimony about those other facts); *Super Valu Stores Inc. v. Exxon Corp.*, 11 USPQ2d 1539, 1543 (TTAB 1989) (party may not refuse to answer interrogatories by claiming confidentiality and then introduce responsive information during its trial period); *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1896 n.5 (TTAB 1988) (trademark search report not produced under attorney-client privilege, albeit rightfully withheld, still cannot be relied upon to support motion for summary judgment); *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245, 1247 n.6 (TTAB 1987) (exhibits demonstrating pronunciation not produced during discovery, though encompassed by discovery requests, excluded from consideration); *National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671, 1672 n.3 (TTAB 1987) (opposer's exhibits identified in applicant's brief as within the scope of documents requested by applicant but not produced by opposer during discovery, excluded from consideration).

Cf. Rocket Trademarks Pty. Ltd. v. Phard S.p.A., 98 USPQ2d 1066, 1071-72 (TTAB 2011) (objected-to documents were obtained or created by applicant in anticipation of trial and were not responsive documents that were already in its possession or control when it responded to document requests); *Linville v. Rivard*, 41 USPQ2d 1731, 1733 (TTAB 1996) (no estoppel; party should have filed motion to compel where objections that discovery requests are, for example, ambiguous or burdensome, or are otherwise not of a nature which would lead propounding party to believe that the requested information does not exist), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (no estoppel; where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue material, evidence introduced by applicant at trial was considered), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), *overruled on other grounds, The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720, 723 (TTAB 1984) (Board will not impose sanction of drawing adverse inferences against party based on inconsistent responses to questions asked during discovery deposition without motion to compel complete responses and violation of an order compelling answers); *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040, 2041 (TTAB 1989) (in that party need not specify evidence

it intends to present, failure to identify witness in response to interrogatory seeking identification of all witnesses who would testify at trial, did not preclude testimony of such witness).

3. *See Empresa Cubana Del Tabaco d.b.a Cubatabaco v. General Cigar Co., Inc.*, 2020 USPQ2d 10988, at *5-7 (TTAB 2020) (applying the "Great Seats" factors, the Board found respondent's failure to timely disclose supplemental expert witness report was not substantially justified or harmless); *Sheetz of Delaware, Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1346 (TTAB 2013) (applying " *Great Seats* factors," opposer's failure to supplement its discovery responses or initial disclosures with respect to third-party use found harmless); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1757 (TTAB 2013) (where party did not supplement its discovery responses prior to taking trial testimony of non-parties, Board declined to apply estoppel sanction with regard to trial exhibits), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1242, 1246 (TTAB 2012) (party that fails to provide information via disclosure or discovery or supplements may be precluded from using that information or witness at trial unless failure was substantially justified or harmless; opposer's failure to identify witness prior to pretrial disclosure was neither harmless nor substantially justified); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327-28 (TTAB 2011) (opposer's identification of 26 additional witnesses for the first time in its amended and supplemental pretrial disclosures was neither harmless nor substantially justified).

4. *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1439 (Fed. Cir. 2012) (Board did not abuse its discretion by refusing to strike plaintiff's evidence where plaintiff objected to production, did not represent that responsive documents did not exist but defendant failed to follow up on plaintiff's offer to produce the evidence at a mutually agreeable time and place and in view of defendant's failure to file a motion to compel); *Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005) (opposer's request for reconsideration of Board order denying its motion for summary judgment denied; Board properly considered applicant's declaration provided on summary judgment, reasoning that it would be "unfair to foreclose applicant from the opportunity to amplify the assertions made in his previous discovery responses in order to defend against opposer's motion for summary judgment"). *Cf. General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (motion to exclude expert testimony denied where timely-served but deficient expert disclosures were promptly supplemented; failure to notify the Board of service of expert disclosure is not a ground to exclude the testimony of the expert witness).

5. *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1439 (Fed. Cir. 2012).

527.01(f) Motions in Limine

It is not the Board's practice to make prospective or hypothetical evidentiary rulings. Further, the Board will not screen all of a party's proffered evidence before trial. Thus, the Board will deny a motion to prospectively exclude evidence that might be introduced at trial and that might be inconsistent with discovery responses or other material not provided during discovery. [Note 1.] Rather than requesting a discovery sanction prospectively, the better practice is to file a motion to strike or otherwise object to such evidence after it is introduced, identifying the specific evidence objected to and the asserted basis for exclusion thereof. If the objection is one that cannot be cured promptly, the adverse party may wait and raise the objection in or with its main brief on the case. [Note 2.] *See*TBMP § 707.

NOTES:

1. *See Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995).

2. *See, e.g., Hunter Industries Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.11 (TTAB 2014), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016) (as Board does not entertain motions in limine, opposer was unable to raise the matter by motion until applicant submitted declarations during its testimony period); *RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1493-94 (TTAB 2013) ("Board does not make prospective or hypothetical evidentiary rulings."); *Dan Foam ApS v. Sleep Innovations Inc.*, 106 USPQ2d 1939, 1942 (TTAB 2013) (Board does not entertain motions in limine or otherwise exclude evidence prospectively); *Carl Karcher Enters. Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1372 n.3 (TTAB 2011) ("While the pretrial disclosures in court may be important to the resolution of motions in limine handled prior to trial, the Board does not hear and resolve such motions in its practice."); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893-94 (TTAB 2011) (Board does not hear motions in limine; whether expert is qualified cannot be imputed from technical deficiencies in originally served expert disclosure but may be raised later at the appropriate time); *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1178 (TTAB 2010) ("Turning next to applicant's motion to exclude, the motion is not construed as a motion in limine, which the Board does not hear. Rather, under the circumstances of this case, applicant's motion is more akin to a motion to quash a notice of testimonial deposition based on insufficient or unreasonable notice.") (citing *Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995)).

527.02 Motion for Fed. R. Civ. P. 11 Sanctions

Fed. R. Civ. P. 11…

(b) ***Representations to 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 needlessly increase the cost of litigation;*

(2) *the claims, defenses, and other legal contentions 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.*

(2) ***Motion for Sanctions.*** *A motion for sanctions must be made separately from any other motion and must describe the specific conduct that allegedly violates Rule 11(b). The motion must be served..., but it must not be filed or be presented to the court if the challenged paper, claim, defense, contention, or denial is withdrawn or appropriately corrected within 21 days after service or within another time as the court sets. ...*

(3) ***On the Court's Initiative.*** *On its own, the court may order an attorney, law firm, or party to show cause why conduct specifically described in the order has not violated Rule 11(b).*

(4) ***Nature of a Sanction.*** *A sanction imposed under this rule must be limited to what suffices to deter repetition of the conduct or comparable conduct by others similarly situated. The sanction may include nonmonetary directives...*

…

(6) ***Requirements for an Order.*** *An order imposing a sanction must describe the sanctioned conduct and explain the basis for the sanction.*

(d) ***Inapplicability to Discovery.*** *This rule does not apply to disclosures and discovery requests, responses, objections, and motions under Rules 26 through 37.*

37 C.F.R. § 11.18 ***Signature and certificate for correspondence filed in the Patent and Trademark Office.***

(a) *For all documents filed in the Office in patent, trademark, and other non-patent matters, ... except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1), § 1.4(d)(2), or § 2.193(a) of this chapter.*

(b) *By presenting to the Office … (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-*

(1) *All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper, and*

(2) *To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,*

(i) *The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;*

(ii) *The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;*

(iii) *The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and*

(iv) *The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.*

(c) *Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of-*

(1) *Striking the offending paper;*

(2) *Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;*

(3) *Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;*

(4) *Affecting the weight given to the offending paper, or*

(5) *Terminating the proceedings in the Office.*

(d) *Any practitioner violating the provisions of this section may also be subject to disciplinary action.*

The quoted provisions of Fed. R. Civ. P. 11 are applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board. [Note 1.] Thus, if a paper filed in an inter partes proceeding before the Board violates the provisions of Fed. R. Civ. P. 11, any party to the proceeding may file a motion for the imposition of an appropriate sanction. The Board may find a Fed. R. Civ. P. 11 violation, and impose an appropriate sanction, not only upon motion, but also upon its own initiative, following issuance of an order to show cause and an opportunity for the party to be heard. [Note 2.]

Moreover, Fed. R. Civ. P. 11 certification standards apply to parties as well as attorneys. [Note 3.]

While Fed. R. Civ. P. 11 provides, inter alia, for the imposition of monetary sanctions, the Board will not impose monetary sanctions, or award attorneys' fees or other expenses to any party. [Note 4.] *See*TBMP § 502.05. However, the Board may enter other appropriate sanctions, up to and including the entry of judgment, against a party that violates Fed. R. Civ. P. 11. [Note 5.]

Fed. R. Civ. P. 11(c)(2) provides a "safe harbor" provision allowing the party or attorney an opportunity to withdraw or correct a challenged submission. This provision delays filing of a motion for sanctions before the Board for twenty-one days after service of the motion and allows the motion to be filed only if the challenged submission is not withdrawn or appropriately corrected within those twenty-one days or within another time that the Board may set. The Board will deny motions for Fed. R. Civ. P. 11 sanctions that fail to comply with this requirement.

A motion for sanctions under Fed. R. Civ. P. 11(c) is governed by, and should not be filed in violation of, Fed. R. Civ. P. 11(b). If the Board finds that a motion for Fed. R. Civ. P. 11(c) sanctions itself violates the provisions of Fed. R. Civ. P. 11(b), an appropriate Fed. R. Civ. P. 11(c) sanction may be entered against the party that filed the motion.

The provisions of 37 C.F.R. § 11.18 largely pattern Fed. R. Civ. P. 11 and are also applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board. [Note 6.] Any practitioner who knowingly violates the provisions of that rule is subject to disciplinary action and any appropriate complaint should be brought to the attention of the Office of Enrollment and Discipline. [Note 7.] *See*TBMP § 115.02.

NOTES:

1. *See* 37 C.F.R. § 2.116(a); *NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1038 (TTAB 2014) (in applying Rule 11 sanctions, considering not just the pleading in the form of a petition to cancel but party's conduct in other Board proceedings); *Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1213 (TTAB 2001) (considering not only the pleading in the form of a notice of opposition but extensions of time to oppose as potential basis for applying Rule 11 sanctions); *The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098, 1100 n.9 (TTAB 1996) (accuracy in factual representations is expected); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426 (TTAB 1993) (filing of notice of reliance on third-party discovery deposition constitutes certificate that circumstances exist which justify acceptance of the evidence).

2. *See* Fed. R. Civ. P. 11(c)(2) and (3); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2023 (TTAB 1998) (order to show cause issued where, although Fed. R. Civ. P. 56(f) (restyled by amendment as Fed. R. Civ. P. 56(d)) motion was granted, party responded to summary judgment without taking the requested discovery); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 634 n.19 (TTAB 1986) (Rule 11 permits court to enter sanctions sua sponte).

3. *See Business Guides, Inc. v. Chromatic Communications Enterprises, Inc.* , 498 U.S. 533, 547 (1991); *Central Manufacturing Inc. v. Third Millennium Technology Inc.* , 61 USPQ2d 1210, 1213 (TTAB 2001) (authority to sanction pro se party "is manifestly clear."). *See also* 37 C.F.R. § 11.18(c).

4. *See* 37 C.F.R. § 2.127(f). *Compare* 37 C.F.R. § 2.120(g) and 37 C.F.R. § 2.120(h)(1); *Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1213 (TTAB 2001).

5. *See* 37 C.F.R. § 2.116(a); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1596 n.19 (TTAB 2011) (in earlier order, Board imposed sanction prohibiting applicant from objecting to opposer's evidence), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2023 (TTAB 1998) (sanctions included requirement that law firm include express provision in all subsequent filings acknowledging Rule 11(b) and 37 C.F.R. § 11.18(a) and stating that motion was read, has a sound legal basis and is not interposed for delay, harassment or other improper purpose); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1221 (TTAB 1990) (Rule 11 not designed to punish semantic errors; applicant had reasonable basis for allegations in its pleading); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1554 (TTAB 1987) (filing of discovery motions without reasonable basis in law or in fact resulted in Rule 11 sanctions precluding applicant from filing further discovery motions and from filing any motion without prior leave of Board); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 634 n.19 (TTAB 1986) (applicant's frivolous request for reconsideration of order imposing Rule 11 sanctions resulted in entry of judgment); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 967-68 (TTAB 1986) (applicant warned that any other filing deemed frivolous would result in judgment).

6. *See Carrini Inc. v. Carla Carini, Srl*, 57 USPQ2d 1067, 1071 (TTAB 2000) (Board has discretion under Rule 11 to impose sanctions for filings that are presented to the Board for any improper purpose).

7. *See* 37 C.F.R. § 11.18. *See, e.g., ITC Entertainment Group Ltd. v. Nintendo of America Inc.* , 45 USPQ2d 2021, 2023 (TTAB 1998). For information concerning disciplinary proceedings, *see* 37 C.F.R. § 11.19, *et seq.* In addition, conduct in violation of the Disciplinary Rules set forth in 37 C.F.R. part 11 may be referred to the Office of Enrollment and Discipline for appropriate action. *See* 37 C.F.R. § 11.18(d) and 37 C.F.R. § 11.20, *et seq.*

527.03 Inherent Authority to Sanction

Flowing from the Board's inherent authority to manage the cases on its docket is the inherent authority to enter sanctions against a party. [Note 1.] The Board's exercise of this authority is clearly permitted in a variety of situations where the conduct in question does not fall within the reach of other sanctioning provisions of the rules. [Note 2.]

For example, when a party to an inter partes proceeding before the Board advises an adverse party that it will not take any further action in the case, the adverse party may file a motion asserting this fact and request entry of judgment in its favor. If, as is usually the case, the motion is uncontested, the Board normally will grant it. [Note 3.]

Similarly, if a registrant (having been served by the Board with a notice of institution and a web link or web address to access a petition to cancel its registration on TTABVUE) or any other party to an inter partes proceeding before the Board, relocates, and fails to inform its attorney (if it is represented by an attorney) or the Board or any adverse party of its new address, with the result that the party cannot be found, and papers relating to the proceeding cannot be served upon it, any adverse party may file a motion asserting

such fact and requesting entry of judgment in its own favor. Again, if the motion is uncontested, the Board normally will grant it. Alternatively, under these or similar circumstances indicating that a party is no longer interested in the case, the Board may, either upon motion by the adverse party or upon its own initiative, issue an order that the party show cause why the Board should not enter judgment in view of the party's apparent loss of interest in the case. If the party files no response to the order, judgment will normally be entered. Furthermore, inasmuch as the assigned Board attorney has the authority to act upon on motions, requests, and other matters not actually or potentially dispositive of a proceeding, the assigned Board attorney has the discretion to issue sanctions addressing party conduct with respect to motions, requests, and other matters not actually or potentially dispositive of a proceeding. *See* 37 C.F.R. § 2.127(c).

Other circumstances involving the Board's inherent power to sanction are set forth in the cases cited in the note below. [Note 4.]

NOTES:

1. *See Chambers v. NASCO, Inc.*, 501 U.S. 32, 49 (1991) (stating that this inherent power "stems from the very nature of courts and their need to be able to manage their own affairs so as to achieve the orderly and expeditious disposition of the cases") (citations omitted).

2. *See Chambers v. NASCO, Inc.*, 501 U.S. 32, 50 (1991) (stating that "[i]f in the informed discretion of the court, neither the statute nor the Rules are up to the task, the court may safely rely on its inherent power."); *Optimal Chemical Inc. v. Srills, LLC*, 2009 USPQ2d 338409 (TTAB 2019) (petition to cancel dismissed as a sanction based on a finding of fabrication of evidence); *NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1038 (TTAB 2014) (entering sanction of entry of judgment for bad-faith litigation under both the Board's inherent authority to sanction and Rule 11); *HighBeam Marketing LLC v. HighBeam Research LLC*, 85 USPQ2d 1902, 1906-07 (TTAB 2008) (sanction of precluding use of testimony granted where attorney ensured witness would not appear); *Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1215 (TTAB 2001) (applying sanction for bad-faith conduct under the Board's inherent authority to sanction, regardless of whether sanctions available under Fed. R. Civ. P. 11); *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071-72 (TTAB 2000) (opposer's conduct did not "fall within reach" of Rule 11 but resulted in judgment under Board's inherent power to sanction).

3. *See* 37 C.F.R. § 2.127(a).

4. *Schering-Plough Animal Health Corp. v. Aqua Gen AS*, 90 USPQ2d 1184, 1185 (TTAB 2009) (Board required party to obtain permission before filing any unconsented or unstipulated motion); *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 n.23 (TTAB 2002) (following opposer's third motion to compel, Board prohibited opposer from filing any further motions to compel without prior Board permission); *Central Manufacturing Inc. v. Third Millennium Technology, Inc.*, 61 USPQ2d 1210, 1212-13 (TTAB 2001) (extensions of time based on false allegations of continuing settlement negotiations resulted in imposition of continuing sanctions in future cases); *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071-72 (TTAB 2000) (opposer's "callous disregard for Board orders and ignorance of warnings" including violation of order prohibiting filing of any further papers without prior leave, resulted in order dismissing opposition without prejudice, and holding opposed application abandoned without prejudice); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 n.4 (TTAB 1989) (opposer's counsel warned that Board would not tolerate any further "game playing" or evasiveness in discovery). *Cf. Thrifty Corp. v. Bomax Enterprises*, 228 USPQ 62, 63 n.2 (TTAB 1985) (Board, while noting that it did not condone applicant's repeated failure to comply with the requirements of 37 C.F.R. § 2.119(a) and 37 C.F.R. § 2.119(b) found that, in absence of any prejudice to opposer, such conduct did not justify the harsh result of entry of default judgment).

528 Motion For Summary Judgment and Accelerated Case Resolution (ACR)

Fed. R. Civ. P. 56. Summary Judgment

(a) ***Motion for Summary Judgment or Partial Summary Judgment.*** *A party may move for summary judgment, identifying each claim or defense — or the part of each claim or defense — on which summary judgment is sought. The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law. The court should state on the record the reasons for granting or denying the motion.*

…

(c) ***Procedures.***

(1) ***Supporting Factual Positions.*** *A party asserting that a fact cannot be or is genuinely disputed must support the assertion by:*

(A) *citing to particular parts of materials in the record, including depositions, documents, electronically stored information, affidavits or declarations, stipulations (including those made for purposes of the motion only), admissions, interrogatory answers, or other materials; or*

(B) *showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact.*

(2) ***Objection That a Fact Is Not Supported by Admissible Evidence.*** *A party may object that the material cited to support or dispute a fact cannot be presented in a form that would be admissible in evidence.*

(3) ***Materials Not Cited.*** *The court need consider only the cited materials, but it may consider other materials in the record.*

(4) ***Affidavits or Declarations.*** *An affidavit or declaration used to support or oppose a motion must be made on personal knowledge, set out facts that would be admissible in evidence, and show that the affiant or declarant is competent to testify on the matters stated.*

(d) ***When Facts Are Unavailable to the Nonmovant.*** *If a nonmovant shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition, the court may:*

(1) *defer considering the motion or deny it;*

(2) *allow time to obtain affidavits or declarations or to take discovery; or*

(3) *issue any other appropriate order.*

(e) ***Failing to Properly Support or Address a Fact.*** *If a party fails to properly support an assertion of fact or fails to properly address another party's assertion of fact as required by Rule 56(c), the court may:*

(1) *give an opportunity to properly support or address the fact;*

(2) *consider the fact undisputed for purposes of the motion;*

(3) *grant summary judgment if the motion and supporting materials — including the facts considered undisputed — show that the movant is entitled to it; or*

(4) *issue any other appropriate order.*

(f) ***Judgment Independent of the Motion.*** *After giving notice and a reasonable time to respond, the court may:*

(1) *grant summary judgment for a nonmovant;*

(2) *grant the motion on grounds not raised by a party; or*

(3) *consider summary judgment on its own after identifying for the parties material facts that may not be genuinely in dispute.*

(g) ***Failing to Grant All the Requested Relief.*** *If the court does not grant all the relief requested by the motion, it may enter an order stating any material fact — including an item of damages or other relief — that is not genuinely in dispute and treating the fact as established in the case.*

(h) **Affidavit or Declaration Submitted in Bad Faith.** *If satisfied that an affidavit or declaration under this rule is submitted in bad faith or solely for delay, the court — after notice and a reasonable time to respond — may order the submitting party to pay the other party the reasonable expenses, including attorney's fees, it incurred as a result. An offending party or attorney may also be held in contempt or subjected to other appropriate sanctions.*

* * * *

528.01 General Nature of Motion

The motion for summary judgment is a pretrial device to dispose of cases in which "the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." [Note 1.] "A party asserting that a fact cannot be or is genuinely disputed must support the assertion by: A) citing to particular parts of materials in the record, including depositions, documents, electronically stored information, affidavits or declarations, stipulations (including those made for purposes of the motion only), admissions, interrogatory answers, or other materials; or B) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact." [Note 2.] The purpose of the motion is judicial economy, that is, to avoid an unnecessary trial where there is no genuine dispute of material fact and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result in the case. [Note 3.]

The summary judgment procedure is regarded as "a salutary method of disposition," and the Board does not hesitate to dispose of cases on summary judgment when appropriate. [Note 4.]

A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to judgment as a matter of law. [Note 5.] This burden is greater than the evidentiary burden at trial. [Note 6.] The burden of the moving party may be met by showing "that there is an absence of evidence to support the nonmoving party's case." [Note 7.]

If the moving party meets its burden, that is, if the moving party has supported its motion with affidavits or other evidence that, if unopposed, would establish its right to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. [Note 8.] A factual dispute is genuine if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the nonmoving party. [Note 9.]

In deciding a motion for summary judgment, the function of the Board is not to try issues of fact, but to determine instead if there are any genuine disputes of material fact to be tried. [Note 10.] The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine disputes of material fact exist; and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. [Note 11.]

A fact is material if it "may affect the decision, whereby the finding of that fact is relevant and necessary to the proceedings." [Note 12.] However, a dispute over a fact that would not alter the Board's decision on the legal issue will not prevent entry of summary judgment. [Note 13.] Further, even a genuine dispute over

a fact relating only to an issue that is not the subject of the summary judgment motion will not preclude determination of the motion. [Note 14.]

Where both parties have moved for summary judgment, the mere fact that they have done so does not necessarily mean that there are no genuine disputes of material fact, or authorize the resolution of such disputes, or dictate that judgment should be entered in favor of one of them. [Note 15.]

A party moving for summary judgment should specify, in its brief in support of the motion, the material facts that are undisputed. The nonmoving party, in turn, should specify, in its brief in opposition to the motion, the material facts that are in dispute. [Note 16.]

If the Board concludes that there is no genuine dispute of material fact, but that the nonmoving party is the one entitled to judgment as a matter of law, the Board may, after giving notice and a reasonable time to respond, grant summary judgment in favor of the nonmoving party, grant the motion on grounds not raised by a party, or consider summary judgment on its own after identifying for the parties material facts that may not be genuinely in dispute. [Note 17.]

Briefs in support of a motion for summary judgment and briefs in response or cross-motions for summary judgment on the same issue are limited to 25 pages, and a reply brief shall not exceed 10 pages in length. The brief in support of a cross-motion on a separate issue will not count against the page limit applicable to the response to the original motion only in situations where the original summary judgment motion and cross-motion involve separate issues. Exhibits submitted in support of or in opposition to the motion are not deemed to be part of the brief for purposes of determining the length of the brief. [Note 18.] A motion for summary judgment should be filed in single (not multiple) form.

The Board's determination on summary judgment is interlocutory in nature except for a grant of a summary judgment motion entering judgment that is a final disposition of all issues in the proceeding. The time for seeking judicial review of such a decision shall expire sixty-three (63) days from the date on which a final order is entered in the case. Any appeal prior to that time is premature. [Note 19.] *See*TBMP § 518 and TBMP § 901.

Where appropriate, partial summary judgment may be entered as to separate classes of goods or services. [Note 20.] If, in a case involving multiple grounds, the Board enters partial summary judgment on one ground, it may dispose of the case on that basis without considering the other grounds. [Note 21.]

NOTES:

1. Fed. R. Civ. P. 56(a). **Please Note:** The 2010 amendments to Fed. R. Civ. P. 56 changed the terminology in the summary judgment standard from genuine "issues" to genuine "disputes" to better reflect the focus of a summary judgment determination. *See* Fed. R. Civ. P. 56, Fed. R. Civ. P. 56(a) Advisory Committee's notes (2010 amendment). Consequently, cases determined before the amendments went into effect use the earlier terminology, e.g., "genuine issues of material fact" rather than "genuine disputes of material fact."

2. Fed. R. Civ. P. 56(c)(1). *See generally Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48 (1986); *see also T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996); *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1049 (Fed. Cir. 1991); and *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1297-98 (Fed. Cir. 1991). *See also Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1783 (Fed. Cir. 1990); *Sweats Fashions Inc. v. Pannill Knitting Co.*,

833 F.2d 1560, 4 USPQ2d 1793, 1795-96 (Fed. Cir. 1987); *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 221 USPQ 151, 154 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *Flatley v. Trump*, 11 USPQ2d 1284, 1287 (TTAB 1989); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376, 1378 (TTAB 1986); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 961 (TTAB 1986).

3. *See, e.g., Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741, 743 (Fed. Cir. 1984) (TTAB properly determined that evidence which might be adduced at trial would not change result given the differences in the goods of the parties), *aff'g* 221 USPQ 151 (TTAB 1983); *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ 1840, 1843 (TTAB 1995) (where issue involved collateral estoppel); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1390-91 (TTAB 1994) (parties submitted voluminous evidence in support of their cross-motions for summary judgment).

4. *See, e.g., Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987) (conclusory statements and denials do not raise genuine issues of material fact); *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 941 (Fed. Cir. 1984) (response contained only unsupported arguments and conclusions); *The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098, 1102 (TTAB 1996) (question of legal effect of assigning ITU application is one of law). *But see In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) (reversing *Bose Corp. v. Hexawave, Inc.*, 88 USPQ2d 1332 (TTAB 2007) and remanding in light of finding no willful intent to deceive by party against whom summary judgment granted on ground of fraud); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298-99 (Fed. Cir. 1991) (factual question of intent regarding misuse of registration symbol is particularly unsuited to disposition on summary judgment); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507-08 (TTAB 1993) (question of intent regarding filing of ITU application generally unsuitable for disposal by summary judgment).

5. *See, e.g., Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298-99 (Fed. Cir. 1991) (moving party's conclusory statement as to intent insufficient); *Kelly Services, Inc. v. Creative Harbor, LLC*, 846 F.3d 857, 121 USPQ2d 1357, 1363 (6th Cir. 2017) (moving party has initial burden); *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1479 (TTAB 1998) (moving party established that no genuine issue of material fact remains for trial).

6. *See, e.g., Gasser Chair Co. v. Infanti Chair Manufacturing Corp.*, 60 F.3d 770, 34 USPQ2d 1822, 1824 (Fed. Cir. 1995) (in addition to proving elements of laches by preponderance of the evidence, moving party must also establish no genuine issue of material fact as to those elements).

7. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986) (no requirement that moving party support its motion with affidavits or other similar materials negating the opponent's claim but may be based on nonmovant's failure to make sufficient showing as to its own case on which it has burden of proof); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 256-57 (1986) (movant has burden of showing the absence of a genuine issue of fact, but nonmovant is not relieved of its own burden to produce evidence pointing to genuine issue); *Enbridge, Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1540 (TTAB 2009) (nonmovant must proffer countering evidence to show existence of genuine factual dispute for trial); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1860 (TTAB 2007) (although listing of allegedly undisputed facts is often submitted and is preferred, no requirement that movant set forth such listing of allegedly undisputed facts in its summary judgment motion). *See also Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991); *Avia Group International*

Inc. v. L.A. Gear California Inc., 853 F.2d 1557, 7 USPQ2d 1548, 1550-51 (Fed. Cir. 1988); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1795-96 (Fed. Cir. 1987).

8. Fed. R. Civ. P. 56(c)(1). *See also Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990) (nonmoving party's response was not supported by contradictory facts, but merely expressed disagreement with facts); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987) ("Mere conclusory statements and denials do not take on dignity by placing them in affidavit form"); *Embarcadero Techs., Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1523 (TTAB 2016) (non-moving party failed to rebut moving party's evidence or raise genuine dispute of material fact); *Venture Out Properties LLC v. Wynn Resort Holdings LLC*, 81 USPQ2d 1887, 1890 (TTAB 2007) ("The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.").

9. *See Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992) (nonmovant not required to present entire case but just sufficient evidence to show an evidentiary conflict as to the material fact in dispute); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1795 (Fed. Cir. 1987) (dispute is genuine "only if, on the entirety of the record, a reasonable jury could resolve a factual matter in favor of the nonmovant"); *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001) (if moving party meets burden of demonstrating absence of genuine issue of material fact, nonmoving party must present evidence that one or more material facts is at issue); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1299 (TTAB 2016) (Where the moving party "has supported its motion by demonstrating the lack of any evidence that it intended to create an association with [nonmovant's marks], the burden then shifts to [the nonmovant] to demonstrate the existence of a genuine dispute of material fact to be resolved at trial.").

10. *See Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1254 (TTAB 1995); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

11. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029-30 (Fed. Cir. 1993) (impermissible inferences against nonmovant); *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992) (evidence submitted by nonmovant is to be believed and all justifiable inferences drawn in its favor); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1546 (Fed. Cir. 1992) (impermissible inferences in favor of movant); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991) (reasonable inferences as to intent could have been drawn in nonmovant's favor); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1034 (TTAB 1996) (Board accepted nonmovant's version of the facts for purposes of deciding motion); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993) (on opposer's motion for summary judgment, applicant's evidence of statement of use filed in connection with another of its applications covering many of same goods as in opposed application created inference of bona fide intent to use present mark despite absence of any documents regarding its intent to use present mark). *Cf. A&H Sportswear Co. v. Yedor*, 2019 USPQ2d 111513, at *4-5 (TTAB 2019) (lack of documentation bearing on the intent to use a mark in commerce from the time of filing of intent-to-use application is highly probative that an applicant lacked such bona fide intent); *Honda Motor Co., Ltd. v. Friedrich Winkelmann*, 90 USPQ2d 1660, 1662 (TTAB 2009) (factual question of intent generally unsuited to disposition on summary judgment, however, unexplained lack of documentary evidence regarding nonmovant's bona fide intent to use mark in commerce sufficient to prove that nonmovant lacks such intention).

12. *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992) (dispute is genuine if evidence could lead reasonable finder of fact to decide question in favor of nonmovant); *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1879 (TTAB 1998) (fact is material when its resolution would affect the outcome of the case).

13. *See, e.g., Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (single du Pont factor of dissimilarity of marks outweighed all others such that other factors, even if decided in nonmovant's favor, would not be material because they would not change the result), *aff'd*,14 USPQ2d 1545 (TTAB 1990); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1292-1294 (TTAB 2016) (same). *See also Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986); *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1879 (TTAB 1998).

14. *See United States Olympic Committee v. O-M Bread Inc.*, 29 USPQ2d 1555, 1557 n.5 (TTAB 1993) (genuine issues of fact as to grounds which were asserted in opposition but were not grounds for summary judgment were irrelevant).

15. *See Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1437 (TTAB 2007); *Fishking Processors Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1764 (TTAB 2007); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

16. Fed. R. Civ. P. 56(c)(1).

17. Fed. R. Civ. P. 56(f). *Cf. Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205, 1209 n.10 (TTAB 2003) (in considering whether to enter summary judgment in favor of petitioner as nonmoving party, Board treated respondent's statements as it would those of a nonmovant and accepted the statements as true); *The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098, 1104 (TTAB 1996) (effect of assigning ITU application if statutory exception is not met is one of law and could be decided in nonmovant's favor).

18. 37 C.F.R. § 2.127(a). *See Cooper Technologies Co. v. Denier Electric Co.*, 89 USPQ2d 1478, 1479 (TTAB 2008) (cross-motions for summary judgment denied without prejudice because briefs exceeded page limits; page limits include, if submitted, table of contents, index of cases, description of record, statement of issues, recitation of facts, argument and summary).

19. *See Copelands' Enterprises, Inc. v. CNV, Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1564-65 (Fed. Cir. 1989). *See also Hewlett-Packard Development Co., L.P. v. Vudu, Inc.*, 92 USPQ2d 1630, 1632 n.5 (TTAB 2009); *Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc.*, 86 USPQ2d 1572, 1579 n.6 (TTAB 2008).

20. *Hewlett-Packard Development Co. v. Vudu, Inc.*, 92 USPQ2d 1630, 1634 (TTAB 2009) (opposer's motion for summary judgment on its Trademark Act § 2(d) claim granted as to International Class 9 goods but denied as to services in International Classes 35, 38, 41 and 42).

21. *Compare Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171-72 (TTAB 2013) (where summary judgment entered on fewer than all pleaded grounds, Board might dispose of case without considering alternate grounds) with *SARL Corexco v. Webid Consulting Ltd.*, 110 USPQ2d 1587, 1591 (TTAB 2014) (when party moved for summary judgment on both pleaded grounds, Board granted summary judgment on one ground and allowed party time to inform Board whether the party wished to proceed with the other ground).

528.02 Time For Filing Motion

37 C.F.R. § 2.127(e)(1) *A party may not file a motion for summary judgment until the party has made its initial disclosures, except for a motion asserting claim or issue preclusion or lack of jurisdiction by the Trademark Trial and Appeal Board. A motion for summary judgment must be filed before the day of the deadline for pretrial disclosures for the first testimony period, as originally set or as reset.*

A motion for summary judgment generally may not be filed until after the moving party has made its initial disclosures. [Note 1.] However, as provided in 37 C.F.R. § 2.127(e)(1), the Board may entertain a summary judgment motion filed prior to initial disclosures that is based upon lack of jurisdiction, res judicata (claim preclusion), or collateral estoppel (issue preclusion). [Note 2.]

Moreover, the motion for summary judgment must be filed before the day of the deadline for pretrial disclosures for the first testimony period, as originally set or as reset. [Note 3.] The motion for summary judgment is a pretrial device, intended to save the time and expense of a full trial when a party is able to demonstrate, prior to trial, that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. [Note 4.] Therefore, any motion for summary judgment must be filed before the day of the deadline for pretrial disclosures for the first testimony period. If the day of the deadline for pretrial disclosures for the first testimony period is reset before the day of the deadline for pretrial disclosures for the first testimony period as originally set, a motion for summary judgment will be timely. [Note 5.] As of the day of the deadline for pretrial disclosures for the first testimony period, however, any summary judgment motion filed thereafter is untimely, even if filed prior to a day of a rescheduled deadline for pretrial disclosures for the first testimony period. [Note 6.]

When a motion for summary judgment is filed, a brief in response, or a motion under Fed. R. Civ. P. 56(d), must be filed within 30 days from the date of service of the motion. A reply brief, if any, must be filed within 20 days from the service date of the brief in response. The time for filing a reply brief will not be extended or reopened. [Note 7.] The time for filing a responsive brief may be extended, but the time for filing a motion under Fed. R. Civ. P. 56(d) in lieu thereof, will not be extended or reopened. *See*TBMP § 528.06.

Parties are encouraged to contact the assigned Board attorney immediately after a cross-motion for summary judgment is filed so that the Board attorney may issue an appropriate order clarifying brief due dates and page limits. [Note 8.] *See*TBMP § 528.01

NOTES:

1. 37 C.F.R. § 2.127(e)(1). *See Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment denied as premature where movant had yet to serve initial disclosures).

2. 37 C.F.R. § 2.127(e)(1); *Unrock Network, LLC v. Sulpasso* , 115 USPQ2d 1409, 1410 n.5 (TTAB 2015) (motion to dismiss considered as one for summary judgment where it asserts claim preclusion); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.* , 98 USPQ2d 1106, 1108 n.4 (TTAB 2011) (same); *Compagnie Gervais Danone v. Precision Formulations LLC* , 89 USPQ2d 1251, 1255 n.7 (TTAB 2009) ("if a party moves for summary judgment prior to the deadline for making initial disclosures it should indicate in its motion that the disclosures have been made, or are not required because the motion seeks judgment on claim or issue preclusion or on a jurisdictional issue"); *NH Beach Pizza LLC v. Cristy's Pizza Inc.* , 119 USPQ2d 1861, 1862 n.1 (TTAB 2016) (construing motion to dismiss filed in lieu of answer as motion for summary judgment on issue preclusion). *See also* 37 C.F.R. § 2.120(a). For information concerning the application of issue or claim preclusion in Board proceedings at summary judgment, *see Nasalok Coating*

Corp. v. Nylok Corp., 522 F.3d 1320, 86 USPQ2d 1369, 1375-77 (Fed. Cir. 2008); *Mayer/Berkshire Corp. v. Berkshire Fashions*, 424 F.3d 1229, 76 USPQ2d 1310, 1312 (Fed. Cir. 2005); *Be Sport, Inc. v. Al-Jazeera Satellite Channel*, 115 USPQ2d 1765 (TTAB 2015).

3. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 82 Fed. Reg. 33804 (July 21, 2017). *See KID-Systeme GmbH v. Turk Hava Yollari Teknik Anonim*, 125 USPQ2d 1415, 1416-17 (TTAB 2018) (motion for summary judgment must be filed the day before the deadline for pretrial disclosures).

4. *Celotex Corp. v. Catrett*, 477 U.S. 317, 327 (1986); *Hewlett-Packard Development Co. v. Vudu Inc.*, 92 USPQ2d 1630, 1631 (TTAB 2009).

5. 37 C.F.R. § 2.127(e)(1); *KID-Systeme GmbH v. Turk Hava Yollari Teknik Anonim*, 125 USPQ2d 1415, 1416-17 (TTAB 2018).

6. *See KID-Systeme GmbH v. Turk Hava Yollari Teknik Anonim*, 125 USPQ2d 1415, 1416-17 (TTAB 2018). *Cf. La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235-36 (Comm'r 1976) (motion filed before reset testimony period opened but after previous testimony period opened was untimely; petition to Commissioner to reverse Board action denied).

7. 37 C.F.R. § 2.127(e)(1).

8. 37 C.F.R. § 2.127(e)(1). *See, e.g., Cooper Technologies Co. v. Denier Electric Co.*, 89 USPQ2d 1478, 1479 (TTAB 2008) (the page limitation for a "brief in response to a motion" applies to a brief in which an opposition to a motion and a cross-motion are combined but address the same issues; in other words, one cannot exceed the page limitation for a brief by combining an opposition brief and cross-motion addressing the same issue).

528.03 Suspension Pending Determination of Motion

37 C.F.R. § 2.127(d) *When any party timely files a potentially dispositive motion, including, but not limited to, a motion to dismiss, a motion for judgment on the pleadings, or a motion for summary judgment, the case is suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise may be specified in a Board order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.*

When a party files a timely motion for summary judgment, the case is suspended by the Board with respect to all matters not germane to the motion. [Note 1.] The filing of an untimely motion generally will not be considered grounds for suspension. If the motion was untimely filed, the Board may issue an immediate action denying the motion for that reason. For a discussion regarding suspension of proceedings following the filing of a potentially dispositive motion, see TBMP § 510.03.

Once the Board has suspended proceedings in a case pending the determination of a motion for summary judgment, no party should file any paper that is not germane to the motion. [Note 2.] Examples of papers that are or may be germane to a motion for summary judgment include a brief in opposition to the summary judgment motion, a motion for an extension of time in which to respond to the summary judgment motion, a motion under Fed. R. Civ. P. 56(d) for discovery needed to enable the nonmoving party to respond to the summary judgment motion, a cross-motion for summary judgment, a motion for leave to amend a party's

pleading or a motion to amend or withdraw requests for admissions. [Note 3.] *See*TBMP § 507 (Motion to Amend Pleading), TBMP § 509 (Motion to Extend Time), TBMP § 525 (Motion to Withdraw or Amend Admission), TBMP § 528.06 (Request for Discovery to Respondent to Summary Judgment), and TBMP § 528.07 (Unpleaded Issue).

In addition to tolling the time to respond to outstanding discovery requests, suspension of proceedings tolls the time for parties to make required disclosures.

Extensions of time will not be granted for a motion under Fed. R. Civ. P. 56(d) for discovery or for the moving party to file a reply brief. The Board will consider no further papers beyond a timely reply brief in support of or in opposition to a motion for summary judgment. [Note 4.]

If the Board's determination of the summary judgment motion does not dispose of the case, the Board ordinarily will issue an order resuming proceedings. [Note 5.]

NOTES:

1. *See* 37 C.F.R. § 2.127(d) and 37 C.F.R. § 2.127(e)(1). *See also Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 965 (TTAB 1986) (motion to compel deferred pending ruling on summary judgment motion).

2. *See* 37 C.F.R. § 2.127(d). *See also Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1479 (TTAB 1998) (motion for discovery sanctions not considered).

3. *See International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1603-04 (TTAB 2002) (motion to amend opposition germane inasmuch as it related to the issue of whether applicant's motion is one for complete or partial summary judgment); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1032 (TTAB 1996) (motion to amend pleading to add new claim); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993) (motion to amend to amplify pleading); *Nestle Co. v. Joyva Corp.*, 227 USPQ 477, 478 n.4 (TTAB 1985) (cross-motion for summary judgment is a proper filing even after proceeding is suspended).

4. *See* 37 C.F.R. § 2.127(e)(1).

5. 37 C.F.R. § 2.127(d).

528.04 Miscaptioned Motion

The circumstances in which the Board will treat as a motion for summary judgment either a motion to dismiss under Fed. R. Civ. P. 12(b)(6) relying on matters outside the pleadings, or a motion for judgment on the pleadings under Fed. R. Civ. P. 12(c), filed prior to the moving party's service of initial disclosures and relying on matters outside the pleadings, are very limited. A party may not file a motion for summary judgment until it has made its initial disclosures (unless the motion is based on claim or issue preclusion or lack of jurisdiction) and such disclosures are not made until after the pleadings have closed and issues have been joined. Thus, consideration of either a motion to dismiss under Fed. R. Civ. P. 12(b)(6) or a motion for judgment on the pleadings under Fed. R. Civ. P. 12(c) as a motion for summary judgment generally would result in a premature motion for summary judgment. [Note 1.] As a result, the Board generally will not construe either a motion to dismiss or a motion for judgment on the pleadings, filed prior to initial disclosures, as a motion for summary judgment.

Conversely, a motion for summary judgment without supporting evidence is the functional equivalent of a motion to dismiss for failure to state a claim upon which relief can be granted, see TBMP § 503, or of a motion for judgment on the pleadings.[Note 2.] *See*TBMP § 504.

NOTES:

1. *See* 37 C.F.R. § 2.127(e)(1); *Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009) (motion to dismiss not converted to motion for summary judgment in opposition). *But see NH Beach Pizza LLC v. Cristy's Pizza Inc.*, 119 USPQ2d 1861, 1862 n.1 (TTAB 2016) (construing motion captioned as motion to dismiss filed in lieu of answer as motion for summary judgment on issue preclusion).

2. *See S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1225 n.9 (TTAB 1987) (motion for summary judgment was unsupported and whether movant was entitled to judgment as a matter of law could not be determined on pleadings alone). *See also* 5B C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 2722 (4th ed. 2020).

528.05 Summary Judgment Evidence

528.05(a)

528.05(a)(1) In General

The types of evidence that may be submitted in support of, or in opposition to, a motion for summary judgment include "depositions, documents, electronically stored information, affidavits or declarations, stipulations (including those made for purposes of the motion only), admissions, interrogatory answers, or other materials," affidavits or declarations, and other materials in the record. [Note 1.]

The evidentiary record upon summary judgment in an inter partes proceeding before the Board also includes, without action by any party, the pleadings, the file of any application or registration that is the subject of the proceeding as provided in 37 C.F.R. § 2.122(b) [Note 2.] and a copy of any registration pleaded and made of record by the plaintiff with its complaint, in the manner prescribed in 37 C.F.R. § 2.122(d)(1). In addition, a party may make of record, for purposes of summary judgment; copies of other registrations; disclosure materials; documents or things produced in response to a request for production; official records, if competent evidence and relevant to an issue; printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public that is relevant under an issue, if the publication is competent evidence and relevant to an issue; and testimony from other proceedings, so far as relevant and material. [Note 3.] Additionally, a party may make of record documents obtained during settlement negotiations so long as those documents are otherwise discoverable. [Note 4.] A party need not submit these materials under a notice of reliance in order to make them of record for purposes of a summary judgment motion. Rather, the materials may be submitted as attachments or exhibits to a party's brief or affidavit in support of the motion. *Cf.*TBMP § 700.

In addition, the Board may grant a party's request or otherwise exercise its discretion to take judicial notice of appropriate dictionary definitions, translations, and other facts that are germane to a summary judgment motion. [Note 5.] *See*TBMP § 704.12. The parties further may bring to the attention of the Board supplemental legal authority issuing after briefing of the summary judgment motion, e.g., a precedential decision from the Federal Circuit or Board that is relevant to the issues under consideration, along with a brief description

of its significance. [Note 6.] However, such a submission may not be used as a subterfuge to avoid the prohibition on filing surreplies or further briefing of such motions.

In a Board proceeding, the only evidentiary materials likely to be already of record when a motion for summary judgment is filed are the pleadings, the file of any application or registration that is the subject matter of the proceeding [Note 7], and any registration pleaded and made of record by the plaintiff with its complaint. Any other evidence that a party wishes to have considered upon summary judgment must usually be submitted in connection with the summary judgment motion. [Note 8.]

Because it is not the practice of the Board to make evidentiary rulings prior to briefing and determination of summary judgment motions, the Board will not entertain a motion in limine to preclude a party from presenting certain types or categories of evidence at summary judgment or, for that matter, at trial. [Note 9.] *See*TBMP § 527.01(f). Objections to evidence may be made in a party's responsive brief, if one is permitted. [Note 10.]

Evidence submitted in connection with a motion for summary judgment is ordinarily of record only for purposes of that motion. If the case goes to trial, the summary judgment evidence may not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate testimony period. [Note 11.] However, the parties may stipulate that any or all of the summary judgment evidence be treated as properly of record for purposes of final decision. [Note 12.] Moreover, the parties may, if they so desire, stipulate that the summary judgment motion and evidence be treated as the final record and briefs in the case. [Note 13.] *See*TBMP § 528.05(a)(2).

NOTES:

1. Fed. R. Civ. P. 56(c)(1)(A).

2. *See The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009) (the entire file of a subject registration, including any evidence made of record during prosecution of the underlying application, is part of the record in a cancellation proceeding without any action of the parties). *See also Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1507 n.221 (TTAB 2017) (entire opposed application file is automatically part of the record in an opposition proceeding), appeal dismissed, No. 1:17-CV-00345 (E.D. Va. Aug. 24, 2017); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 (TTAB 2010) (record includes pleadings and file of the opposed application).

3. *See* 37 C.F.R. § 2.122(b), 37 C.F.R. § 2.122(d)(2), 37 C.F.R. § 2.122(e), 37 C.F.R. § 2.122(f), and 37 C.F.R. § 2.127(e)(2). *See also Raccioppi v. Apogee Inc.*, 47 USPQ 1368, 1369-70 (TTAB 1998) (party may rely on documents admissible under 37 C.F.R. § 2.122(e)).

4. *See Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2d 1925, 1930-31 (TTAB 2015) (Fed. R. Evid. 408(a) does not preclude use of documents because they are provided during the course of compromise negotiations if the evidence is otherwise discoverable).

5. *See generally University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). *See also Enbridge Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1542 (TTAB 2009); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1515 (TTAB 2009).

6. *See Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1291 n.2 (TTAB 2016) (party may bring supplemental legal authority to the attention of the Board after briefing of a summary judgment motion).

7. *See The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009) (the entire file of a subject registration, including any evidence made of record during prosecution of the underlying application, is part of the record in a cancellation proceeding without any action of the parties).

8. *See Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 n.9 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

9. *See Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995).

10. *See* Fed. R. Civ. P. 56(c)(2); Fed. R. Civ. P. 56(c)(2) Committee Notes on Rules - 2010 amendment ("Subdivision (c)(2) provides that a party may object that material cited to support or dispute a fact cannot be presented in a form that would be admissible in evidence. … There is no need to make a separate motion to strike.").

11. *See Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1115 n.10 (TTAB 2011) (evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of such motion); *Land O'Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1960 n.7 (TTAB 2008); *University Games Corp. v. 20Q.net Inc.*, 87 USPQ2d 1465, 1468 n.4 (TTAB 2008); *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1465 n.2 (TTAB 1993), *recon. denied*, 36 USPQ2d 1328 (TTAB 1994) (declaration of witness submitted in connection with summary judgment motion was part of record for trial where witness identified and attested to accuracy of it during applicant's testimony period); *Pet Inc. v. Bassetti*, 219 USPQ 911, 913 n.4 (TTAB 1983) (affidavit offered with response to motion for summary judgment became part of trial record when witness identified it during testimony deposition and adverse counsel cross-examined witness about statements in the affidavit); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712, 716 n.2 (TTAB 1981) (material in support of untimely summary judgment motion not trial evidence absent agreement of parties).

12. *See, e.g., Frito-Lay N. America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1951 (TTAB 2014) (parties stipulated that they could rely at trial on materials submitted in support of and against each party's motion for summary judgment), *vacated on other grounds*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015); *Eveready Battery Co. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial pursuant to Accelerated Case Resolution (ACR)); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial).

13. *See, e.g., Freeman v. National Association of Realtors*, 64 USPQ2d 1700, 1701 (TTAB 2002); *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 676 (TTAB 1986).

528.05(a)(2) Accelerated Case Resolution (ACR)

Parties to Board inter partes proceedings may stipulate to pretrial final disposition on the merits (as well as abbreviated trial on the merits, see TBMP § 702) of inter partes cases via Accelerated Case Resolution

(ACR). [Note 1.] In that regard, ACR expands upon earlier Board practice allowing parties to stipulate that their summary judgment motions and accompanying evidence be treated as the final record and briefs in a case. [Note 2.] ACR is available in all cases.

Parties requesting ACR may stipulate to a variety of matters to accelerate disposition of the proceeding, including permitting the Board to resolve issues of fact at summary judgment and to treat the parties' summary judgment motion papers and evidence as the final record and briefs on the merits of the case. In addition, parties may stipulate to the following: abbreviating the length of the discovery, testimony, and briefing periods as well as the time between them; limiting the number or types of discovery requests or the subject matter thereof; limiting the subject matter for testimony, or limiting the number of witnesses, or streamlining the method of introduction of evidence, for example, by stipulating to facts and introduction of evidence by affidavit or declaration without cross-examination. [Note 3.]

To optimize ACR efficiencies and streamline the case at final decision, parties should avoid excessive evidentiary objections and those contrary to the parties' stipulations as well as avoid submission of excessive documentary evidence. [Note 4.]

Unlike summary judgment decisions, which are interlocutory in nature, the Board's decision in a proceeding utilizing ACR is final, and thus, is judicially reviewable as set forth in 37 C.F.R. § 2.145. [Note 5.] *See*TBMP § 528.01 and TBMP § 901.

Parties may stipulate to ACR at any time during the pretrial phase of the proceeding. Thus, parties that have been in contact prior to commencement of an opposition or cancellation may stipulate to ACR as early as the filing and service of their pleadings. Parties that have not been in prior contact may stipulate to ACR during their discovery conference, or at any time prior to the opening of testimony. Thereafter, parties still may agree to abbreviating trial and briefing schedules, limiting the types and methods of introduction of evidence, and stipulating to facts. [Note 6.] Oral hearings are available in ACR cases in accordance with 37 C.F.R. § 2.129(a). *See*TBMP § 802.

Parties may stipulate to ACR by informing the Board attorney assigned to their case during a telephone conference or by filing a stipulation. In any event, parties must either alert the assigned attorney by telephone that the parties are seeking ACR, in which case the attorney will issue an order outlining the parties' agreement, or submit a stipulation in writing memorializing and outlining their agreement. [Note 7.] Failure to do so may result in delays in implementing ACR and the disposition of the proceeding.

Although ACR generally will be available to any parties seeking to avail themselves of accelerated resolution of their proceedings, the ultimate decision as to whether the parties may proceed by means of ACR lies with the discretion of the Board. In most cases it is anticipated that decisions on ACR cases will be rendered within fifty days of the scheduled due date of a reply brief or hearing. [Note 8.]

What follows in TBMP § 528.05(b) through TBMP § 528.05(f) is a more detailed discussion of some of the types of evidence that may be submitted in connection with a summary judgment motion, or a case in which the parties seek expedited determination under ACR.

For a further discussion regarding other ACR models, *see*TBMP § 702.04 and TBMP § 705.

NOTES:

1. *See M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006) (Board's first, non-precedential, ACR decision in Opposition No. 91158118 affirmed by Federal Circuit). *See also Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086 (TTAB 2020) (parties stipulated to ACR option pursuant to Board's pilot expedited cancellation proceeding); *Weatherford/Lamb, Inc. v. C& J Energy Services, Inc.*, 96 USPQ2d 1834, 1836 (TTAB 2010) (parties stipulated to ACR after filing cross motions for summary judgment); *Eveready Battery Co. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial pursuant to ACR). *See also Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016) ("In order to take advantage of any form of ACR, the parties must stipulate that the Board may resolve any genuine disputes of material fact in the context of something less than a full trial.").

2. *See, e.g., Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1304 (TTAB 2014) (parties agreed to try case using cross-motions for summary judgment ACR model); *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2016 (TTAB 2014); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949 (TTAB 2014) (after suggestion by Board in order denying motion for summary judgment, parties stipulated to forego trial and rely on evidence submitted in support of the motions for summary judgment, supplemented by expert declarations, trial briefs and an oral hearing), *vacated on other grounds*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1827-28, 1830 (TTAB 2012) (parties may stipulate that their cross motions for summary judgment be the ACR record); *Freeman v. National Association of Realtors*, 64 USPQ2d 1700, 1701 (TTAB 2002); *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 676 (TTAB 1986). *See also Bond v. Taylor*, 119 USPQ2d 1049, 1501 (TTAB 2016).

3. *See* 37 C.F.R. § 2.120(a)(2)(iv) ("The parties may stipulate to a shortening of the discovery period."); *Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913 (TTAB 2015) (parties filed ACR stipulation, agreed to forego discovery, waived disclosures, stipulated to facts and attached documents, filed briefs with additional evidence); *Inter IKEA Systems B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1738 (2014) (parties filed joint stipulation that testimony could be submitted by declaration or affidavit subject to cross-examination upon request, and all documents produced in response to a request for production of documents were deemed authentic business records and were admissible subject to any objections other than authenticity); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 (TTAB 2014), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016) (parties' stipulation under ACR provided limitations on discovery, excluded the filing of motions for summary judgment and the use of expert testimony, streamlined the methods for introduction of evidence during trial, stipulated to fact regarding no actual confusion); *Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1186 (TTAB 2014) (stipulation to the admission and use of produced documents and waiver of objections based on authenticity or hearsay); *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1547 (TTAB 2012) (parties filed a joint stipulation of undisputed facts and a stipulation to seek a determination through ACR); *Brooks v. Creative Arts by Calloway LLC*, 93 USPQ2d 1823, 1825-26 (TTAB 2009) (parties stipulated to 14 paragraphs of facts, submission of testimony of certain witnesses in declaration form, and that sole issue to be decided at final was priority), *aff'd on other grounds, Creative Arts by Calloway LLC v. Brooks*, 09-cv-10488 (S.D.N.Y. December 27, 2012), *dismissed*, No. 13-147 (unpublished) (2d Cir. March 7, 2013); *Eveready Battery Co. v. Green Planet, Inc.* 91 USPQ2d 1511, 1513 (TTAB 2009) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial pursuant to Accelerated Case Resolution (ACR)); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties stipulated to 13 paragraphs of facts). *See also Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial).

4. *See Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913, 1916 (TTAB 2015) (parties utilized ACR process and submitted clean and concise record); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 n.3 (TTAB 2014), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016) (ACR proceeding experienced delay in issuing decision due to the number and nature of objections and precedential nature of decision); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1873-75 (TTAB 2011) (efficiencies of parties' stipulations as to evidentiary record defeated by submission of excessive records, more than necessary to establish party's position; although parties stipulated to testimony by declaration to streamline proceeding, numerous objections to evidence subverted the parties' stipulations).

5. *Cf. Copelands' Enterprises, Inc. v. CNV, Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1564-65 (Fed. Cir. 1989); *Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc.*, 86 USPQ2d 1572, 1579 n.6 (TTAB 2008).

6. *See Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007).

7. *See Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1829-30 n.9 (TTAB 2012) (although the parties crafted and proceeded with their own ACR approach, better practice is to contact the assigned Board attorney when the parties elect to pursue ACR); *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767 (TTAB 2008) (parties must inform Board by stipulation or motion any time they agree to modify their obligations under the rules regarding disclosure and discovery or deadlines involving disclosure, discovery, trial or briefing).

8. *See Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 n.3 (TTAB 2014), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016) (ACR proceeding experienced delay in issuing decision due to precedential nature of decision and the number and nature of objections).

528.05(b) Affidavits and Accompanying Exhibits

Fed. R. Civ. P. 56(c)(4) Affidavits or Declarations. *An affidavit or declaration used to support or oppose a motion must be made on personal knowledge, set out facts that would be admissible in evidence, and show that the affiant or declarant is competent to testify on the matters stated.*

Affidavits may be submitted in support of, or in opposition to, a motion for summary judgment provided that they (l) are made on personal knowledge; (2) set forth such facts as would be admissible in evidence; and (3) show affirmatively that the affiant is competent to testify to the matters stated therein. This is so even though affidavits are self-serving in nature, and even though there is no opportunity for cross-examination of the affiant. However, an adverse party may have an opportunity for direct examination of the affiant, if a Fed. R. Civ. P. 56(d) motion to take the discovery deposition of the affiant is made and granted. [Note 1.] *See*TBMP § 528.06.

The Board may permit affidavits submitted in connection with a summary judgment motion to be supplemented or opposed by depositions, answers to interrogatories, or further affidavits. [Note 2.]

Documents submitted with a summary judgment affidavit, but not identified therein, cannot be considered as exhibits to the affidavit. [Note 3.] An affidavit that is not supported by documentary evidence may nevertheless be given consideration if the statements contained in the affidavit are clear and convincing in character, and uncontradicted. [Note 4.]

In lieu of an affidavit, a party may submit a declaration meeting the requirements of 37 C.F.R. § 2.20. [Note 5.]

Although submissions to the Board by external storage media or devices (e.g., CD-ROM, flash drives, etc.) are not permitted, (*see*TBMP § 106.03), exhibits to affidavits consisting of recordings of commercials, demonstrations, etc., may be transferred to an appropriate electronic format such as a DVD or CD for submission to the Board. *See, e.g.,*TBMP § 703.01(i). Flash drives are not accepted because of the security risks to USPTO systems, including the potential for introduction of viruses and worms.

NOTES:

1. *See* Fed. R. Civ. P. 56(c)(4). *See also Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987) (moving party's affidavit and other evidence were not contradicted by nonmoving party); *Ava Ruha Corp. v. Mother's Nutritional Center, Inc.*, 113 USPQ2d 1575, 1578 (TTAB 2015) (Fed. R. Civ. P. 56(c)(4) allows testimony from personal knowledge based on review of files and records or position with company, and Board may not consider portions of affidavit or declaration not based on personal knowledge); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1864 n.8 (TTAB 2007) (self-serving declaration permissible on summary judgment despite absence of opportunity for cross-examination of declarant); *Westrex Corp. v. New Sensor Corp.*, 83 USPQ2d 1215, 1217 (TTAB 2007) (declaration submitted with summary judgment motion clarifies discrepancies in discovery deposition); *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1479 (TTAB 1998) (use of standard language in declaration did not raise genuine issue as to personal knowledge); *C & G Corp. v. Baron Homes, Inc.*, 183 USPQ 60, 60 (TTAB 1974) (affidavit is competent evidence); *John T. Clark Co. v. Colgate-Palmolive Co.*, 176 USPQ 93, 94 (TTAB 1972) (affidavit was not made on personal knowledge and there was no foundation for statements made therein); *4U Co. of America, Inc. v. Naas Foods, Inc.*, 175 USPQ 251, 253 (TTAB 1972) (issue of credibility raised as to one affiant but statements by another affiant were competent and uncontradicted and suspicion alone is insufficient to invalidate).

2. *See* Fed. R. Civ. P. 56(c). *See also Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516, 1517 (TTAB 1993) (additional affidavit submitted with reply brief considered).

3. *See Missouri Silver Pages Directory Publishing Corp. Inc. v. Southwestern Bell Media, Inc.*, 6 USPQ2d 1028, 1030 n.9 (TTAB 1988) (documents were related to information given in affidavit, but were not specifically identified therein).

4. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1736 (TTAB 2001) (opposer's declaration, while not accompanied by any documentary evidence, was internally consistent, not characterized by uncertainty and was unchallenged by applicant); *4U Co. of America, Inc. v. Naas Foods, Inc.*, 175 USPQ 251, 253 (TTAB 1972) (fact that allegations in affidavit not supported by invoice does not undermine the testimony when uncontradicted). *Cf., e. g.*, with respect to testimony depositions, *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 307 n.1 (TTAB 1979); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976); *Clubman's Club Corp. v. Martin*, 188 USPQ 455, 458 (TTAB 1975); *Rite Aid Corp. v. Rite-Way Discount Corp.*, 182 USPQ 698, 702 n.5 (TTAB 1974), *aff'd*, 508 F.2d 828, 184 USPQ 351 (CCPA 1975).

5. Fed. R. Civ. P. 56(c)(4). *See* 37 C.F.R. § 2.20. *See also Taylor Brothers, Inc. v. Pinkerton Tobacco Co.*, 231 USPQ 412, 415 n.3 (TTAB 1986).

6. *See Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1654-55 (TTAB 2014), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016) (parties may not override Trademark Rule 2.126 provisions for form of submissions by agreement; however, video and audio recordings of evidence such as commercials may be submitted on CD-ROM).

528.05(c) Discovery Responses and Disclosures

37 C.F.R. § 2.127(e)(2) *For purposes of summary judgment only, the Board will consider any of the following, if a copy is provided with the party's brief on the summary judgment motion: written disclosures or disclosed documents, a discovery deposition or any part thereof with any exhibit to the part that is filed, an interrogatory and answer thereto with any exhibit made part of the answer, a request for production and the documents or things produced in response thereto, or a request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto). If any motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion be considered at trial as trial evidence, which may be supplemented by additional evidence during trial.*

37 C.F.R. § 2.120(k)(8) *Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board, except when submitted with a motion relating to disclosure or discovery, or in support of or in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.*

See also TBMP § 409. *Cf.* 37 C.F.R. § 2.120(k), governing the use of discovery responses as trial evidence, and TBMP § 704.09,TBMP § 704.11 regarding the introduction of depositions, interrogatory responses, responses to requests for admissions, and produced documents.

528.05(d) Registrations

37 C.F.R. § 2.122(d)(1) *A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by 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).*

If a plaintiff's registration is pleaded and made of record pursuant to 37 C.F.R. § 2.122(d)(1), the registration is of record for all purposes, including a summary judgment motion.

Alternatively, a plaintiff may make its pleaded registration of record, for purposes of summary judgment only, by filing a status and title copy thereof, or a current printout of information from the USPTO electronic database records showing the status and title thereof, with its brief on the summary judgment motion. [Note 1.] A registration owned by a defendant may be made of record in the same manner for purposes of summary judgment or Accelerated Case Resolution (ACR), if consistent with the parties' ACR stipulation. *See*TBMP § 528.05(a)(2). A copy printed from the USPTO's TSDR or TESS database is sufficient for this purpose.

A party may make a third-party registration of record, for purposes of summary judgment only, by filing a copy thereof with its brief on the summary judgment motion; the copy need not be a certified copy, nor need it be a status and title copy. [Note 2.] A copy printed from the USPTO's TSDR or TESS database likewise is sufficient for this purpose.

For purposes of summary judgment only, a copy of a trademark search report, made of record as an exhibit to an affidavit, or as part of a discovery response, submitted in opposition to a summary judgment motion,

may be sufficient to raise a genuine dispute of material fact as to the nature and extent of third-party use of a particular designation. [Note 3.]

NOTES:

1. *See Bongrain International (American) Corp. v. Moquet Ltd.* , 230 USPQ 626, 628 n.3 (TTAB 1986). *Cf.* 37 C.F.R. § 2.122(d)(2).

2. *See Interbank Card Association v. United States National Bank of Oregon* , 197 USPQ 123, 124 n.6 (TTAB 1977) (third-party registrations may be plain copies). *See also* 37 C.F.R. § 2.122(e); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998) (incomplete TRAM records of third-party registrations not sufficient).

3. *See, e.g., Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993) (search reports and telephone directory listings sufficient to raise genuine issue regarding strength of mark). With respect to third-party applications, see also *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1467-68 n.6 (TTAB 2003) (third-party applications which were published for opposition, submitted in response to motion for summary judgment, were considered by the Board, but failed to raise a genuine issue of material fact).

528.05(e) Printed Publications and Official Records

37 C.F.R. § 2.122(e) ***Printed publications and official records.***

(1) *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant in a particular proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered in accordance with paragraph (g) of this section. The notice of reliance shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Office need not be certified to be offered in evidence.*

(2) *Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided.*

Printed publications, as described in 37 C.F.R. § 2.122(e), include such materials as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding. [Note 1.] *See* TBMP § 704.08. The term "official records," as used in 37 C.F.R. § 2.122(e), refers not to a party's company business records, but rather to the records of public offices or agencies, or records kept in the performance of duty by a public officer. [Note 2.] *See*TBMP § 704.07.

Materials that qualify as printed publications or official records under 37 C.F.R. § 2.122(e) are considered essentially self-authenticating, that is, the nonoffering party is readily able to verify the authenticity of the proffered materials. [Note 3.] As such, these materials may be relied on for purposes of summary judgment without further evidence of authenticity. [Note 4.] A party may introduce evidence of this nature in connection with a summary judgment motion, if the evidence is competent and relevant, by: specifying the official

record or printed publication (including, with respect to the printed publication, information sufficient to identify the source and date of the publication) and the pages to be read; indicating generally the relevance of the material being offered; and including a copy of the proffered material with the party's brief. [Note 5.]

The material need not be submitted under a notice of reliance or in connection with the affidavit or declaration of a witness, and may simply be submitted as an attachment or exhibit to a party's supporting brief.

Internet evidence. Materials obtained from the Internet that identify: (1) dates they were accessed; and (2) their source (e.g., the URL), are considered to be self-authenticating and may be admitted into evidence in the same manner as a printed publication in general circulation in accordance with 37 C.F.R. § 2.122(e). [Note 6.] TBMP § 704.08(b). In all cases, printed publications are only admissible for what they show on their face, and not as proof of any facts asserted therein. [Note 7.] *See*TBMP § 704.08.

Materials that are not self-authenticating. Materials that do not fall within 37 C.F.R. § 2.122(e), that is, materials which are not self-authenticating in nature, may nonetheless be admissible as evidence in connection with a summary judgment motion, if competent and relevant, provided they are properly authenticated by an affidavit or declaration pursuant to Fed. R. Civ. P. 56(c)(4). *See*TBMP § 528.05(b). Such materials may, on summary judgment, be introduced by the affidavit or declaration of a person who can clearly and properly authenticate and identify the materials, including identifying the nature, source and date of the materials. [Note 8.]

For further information concerning official records and printed publications, including the probative value of such evidence, see TBMP § 704.07 and TBMP § 704.08. [Note 9.]

NOTES:

1. *See* 37 C.F.R. § 2.122(e). *See also Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1857 (TTAB 2007).

2. *See Brooks v. Creative Arts by Calloway LLC*, 93 USPQ2d 1823, 1825-26 (TTAB 2009) (applicant's own file copies of briefs from district court case not proper under notice of reliance as official records), *aff'd on other grounds, Creative Arts by Calloway, LLC v. Brooks*, 09-cv-10488 (SDNY December 27, 2012), dismissed, No. 13-147 (unpublished) (2d Cir. March 7, 2013).

3. *See Weyerhaeuser v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992).

4. *See* 37 C.F.R. § 2.122(e).

5. *Cf. Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998) (noting that a proffered excerpt from a newspaper or periodical is lacking in foundation and, thus, is not admissible as evidence to the extent that it is an incomplete or illegible copy, is unintelligible because it is in a language other than English, or is not fully identified as to the name and date of the published source).

6. 37 C.F.R. § 2.122(a). *See Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). *See also Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071 (TTAB 2011) (documents obtained from Internet admitted even though witness did not personally obtain or download documents); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1857 (TTAB 2007) (article from a

trade magazine is admissible under 37 C.F.R. § 2.122(e) because, "[o]n its face, it identifies the publication and the date published").

Cf. International Association of Fire Chiefs v. H. Marvin Ginn Corp., 225 USPQ 940, 942 n.6 (TTAB 1985), *rev'd on other grounds*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) (excerpts of printed articles from electronic database were admissible through notice of reliance because the materials "clearly identify the excerpted articles by their dates of publication and sources, all of which are readily available in published materials"). *See also In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984), *rev'd on other grounds*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1085) (magazine articles obtained through search of electronic database admissible because they were clearly identified and therefore there was "no credibility problem"); *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 918 n.3 (TTAB 1983) (printed articles from electronic database are clearly identified by name and date; therefore applicant could have easily checked the articles).

7. *See Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2020 n.8 (TTAB 2008); *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443, 445 (TTAB 1974).

8. *See* Fed. R. Civ. P. 56(c)(1)(A) and Fed r. Civ. P. P. 56(c)(4); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1864 n.8 (TTAB 2007); *Westrex Corp. v. New Sensor Corp.*, 83 USPQ 1215, 1217 (TTAB 2007). **Please Note:** The 2010 amendment to Fed. R. Civ. P. 56(c)(2) "eliminated the unequivocal requirement that documents submitted in support of a summary judgment motion must be authenticated." *Akers v. Beal Bank*, 845 F. Supp. 2d 238, 243 (D.D.C. 2012). The lack of authentication is now grounds for objection, but only on the basis that the evidence cannot be presented in a form that would be admissible in evidence. Fed. R. Civ. P. 56(c)(2), Committee Notes on Rules - 2010 amendment ("The objection functions much as an objection at trial, adjusted for the pretrial setting. The burden is on the proponent to show that the material is admissible as presented or to explain the admissible form that is anticipated.").

9. *See Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) for a discussion of the probative weight given evidence obtained from the Internet.

528.05(f) Testimony from Another Proceeding

37 C.F.R. § 2.122(f) ***Testimony from other proceedings.*** *By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.*

Upon motion granted by the Board, testimony taken in another proceeding, or in a suit or action in a court, between the same parties or their privies, may be used in connection with a summary judgment motion in a pending Board proceeding, to the extent that the testimony is relevant and material. The use of such testimony, however, is subject "to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony." [Note 1.] Any motion made to enter testimony from another proceeding should be accompanied by a copy of the testimony sought to be entered in the record together with clear arguments as to its relevance and materiality. Relevance and materiality frequently hinge upon the marks and goods or services involved in the two proceedings. *See*TBMP § 530.

When the Board allows testimony of this nature to be used in connection with a motion for summary judgment, the testimony, and any testimony taken upon recall of the same witness for examination or cross-examination, or in rebuttal thereof, is of record only for purposes of the motion for summary judgment; it will not be considered at final hearing if the case goes to trial, unless it is reintroduced, upon motion granted by the Board, during the appropriate trial period, or the parties stipulate to its use at trial. [Note 2.] *See*TBMP § 528.05(a)(1).

NOTES:

1. 37 C.F.R. § 2.122(f).

2. *See, e.g., Eveready Battery Co. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (regarding parties' stipulation that evidence submitted in connection with summary judgment motion shall be deemed of record for trial pursuant to Accelerated Case Resolution (ACR)); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial).

528.06 Request For Discovery to Respond to Summary Judgment

Fed. R. Civ. P. 56(d) When Facts Are Unavailable to the Nonmovant. *If a nonmovant shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition, the court may:*

(1) *defer considering the motion or deny it;*

(2) *allow time to obtain affidavits or declarations or to take discovery; or*

(3) *issue any other appropriate order.*

37 C.F.R. § 2.127(e)(1) …*A motion under Rule 56(d) of the Federal Rules of Civil Procedure, if filed in response to a motion for summary judgment, shall be filed within thirty days from the date of service of the summary judgment motion. The time for filing a motion under Rule 56(d) will not be extended or reopened.* …

Please Note: Former subdivision (f) of Fed. R. Civ. P. 56 has been carried forward by the 2010 amendments to the Federal Rules of Civil Procedure as subdivision (d). The textual differences between current Rule 56(d) and former Rule 56(f) are purely stylistic. Case law developed under the earlier version remains authoritative. [Note 1.]

A party that believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board for time to take the needed discovery. The request must be supported by an affidavit showing that the nonmoving party cannot, for reasons stated therein, present facts essential to justify its opposition to the motion. [Note 2.]

In the event the moving party fails to support its Fed. R. Civ. P. 56(d) motion by an affidavit, the motion generally will be denied. It is not sufficient that a nonmoving party simply state in an affidavit supporting its motion under Fed. R. Civ. P. 56(d) that it needs discovery in order to respond to the motion for summary judgment; rather, the party must state therein the reasons why it is unable, without discovery, to present facts sufficient to show the existence of a genuine dispute of material fact for trial. [Note 3.] If a party has demonstrated a need for discovery that is reasonably directed to obtaining facts essential to its opposition to the motion, discovery will be permitted, especially if the information sought is largely within the control

of the party moving for summary judgment. [Note 4.] The motion should set forth with specificity the areas of inquiry needed to obtain the information necessary to enable the party to respond to the motion for summary judgment. [Note 5.]

In lieu of an affidavit, a party may submit a declaration meeting the requirements of 37 C.F.R. § 2.20. [Note 6.]

When a request for discovery under Fed. R. Civ. P. 56(d) is granted by the Board, the discovery allowed is limited to that which the nonmoving party must have in order to oppose the motion for summary judgment; this is so even if the nonmoving party had, at the time when the summary judgment motion was filed, broader requests for discovery outstanding, and those requests remain unanswered.

A request for Fed. R. Civ. P. 56(d) discovery, if filed, must be filed within 30 days of the date of service of the summary judgment motion. [Note 7.] No extensions of time will be granted to file a motion under Fed. R. Civ. P. 56(d), nor may the time to file a motion under Fed. R. Civ. P. 56(d) be reopened. [Note 8.] The affidavit in support of the request may be signed either by the requesting party or by its counsel, as appropriate.

A request for Fed. R. Civ. P. 56(d) discovery should be clearly made, and certainly not buried somewhere in a responsive brief or other paper, and should not be filed as a "throw away" alternative accompanying a response to the motion for summary judgment on the merits. When a party faced with a summary judgment motion files a combined request for Fed. R. Civ. P. 56(d) discovery and response on the merits of the motion, the Board ordinarily will deem the Fed. R. Civ. P. 56(d) discovery request moot, and decide the summary judgment motion on the merits thereof. [Note 9.] Moreover, if a party's request for discovery under Fed. R. Civ. P. 56(d) is granted by the Board, and the party thereafter files a response to the summary judgment without taking the requested discovery, the filing of the Fed. R. Civ. P. 56(d) motion may be viewed as sanctionable conduct under Fed. R. Civ. P. 11. [Note 10.]

NOTES:

1. *See* Fed. R. Civ. P. 56(a) Advisory Committee's notes (2010 amendment); *Godin v. Schencks*, 629 F.3d 79, 90-91 n.19 (1st Cir. 2010) ("The substance of the rule has not materially changed.").

2. *See* Fed. R. Civ. P. 56(d); *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1475 (Fed. Cir. 1992) (finding sufficient need for additional discovery); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (unfocused requests for discovery; Rule 56(f) makes no distinction between whether no discovery has been taken and whether additional discovery is needed); *Avia Group International Inc. v. L.A. Gear California Inc.*, 853 F.2d 1557, 7 USPQ2d 1548, 1551 (Fed. Cir. 1988) (complaint that summary judgment was granted before it could take discovery unavailing where party failed to seek Rule 56(f) protection); *Spectra Corp. v. Lutz*, 839 F.2d 1579, 5 USPQ2d 1867, 1868-69 n.4 (Fed. Cir. 1988) (discovery properly denied where plaintiff had conducted 11 months of discovery and was allowed to continue taking discovery pending decision on defendant's motion for summary judgment and failed to file Rule 56(f) affidavit); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987) (mere assertion in brief of need for discovery insufficient); *Chavakula v. Praise Broadcasting AKA Praise FM*, 2020 USPQ2d 10855, at *3-5 (TTAB 2020) (defendant's Fed. R. Civ. P. 56(d) discovery motion granted where plaintiff filed a motion for summary judgment instead of responding to defendant's discovery requests on issues relevant to plaintiff's likelihood of confusion claim); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1860 (TTAB 2007) (nonmoving party may respond to summary judgment motion by filing motion for Rule 56(f) discovery).

See also Institut National des Appellations d'Origine v. Brown-Forman Corp., 47 USPQ2d 1875, 1896 n.13 (TTAB 1998) (assertion in response to summary judgment motion that opposers intend to conduct further discovery was not proper request for Fed. R. Civ. P. 56(f) discovery); *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1253 (TTAB 1995) (motion for Rule 56(f) discovery denied where applicant also filed a response to the summary judgment motion on the merits); *Blansett Pharmacal Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1476 (TTAB 1992) (failure to file Rule 56(f) motion creates presumption party did not consider such discovery essential); *Orion Group Inc. v. Orion Insurance Co.*, 12 USPQ2d 1923, 1924-25 (TTAB 1989) (Rule 56(f) declaration sufficient); *Nature's Way Products Inc. v. Nature's Herbs Inc.*, 9 USPQ2d 2077, 2081 (TTAB 1989) (mere unsupported assertion of desire to take deposition inadequate).

3. *See Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1253 (TTAB 1995) (Rule56(f) motion denied where applicant failed to show need for discovery as to specific issues, not merely a showing that it deferred taking discovery it otherwise would have taken had it known a motion for summary judgment would be filed). *See also* cases cited in previous note.

4. *See Orion Group Inc. v. Orion Insurance Co.*, 12 USPQ2d 1923, 1925-26 (TTAB 1989).

5. *See Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (unfocused requests for discovery are insufficient); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987) (mere assertion that discovery is necessary is insufficient); *Strang Corp. v. The Stouffer Corp.*, 16 USPQ2d 1309, 1311 n.6 (TTAB 1990) (affidavit stating that, during discovery, party will seek to elicit information on likelihood of confusion insufficient); *Nature's Way Products Inc. v. Nature's Herbs Inc.*, 9 USPQ2d 2077, 2081 (TTAB 1989) (Rule 56(f) motion, to the extent it could be construed as such, was not supported by required affidavit); *J.I. Case Co. v. F.L. Industries, Inc.*, 229 USPQ 697, 701 (TTAB 1986) (statement by applicant of need to take discovery on validity of assignment was unsupported speculation).

6. Fed. R. Civ. P. 56(d). *Cf. Taylor Brothers, Inc. v. Pinkerton Tobacco Co.*, 231 USPQ 412, 415 n.3 (TTAB 1986).

7. 37 C.F.R. § 2.127(e)(1).

8. *See McDonald's Corp. v. Cambrige Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013) (extending filing deadline of a Rule 56(d) motion, even by consent, is in contravention of the provisions of 37 C.F.R. § 2.127 and, therefore, prohibited).

9. *See Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2d 1925, 1930 (TTAB 2015) (Fed. R. Civ. P. 56(d) motion denied as moot because party filed substantive response to summary judgment motion); *Ava Ruha Corp. v. Mother's Nutritional Center, Inc.*, 113 USPQ2d 1575, 1578 (TTAB 2015) (same); *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009, 2012 n.8 (TTAB 2002) (same).

10. *See ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (order to show cause issued where, although Rule 56(f) motion was granted, party responded to summary judgment without taking the requested discovery).

528.07 Unpleaded Issue

528.07(a) Not Basis for Entering Summary Judgment

A party may not obtain summary judgment on an issue that has not been pleaded. [Note 1.] Moreover, at the summary judgment stage of a proceeding before the Board, there has not yet been a trial of any issue, whether pleaded or unpleaded, and therefore the requirements of Fed. R. Civ. P. 15(b) for an amendment to conform the pleadings to the evidence cannot have been met. [Note 2.]

Generally, a party that seeks summary judgment on an unpleaded issue may simultaneously move to amend its pleading to assert the matter. [Note 3.] Alternatively, if the parties, in briefing a summary judgment motion, have treated an unpleaded issue on its merits, and the nonmoving party has not objected to the motion on the ground that it is based on an unpleaded issue, the Board may deem the pleadings to have been amended, by agreement of the parties, to allege the matter. [Note 4.] For purposes of determining the summary judgment motion, the Board will deem such new allegations to be denied if no amended answer is accepted and of record at the time. However, an opposition against a Trademark Act § 66(a), 15 U.S.C. § 1141f (a) application may not be amended (or deemed amended) to assert an entirely new claim or to rely on an additional registration in support of an existing Trademark Act § 2(d), 15 U.S.C. § 1052 claim. [Note 5.] There are other limitations on amendments to a notice of opposition against a § 66(a) application. *See*TBMP § 314 and TBMP § 507.01.

NOTES:

1. *See* Fed. R. Civ. P. 56(a); *Spanishtown Enterprises, Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *4 (TTAB 2020) (applicant cannot obtain summary judgment on unpleaded lack of capacity defense); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1291 n.2, 1292 (TTAB 2016) (applicant may not obtain summary judgment on unpleaded defense); *Asian and Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009) (petitioner cannot obtain summary judgment on an insufficiently pleaded fraud claim); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1528 n.3 (TTAB 2008); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1438 n.12 (TTAB 2007); *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1309 n.3 (TTAB 2007); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1386 n.8 (TTAB 1991); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 628 (TTAB 1986); *Consolidated Foods Corp. v. Berkshire Handkerchief Co.*, 229 USPQ 619, 621 (TTAB 1986).

2. *See, e.g., Vaughn Russell Candy Co. and Toymax Inc. v. Cookies in Bloom Inc.*, 47 USPQ2d 1635, 1635 (TTAB 1998) (attempt to amend pleadings under Fed. R. Civ. P. 15(b) denied since there had not yet been a trial, but allowed time to move to amend under Fed. R. Civ. P. 15(a)).

3. *See Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1309 n.3 (TTAB 2007); *Fishking Processors Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1764 n.3 (TTAB 2007) (Board sua sponte allowed movant time to amend pleading to assert matter raised at summary judgment); *Vaughn Russell Candy Co. v. Cookies in Bloom Inc.*, 47 USPQ2d 1635, 1635 (TTAB 1998) (allowed time to file motion to amend pleading to add new grounds and to renew summary judgment motion); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993) (motion to amend, filed after summary judgment on unpleaded issue had been denied, was granted); *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).

4. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994) (pleading deemed amended where nonmoving party did not object to motion as seeking judgment on unpleaded claim), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 82 n.3 (TTAB 1984) (pleading deemed amended where nonmoving party did not object to motion on unpleaded claim and treated it on its merits). *Cf. Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 n.5 (TTAB 1995) (not permitted where nonmoving party objected to inclusion of unpleaded grounds even though party responded to motion on unpleaded grounds on merits).

5. *See* 37 C.F.R. § 2.107(b). *See* RULES OF PRACTICE FOR TRADEMARK-RELATED FILINGS UNDER THE MADRID PROTOCOL IMPLEMENTATION ACT, 68 Fed. Reg. 55748, 55757 (September 26, 2003); *Prosper Business Development Corp. v. International Business Machines, Corp.*, 113 USPQ2d 1148, 1151 (TTAB 2014) (opposition against § 66(a) application, once filed, cannot be amended to add grounds for opposition or to add the goods or services subject to opposition beyond those to which the IB has been notified); *CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1962-63 (TTAB 2011) (scope of grounds against a § 66(a) application governed by ESTTA cover sheet not by supporting pleading); *O.C. Seacrets, Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1329-30 (TTAB 2010) (cannot amend notice of opposition to add a claim against a § 66(a) application).

528.07(b) Not Defense Against Summary Judgment

A party may not defend against a motion for summary judgment by asserting the existence of genuine disputes of material fact as to an unpleaded claim or defense. [Note 1.]

However, a party that seeks to defend against a motion for summary judgment by asserting the existence of genuine disputes of material fact regarding an unpleaded claim or defense, may move to amend its pleading to allege the matter. [Note 2.] Alternatively, if a party seeks to defend against a motion for summary judgment by asserting the existence of genuine disputes of material fact regarding an unpleaded claim or defense, and the party moving for summary judgment treats the unpleaded matter on its merits, and does not object thereto on the ground that the matter is unpleaded, the Board may deem the pleadings to have been amended, by agreement of the parties, to allege the matter. *Cf.*TBMP § 528.07(a). However, an opposition against a Trademark Act § 66(a), 15 U.S.C. § 1141f(a), application, may not be amended (or deemed amended) to assert a new ground for opposition. [Note 3.] *See*TBMP § 314 and TBMP § 507.01.

NOTES:

1. *See Blansett Pharmacal Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992) (may not assert unpleaded Morehouse defense); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1135 n.2 (TTAB 1992) (no consideration given to three unpleaded grounds asserted by opposer in response to applicant's motion for summary judgment).

2. *See United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1223 (TTAB 1993).

3. *See* 37 C.F.R. § 2.107(b).

528.08 Entry of Summary Judgment in Favor of Nonmoving Party

Fed. R. Civ. P. 56 (f) Judgment Independent of the Motion. *After giving notice and a reasonable time to respond, the court may:*

(1) *grant summary judgment for a nonmovant;*

(2) *grant the motion on grounds not raised by a party; or*

(3) *consider summary judgment on its own after identifying for the parties material facts that may not be genuinely in dispute.*

If the Board concludes, upon motion for summary judgment, that there is no genuine dispute of material fact, but that it is the nonmoving party, rather than the moving party, which is entitled to judgment as a matter of law, the Board may, after giving notice and a reasonable time to respond, in appropriate cases, grant summary judgment in favor of the nonmoving party (that is, enter summary judgment in favor of the nonmoving party even though there is no cross-motion for summary judgment). [Note 1.]

NOTES:

1. *See, e.g., Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443, 1446 (TTAB 1996) (nonmovant entitled to summary judgment where question was one of law); *The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098, 1106 nn. 17 and 18 (TTAB 1996) (effect of assigning ITU application if statutory exception is not met is one of law and could be decided in nonmovant's favor); *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857, 858-59 (TTAB 1986) (granted to nonmovant as to its standing); *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984) (granted to nonmovant applicant because application elements allegedly missing from application were not required by Paris Convention); *Visa International Service Assn v. Life-Code Systems, Inc.*, 220 USPQ 740, 744-45 (TTAB 1983) (nonmovant entitled to judgment as a matter of law on issues of abandonment, non-use and fraud).

529 Motion to Offer Discovery Deposition of Self or Nonparty

37 C.F.R. § 2.120(k) ***Use of discovery deposition, answer to interrogatory, admission or written disclosure.***

(1) *The discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party.*

(2) *Except as provided in paragraph (k)(1) of this section, the discovery deposition of a witness, whether or not a party, shall not be offered in evidence unless the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or there is a stipulation by the parties; or upon a showing that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The use of a discovery deposition by any party under this paragraph will be allowed only by stipulation of the parties approved by the Trademark Trial and Appeal Board, or by order of the Board on motion, which shall be filed when the party makes its pretrial disclosures, unless the motion is based upon a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, even though such deadline has passed, in which case the motion shall be filed promptly after the circumstances claimed to justify use of the deposition became known.*

Ordinarily, the discovery deposition of a party or of anyone who, at the time of taking the deposition, was an officer, director, or managing agent of a party, or a person designated by a party pursuant to Fed. R. Civ. P. 30(b)(6) or Fed. R. Civ. P. 31(a)(4), may be offered in evidence only by an adverse party; a party may not, in the first instance, offer in evidence a discovery deposition taken of itself or of its officer, director, managing agent, etc. by an adverse party, except by stipulation of the parties approved by the Board, or by order of the Board on motion. Similarly, no party may offer into evidence the discovery deposition of a nonparty witness, except by stipulation of the parties approved by the Board, or by order of the Board on motion. [Note 1.] *See*TBMP § 704.09.

A motion for leave to offer in evidence a discovery deposition taken by an adverse party of the moving party itself (or of an officer, director, managing agent, etc., of the moving party), or the discovery deposition of a nonparty witness, must show that:

(1) The person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition) [Note 2.]; or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or

(2) Such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. [Note 3.]

A motion based on one of the first grounds listed above must be filed when a party makes its pretrial disclosures. A motion based on the second ground must be filed promptly after the circumstances claimed to justify use of the deposition become known. [Note 4.]

NOTES:

1. 37 C.F.R. § 2.120(k)(2). *See Azalea Health Innovations, Inc. v. Rural Health Care, Inc.* , 125 USPQ2d 1236, 1240 (TTAB 2017) (granting motion to strike discovery deposition transcript of nonparties submitted under notice of reliance because discovery depositions may only be offered into evidence by stipulation or by order of the Board granting an appropriate motion seeking approval of use of the discovery depositions); *Harry Winston, Inc. v. Bruce Winston Gem Corp.* , 111 USPQ2d 1419, 1425 n.21 (TTAB 2014) (discovery depositions of opposers' own officers submitted by parties' stipulation); *McDonald's Corp. v. McSweet, LLC* , 112 USPQ2d 1268, 1274 n.5 (TTAB 2014) (parties stipulated to discovery depositions of nonparty witnesses as testimony. *Cf.* 37 C.F.R. § 2.120(k)(4) (fairness exception provides that if only part of a discovery deposition is made of record by a party, an adverse party may introduce any other part of the deposition which should be considered so as to make not misleading what was offered by the submitting party).

2. *See Galaxy Metal Gear Inc. v. Direct Access Technology, Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009) (discovery deposition of foreign nonparty witness admissible at trial given that witness lives outside United States and does not plan to be present during trial); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426 (TTAB 1993) (opposer established that one third-party witness was out of the country during its testimony period).

3. *See Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426 (TTAB 1993) (opposer established that one third-party witness was out of the country during its testimony period but failed to establish that another witness was a "party" as contemplated by 37 C.F.R. § 2.120(j)(1) [now 2.120(k)(1)], at the time of deposition or the existence of exceptional circumstances). *Cf. Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons, Inc.*, 55 USPQ2d 1298, 1302 n.11 (TTAB 2000) (deposition of nonparty witness properly entered given the stipulation of the parties approved by the Board); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 748 n.4 (TTAB 1986) (deposition of opposer's nonparty witness taken by opposer

during discovery treated as testimony deposition taken by stipulation of the parties prior to trial); *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354, 356 n.5 (TTAB 1984) (discovery deposition of nonparty treated as stipulated in the record where applicant had not objected to opposer's notice of reliance upon the deposition).

4. 37 C.F.R. § 2.120(K)(2).

530 Motion to Use Testimony From Another Proceeding

37 C.F.R. § 2.122(f) ***Testimony from other proceedings.*** *By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.*

The use, in an inter partes proceeding before the Board, of testimony taken or filed in another Board proceeding, or testimony taken in a suit or action in a court, is governed by 37 C.F.R. § 2.122(f). *Cf.*TBMP § 704.11.

A party may seek, by motion, to use testimony from another proceeding, either as evidence on its behalf upon summary judgment or as part of its evidence on trial of the case. *See* TBMP § 528.05(f) and TBMP § 704.11 [Note 1.] A motion for leave to use testimony from another proceeding as evidence on the case may be filed during discovery, the time between the close of discovery and the beginning of testimony, or the testimony period of the moving party. [Note 2.] The better practice is to file the motion as early as possible, in order to minimize the resulting delay in the proceeding. Such a motion would not usually result in suspension of the proceeding; if the motion is made without the consent of every adverse party and filed during the testimony period, and if the moving party believes that it will need additional time to present evidence if the motion is denied, the moving party should file a motion to extend its testimony period with its motion under 37 C.F.R. § 2.122(f).

However, 37 C.F.R. § 2.122(f) does not require that a motion for leave to use testimony from another proceeding be filed during the testimony period of the moving party, and it is not unreasonable for a party to want to ascertain, prior to the opening of its testimony period, whether it will be allowed to rely on such testimony. Thus, a motion under 37 C.F.R. § 2.122(f) filed prior to the opening of the moving party's testimony period will not be denied as untimely. [Note 3.]

A motion for leave to use testimony from another proceeding should be accompanied by a copy of the testimony, and accompanying exhibits, sought to be introduced. A copy of the motion, testimony, and accompanying exhibits should be served on every other party to the proceeding. [Note 4.]

The Board has construed the term "testimony," as used in 37 C.F.R. § 2.122(f), as meaning only trial testimony (i.e. an oral testimony deposition or testimony affidavit or declaration) [Note 5] or a discovery deposition that was used, by agreement of the parties, as trial testimony in the other proceeding.

NOTES:

1. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1467 n.4 (TTAB 2016) (granting motions for leave to use testimony and evidence from civil action and considering as part of evidence on trial).

2. *Cf.* 37 C.F.R. § 2.120(k)(2).

3. *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1317 (TTAB 1992) (motion to admit testimony from prior opposition filed during discovery period).

4. *See* 37 C.F.R. § 2.119(a); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1317 (TTAB 1992).

5. *See Threshold.TV Inc. v. Metronome Enterprises Inc.*, 96 USPQ2d 1031, 1035 n.8 (TTAB 2010); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1316-17 (TTAB 1992).

531 Motion That Deposition in Foreign Country Upon Written Questions Be Taken Orally

37 C.F.R. § 2.123(a)(1) ***Trial testimony in inter partes cases.***

(a)(1) *The testimony of witnesses in inter partes cases may be submitted in the form of an affidavit or a declaration pursuant to § 2.20 and in conformance with the Federal Rules of Evidence, filed during the proffering party's testimony period, subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination of that witness as provided under paragraph (c) of this section if such witness is within the jurisdiction of the United States, or conduct cross-examination by written questions as provided in § 2.124 if such witness is outside the jurisdiction of the United States, and the offering party must make that witness available; or taken by deposition upon oral examination as provided by this section; or by deposition upon written questions as provided by § 2.124.*

(a)(2) *Testimony taken in a foreign country shall be taken: by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within twenty days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.*

Testimonial depositions taken in a foreign country shall be taken by deposition upon written questions. [Note 1.] The Board may, depending upon the particular facts and circumstances in each case, upon motion for good cause, order that the deposition be taken by oral examination. Trial testimony in a foreign country may be taken by affidavit or declaration (subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness). [Note 2.]

A party served with a notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present in the United States or any territory which is under the control and jurisdiction of the United States, may file within twenty days from the date of service of the notice a motion with the Board showing good cause for an order that the deposition be taken on oral examination. [Note 3.]

NOTES:

1. 37 C.F.R. § 2.123(a)(2)*See* 37 C.F.R. § 2.124.

2. *See* 37 C.F.R. § 2.123(a)(2). *Orion Group Inc. v. Orion Insurance Co.*, 12 USPQ2d 1923, 1525-26 (TTAB 1989) (good cause to take oral discovery deposition of witness in England).

2. 37 C.F.R. § 2.123(a)(2)

532 Motion to Strike Notice of Reliance

During its testimony period, a party may make certain specified types of evidence of record by filing a notice of reliance thereon, accompanied by the evidence being offered. For a discussion of the introduction of evidence, see TBMP § 700. 37 C.F.R. § 2.120(k) provides for the introduction, by notice of reliance, of a discovery deposition, answer to interrogatory, admission or written disclosure; but specifically states that documents obtained by production under Fed. R. Civ. P. 34 may not be made of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of 37 C.F.R. § 2.122(e). 37 C.F.R. § 2.122(d)(2), provides for the introduction, by notice of reliance, of a registration owned by a party to a proceeding. 37 C.F.R. § 2.122(e), provides for the introduction, by notice of reliance, of certain specified types of printed publications and official records. *See*TBMP § 704.03(b); TBMP § 704.07; and TBMP § 704.11.

When a notice of reliance under any of the aforementioned rules is filed after the close of the offering party's testimony period, an adverse party may file a motion to strike the notice of reliance and, thus, the evidence submitted thereunder, in its entirety, as untimely. *See*TBMP § 707.02(c).

An adverse party may also move to strike a notice of reliance, in whole or in part, on the ground that the notice of reliance does not comply with the procedural requirements of the particular rule under which it was submitted. For example, a party may move to strike a notice of reliance on a printed publication pursuant to 37 C.F.R. § 2.122(e), on the ground that it does not include a copy of the printed publication, or does not indicate the general relevance thereof [Note 1], *see*TBMP § 707.02(b)(2), or that the proffered materials are not appropriate for introduction by notice of reliance. [Note 2.] *See*TBMP § 707.02(b)(2). If, upon motion to strike a notice of reliance on the ground that it does not meet the procedural requirements of the rule under which it was filed, the Board finds that the notice is defective, but that the defect is curable, the Board may allow the party that filed the notice of reliance time within which to cure the defect, failing which the notice will stand stricken. [Note 3.]

Objections to a notice of reliance on substantive grounds, such as objections on the grounds that evidence offered under a notice of reliance constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial, normally need not and should not be raised by motion to strike. Rather, such objections should be raised in the objecting party's brief on the case, unless the ground for objection is one that could have been cured if raised promptly by motion to strike. [Note 4.] *See*TBMP § 707.02(c).

It is the policy of the Board not to read trial testimony or examine other trial evidence prior to final decision. *See*TBMP § 502.01. Thus, if a motion to strike cannot be resolved simply by reviewing the face of the notice of reliance and attached documents, but instead would require a review of testimony or other evidence, determination of the motion will be deferred by the Board until final hearing. [Note 5.]

Evidence timely and properly introduced by notice of reliance under the applicable Trademark Rules of Practice generally will not be stricken, but the Board will consider any objections thereto in its evaluation of the probative value of the evidence at final hearing. [Note 6.] *See*TBMP § 707.02(c).

NOTES:

1. 37 C.F.R § 2.122(g). *See, e.g., STX Financing, LLC v. Stacey Michelle Terraza*, 2020 USPQ2d 10989, at *4 (TTAB 2020) (motion to strike exhibit to the notice of reliance consisting of opposer's responses to applicant's interrogatories on the ground that applicant failed to indicate the general relevance of the interrogatory answers, instead asserting broadly that the interrogatories were relevant "to show no likelihood of confusion and/or dilution," granted with leave to cure).

2. *See, e.g., STX Financing, LLC v. Stacey Michelle Terraza*, 2020 USPQ2d 10989, at *4 (TTAB 2020) (motion to strike exhibit consisting of Internet materials submitted under a notice of reliance denied where date of access or publication was not displayed on the face of the Internet materials themselves but was clearly provided in the notice of reliance itself); *Azalea Health Innovations, Inc. v. Rural Health Care, Inc.*, 125 USPQ2d 1236, 1240 (TTAB 2017) (granting motion to strike discovery deposition transcript of nonparties submitted under notice of reliance because discovery depositions may only be offered into evidence by stipulation or by order of the Board granting an appropriate motion seeking approval of use of the discovery depositions); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1164-65 (TTAB 2017) (notice of reliance failed to sufficiently delineate relevance of specific pages within exhibits and press release found to be improper for submission under notice of reliance); *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014) (notice of reliance failed to sufficiently indicate the relevance of the material being offered by not specifying the relevance of the voluminous web pages submitted under two exhibits); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1654 (TTAB 2014) *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016) (evidence submitted on flash drive stricken from record, parties may not by agreement override 37 C.F.R. § 2.126 provisions prescribing form of submission), *Corporacion Habanos SA v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1093 (TTAB 2012) (objection that relevance of evidence not identified waived where raised for first time with brief because procedural deficiency could have been cured if objection had been raised seasonably); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (improper rebuttal evidence stricken); *Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2019-20 (TTAB 2003) (whether plaintiff's price sheets and catalogs constitute proper subject matter for a notice of reliance is not a substantive issue and may be determined from the face of the notice of reliance). *See also Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ 1492, 1497-1500 (Board ruled on multiple motions to strike numerous notices of reliance or portions thereof).

3. 37 C.F.R. § 2.122(g) ("[f]ailure to identify the relevance of the evidence, or associate it with issues in the proceeding, with sufficient specificity is a procedural defect that can be cured"). *See STX Financing, LLC v. Stacey Michelle Terraza*, 2020 USPQ2d 10989, at *4 (TTAB 2020) (motion to strike exhibits comprised of third-party registrations and applications and interrogatory responses for failing to identify relevance of these materials to asserted claims granted with leave to cure); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1165 (TTAB 2017) (motion to strike exhibits under notice of reliance granted in part with leave to cure); *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014) (motion to strike exhibits under notice of reliance granted with leave to cure); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (allowed 20 days to correct deficiencies); *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.6 (TTAB 1988) (where registrant was given leave to amend notice of reliance to correct deficiencies but failed to do so, documents remained stricken).

4. *See Apollo Medical Extrusion Technologies, Inc. v. Medical Extrusion Technologies, Inc.*, 123 USPQ2d 1844, 1846-47 (TTAB 2017) (failure to raise an evidentiary objection that could have been cured waived), *appeal docketed*, 3:17-CV-01250 (S.D. Cal. Oct. 19, 2017); *United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1046-47 (TTAB 2014) (evaluation of various documents submitted under notice of reliance); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007); *but see The Ritz*

Hotel Limited v. Ritz Closet Seat Corp., 17 USPQ2d 1466, 1468-69 (TTAB 1990). *See also Seaward Corp. v. Seaward International, Inc.*, 223 USPQ 48, 49 n.4 (TTAB 1984); *Otis Elevator Co. v. Echlin Manufacturing Co.*, 187 USPQ 310, 313 n.4 (TTAB 1975).

5. *See FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (motion to strike unpleaded registration deferred as admissibility depends on purpose for which it was submitted); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 n.2 (TTAB 1990) (questions of admissibility of documents based on hearsay and lack of authentication deferred). *See also Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1371-72 n.2 (TTAB 2011) (it is not the Board's policy to read trial testimony or other trial evidence prior to final decision).

6. *See M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 n.2 (TTAB 1990).

533 Motion to Strike Trial Testimony Affidavits and Declarations, and Oral Testimony Depositions

533.01 On Ground of Untimeliness

37 C.F.R. § 2.121(a) *The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's required pretrial disclosures and assigning to each party its time for taking testimony and presenting evidence ("testimony period"). No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. …*

37 C.F.R. § 2.123(a)(1) *The testimony of witnesses in inter partes cases may be submitted in the form of an affidavit or a declaration pursuant to § 2.20 and in conformance with the Federal Rules of Evidence, filed during the proffering party's testimony period, subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination of that witness as provided under paragraph (c) of this section if such witness is within the jurisdiction of the United States, or conduct cross-examination by written questions as provided in § 2.124 if such witness is outside the jurisdiction of the United States, and the offering party must make that witness available; or taken by deposition upon oral examination as provided by this section or by deposition upon written questions as provided by § 2.124.*

A party may not take an oral testimony deposition or execute or submit a testimony affidavit or declaration outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. [Note 1.] *See*TBMP § 701.

When there is no such approved stipulation, granted motion, or Board order, and an oral testimony deposition is taken after the close of the deposing party's testimony period or a testimony affidavit or declaration is executed or filed outside of the assigned testimony period, an adverse party may file a motion to strike the testimony deposition, in its entirety, as untimely. [Note 2.] In some circumstances it may be appropriate for the adverse party to wait and raise this ground for objection in its brief on the case; however, in others it may be deemed waived. [Note 3.] *See*TBMP § 707.03(b)(1).

NOTES:

1. 37 C.F.R. § 2.121(a). *See Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 71345, at *2 (TTAB 2020) ("a party may introduce testimony and evidence only during its assigned testimony period"); *Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *2 n.3 (TTAB 2020) (parties stipulated that any declaration

or affidavit shall be admissible even though executed before and not during the testimony period of a party); *M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd.*, 2019 USPQ2d 149090, at *2 n.11 (TTAB 2019) (substitute testimony declaration was untimely filed outside of opposer's testimony period); *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, *3-4 (TTAB 2019) (three year old declaration from application file was not of record as trial testimony as it was not executed (taken) during the assigned testimony period), *cancellation order vacated on default judgment*, (S.D. Fla. Dec. 17, 2019). *See also Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451, 1454 n.1 (TTAB 1998) (parties stipulated that testimony deposition of applicant's witness could be taken prior to its testimony period on the same day as opposer's witness to achieve efficiencies in time and cost). *Cf. Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1651 (TTAB 2007) (objection to notice of deposition based on timeliness overruled because the deposition was noticed and taken during the assigned testimony period). *But see International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *3 n.12 (TTAB 2020) (declarations signed by witnesses prior to testimony period and submitted by opposers as trial testimony considered to have been properly submitted because applicants did not object to them as untimely, and, in fact, treated them as part of the record by raising substantive objections against them).

2. *See* 37 C.F.R. § 2.121(a); *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998) (testimonial deposition taken outside testimony period stricken); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1072-23 (TTAB 1990) (motion to strike testimony for insufficient notice construed as motion to strike testimony taken out of time).

3. *See Societe Des Produits Nestle S.A. v. Cándido Viñuales Taboada*, 2020 USPQ2d 10893, at *7 (TTAB 2020) (objection that evidence was not adequately disclosed in pretrial disclosures overruled as untimely when first raised in trial brief; objection is curable and should have been made via motion to strike promptly after testimony declaration and exhibits were filed). *Cf. Moke America, LLC v. Moke USA*, LLC, 2020 USPQ2d 10400, at *5 (TTAB 2020) ("An objection to foundation raised for the first time in a trial brief is untimely because the party offering the testimony (whether by deposition, affidavit or declaration) does not have the opportunity to cure the alleged defect."); *Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (where applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of testimony deposition two days prior to opening of testimony period could have been corrected upon seasonable objection).

533.02 On Other Grounds

533.02(a) On Ground of Improper or Inadequate Notice of Witness Testimony Taken by Oral Testimony Deposition

37 C.F.R. § 2.123(c) ***Notice of examination of witnesses.*** *Before the oral depositions of witnesses shall be taken by a party, due notice in writing shall be given to the adverse party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined. ...*

37 C.F.R. § 2.123(e)(3) ***Examination of witnesses.*** *If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.*

(i) *A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e).*

(ii) *A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

If pretrial or rebuttal disclosures or the notice of examination of witnesses by oral testimony served by a party is improper or inadequate with respect to any witness, e.g., does not give due (i.e., reasonable) notice, or does not identify a witness whose oral deposition is to be taken, an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence. However, promptly after the oral deposition is completed, the adverse party, if it wishes to preserve the objection, must move to strike the testimony from the record. [Note 1.]

A motion to strike an oral testimony deposition for improper or inadequate notice must request the exclusion of the entire testimony deposition, not just a part thereof. The motion will be decided on the basis of all the relevant circumstances. [Note 2.]

Parties should note that objections to an oral testimony deposition based upon improper or inadequate pretrial disclosures or notice may also be raised by a motion to quash. [Note 3.] *See*TBMP § 521. Raising such objections by means of a motion to quash may avoid the time and expense of taking the deposition in the event the motion is granted, and further leaves open the possibility that such deposition could be rescheduled with more appropriate notice. If the matter is raised by a motion to quash, parties are encouraged to contact the assigned Board attorney by telephone, and ask that the matter be resolved by telephone conference, as time is of the essence with such a motion. For information on telephone conferences with Board attorneys concerning motions, see TBMP § 413.01 and TBMP § 502.06(a).

Parties also should note that the majority of disputes arising from the improper or inadequate notice of oral trial testimony depositions may be avoided by early communication regarding the planning and scheduling of such depositions. Parties may discuss scheduling of testimonial depositions early in the pretrial phase of the proceeding, e.g., when serving their pretrial disclosures. In any event, the Board expects a reasonable degree of cooperation and flexibility in scheduling to avoid such disputes.

NOTES:

1. *See* 37 C.F.R. § 2.123(e)(3); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1652-53 (TTAB 2007) (reasonableness of notice based upon calendar days and not business days, six calendar days in this case is reasonable notice); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1704 (TTAB 1990) (one day notice not sufficient time for applicant to prepare for deposition but opposer allowed time to recall witness for purpose of cross-examination and redirect); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (substitute witness not identified but adverse party failed, after deposition, to move to strike); *Home Juice Co. v. Runglin Cos. Inc.*, 231 USPQ 897, 898 n.4 (TTAB 1986) (motion to strike filed four months after testimony taken was untimely); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (where applicant attended deposition and objected to its consideration on ground that it was taken on two days' notice, Board found that notice, although short, was not unreasonable where deposition was held a short distance from applicant's attorney's office and where no specific prejudice was shown).

See also, e.g., Gaudreau v. American Promotional Events, Inc., 82 USPQ2d 1692, 1696 (TTAB 2007) (motion to strike testimony deposition granted where there was no attempt to contact adversary regarding an individual's deposition until two days before the testimony period closed); *Duke University v. Haggar*

Clothing Co., 54 USPQ2d 1443, 1444 (TTAB 2000) (one and two-day notices were not reasonable without compelling need for such haste; three-day notice was reasonable); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 (TTAB 1999) (two-day notice was not reasonable and opposing counsel's failure to appear was excused); *Penguin Books Ltd. V. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998) (one-day notice for deposition of expert witness was short but not prejudicial where party gave notice "as early as possible" and moreover offered to make witness available again at a future date).

2. *See* 37 C.F.R. § 2.123(e)(3).

3. *See* 37 C.F.R. § 2.123(c); Fed. R. Civ. P. 30(b) and Fed. R. Civ. P. 31(a); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000) (on a motion to quash five testimony depositions, whether notice is reasonable depends upon the circumstances of each case; one and two-day notices were not reasonable without compelling need for such haste, but three-day notice was reasonable.)

533.02(b) On Ground of Failure to Disclose Witness in Expert, Pretrial or Rebuttal Disclosures

37 C.F.R. § 2.120(a)(1) ***In general.*** *...The Board will specify the deadline … for making … expert disclosure.*

37 C.F.R. § 2.121(e) ***Assignment of times for taking testimony and presenting evidence.*** *A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. However, no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. The testimony of a witness may be taken upon oral examination and transcribed, or presented in the form of an affidavit or declaration, as provided in § 2.123 and 2.124.*

37 C.F.R. § 2.123(e)(3) ***Examination of Witnesses.*** *If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.*

(i) *A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e).*

(ii) *A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

Pretrial and rebuttal disclosures require that a party, in advance of the presentation of its testimony, inform its adversary of the names of, and certain minimal identifying information about, the individuals who are expected to, or may, if the need arises, testify at trial. [Note 1.] Although a party need not identify particular individuals as prospective trial witnesses through its mandatory initial disclosures, it must identify "each individual likely to have discoverable information along with the subjects of that information that the disclosing party may use to support its claims or defenses." [Note 2.]

With regard to expert witnesses, as with fact witnesses, the deadline for expert disclosure will be set by the Board in the notice of institution. [Note 3.] If the expert is retained after the deadline for the disclosure of expert testimony, the party must promptly file a motion for leave to use expert testimony. [Note 4.]

If timely-served expert disclosures are deficient, the Board expects the parties to cooperate to resolve the matter. It is not the Board's policy to exclude either the testimony to be proffered by the expert witness or the information originally excluded when there has been supplementation of the deficient expert disclosure, either upon the initiative of the disclosing party or after notification by the adverse party that the disclosure was incomplete. [Note 5.] A disclosing party's failure to inform the Board of timely disclosure of an expert witness is not a ground to exclude the testimony of such witness. [Note 6.]

If pretrial or rebuttal disclosures are improper or inadequate with respect to a particular witness, in the case of an oral testimony deposition, the adverse party may cross-examine that witness under protest while reserving its right to object to receipt of the testimony into evidence. However, promptly after the deposition is completed, the adverse party, if it wishes to preserve the objection, must move to strike the testimony from the record. [Note 7.] When testimony is presented by affidavit or declaration, but was not covered by an earlier pretrial or rebuttal disclosure, the remedy is the prompt filing of a motion to strike. [Note 8.]

Parties should note that, in accordance with the above discussion, objections to an oral testimony deposition based upon improper or inadequate notice may also be raised by a motion to quash. It is best to raise the matter promptly to avoid expending resources associated with taking a deposition should a motion to quash or strike pretrial disclosures be granted. [Note 9.] *See*TBMP § 521 and TBMP § 533.02(a).

If the matter is raised by a motion to quash, parties are encouraged to contact the assigned Board attorney by telephone, and ask that the matter be resolved by telephone conference, as time is of the essence with such a motion. For information on telephone conferences with Board attorneys concerning motions, see TBMP § 413.01and TBMP § 502.06(a).

The Board, depending on the circumstances presented, may be guided by the following five-factor test enunciated in *Southern States Rack & Fixture, Inc. v. Sherwin-Williams Co.*, 318 F.3d 592 (4th Cir. 2003) and adopted by the Board in *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323 (TTAB 2011): "1) the surprise to the party against whom the evidence would be offered; 2) the ability of that party to cure the surprise; 3) the extent to which allowing the testimony would disrupt the trial; 4) importance of the evidence; and 5) the nondisclosing party's explanation for its failure to disclose the evidence." [Note 10.]

The Board often allows parties to cure technical deficiencies in connection with otherwise timely matters. If technical deficiencies with pretrial disclosures are raised promptly, the matter may be resolved, either between the parties or with Board intervention, before the parties incur the expense associated with taking a testimonial deposition. [Note 11.]

NOTES:

1. *See* 37 C.F.R. § 2.121(e); *Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1371-72 n.1 (TTAB 2011); *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009).

2. Fed. R. Civ. P. 26(a)(1). *See* 37 C.F.R. § 2.116(a); *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1178 (TTAB 2010); *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443, 1443 n.1 (TTAB 2009).

3. 37 C.F.R. § 2.120(a)(1).

4. *See* 37 C.F.R. § 2.120(a)(2).

5. *See General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011).

6. *See Monster Energy Co. v. Martin*, 125 USPQ2d 1774, 1776 (TTAB 2018); *General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011).

7. *See* 37 C.F.R. § 2.123(e)(3); *Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1373-74 n.4 (TTAB 2011); *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443, 1445 (TTAB 2009) (testimony deposition of witness stricken where witness was not identified in pretrial or initial disclosures). *Cf. Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1928 (TTAB 2011) (objection on the basis that the witness had not been previously disclosed waived where not renewed in main brief and raised for first time in rebuttal brief), *aff'd*, 188 F.Supp.3d 22 (D.D.C. 2016), *on appeal*, No. 17-17075 (D.C. Cir. May 3, 2017); *Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (where applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of testimony deposition two days prior to opening of testimony period could have been corrected upon seasonable objection).

8. *See* 37 C.F.R. § 2.121(e); 37 C.F.R. § 2.123(e)(3)(i). *See Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *2-3 (TTAB 2020) (respondent timely moved to strike the testimony of petitioner's rebuttal witness on the basis that petitioner failed to disclose her as a potential witness in petitioner's pretrial rebuttal disclosures; Board deferred ruling until final decision); *Societe Des Produits Nestle S.A. v. Cándido Viñuales Taboada*, 2020 USPQ2d 10893, at *7 (TTAB 2020) (objection that evidence submitted with testimony declaration was not adequately disclosed in pretrial disclosures overruled as untimely when first raised in trial brief; objection is procedural and should have been made via motion to strike promptly after testimony declaration and exhibits were filed).

9. 37 C.F.R. § 2.121(e). *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1240 (TTAB 2012) (judicial economy served by promptly filing a motion to quash or to strike the pretrial disclosures as insufficient before the deposition takes place).

10. *See Southern States Rack & Fixture, Inc. v. Sherwin-Williams Co.*, 318 F.3d 592, 597 (4th Cir. 2003). *See also MicroStrategy, Inc. v. Business Objects, S.A.*, 429 F.3d 1344, 1357, 77 USPQ2d 1001, 1009-10 (Fed. Cir. 2005) (applying *Southern States* factors in excluding non-expert damages evidence as a sanction for late disclosure); *Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1102-04 (TTAB 2018) (applying the *Great Seats* test, motion to strike pretrial disclosures and exclude subsequently filed testimony declarations denied because failure to disclose witnesses was both substantially justified and harmless); *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012) (after conducting analysis, the Board concluded that opposer's failure to identify witness prior to pretrial disclosure was neither harmless nor substantially justified; combined motion to strike pretrial disclosure and to quash notice of testimony granted); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327-28 (TTAB 2011) (after conducting the analysis, the Board found that opposer's failure to name one witness until original pretrial closures and twenty-six witnesses until supplement to amended pretrial disclosures was neither harmless nor substantially justified and motion to quash granted as to twenty-six witnesses but testimony of one witness, identified months before in original pretrial disclosure, not excluded provided adverse party be given an opportunity to take a discovery deposition).

11. *See Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1373-74 n.4 (TTAB 2011).

533.03 Guidance Regarding Motions to Strike Testimony and Raising Substantive Objections

The Board does not ordinarily strike testimony taken in accordance with the applicable rules on the basis of substantive objections; rather, such objections are considered by the Board in its evaluation of the probative value of the testimony at final hearing. [Note 1.]

Objections to testimony depositions on grounds other than the ground of untimeliness, or the ground of improper or inadequate notice, generally should not be raised by motion to strike. Rather, the objections should simply be made in writing at the time specified in the applicable rules, and orally "on the record" at the taking of the deposition, as appropriate. [Note 2.] *See*TBMP § 707.03(c). Such objections to an oral testimony deposition must be maintained in the objecting party's brief, or they are considered to have been waived. [Note 3.]

The defending party may seasonably raise the objection in different ways where the testimony is by declaration or affidavit depending on the circumstances of the case. [Note 4.] For example, in the case of a curable objection such as lack of foundation, the defending party may elect to seek oral cross-examination, query the foundation for the testimony and exhibits introduced, and, if the defending party finds the foundation testimony to be insufficient, it may raise an objection to the testimony or exhibit on the deposition record. [Note 5.]

In the alternative, the defending party may serve an objection on the party proffering the declaration or affidavit and assert the objection in its brief. The defending party should file the objection with the Board when made, to put the Board on notice that it made a timely objection and the party offering the witness may seek to extend or reopen testimony to cure the defect. The proffering party has the option of trying to cure the defect or arguing that the objection should be overruled. [Note 6.]

Finally, an objection may be made by way of a motion to strike filed no later than the twenty (20) days permitted for the defending party to elect cross-examination, which again puts the proffering party on notice that there may be a curable defect and puts the Board on notice that an extension or reopening of the testimony period may be sought, recognizing that a determination may be deferred to final decision. [Note 7.] The key aspect is that an objection is seasonably lodged. [Note 8.] The manner in which it is raised may vary depending on the circumstances.

NOTES:

1. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1047 (TTAB 2017); *Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1194 n.19 (TTAB 2014); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1755 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992).

2. *See Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.4 (TTAB 1990).

3. *See Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived).

4. *Moke America, LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *5 (TTAB 2020).

5. *Moke America, LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *5 (TTAB 2020). *See, e.g., Barclays Capital Inc. v. Tiger Lily Ventures*, 124 USPQ2d 1160, 1167 (TTAB 2017) (party objecting to declaration testimony [on substantive grounds] may either elect oral cross-examination or file a motion to strike in order to lodge an objection to declaration testimony).

6. *Moke America, LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *5 (TTAB 2020).

7. *Moke America, LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *5 (TTAB 2020).

8. *Moke America, LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *5 (TTAB 2020) ("a]n objection to foundation raised for the first time in a trial brief is untimely because the party offering the testimony (whether by deposition, affidavit or declaration) does not have the opportunity to cure the alleged defect."); *International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *3-4 (TTAB 2020) (when raised for the first time with main brief, objection on the basis of lack of foundation is untimely and waived).

534 Motion For Judgment For Plaintiff's Failure to Prove Case

534.01 In General

37 C.F.R. § 2.132 ***Involuntary dismissal for failure to take testimony.***

(a) *If the time for taking testimony by any party in the position of plaintiff has expired and it is clear to the Board from the proceeding record that such party has not taken testimony or offered any other evidence, the Board may grant judgment for the defendant. Also, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground of the failure of the plaintiff to prosecute. The party in the position of plaintiff shall have twenty days from the date of service of the motion to show cause why judgment should not be rendered dismissing the case. In the absence of a showing of excusable neglect, judgment may be rendered against the party in the position of plaintiff. If the motion is denied, testimony periods will be reset for the party in the position of defendant and for rebuttal.*

(b) *If no evidence other than Office records showing the current status and title of plaintiff's pleaded registration(s) is offered by any party in the position of plaintiff, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground that upon the law and the facts the party in the position of plaintiff has shown no right to relief. The party in the position of plaintiff shall have twenty days from the date of service of the motion to file a brief in response to the motion. The Trademark Trial and Appeal Board may render judgment against the party in the position of plaintiff, or the Board may decline to render judgment until all testimony periods have passed. If judgment is not rendered on the motion to dismiss, testimony periods will be reset for the party in the position of defendant and for rebuttal.*

(c) *A motion filed under paragraph (a) or (b) of this section must be filed before the opening of the testimony period of the moving party, except that the Trademark Trial and Appeal Board may in its discretion*

grant a motion under paragraph (a) even if the motion was filed after the opening of the testimony period of the moving party.

When a party has not taken testimony or offered any other evidence the Board may grant judgment for the defendant sua sponte. [Note 1.] In addition, the Trademark Rules of Practice permit the filing of a motion for judgment directed to the sufficiency of a plaintiff's trial evidence in two particular situations, described in 37 C.F.R. § 2.132(a) and 37 C.F.R. § 2.132(b). Only in these two situations will the Board entertain such a motion. *See*TBMP § 534.04. *But cf.*TBMP § 527.03.

NOTES:

1. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is amending § 2.132(a) to clarify that, if a plaintiff has not submitted evidence and its time for taking testimony has expired, the Board may grant judgment for the defendant sua sponte.").

534.02 Motion For Judgment Under 37 C.F.R. § 2.132(a)

The first situation in which a defendant may appropriately file a motion for judgment directed to the sufficiency of a plaintiff's trial evidence, is when the plaintiff's testimony period has passed, and the plaintiff has not taken testimony or offered any other evidence. [Note 1.] In such a situation, the defendant may, without waiving its right to offer evidence in the event the motion is denied, move for dismissal for failure of the plaintiff to prosecute. [Note 2.] A motion for judgment under 37 C.F.R. § 2.132(a) should be filed before the opening of the moving party's testimony period, but the Board may, in its discretion, grant the motion even if it is filed thereafter. [Note 3.]

When a motion for judgment under 37 C.F.R. § 2.132(a) has been filed by a defendant, the plaintiff has 20 days from the date of service of the motion in which to respond and show cause why judgment should not be rendered against it. In the absence of a showing of excusable neglect, judgment may be rendered against the plaintiff. [Note 4.]

The "excusable neglect" standard, in the context of this rule, is equivalent to the "excusable neglect" standard that would have to be met by any motion under Fed. R. Civ. P. 6(b) to reopen the plaintiff's testimony period. [Note 5.]

For examples of cases involving the question of whether excusable neglect has been shown for a plaintiff's failure to offer any evidence, see note below. [Note 6.] For a complete discussion of excusable neglect and the standard to be applied, see TBMP § 509.01(b) regarding motions to reopen, and cases cited therein.

If a timely motion under 37 C.F.R. § 2.132(a) is denied because plaintiff has shown excusable neglect, the result is that plaintiff's testimony period will be reopened, and testimony periods will be reset for the plaintiff and defendant, and for rebuttal. [Note 7.] The deadlines for defendant's pretrial disclosures and plaintiff's rebuttal disclosures will be reset as well.

The purpose of the motion under 37 C.F.R. § 2.132(a) is to save the defendant the expense and delay of continuing with the trial in those cases where plaintiff has failed to offer any evidence during its testimony period. [Note 8.] However, the defendant is under no obligation to file such a motion; the motion is optional, not mandatory. [Note 9.] If no motion under 37 C.F.R. § 2.132(a) is filed, trial and pretrial disclosure dates will continue to run, and the case may be determined at final hearing. In those cases where plaintiff did, in

fact, fail to offer any evidence during its testimony period, plaintiff cannot prevail and, thus, defendant need not offer evidence either. [Note 10.]

The fact that a defendant may have previously sought judgment under 37 C.F.R. § 2.132(b) does not preclude it from thereafter seeking judgment under 37 C.F.R. § 2.132(a). [Note 11.]

NOTES:

1. *See* 37 C.F.R. § 2.132(a); *Otter Products LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012) (" . . . the clear language of Trademark Rule 2.132(a) indicates that it applies only where the plaintiff has not introduced "any" evidence, i.e., no evidence of any kind, and here opposer has introduced something, regardless of whatever is found with respect to its ultimate impact."); *Loren Cook Company v. The Acme Engineering and Manufacturing Corp.*, 216 USPQ 517, 519 (TTAB 1982) ("The [motion for judgment] rule is limited to situations where the plaintiff presents no evidence (2.132(a)) or where only Patent and Trademark Office records are of record (2.132(b))").

2. *See* 37 C.F.R. § 2.132(a). *See also, e.g.*, *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1712 (Fed. Cir. 1991) (Board did not abuse discretion in denying motion to reopen testimony and dismissing proceeding on motion to dismiss where plaintiff submitted no evidence and failed to make a prima facie case); *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.*, 61 USPQ2d 1542, 1544 (TTAB 2001) (motion to extend testimony period denied; motion to dismiss granted); *SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372, 1374 (TTAB 2001) (same); *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1384 (TTAB 2001) (motion to extend testimony period granted, motion to dismiss denied); *Atlanta Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858, 1860 (TTAB 1998) (motion to reopen discovery and testimony periods denied, motion to dismiss granted); *Hartwell Co. v. Shane*, 17 USPQ2d 1569, 1570 n.4 (TTAB 1990) (respondent advised that if petitioner continued to show no interest and failed to take testimony, applicant may avail itself of 37 C.F.R. § 2.132(a)); *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1645, 1845-46 (TTAB 1987) (where opposer failed to offer evidence during its testimony period, applicant could have filed motion to dismiss instead of offering its own evidence); *Loren Cook Co. v. Acme Engineering and Manufacturing Corp.*, 216 USPQ 517, 519 (TTAB 1982) (where evidence was presented by plaintiff, motion for judgment under 37 C.F.R. § 2.132 was not entertained).

3. *See* 37 C.F.R. § 2.132(c). *See also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1712 (Fed. Cir. 1991); *Atlanta Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858, 1860 (TTAB 1998).

4. *See* 37 C.F.R. § 2.132(a). *See also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) ("While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines"); *Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1601-02 (TTAB 2014) (granting 37 C.F.R. 2.132(a) motion to dismiss for failure to prosecute where opposer took no testimony and plain copy of pleaded registration was attached to notice of opposition – registration not properly of record, and applicant's admission in answer that opposer "is listed" as the owner does not establish opposer's current ownership of the pleaded registration); *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860, 1862 (TTAB 2002) (Board is justified in enforcing procedural deadlines). *Cf. Litton Business Systems, Inc. v. JG Furniture Co.*, 188 USPQ 509, 512 (TTAB 1976) (although no testimony or other evidence was introduced, answer to complaint contained certain admissions which arguably preserved enough of an issue to proceed to final hearing). *But see Cutino v. Nightlife Media, Inc.*, 575 F. App'x 888 (Fed. Cir. 2014) (applicant admitted in

its answer that opposer was the owner of the mark, and did not deny in the answer that opposer owned the pleaded registration sufficient to be an admission regarding ownership and status of the pleaded registration).

5. 37 C.F.R. § 2.132(a). The 2017 amendments to 37 C.F.R. § 2.132(a) changed the terminology in the applicable standard from "good and sufficient cause" to "excusable neglect." *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is further amending §2.132(a) to clarify that the standard for the showing required not to render judgment dismissing the case is excusable neglect.") Consequently, cases determined before the amendments went into effect may use the earlier terminology, e.g., "good and sufficient cause" but they remain authoritative. *See also PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860, 1860-61 (TTAB 2002) (good and sufficient cause standard in context of motion to dismiss under 37 C.F.R. § 2.132(a) is excusable neglect standard); *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1157 (TTAB 1998) (good and sufficient cause standard is equivalent of excusable neglect because response to motion to dismiss is essentially motion to reopen testimony); *Grobet File Co. of America Inc. v. Associated Distributors Inc.*, 12 USPQ2d 1649, 1651 (TTAB 1989) (showing of good and sufficient cause is equivalent of excusable neglect because it requires the reopening of the testimony period to introduce the evidence).

6. *See Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507 U.S. 380, 395 (1993) (Supreme Court articulates present standard for excusable neglect – cases decided prior to *Pioneer* may no longer be correct); *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997) (Board adopts *Pioneer* standard that excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay, including (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith).

See also Vital Pharmaceuticals Inc. v. Kronholm, 99 USPQ2d 1708, 1711 (TTAB 2011) (no excusable neglect to reopen testimony based on purported settlement discussions); *Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1541-42 (TTAB 2010) (excusable neglect not found where reason for delay was opposer's mistaken belief that proceedings were suspended); *Old Nutfield Brewing Co., Ltd. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1703 (TTAB 2002) (excusable neglect not found where opposer waited four months after close of testimony period to file motion to reopen and where reason for delay was based on, inter alia, opposer's asserted failure to receive answer to opposition); *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860, 1860-61 (TTAB 2002) (excusable neglect not found where motion to reopen was filed nearly one month after close of testimony period and was based on mistaken belief that extension of time to respond to discovery extended testimony period and on fact that petitioner was gathering information to respond to discovery); *Jain v. Ramparts*, 49 USPQ2d 1429, 1431 (TTAB 1998) (pendency of plaintiff's motion to compel and extend trial dates after ruling on such motion sufficient cause for failure to try case); *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1157 (TTAB 1998) (plaintiff provided no factual details as to the date of counsel's death in relation to plaintiff's testimony period or as to why other lawyers in deceased counsel's firm could not have assumed responsibility for the case); *Atlanta Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858, 1859-60 (TTAB 1998) (mere existence of settlement negotiations insufficient).

7. *See* 37 C.F.R. § 2.132(a).

8. *See Otter Products LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012) (Supplemental Registration of record is evidence of record such that a motion under 37 C.F.R. § 2.132(a) is not available, though a motion under 37 C.F.R. § 2.132(b) may be available); *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 428, 430-31, *recon. denied*, 190 USPQ 431 (TTAB 1976).

9. *See Pfaltzgraf v. William Davies Co.*, 175 USPQ 620, 620-21 (TTAB 1972).

10. *See, e.g., Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1645, 1645-46 (TTAB 1987) (opposition dismissed where applicant filed evidence instead of a motion to dismiss and opposer filed improper rebuttal); *Pfaltzgraf v. William Davies Co. Inc.*, 175 USPQ 620, 620-21 (TTAB 1972).

11. *See W. R. Grace & Co. v. Red Owl Stores, Inc.*, 181 USPQ 118, 119-20 (TTAB 1973).

534.03 Motion For Judgment Under 37 C.F.R. § 2.132(b)

The second situation in which a defendant may appropriately file a motion for judgment directed to the sufficiency of a plaintiff's trial evidence is when the plaintiff's testimony period has passed, and the plaintiff has offered no evidence other than a copy or copies of USPTO records. Such records include originals or copies of a plaintiff's pleaded registration prepared and issued by the USPTO showing status and title thereof, or a current printout obtained from the USPTO database records showing status and title thereof. In such a situation, the defendant may, without waiving its right to offer evidence in the event the motion is denied, move for dismissal on the ground that upon the law and the facts the plaintiff has shown no right to relief. [Note 1.] A motion for judgment under 37 C.F.R. § 2.132(b) must be filed before the opening of the moving party's testimony period. [Note 2.]

When a motion for judgment under 37 C.F.R. § 2.132(b) has been filed by a defendant, the plaintiff has 20 days from the date of service of the motion to file a brief in response. [Note 3.]

In determining a motion under 37 C.F.R. § 2.132(b), the Board may either render judgment against the plaintiff, or decline to render judgment until all of the evidence is in the record and decide the case on its merits. [Note 4.]

If a timely motion under 37 C.F.R. § 2.132(b) is denied, testimony periods and pretrial disclosure deadlines will be reset for the defendant and for rebuttal. [Note 5.]

The purpose of the motion under 37 C.F.R. § 2.132(b) is to save the defendant the expense and delay of continuing with the trial in those cases where plaintiff, during its testimony period, has offered no evidence other than copies of USPTO records, and those records do not make out a prima facie case. [Note 6.] However, the defendant is under no obligation to file such a motion; the motion is optional, not mandatory. [Note 7.]

The fact that a defendant may have previously sought judgment under 37 C.F.R. § 2.132(a) does not preclude it from thereafter seeking judgment under 37 C.F.R. § 2.132(b). [Note 8.]

NOTES:

1. *See* 37 C.F.R. § 2.132(b).

2. *See* 37 C.F.R. § 2.132(c).

3. *See* 37 C.F.R. § 2.132(b).

4. 37 C.F.R. § 2.132(b). *See Merker Counter Co. v. Central Counter Co.*, 310 F.2d 746, 135 USPQ 433, 434-35 (CCPA 1962) (declined to render judgment); *Skincode AG v. Skin Concept AG*, 109 USPQ2d 1325, 1329 (TTAB 2013) (dismissed opposition with prejudice with respect to unproven common law rights

(likelihood of confusion) and dilution claim; denied motion with respect to pleaded registration which was of record since prima facie case of likelihood of confusion established); *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (judgment entered where marks not identical and the relationship, if any, between the parties' goods not apparent from the face of pleaded registration); *Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc.*, 193 USPQ 313, 315 (TTAB 1976) (motion granted as conceded but even if denied, petition to cancel would have been dismissed on the merits). *Cf. Litton Business Systems, Inc. v. JG Furniture Co.*, 188 USPQ 509, 512 (TTAB 1976) (where 37 C.F.R. § 2.132(a) motion was filed, although no testimony or other evidence had been introduced, answer to complaint contained certain admissions which arguably preserved enough of an issue to proceed to final hearing).

5. 37 C.F.R. § 2.132(b).

6. *See, e.g., Otter Products LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1256 (TTAB 2012) (Supplemental Registration insufficient to establish that opposer owns a proprietary right); *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (marks not identical and the relationship, if any, between the parties' goods not apparent from the face of pleaded registration); *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431, 434 (TTAB 1976) (Board will not use judicial notice to remedy plaintiff's failure to present adequate evidence). *Cf. Benedict v. Super Bakery Inc.*, 665 F.3d 1263, 101 USPQ2d 1089, 1092 (Fed. Cir. 2011) (Board did not abuse discretion in entering default judgment under 37 C.F.R. § 2.132(b) against registrant who "continually failed to comply with Board orders, and had hampered reasonable procedures appropriate to resolution of this trademark conflict").

7. *Cf. Pfaltzgraf v. William Davies Co.*, 175 USPQ 620, 621 (TTAB 1972) (respondent under no obligation to move for judgment under 37 C.F.R. § 2.132(a)).

8. *See W.R. Grace & Co. v. Red Owl Stores, Inc.*, 181 USPQ 118, 119-20 (TTAB 1973); *see also Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc.*, 193 USPQ 313, 315 (TTAB 1976) (entertaining motion under 37 C.F.R. § 2.132(b) after the filing of a motion under 37 C.F.R. § 2.132(a)).

534.04 Motion Under Fed. R. Civ. P. 41(b) or Fed. R. Civ. P. 50(a) Not Available

Trial testimony, in Board inter partes proceedings, is taken out of the presence of the Board, and it is the policy of the Board not to read trial testimony, or examine other trial evidence, prior to its final deliberations in the proceeding. *See*TBMP § 502.01.

Accordingly, the only means available for testing the sufficiency of trial evidence in an inter partes proceeding before the Board are the motions described in 37 C.F.R. § 2.132(a) and 37 C.F.R. § 2.132(b). [Note 1.] *See*TBMP §534.02 and TBMP § 534.03. The motion under Fed. R. Civ. P. 41(b) for involuntary dismissal, and the motion under Fed. R. Civ. P. 50(a) for judgment as a matter of law during and following jury trials (also referred to as a "directed verdict"), are not available in Board proceedings. *See*TBMP § 502.01. [Note 2.]

NOTES:

1. *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (motion for involuntary dismissal under 37 C.F.R. § 2.132(a) denied; six days' notice reasonable for testimony deposition that took place during opposer's testimony period).

2. *See Kasco Corp. v. Southern Saw Service, Inc.*, 27 USPQ2d 1501, 1504 n.2 (TTAB 1993) (Fed. R. Civ. P. 50(a) motion unavailable); *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502, 506 n.9 (TTAB 1985) (Fed. R. Civ. P. 41(b) motion unavailable).

535 Motion For Order to Show Cause Under 37 C.F.R. § 2.134(b)

37 C.F.R. § 2.134(b) *After the commencement of a cancellation proceeding, if it comes to the attention of the Trademark Trial and Appeal Board that the respondent has permitted its involved registration to be cancelled under section 8 or section 71 of the Act of 1946, or has failed to renew its involved registration under section 9 of the Act of 1946, or has allowed its registered extension of protection to expire under section 70(b) of the Act of 1946, an order may be issued allowing respondent until a set time, not less than fifteen days, in which to show cause why such cancellation, failure to renew, or expiration should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party and should not result in entry of judgment against respondent as provided by paragraph (a) of this section. In the absence of a showing of good and sufficient cause, judgment may be entered against respondent as provided by paragraph (a) of this section.*

It is generally the responsibility of a petitioner for cancellation to keep track of the status of the respondent's subject registration, and to file a motion for an order to show cause under 37 C.F.R. § 2.134(b) if such registration is cancelled under Trademark Act § 8, 15 U.S.C. § 1058 or Trademark Act § 9, 15 U.S.C. § 1059, after the commencement of the proceeding. However, if the cancellation of the registration under Section 8 or 9 of the Trademark Act comes to the attention of the Board in another manner, the Board may issue an order to show cause upon its own initiative. [Note 1.]

The purpose of 37 C.F.R. § 2.134(b) is to prevent a cancellation proceeding respondent from being able to moot the proceeding and avoid judgment by deliberately failing to file a required affidavit of use under § 8 or renewal application under § 9. [Note 2.]

In those cases where the Board finds that respondent has not acted deliberately to avoid judgment and thereby has shown good and sufficient cause why judgment should not be entered against it under 37 C.F.R. § 2.134(b), petitioner will be given time in which to elect whether it wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot. If respondent submits a showing that the cancellation or expiration was occasioned by the fact that its registered mark had been abandoned and that such abandonment was not made for purposes of avoiding the proceeding, but rather was the result, for example, of a three-year period of non-use which commenced well before registrant learned of the existence of the proceeding, judgment will be entered against it only and specifically on the ground of abandonment. [Note 3.] In those cases where the Board enters judgment against the respondent only and specifically on the ground of abandonment, petitioner will be given time in which to elect whether it wishes to go forward to obtain a determination of the remaining issues, or to have the cancellation proceeding dismissed without prejudice as to those issues. TBMP § 602.02(b).

For further information concerning orders to show cause under 37 C.F.R. § 2.134(b), and related orders to show cause in the case of Trademark Act § 66(a), 15 U.S.C. § 1141f(a), applications or registrations, see TBMP § 602.01 and TBMP § 602.02(b).

NOTES:

1. *See Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *2 (TTAB 2020) (Board exercised its discretion not to issue show cause order where respondent testified that the mark in the cancelled registration

is no longer used and that respondent does not intend to use it again in the future); *Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1110 (TTAB 2015) (Board exercised discretion not to issue show cause order where respondent's intent was manifest).

2. *See, e.g., Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989) (failure to file Section 8 affidavit occurred prior to commencement of proceeding and therefore not to avoid judgment.)

3. *See C.H. Guenther & Son, Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450, 1452 n.4 (TTAB 1988). Nonuse for 3 consecutive years shall be prima facie evidence of abandonment is required currently. Trademark Act § 45, 15 U.S.C §1127.

536 Motion For Order to Show Cause Under 37 C.F.R. § 2.128(a)(3)

37 C.F.R. § 2.128(a)(3) *When a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than fifteen days, in which to show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response to the order, or files a response indicating that 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.*

When a plaintiff fails to file a main brief on the case, it is the normal practice of the Board to issue, sua sponte, an order to show cause why the failure to file a brief should not be treated as a concession of the case. If such an order is not issued by the Board sua sponte, or if an adverse party finds that the Board has inadvertently overlooked a plaintiff's failure to file a main brief, the adverse party may file a motion for an order to show cause. In contrast, because a defendant in a Board inter partes proceeding is not obligated to file a brief, or, for that matter, to take discovery or offer testimony or other evidence, there is no procedure by which the Board will issue a show cause order based upon a defendant's failure to take discovery, offer testimony, or file a brief.

The principal purpose of 37 C.F.R. § 2.128(a)(3) is to save the Board the burden of determining a case on the merits where the parties have entered into a final settlement of the matter, but have neglected to notify the Board thereof, or where the plaintiff has lost interest in the case. It is not the policy of the Board to enter judgment against a plaintiff for failure to file a main brief on the case if the plaintiff still wishes to obtain an adjudication of the case on the merits. [Note 1.] If a show cause order is issued under 37 C.F.R. § 2.128(a)(3), and the plaintiff files a response indicating that it has not lost interest in the case, the show cause order will be discharged by Board order, and judgment will not be entered against plaintiff based on the presumption of lack of interest stemming from its failure to file a main brief. [Note 2.] Even if the show cause order is discharged, the plaintiff may not be accorded an opportunity to present a brief for consideration because a late-filed brief may not be accepted and the time for filing a brief may not necessarily be reset. [Note 3.] In addition, even if the show cause order is discharged, the plaintiff's claims may be dismissed if plaintiff placed no evidence in the record. In other words, even if a plaintiff avoids entry of judgment based on loss of interest, it may still face dismissal for failure to prosecute unless it files, and the Board grants, a motion to reopen the plaintiff's testimony period, and the plaintiff files admissible evidence or testimony during its reopened testimony period. *See*TBMP § 509.01(b)(1). If the plaintiff files no response to the show cause order, or files a response indicating that it has lost interest in the case, judgment may be entered against the plaintiff. [Note 4.]

When the Board discharges a 37 C.F.R. § 2.128(a)(3) order to show cause, plaintiff's time for filing its brief necessarily will have passed. Therefore, notwithstanding that plaintiff may have shown that it is still interested in having the Board decide the case on its merits, unless plaintiff has included with its response a motion to reopen its time for filing its brief, plaintiff may not have a second chance to file a brief. [Note 5.] If the plaintiff files a motion to reopen that is granted by the Board (based on plaintiff's showing of excusable neglect, or on consent, or because the motion is conceded), plaintiff will then be afforded an opportunity to file its main trial brief, and the Board will reset the times for filing that brief and all remaining briefs on the case. If, however, plaintiff included a copy of its brief with its motion to reopen, and the Board issues an order granting the motion and accepting the brief, then the Board will reset remaining briefing deadlines beginning with the deadline for defendant's brief. In instances where the show cause order has been discharged and the plaintiff has submitted its main brief without including a motion to reopen its time to file the main brief under Fed. R. Civ. P. 6(b)(1)(B), the plaintiff's main brief will be given no consideration, even if the defendant raises no objection thereto, and the Board may reset the times for filing remaining briefs beginning with the deadline for defendant's brief, if evidence is in the record. [Note 6.]

It is not unusual for a plaintiff to file a response to the Board's 37 C.F.R. § 2.128(a)(3) order to show cause in a case in which the plaintiff cannot bear its burden of proof, regardless of whether the Board reopens the time for the plaintiff to file its brief. If the record shows (1) that plaintiff failed, during its testimony period, to take any testimony or offer any other evidence in its behalf, (2) that plaintiff failed to make (if applicable) a pleaded registration properly of record with its complaint, and (3) that defendant in its answer did not admit to any dispositive allegations, the Board, in lieu of reopening the briefing schedule, may proceed to enter judgment against plaintiff for failure to prove its case, absent the filing of, and granting of, a motion to reopen testimony brought by plaintiff. [Note 7.] Where plaintiff has made its pleaded registrations of record and/or defendant has made admissions in its answer, the Board may make a determination without the need for defendant to file a brief. [Note 8.]

Thus, all times for filing briefs on the case will be reset, commencing with the deadline for plaintiff's main brief, only in instances where the plaintiff includes with its response to the show cause order a motion under Fed. R. Civ. P. 6(b)(1)(B) to reopen its time to file a main brief (*see*TBMP § 509), and there is evidence in the record. In such a case, the Board may in its discretion set a time for defendant to file a response to the motion to reopen. Similarly, in instances where plaintiff argues that it has established excusable neglect to reopen its testimony period with or without filing a formal motion under Fed. R. Civ. P. 6(b)(1)(B) to reopen, the Board may in its discretion set a time for defendant to file a response to the motion.

NOTES:

1. *See* NOTICE OF FINAL RULEMAKING, 48 Fed. Reg. 23122, 23132 (May 23, 1983); *Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1709-10 (TTAB 2011).

2. *See Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1710 (TTAB 2011).

3. *See Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1710 (TTAB 2011).

4. *See, e.g., CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1302 (TTAB 1999) (no response filed).

5. *See Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1710-11 (TTAB 2011).

6. *See Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1711 (TTAB 2011) (explanation of briefing schedule had motion to reopen testimony and/or alternative motion to reopen time to file a brief been granted).

7. 37 C.F.R. § 2.128(a)(3). *See Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000) (show cause order discharged but plaintiff failed to show excusable neglect to reopen case). *Cf. Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1704 (TTAB 2002) (judgment entered against opposer under 37 C.F.R. § 2.132(a) where opposer's motion to reopen its testimony period denied for failure to establish excusable neglect).

8. *See Vital Pharmaceuticals, Inc. v. Kronholm*, 99 USPQ2d 1708, 17111-12 (TTAB 2011) (opposer's pleaded registrations of record with notice of opposition and applicant made limited admissions in its answer).

537 Motion For Leave to Exceed Page Limit For Brief On Case

37 C.F.R. § 2.128(b) ***Briefs at final hearing.*** *... Each brief shall contain an alphabetical index of cited cases. 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.*

Motions for leave to file a brief on the case in excess of the page limit are disfavored by the Board and rarely granted. Because the Board is an administrative tribunal of limited jurisdiction, empowered to determine only the right to register, very few of the cases before it are of such a nature as to require a brief on the case that exceeds the 37 C.F.R. § 2.128(b) page limit. Further, one of the primary purposes of the rule is to assist the Board in managing its workload, and to encourage litigants to focus their arguments and eliminate needless verbiage. [Note 1.] Thus, a party seeking leave to file a brief on the case with more than the allowed number of pages must obtain "prior leave" from the Board to do so. [Note 2.] The motion must be submitted on or before the date that the brief is due. [Note 3.] This is so even in those cases where the motion is filed with the consent of the adverse party or parties. 37 C.F.R. § 2.128(b) is for the benefit of the Board, and it is only with the Board's permission, timely sought, that a brief exceeding the page limit will be entertained.

The preferred practice, when a timely motion for leave to exceed the page limit is filed, is that the proposed over-length brief not be filed with the motion. If the moving party refrains from filing its brief with the motion, and the motion is granted, the Board in its decision on the motion will allow time for the filing of the brief and specify the number of additional pages granted. Alternatively, if the motion is denied, the Board, in its decision, will allow time for the filing of a brief that does not exceed the page limit specified in 37 C.F.R. § 2.128(b). On the other hand, if the proposed overlength brief is filed with a timely motion, and the motion is granted, the Board will accept the brief. If a timely motion is denied, the overlength brief submitted with the motion will be given no consideration, and the Board will allow time for the filing of a brief that conforms to the page limit set out in 37 C.F.R. § 2.128(b). [Note 4.]

A timely motion to exceed the specified page limit need not be accompanied by a motion to extend the time for filing the subject brief. As noted in the preceding paragraph, when the Board rules upon the motion to exceed the page limit, it will reset the due date for the brief that is the subject of the motion, along with the due dates for any remaining briefs on the case, whether or not the motion is granted.

If a party files a brief that exceeds the page limit, but does not file a timely motion for leave to file such a brief, the brief will be stricken in its entirety, without leave to file a substitute brief that meets the limit. [Note 5.]

A motion for leave to file a brief exceeding the page limit is evaluated on the basis of the reasonableness of the request in light of such factors as the number of additional pages sought, the novelty and/or complexity of the issues in the case, the extent of the trial record, and any other relevant facts or circumstances that may serve to demonstrate why additional pages are necessary. [Note 6.] *Cf.*TBMP § 541.02.

For information concerning the parts of a brief that fall within the page limit, see TBMP § 801.03.

For information concerning the page limits for briefs on motions, see TBMP § 502.02(b). The Board generally does not extend page limits for briefs on motions.

NOTES:

1. *See First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 77 USPQ2d 1334, 1336 n.4 (TTAB 2005), *rev'd on other grounds*,476 F.3d 867, 81 USPQ2d 1375 (Fed. Cir. 2007). *Cf. Fleming v. County of Kane*, 855 F.2d 496, 497 (7th Cir. 1988) (same concerns underlie appellate page limitations).

2. *See* 37 C.F.R. § 2.128(b). *See, e.g., Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1604 n.4 (TTAB 1999).

3. *See United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542, 1542 (TTAB 1994).

4. *See United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542, 1542-43 (TTAB 1994) (filing overlength brief with motion is potentially disadvantageous as movant may end up having to redo brief if motion is denied).

5. *See United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542, 1543 (TTAB 1994).

6. *See United Foods Inc. v. United Air Lines Inc.* , 33 USPQ2d 1542, 1543 (TTAB 1994), (30-page reply brief unnecessary where main brief was 18 pages and responsive brief was 37 pages); and *U.S. Navy v. United States Manufacturing Co.* , 2 USPQ2d 1254, 1255 (TTAB 1987) (due to size of record, parties allowed to file overlength briefs). *Cf.* 37 C.F.R. § 2.129(a).

538 Motion For Leave to File Amicus Brief

Amicus briefs are neither provided for nor prohibited in the rules governing practice in Board proceedings. Thus, the Board may, in its discretion, entertain an amicus brief if the Board finds that such a brief is warranted under the circumstances of a particular case. [Note 1.]

An entity that wishes to file an amicus brief should file a motion with the Board for leave to do so. The motion may be accompanied by the proposed brief. An amicus brief should be filed within the time allowed the party whose position the brief serves to support, unless all parties consent otherwise, or the Board, upon motion for good cause shown, permits a later filing. [Note 2.]

A motion for leave to file an amicus brief may not be used as a substitute for a timely notice of opposition or petition for cancellation.

Motions for leave to file an amicus brief are rarely filed in Board proceedings, and the granting thereof by the Board is even rarer. The Board will determine whether the proposed brief will aid the Board in resolving issues of law, whether the moving party is effectively seeking a role in the proceeding beyond arguing questions of law, and is effectively arguing factual matters, and whether any partisan arguments would prejudice a party to the proceeding. [Note 3.]

NOTES:

1. *See, e.g., Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1791 (TTAB 1998) (leave to file amicus brief denied as unnecessary to resolve issues which have been adequately addressed by parties); Federal Circuit Rule 29 (governing the filing of amicus briefs in appeals to the Court of Appeals for the Federal Circuit).

2. *Cf.* Federal Circuit Rule 29.

3. *See Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1791 (TTAB 1998) (motion denied where Board, noting "intimate" relationship between movants and petitioners, found that movants were seeking to introduce new evidence and advance partisan arguments).

539 Motion to Strike Brief On Case

The Trademark Rules of Practice specifically provide for the filing of briefs on the case, namely, the main brief of the party in the position of plaintiff, the answering brief of the party in the position of defendant, and the reply brief of the party in the position of plaintiff. [Note 1.] *See*TBMP § 801.02.

Subject to the provisions of Fed. R. Civ. P. 11, a party is entitled to offer in its brief on the case any argument it believes will be to its advantage. [Note 2.] Accordingly, when a brief on the case has been regularly filed, the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party that simply objects to the contents thereof. Rather, any objections that an adverse party may have to the contents of such a brief should be stated in a responsive brief, if allowed, and will be considered by the Board in its determination of the case, and any portions of the brief that are found by the Board to be improper will be disregarded.

However, if a brief on the case is not timely filed, or violates the length limit or other format requirements specified in 37 C.F.R. § 2.128(b), it may be stricken or given no consideration by the Board. [Note 3.] *See* TBMP § 537 and TBMP § 801.03. If a brief is stricken because of a format violation, the Board may, in its discretion, allow the offending party time to submit a substitute brief complying with the requirements of 37 C.F.R. § 2.128(b). *But see*TBMP § 537.

Because the rules do not provide for the filing of a surreply or rejoinder brief by a party in the position of defendant, any such brief will be stricken or given no consideration by the Board. [Note 4.]

Evidence may not be submitted with a brief, with the exception of a proper request for judicial notice. [Note 5.] Evidentiary material attached to a brief on the case can be given no consideration unless it was properly made of record during the testimony period of the offering party. If evidentiary material not of record is attached to a brief on the case, an adverse party may object thereto by motion to strike or otherwise. [Note 6.]

NOTES:

1. *See* 37 C.F.R. § 2.128(a).

2. *See Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071 (TTAB 2011) (motion to strike portions of plaintiff's trial brief denied; issues sought to be stricken are possible factors in considering likelihood of confusion and Board is capable of weighing relevance and strength or weakness of arguments presented in briefs).

3. 37 C.F.R. § 2.128(b). *See Ariola-Eurodisc Gesellschaft v. Eurotone International Ltd.*, 175 USPQ 250, 250 (TTAB 1972) (brief filed three weeks late stricken); *American Optical Corp. v. Atwood Oceanics, Inc.*, 177 USPQ 585, 586 (Comm'r 1973) (brief that was too long and not in proper form was not considered).

4. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1465 n.3 (TTAB 1993) (motion to strike portions of opposer's reply brief on the case given no consideration since motion was essentially attempt by applicant to file a surreply brief), *recon. denied*, 36 USPQ2d 1328 (TTAB 1994); *Fortunoff Silver Sales, Inc. v. Norman Press, Inc.*, 225 USPQ 863, 863 n.3 (TTAB 1985) (defendant's rejoinder brief stricken). *See also Hydrotechnic Corp. v. Hydrotech International, Inc.*, 196 USPQ 387, 389 n.2 (TTAB 1977); *L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254, 255 n.2 (TTAB 1975); *Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469, 471 n.4 (TTAB 1973).

5. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008).

6. *See, e.g., Lincoln National Corp. v. Anderson*, 110 USPQ2d 1271, 1274 n.5 (TTAB 2014) (evidence submitted for the first time with applicant's trial brief not considered); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1009 n.18 (TTAB 1984) (copy of decision by Canadian Opposition Board attached to brief given no consideration); *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 112 n.3 (TTAB 1978) (applicant's exhibits attached to its brief cannot be considered). *See also Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 391 n.10 (TTAB 1976) ("Evidence submitted by opposer for the first time with its brief has not been considered because it was not regularly made of record during its testimony period in chief or rebuttal testimony period."); *L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254, 255 (TTAB 1975) (same); *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588, 589 n.1 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429, 430 n.3 (TTAB 1973).

540 Motion For Augmented Panel Hearing

"The Trademark Trial and Appeal Board shall include the Director, Deputy Director of the United States Patent and Trademark Office, the Commissioner for Patents, the Commissioner for Trademarks, and administrative trademark judges who are appointed by the Director." [Note 1.] Each case before the Board is heard by a panel of at least three judges. [Note 2.] In addition, cases before the Board may be heard by panels including one or more of the above-noted senior executive officials of the USPTO. [Note 3.] Further, the Board may use an augmented panel to hear a case. [Note 4.] An augmented panel may include any number of Board judges exceeding three, that is, from four to the entire body of judges and one or more of the above-noted senior executive officials of the USPTO. [Note 5.]

A decision by the Board to use an augmented panel may be made either upon the Board's own initiative, or upon motion filed by a party to the proceeding. A motion requesting that a case be heard by an augmented

panel should be filed no later than the time for requesting an oral hearing on the case (i.e., no later than 10 days after the due date for the filing of the last reply brief in the proceeding- *see* 37 C.F.R. § 2.129(a)).

An augmented panel is used by the Board only in extraordinary cases, involving precedent-setting issues of exceptional importance, or when consideration by an augmented panel is necessary to secure or maintain uniformity of Board decisions. [Note 6.]

NOTES:

1. Trademark Act § 17(b), 15 U.S.C. § 1067(b).

2. *See, e.g.,* 37 C.F.R. § 2.129(a) and 37 C.F.R. § 2.142(e)(1). *See also* Trademark Act § 17, 15 U.S.C. § 1067.

3. 37 C.F.R. § 2.129(a)

4. *See, e.g., In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545, 1547 (Fed. Cir. 1994) (Section 7 grants Director the authority to designate the members of a panel and expanded panel including senior executive officials of the USPTO); *see also Board of Trustees of the University of Alabama v. Pitts*, 115 USPQ2d 1099 (TTAB 2015) (augmented panel assembled to decide request to re-open, vacate, and dismiss prior precedential decision); *In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 1215, 1220 (TTAB 2010) (augmented panel of five judges used in the disparagement case; two judges dissented); *Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1267 (TTAB 1995) (augmented panel of nine judges in announcing Board's policy with respect to cancellation premised on Trademark Act § 18, 15 U.S.C. § 1068); *In re Ferrero S.p.A.*, 22 USPQ2d 1800, 1800 (TTAB 1992) (augmented panel used to overrule previous Board 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) (oral hearing held before augmented panel of eight Board members "[i]n view of the issues presented by this case"); *In re McDonald's Corp.*, 230 USPQ 210, 212 n.5 (TTAB 1986) (augmented five-member panel used for rehearing in consolidated cases); *In re WSM, Inc.*, 225 USPQ 883 (TTAB 1985) (augmented panel used to delineate rights in FCC "assigned" call letters for radio broadcasting services).

5. For information concerning the constitution of USPTO Board panels, see *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545, 1547 (Fed. Cir. 1994) (Director has authority to constitute a new panel for purposes of reconsideration).

6. *See, e.g., Board of Trustees of the University of Alabama v. Pitts*, 115 USPQ2d 1099 (TTAB 2015); *In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010); *In re Active Ankle Systems, Inc.*, 83 USPQ2d 1532, 1534 (TTAB 2007); *Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266 (TTAB 1995); *In re Johanna Farms Inc.*, 8 USPQ2d 1408, 1409 (TTAB 1988); *In re McDonald's Corp.*, 230 USPQ 210, 212 n.5 (TTAB 1986); *In re WSM, Inc.*, 225 USPQ 883 (TTAB 1985). *See also* Federal Circuit Rule 35; and *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. Fioravanti v. Fioravanti Corrado S.R.L.*, 1 USPQ2d 1304, 1305 (TTAB 1986) (case not appropriate for designation of more than three-member panel) denying reconsideration of 230 USPQ 36 (TTAB 1986).

541 Motion to Change Oral Hearing Date; For Additional Time

541.01 Motion to Change Oral Hearing Date

If a party to a proceeding before the Board desires to present oral argument (i.e., oral hearing) at final hearing, including a case decided under Accelerated Case Resolution (ACR), *see*TBMP § 528.05(a)(2), the party must file a request therefor, by separate submission, not later than 10 days after the due date for the filing of the last reply brief in the proceeding. *See*TBMP § 802. 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 and times for the hearing within the foregoing parameters, and to provide that information to the Board with the request for oral hearing. When a request for an oral hearing is filed, 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 with the request. The response also should indicate whether either party will attend the oral hearing by video conference. The Board will then set the date and time for the hearing, and send each party written notice thereof. [Note 1.] Ordinarily, oral hearings are scheduled on Tuesdays, Wednesdays and Thursdays between 10:00 a.m. and 3:00 p.m. (Eastern Time).

The date or time of an oral hearing may be reset, so far as is convenient and proper, to meet the wishes of the parties and their attorneys or other authorized representatives if there is a reasonable basis for the request. When parties agree to the resetting of an oral hearing, they should determine a new date and time convenient to every party and then contact the Board's Hearings and Decisions Specialist by phone, well prior to the scheduled hearing date, to request that the hearing be reset for the new date and time. The parties should also file a written stipulation or consented motion confirming their agreement. If parties agree to the resetting of an oral hearing due to settlement negotiations, they should request that proceedings, including the time for oral hearing, be suspended pending completion of the negotiations. If agreement cannot be reached, the party that wishes to have the hearing reset should file a motion therefor. Absent compelling circumstances, a hearing date will not be changed if the request for rescheduling is made within two weeks of the scheduled hearing date unless both parties agree to the change. [Note 2.]

When one or more of the parties does not consent to the resetting of an oral hearing, the party that wishes to have the hearing reset must file a motion therefor, showing good cause. [Note 3.] *See*TBMP § 509. The motion should be filed well in advance of the scheduled hearing date. Further, to ensure that the motion is determined (by telephone conference call, if necessary) prior to the scheduled hearing date, the moving party should file its motion through ESTTA, and telephone the Board’s Hearings and Decisions Specialist. *See*TBMP § 502.06(a). An unconsented motion to reset an oral hearing should not be filed merely because another date would be more convenient. The process of scheduling an oral hearing is a time-consuming task for the Board. Because of the inherent difficulties in arranging a date for an oral hearing, an unconsented motion to reset the hearing should be filed only for the most compelling reasons. Examples thereof include the onset of serious illness, nonelective surgery, death of a family member and similar unanticipated or unavoidable events. [Note 4.]

The Board may deny a request to reset a hearing date for lack of good cause or if multiple requests, including stipulations and consented requests, for rescheduling have been filed. [Note 5.]

For further information concerning oral hearings, see TBMP § 802.

NOTES:

1. *See* 37 C.F.R. § 2.129(a).

2. *See* 37 C.F.R. § 2.129(b).

3. *See* Fed. R. Civ. P. 6(b).

4. *See, e.g., In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1214 n.2 (TTAB 2000) (applicant's request to reschedule oral hearing three hours before hearing due to "a sudden conflict of time" denied).

5. 37 C.F.R. § 2.129(b).

541.02 Motion For Additional Time For Oral Argument

Ordinarily, each party in a Board inter partes proceeding is allowed 30 minutes for its oral arguments. If it so desires, the plaintiff may reserve part of its 30 minutes for rebuttal. [Note 1.] *See*TBMP § 802.05. If, because of the novelty or complexity of the issues, the extent of the record, the presence of a counterclaim involving different issues than those involved in the original proceeding, etc., a party feels that it needs more than 30 minutes for oral argument, it may file a request with the Board for additional time. [Note 2.] Parties will note, however, that such motions are disfavored.

If the request is granted, each party will be allowed the same amount of time for oral argument. In addition, the panel hearing the oral argument may, during the course thereof, sua sponte extend the parties' time to present their arguments.

Ideally, a request for additional time should be included with the request for oral hearing. If a party determines after that time that it needs additional time for oral argument, the party should immediately call the Board and notify the Board that it intends to file a request for additional time. This early notification is necessary to ensure that there will be time in the Board's hearing schedule for an extended oral hearing, and also to ensure that the request will be considered and determined prior to the date of the oral hearing. *Cf.*TBMP § 541.01.

NOTES:

1. *See* 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, 1225 (TTAB 1987) (additional time for arguments allowed in view of voluminous record). *Cf.* 37 C.F.R. § 2.128(b).

542 Motion For Leave to Record Oral Hearing

Upon prior arrangement, the Board will usually permit a party to make an audio recording of an oral hearing. A court reporter is distracting and disruptive in the context of an oral hearing before the Board, and therefore may not be used. For the same reason, an oral hearing before the Board may not be videotaped or otherwise electronically recorded. Any motion for leave to videotape an oral hearing will be denied.

Such a recording is strictly for the party's private use, and is not to be used for purposes of publicity, or as "evidence" in any proceeding (the oral hearing is not part of the evidentiary record in a proceeding before the Board).

Leave to make an audio recording of an oral hearing is secured by filing a motion therefor showing good cause (such as, that the audio recording is desired by the requesting attorney, or the requesting attorney's firm, for personal use in evaluating the performance of the attorney as an advocate). The motion should be filed well in advance of the date set for the oral hearing, so that if an adverse party raises any objections, the Board will have time to rule upon the motion prior to the oral hearing.

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

In addition, parties seeking to remotely attend an oral hearing by means of one of the Board's hearing facilities that is capable of remote, electronic, attendance by a party or Board judge must contact by telephone the Board's Hearings and Decisions Specialist in order to schedule such attendance.

543 Motion For Reconsideration of Final Decision

37 C.F.R. § 2.129(c) *Any request for rehearing or reconsideration or modification of a decision issued after final hearing must be filed within one month from the date of the decision. A brief in response must be filed within 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.*

The filing of a request for rehearing, reconsideration, or modification of a decision issued after final hearing is governed by 37 C.F.R. § 2.129(c). [Note 1.] *See*TBMP § 518.

There is no requirement that an adverse party file a brief in response to a request for rehearing, reconsideration, or modification of a decision issued after final hearing. However, it is the better practice to do so. [Note 2.] If a responsive brief is filed, it must be filed within 20 days from the date of service of the request.

Although 37 C.F.R. § 2.129(c) makes no provision for the filing of a reply brief on a request for rehearing, reconsideration, or modification of a decision issued after final hearing, the Board may, in its discretion, consider such a brief. If a reply brief is filed, it must be filed within 20 days from the date of service of the responsive brief. [Note 3.]

Generally, the premise underlying a request for rehearing, reconsideration, or modification under 37 C.F.R. § 2.129(c) is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. The request may not be used to introduce additional evidence [Note 4.], nor should it be devoted simply to a reargument of the points presented in the requesting party's brief on the case. Rather, the request normally should be limited to a demonstration that, based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate change. [Note 5.]

If a request for rehearing, reconsideration, or modification of a decision after final hearing is timely filed, the time for filing an appeal, or for commencing a civil action for review of the Board's decision, will expire sixty-three (63) days after action on the request. [Note 6.] *See*TBMP § 902.02 and TBMP § 903.04.

A second or subsequent request for reconsideration is not permitted, and if filed, does not toll the time for filing an appeal of the final decision or commencing a civil action.

NOTES:

1. *Cf.* 37 C.F.R. § 2.127(b).

2. *See Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 201 USPQ 410, 411 (TTAB 1979) (serious questions raised by applicant's request for reconsideration ought to have generated response by opposer).

3. *See, e.g., Kappa Books Inc. v. Herbko International Inc.* , 60 USPQ2d 1765, 1766 n.2 (TTAB 2001) ("While there is no provision in the Trademark Rules of Practice for the submission of a reply brief in connection with a request for reconsideration (see Trademark Rule 2.127(b)), we have exercised our discretion and considered the reply brief in this case."), *rev'd on other grounds,* 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002); *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.* , 185 USPQ 61, *recon. denied* , 185 USPQ 176, 177 n.2 (TTAB 1975) (reply brief considered only to the extent it addressed arguments in responsive brief), *aff'd,* 530 F.2d 1396, 189 USPQ 138 (CCPA 1976). *See also* 37 C.F.R. § 2.127(a).

4. *See Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126, 127-28 (TTAB 1978) (motion for reconsideration requesting introduction of survey evidence available during movant's testimony period denied).

5. For examples of cases in which a request for reconsideration of a decision after final hearing has been granted, see *Steiger Tractor Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *reh'g granted,* 3 USPQ2d 1708, 1710 (TTAB 1984); *Cf. In re Kroger Co.*, 177 USPQ 715, 717 (TTAB 1973). *Cf. Conwood Corp. v. Loew's Theatres, Inc.*, 173 USPQ 829, 830 (TTAB 1972) (denying petition to reconsider).

6. *See* 37 C.F.R. § 2.145(d)(1).

544 Motion For Relief From Final Judgment

Fed. R. Civ. P. 60(b) Grounds for Relief from a Final Judgment, Order, or Proceeding.

On motion and just terms, the court may relieve a party or its legal representative from a final judgment, order, or proceeding for the following reasons:

(1) *mistake, inadvertence, surprise, or excusable neglect;*

(2) *newly discovered evidence that, with reasonable diligence, could not have been discovered in time to move for a new trial under Rule 59(b);*

(3) *fraud (whether previously called intrinsic or extrinsic), misrepresentation, or misconduct by an opposing party;*

(4) *the judgment is void;*

(5) *the judgment has been satisfied, released, or discharged; it is based on an earlier judgment that has been reversed or vacated; or applying it prospectively is no longer equitable; or*

(6) *any other reason that justifies relief.*

Fed. R. Civ. P. 60(c)(1) Timing. *A motion under Rule 60(b) must be made within a reasonable time — and for reasons (1), (2), and (3) no more than a year after the entry of the judgment or order or the date of the proceeding.*

Fed. R. Civ. P. 6(b)(2) Extending Time; Exceptions *A court must not extend the time to act under Rules 50(b)* and *(d), 52(b), 59(b), (d), and (e), and 60(b).*

Motions to set aside or vacate a final judgment rendered by the Board are governed by Fed. R. Civ. P. 60(b). [Note 1.] Thus, upon such terms as are just, the Board, on motion, may relieve a party from a final judgment for one of the reasons specified in Fed. R. Civ. P. 60(b).

Fed. R. Civ. P. 60(b), as made applicable by 37 C.F.R. § 2.116(a), applies to all final judgments issued by the Board, including default and consent judgments, grants of summary judgments, and judgments entered after trial on the merits. As a practical matter, motions to vacate or set aside a final Board judgment are usually based upon the reasons set forth in subsections (1), (2) and/or (6) of Fed. R. Civ. P. 60(b).

For examples of cases involving a motion for a relief from a final judgment of the Board, see cases cited in the note below. [Note 2.]

A motion for relief from judgment must be made within a reasonable time; and if the motion is based on reasons (1), (2), and/or (3), it must be filed not more than one year after the judgment was entered – the time will not be extended. [Note 3.] The filing of the motion will not affect the finality of the judgment or suspend its operation. [Note 4.]

Relief from a final judgment is an extraordinary remedy to be granted only in exceptional circumstances or when other equitable considerations exist. [Note 5.] The determination of whether a motion under Fed. R. Civ. P. 60(b) should be granted is a matter that lies within the sound discretion of the Board. [Note 6.]

Where a motion for relief from judgment is made without the consent of the adverse party or parties, it must persuasively show (preferably by affidavits, declarations, documentary evidence, etc., as may be appropriate) that the relief requested is warranted for one or more of the reasons specified in Fed. R. Civ. P. 60(b).

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) and Fed. R. Civ. P. 60(b) seeking relief from such a judgment is generally treated with more liberality by the Board than are motions under Fed. R. Civ. P. 60(b) for relief from other types of judgments. [Note 7.] *See*TBMP § 312.03. 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 8.] *See*TBMP § 312.03.

If, in a cancellation proceeding, a petition to the Director is filed concurrently with a Fed. R. Civ. P. 60(b) motion to the Board for relief from judgment, and the petition and motion seek the same relief and require review of the same set of facts, the Board will rule first upon the motion for relief from judgment. [Note 9.] If the Board grants the motion, the Director, as a ministerial act, will reinstate the subject registration. [Note 10.]

Where the parties are agreed that the circumstances warrant the vacating or setting aside of a final judgment, a stipulation or consented motion for relief from the judgment should be filed. The stipulation or consented motion should set forth in detail the reasons why the parties believe that the vacatur or setting aside of a judgment is warranted under one or more of the subsections of Fed. R. Civ. P. 60(b) or under the Board's general equitable authority. [Note 11.] The Board does not automatically approve such stipulations or consented motions, but independently determines whether vacatur is warranted. *See*TBMP §501.01 (stipulations subject to Board approval). **Please Note:** That the parties have agreed to vacatur does not, by itself, warrant vacatur of a Board decision on the substantive merits of a dispute under the Board's general equitable authority. [Note 12.] Where, however, the parties stipulate or agree that the judgment was entered by mistake or is unwarranted in light of newly-discovered evidence, the requested vacatur may be supportable under Fed. R. Civ. P. 60(b)(1) or 60(b)(2).

Occasionally, a party files a Fed. R. Civ. P. 60(b) motion with the Board contemporaneously with, or during the pendency of an appeal. The Board has jurisdiction to entertain the motion. If the Board determines that the motion is to be denied, it will enter the order denying the motion. Any appeal of the denial may be consolidated with the appeal of the underlying order. If the Board is inclined to grant the Fed. R. Civ. P. 60(b) motion, it will issue a short memorandum so stating. The movant can then request a limited remand from the appellate court for that purpose. [Note 13.]

NOTES:

1. *See* 37 C.F.R. § 2.116(a); *see also Board of Trustees of the University of Alabama v. Pitts*, 115 USPQ2d 1099, 1102-03 (TTAB 2015) (motions for relief from judgment normally made under Fed. R. Civ. P. 60(b)).

2. *See 3PMC, LLC v. Huggins*, 115 USPQ2d 1488 (TTAB 2015) (following remand, granting relief from judgment by affirming Board's holding in *In re First Nat'l Bank of Boston*, 199 USPQ 296 (TTAB 1978) which held that the Board will not take cognizance of fractions of a day and will assume that an opposition and express abandonment, filed on the same day, were filed at the same instant, and therefore, concluding that application was not subject to an opposition when abandoned); *Rolex Watch USA Inc. v. AFP Imaging Corp.*, 107 USPQ2d 1626 (TTAB 2013) (after remand, granting relief from judgment, under *United States Bancorp Mortgage Co. v. Bonner Mall Partnership*, 513 U.S. 18 (1994)); *Pramil S.R.L. v. Michael Farah*, 93 USPQ2d 1093, 1095 (TTAB 2009) (Fed. R. Civ. P. 60(b)(2) motion denied because registration not yet in existence at time of Board's decision was not "newly discovered evidence;" motion not brought within reasonable time; and evidence relied upon merely cumulative or not of a type that would change the result); *Kraft Foods, Inc. v. Desnoes & Geddes Ltd.*, 64 USPQ2d 1154 (TTAB 2002) (motion for relief from judgment under Fed. R. Civ. P. 60(b)(4), Fed. R. Civ. P. 60(b)(5) and Fed. R. Civ. P. 60(b)(6) denied); *CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1302 (TTAB 1999) (Fed. R. Civ. P. 60(b)(1) motion denied; counsel and client share duty "to remain diligent in prosecuting or defending the client's case") (finding that *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992) is no longer good law in light of the Supreme Court's decision in *Pioneer Investment Services Co. v. Brunswick Associates. Ltd. Partnership*, 507 U.S. 380, 396-97 (1993)); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1296 (TTAB 1997) (Fed. R. Civ. P. 60(b)(1) motion granted; petitioner contributed to respondent's delay and confusion); *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952-54 (TTAB 1997) (Fed. R. Civ. P. 60(b)(4) and Fed. R. Civ. P. 60(b)(6) motion, based on alleged failure to receive correspondence from Board, denied, given presumption of receipt of correspondence, passage of 12 years, and resulting hardship to third parties); *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894, 1896 (TTAB 1992) (Fed. R. Civ. P. 60(b)(6) motion granted; petition withdrawn based on apparent acceptance by examining attorney of settlement agreement obviating basis for refusal of petitioner's applications); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991) (Fed. R. Civ. P. 60(b)(1) motion granted; respondent's failure to answer resulted from mistake due to involvement in numerous Board proceedings); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) (Fed. R. Civ. P. 60(b)(1) motion granted; respondent's employees had limited knowledge of English and were unaware cancellation and opposition were separate proceedings). *Cf. In re Sotheby's Inc.*, 18 USPQ2d 1969 (Comm'r 1989) (denying petition to file a late response to Office action withholding decision on §§ 8 & 15 declaration where declarant was not registrant of record despite argument that attorney never so informed registrant).

3. *See* Fed. R. Civ. P. 60(b); Fed. R. Civ. P. 6(b)(2); *Pramil S.R.L. v. Michael Farah*, 93 USPQ2d 1093, 1094-96 (TTAB 2009) (Fed. R. Civ. P. 60(b)(2) motion based on registration that issued after cancellation was ordered was denied because the evidence was not new, because motion was not filed until 6 months after new registration issued); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991) (Fed. R. Civ. P. 60(b)(1) based on excusable neglect was timely when filed only 15 days after entry of default judgment);

Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc., 200 USPQ 819, 822 (TTAB 1978) (Fed. R. Civ. P. 60(b)) motion denied as untimely where judgment was entered under 37 C.F.R. § 2.135 and applicant was mistaken as to consent to abandonment by opposer but delayed over a year to file motion).

4. *See* Fed. R. Civ. P. 60(c).

5. *See Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991).

6. *See Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991); *see also Board of Trustees of University of Alabama v. Pitts*, 115 USPQ2d 1099, 1104 (TTAB 2015) (where opposer did not invoke Fed. R. Civ. P. 60(b), opposer's request for vacatur was assessed under the Board's "general equitable authority" because vacatur is an equitable remedy) (citing *U.S. Bancorp Mortg. Co. v. Bonner Mall Partnership*, 513 U.S. 18, 26-27 (1994)) (further citations omitted).

7. *See Information Sys. 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)).

8. *See Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991) (Fed. R. Civ. P. 60(b)(1) motion granted pending showing of meritorious defense where other two elements were established); and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1155-56 (TTAB 1991) (Fed. R. Civ. P. 60(b)(1) motion granted; excusable neglect shown where respondent's employees had limited knowledge of English and were unaware opposition and cancellation were separate proceedings, potential defense was meritorious, and no substantial prejudice to opposing party). *Compare Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952-54 (TTAB 1997) (Fed. R. Civ. P. 60(b)(6) motion denied as untimely when filed 12 years after cancellation; (Fed. R. Civ. P. 60(b)(4) motion denied because judgment was not void).

9. *See National Telefilm Associates, Inc. v. Craig Denney Productions*, 228 USPQ 61, 61-62 (Comm'r 1985).

10. *See National Telefilm Associates, Inc. v. Craig Denney Productions*, 228 USPQ 61, 62 (Comm'r 1985).

11. *See Board of Trustees of University of Alabama v. Pitts*, 115 USPQ2d 1099, 1102-04 (TTAB 2015) (denying an opposer's unopposed request for vacatur pursuant to an agreement settling opposer's district court case, under 15 U.S.C. § 1071(b), challenging the Board's dismissal of opposition, where opposer's request did not rest upon any provisions of Fed. R. Civ. P. 60(b), nor had opposer demonstrated exceptional circumstances or any other equitable considerations warranting the use of the Board's general equitable authority to issue vacatur orders). *Cf. Ballet Tech Found. Inc. v. The Joyce Theater Found. Inc.*, 89 USPQ2d 1262 (TTAB 2008) (consolidated Opposition No. 91180789 and Cancellation No. 92042019) (not a precedent), final judgment vacated as moot upon settlement on appeal, *Ballet Tech Found. Inc. v. The Joyce Theater Found. Inc.*, (TTAB November 14, 2013) (vacatur was necessary to prevent cancellation of Respondent's registrations and allow its application for registration to go forward.).

12. *Cf. U.S. Bancorp Mortg. Co. v. Bonner Mall Partnership*, 513 U.S. 18, 29 (1994) (under 28 U.S.C. § 2106, "mootness by reason of settlement does not justify vacatur of a judgment under review" in the absence of "exceptional circumstances") (cited in *Board of Trustees of University of Alabama v. Pitts*, 115 USPQ2d 1099, 1102 (TTAB 2015)). The Board also applies its equitable discretion to party-agreed vacaturs entered in the form of signed consent judgments in civil actions contesting Board decisions. The Board generally will give effect to such vacaturs only if they reflect the court's resolution of the dispute on the merits. But

the Board generally will not give effect to party-agreed vacaturs in consent judgments that reflect only the parties' agreement to settle the dispute. Compare *United States v. City of Detroit*, 329 F.3d 515, 523-24 (6th Cir. 2003) (en banc) (agreed vacatur of decision of lower tribunal was appropriate because it reflected parties' agreement on a critical fact upon which liability turned) with *Ass'n for Retarded Citizens of Conn., Inc. v. Thorne*, 30 F.3d 367, 370 (2d Cir. 1994) (where agreed vacatur in consent judgment reflected only parties' agreement to settle and did not reflect an agreed adjudication on the merits, the vacatur bound only the parties themselves). *See also* 15 U.S.C. § 1071(b)(1) (empowering district courts to review Board decisions by "adjudg[ing]" certain matters); 5 U.S.C. § 706 (requirement for any court review of an agency decision is that the reviewing court "shall review the whole record or those parts of it cited by a party"). The Federal Circuit, the Board's primary reviewing court, generally does not enter consented orders requiring the Board to vacate the decision on review, but instead usually remands the case back to the Board for initial determination of whether vacatur is appropriate. *See In re Carmine's Broadway Feast Inc.*, 423 F. App'x 981 (Fed. Cir. 2011) (citing *U.S. Bancorp*, 513 U.S. at 29); *MidAmerican Energy Co. v. Mid-America Energy Resources, Inc.*, 250 F.3d 754 (Fed. Cir. 2000) (table), (citing *U.S. Bancorp*, 513 U.S. at 29).

13. *See Home Products International v. U.S.*, 633 F.3d 1369, 1378 n.9 (Fed. Cir. 2011); *Pramil S.R.L. v. Farah*, 93 USPQ2d 1093, 1095 (TTAB 2009).

Chapter 600 WITHDRAWAL; SETTLEMENT

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601 Withdrawal by Opposition or Cancellation Plaintiff

601.01 Withdrawal by Opposer

37 C.F.R. § 2.106(c) *The opposition may be withdrawn without prejudice before the answer is filed. After the answer is filed, the opposition may not be withdrawn without prejudice except with the written consent of the applicant or the applicant's attorney or other authorized representative.*

An opposer may withdraw its opposition without prejudice at any time before the applicant's answer is filed. After the answer is filed, however, the opposition may not be withdrawn without prejudice except with the written consent of the applicant or the applicant's attorney or other authorized representative. [Note 1.]

For information concerning the effect of a judgment entered against plaintiff for withdrawal after answer without consent, see note below. [Note 2.]

An opposer may withdraw its opposition by electronically filing with the Board a written withdrawal signed by the opposer or the opposer's attorney. Written consent must be signed with and submitted as a copy of an original, handwritten signature, or a complying electronic signature. [Note 3.] The withdrawal should include proof of service upon every other party to the proceeding. [Note 4.] For more information regarding service of papers, see TBMP § 113.

NOTES:

1. 37 C.F.R. § 2.106(c). *See Estee Lauder Inc. v. Aloe Creme Laboratories, Inc.* , 178 USPQ 254, 256 (TTAB 1973) (opposition dismissed with prejudice where applicant's statement that favorable decision in civil action renders issues in opposition moot cannot be construed as consent to opposer's withdrawal). *Cf.* 37 C.F.R. § 2.114(c) (withdrawal of petition for cancellation); *Johnson & Johnson v. Bio-Medical Sciences,*

Inc., 179 USPQ 765, 766 (TTAB 1973) (although there was no indication that the dismissal of the counterclaims in a previous opposition was "with prejudice," because the record showed that the counterclaims were withdrawn after answer and without consent, it was clear that dismissal was with prejudice and that therefore plaintiff was estopped from attempting to assert same counterclaim in subsequent petition to cancel).

2. *See Orouba Agrifoods Processing Co. v. United Food Import*, 97 USPQ2d 1310, 1313-15 (TTAB 2010) (dismissal of opposition for failure to file brief and take testimony operates as res judicata in cancellation against the now-registered mark where the cancellation claims are based on the same transactional facts as those asserted in the opposition); *Johnson & Johnson v. Bio-Medical Sciences, Inc.*, 179 USPQ 765, 766 (TTAB 1973) (dismissal of previous counterclaims with prejudice operated as estoppel barring same counterclaims in subsequent proceeding). *Cf. Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 678 (TTAB 1986) (judgment in first opposition, as result of abandonment of application without consent, operates as claim preclusion in subsequent opposition so as to bar applicant's subsequent application for an insignificantly modified mark); *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984) (abandonment of application without consent in previous opposition does not operate as collateral estoppel or claim preclusion in subsequent cancellation proceeding between same parties since the two cases involve two distinct marks, and does not operate as issue preclusion because no issues were actually litigated in prior opposition); *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*, 200 USPQ 819, 822 (TTAB 1978) (judgment against applicant in prior opposition due to abandonment of application without consent operated as collateral estoppel in subsequent opposition involving same marks and same parties in opposite positions); *In re Communications Technology Corp.*, 182 USPQ 695, 696 (TTAB 1974) (judgment against applicant in prior opposition between applicant and owner of cited registration is not conclusive of likelihood of confusion and does not operate as estoppel in subsequent application for a distinctly different mark).

3. 37 C.F.R. § 2.193(c)(1).

4. 37 C.F.R. § 2.119(a).

601.02 Withdrawal by Petitioner or Counterclaimant

37 C.F.R. § 2.114(c) *The petition for cancellation or counterclaim petition for cancellation may be withdrawn without prejudice before the answer is filed. After the answer is filed, such petition or counterclaim petition may not be withdrawn without prejudice except with the written consent of the registrant or the registrant's attorney or other authorized representative*.

A petitioner or counterclaimant may withdraw its petition for cancellation or counterclaim without prejudice at any time before the registrant's answer is filed. After the answer is filed, however, the petition for cancellation or counterclaim may not be withdrawn without prejudice except with the written consent of the registrant or the registrant's attorney or other authorized representative. [Note 1.]

For information concerning the effect of a judgment entered against plaintiff for withdrawal after answer without consent, see note below. [Note 2.]

A petitioner or counterclaimant may withdraw its petition for cancellation by electronically filing with the Board a written withdrawal signed by the petitioner or counterclaimant or the petitioner's or counterclaimant's attorney. Written consent must be in the form of a copy of an original, handwritten signature, or a complying

electronic signature. [Note 3.] The withdrawal should include proof of service upon every other party to the proceeding. [Note 4.] For more information regarding service of papers, see TBMP § 113.

NOTES:

1. 37 C.F.R. § 2.114(c); *Johnson & Johnson v. Bio-Medical Sciences, Inc.* , 179 USPQ 765, 766 (TTAB 1973). *Cf.* 37 C.F.R. § 2.106(c) (Withdrawal of Notice of Opposition); *Estee Lauder Inc. v. Aloe Creme Laboratories, Inc.*, 178 USPQ 254, 256 (TTAB 1973).

2. *See Orouba Agrifoods Processing Co. v. United Food Import*, 97 USPQ2d 1310, 1313-15 (TTAB 2010) (dismissal of opposition for failure to file brief and take testimony operates as res judicata in cancellation against the now-registered mark where the cancellation claims are based on the same transactional facts as those asserted in the opposition); *Johnson & Johnson v. Bio-Medical Sciences, Inc.*, 179 USPQ 765, 766 (TTAB 1973) (dismissal of previous counterclaims with prejudice operated as estoppel barring same counterclaims in subsequent proceeding).

Cf. Sunrise Jewelry Manufacturing Corp. v. Fred S.A., 175 F.3d 1322, 50 USPQ2d 1532, 1536 (Fed. Cir. 1999) (filing of withdrawal of petition sufficient to consider that no proceeding is "pending" and that proceeding was "disposed of" for purposes of filing Section 15 declaration of incontestability); *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 678 (TTAB 1986) (judgment in first opposition, as result of abandonment of application without consent, operates as claim preclusion in subsequent opposition so as to bar applicant's subsequent application for an insignificantly modified mark); *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984) (abandonment of application without consent in previous opposition does not operate as collateral estoppel or claim preclusion in subsequent cancellation proceeding between same parties since the two cases involve two distinct marks, and does not operate as issue preclusion because no issues were actually litigated in prior opposition); *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*, 200 USPQ 819, 822 (TTAB 1978) (judgment against applicant in prior opposition due to abandonment of application without consent operated as collateral estoppel in subsequent opposition involving same marks and same parties in opposite positions); *In re Communications Technology Corp.*, 182 USPQ 695, 696 (TTAB 1974) (judgment against applicant in prior opposition between applicant and owner of cited registration is not conclusive of likelihood of confusion and does not operate as estoppel in subsequent application for a distinctly different mark).

3. 37 C.F.R. § 2.193(c)(1).

4. *See* 37 C.F.R. § 2.119(a).

601.03 Effect of Motion for Judgment

A plaintiff in an opposition or cancellation proceeding or counterclaimant may unilaterally withdraw its complaint without prejudice, even in the face of a defendant's adverse motion such as a motion to dismiss, motion for summary judgment, or motion for a more definite statement, provided that the withdrawal is filed prior to defendant's answer to the complaint. When a plaintiff or counterclaimant unilaterally withdraws its complaint prior to answer, in the face of a defendant's pending motion for judgment, the proceeding will be dismissed without prejudice (unless plaintiff or counterclaimant specifies that it is withdrawing with prejudice), and the pending motion will be declared moot.

602 Withdrawal by Opposition or Cancellation Defendant

602.01 Withdrawal by Applicant

37 C.F.R. § 2.68 ***Express abandonment (withdrawal) of application.***

(a) ***Written document required.*** *An applicant may expressly abandon an application by filing a written request for abandonment or withdrawal of the application, signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2). A request for abandonment or withdrawal may not subsequently be withdrawn.*

(b) ***Rights in the mark not affected.*** *Except as provided in § 2.135, the fact that an application has been expressly abandoned shall not affect any rights that the applicant may have in the mark in the abandoned application in any proceeding in the Office.*

37 C.F.R. § 2.135 ***Abandonment of application or mark.*** *After the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of the application or of the mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.*

37 C.F.R. § 7.30 ***Effect of cancellation or expiration of international registration.*** *When the International Bureau notifies the Office of the cancellation or expiration of an international registration, in whole or in part, the Office shall cancel, in whole or in part, the corresponding pending or registered extension of protection to the United States. The date of cancellation of an extension of protection or relevant part shall be the date of cancellation or expiration of the corresponding international registration or relevant part.*

There are five filing bases for an application: (1) use of a mark in commerce under Trademark Act § 1(a), 15 U.S.C. § 1051(a); (2) bona fide intention to use a mark in commerce under Trademark Act § 1(b), 15 U.S.C. § 1051(b); (3) a claim of priority based on an earlier-filed foreign application under Trademark Act § 44(d), 15 U.S.C. § 1126(d); (4) ownership of a registration of the mark in the applicant's country of origin under Trademark Act § 44(e), 15 U.S.C. § 1126(e); and (5) extension of protection of an international registration to the United States under Trademark Act § 66(a), 15 U.S.C. § 1141f(a).

An application for an extension of protection of an international registration to the United States is referred to as a "§ 66(a) application." Unlike applications under Trademark Act §§ 1 and 44, there can only be one basis for a § 66(a) application and that basis cannot be changed. [Note 1.]

An applicant may expressly abandon its application by filing with the Office a written statement of abandonment or withdrawal of the application, signed by the applicant or the applicant's attorney or other authorized representative. A request for abandonment or withdrawal may not subsequently be withdrawn. [Note 2.]

However, after the commencement of an opposition proceeding, if the applicant files a written abandonment of its subject application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. [Note 3.] The written consent of an adverse party may be signed by the adverse party itself, or by the adverse party's attorney or other authorized representative. [Note 4.] The written consent of the adverse party must be signed and submitted electronically as a copy of an original, handwritten signature, or a complying electronic signature. [Note 5.]

For information concerning the effect of a 37 C.F.R. § 2.135 (abandonment of application or mark) judgment against applicant, see cases cited in the note below. [Note 6.]

In an opposition to an application having multiple classes, if the applicant files a request to amend the application to delete an opposed class in its entirety, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by 37 C.F.R. § 2.135.

Occasionally, an application may be the subject of more than one opposition brought by unrelated opposers. If an applicant files an abandonment in one opposition, with or without the written consent of the opposer to that opposition, the applicant is usually allowed time to inform the Board whether the abandonment is with or without the consent of the remaining opposers. If the abandonment is with consent in any of the remaining oppositions, the applicant must submit the written consent of any of the remaining opposers who have consented so that judgment is not entered against applicant. Judgment will be entered against the applicant in the remaining oppositions for which the written consent of the opposer is not submitted. [Note 7.]

An abandonment of an opposed application should be electronically filed with the Board, and should bear at the top of its first page both the application serial number, and the opposition number and title. Applicants must use ESTTA for filing an abandonment of an opposed application. [Note 8.] For further information regarding ESTTA, see TBMP § 110. Use of the TEAS system is not appropriate for filing an abandonment of an opposed application.

The abandonment should include proof of service upon every other party to the proceeding. [Note 9.] *See* TBMP § 113. If an applicant files an unconsented abandonment after the commencement of an opposition, but before applicant has been notified of the opposition by the Board, applicant will be allowed an opportunity to obtain and submit the written consent of every adverse party, or to withdraw the abandonment and defend against the opposition, failing which judgment will be entered against applicant. [Note 10.] *Cf.* TBMP § 218. If an opposition and an unconsented abandonment of the opposed application are filed on the same day, 37 C.F.R. § 2.135, does not apply and therefore the abandonment (unless specifically made with prejudice) is without prejudice to applicant; no proceeding will be instituted; and any submitted opposition fee will be refunded. [Note 11.] *Cf.*TBMP § 218.

Abandonment prior to publication. In the rare instance that an opposition is permitted to be filed on paper, if, after the opposition is filed, it comes to the attention of the Board that the opposed application was abandoned prior to its publication for opposition, the Board will advise the parties that the application is not subject to opposition unless applicant files a petition to the Director under 37 C.F.R. § 2.66 or 37 C.F.R. § 2.146, as appropriate, and the petition is granted. If a prior abandonment comes to the attention of the Board at a time reasonably contemporaneous with the filing of the opposition, and the application is not revived, the opposition will not be instituted, and any submitted opposition fee will be refunded. If the prior abandonment comes to the attention of the Board at a later stage in the opposition, and the application is not revived, the opposition will be dismissed without prejudice. [Note 12.] These circumstances will not occur when an opposition is filed electronically through ESTTA, as required, because ESTTA will not institute an opposition against an application that has been abandoned prior to publication in the Official Gazette.

Abandonment for failure to respond to office action after remand. If, during the pendency of an opposition, the Board grants a request by the examining attorney for remand of a Trademark Act §§ 1 or 44 application under 37 C.F.R. § 2.130, and the application thereafter becomes abandoned by operation of law for failure of the applicant to respond to an Office action issued by the examining attorney, or because a final refusal to register is affirmed on appeal, judgment under 37 C.F.R. § 2.135 will not be entered against

applicant in the opposition. *See* TBMP § 515 (Motion to Remand Application to Examining Attorney). However, opposer will be given time to decide whether it wishes to go forward to obtain a determination of the opposition on its merits, or to have the opposition dismissed without prejudice as moot. [Note 13.] *Cf.* TBMP § 602.02(b). 37 C.F.R. § 2.135 comes into play only when there is a written abandonment by the applicant. If, after remand under 37 C.F.R. § 2.130, applicant files a written abandonment of its application without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant pursuant to 37 C.F.R. § 2.135. A Trademark Act § 66(a) application may not be remanded under 37 C.F.R. § 2.130. [Note 14.]

Abandonment of Trademark Act § 66(a) application as the result of cancellation of the underlying international registration by the International Bureau. If an international registration is cancelled, in whole or in part, by the International Bureau (IB) for any reason, the IB will notify the USPTO and the USPTO will abandon the corresponding § 66(a) application, in whole or in part, as appropriate. [Note 15.] When a partial cancellation of the international registration occurs, the IB notifies the USPTO of a "restriction of the request for extension of protection." When a total cancellation occurs, the IB notifies the USPTO of "the death of the international registration." In the case of a § 66(a) application that is the subject of an opposition, if the USPTO is notified of a partial cancellation of the international registration, and such partial cancellation affects the opposed classes, if judgment under 37 C.F.R. § 2.135 is not entered against applicant, opposer will be given time to decide whether it wishes to go forward to obtain a determination of the opposition on its merits, or to have the opposition dismissed without prejudice as moot. If a § 66(a) application that is the subject of an opposition is abandoned by the Office as the result of total cancellation of the underlying international registration or renunciation of the protection sought in the United States, and if judgment under 37 C.F.R. § 2.135 is not entered against applicant, opposer will be given time to decide whether it wishes to go forward to obtain a determination of the opposition on its merits, or to have the opposition dismissed without prejudice as moot. [Note 16.]

Other exemplary situations involving applicant's abandonment of its application. If an applicant whose application is the subject of an opposition files an abandonment of the application with the written consent of the opposer, the opposition will be dismissed without prejudice, and the application will stand abandoned.

If the applicant files an abandonment of the application with the written consent of the opposer, and the opposer files a withdrawal of the opposition, the opposition will be dismissed without prejudice, and the application will stand abandoned.

If the applicant files an abandonment of the application with prejudice with the written consent of the opposer, the opposition will be dismissed without prejudice (and the application will stand abandoned with prejudice to applicant's right to re-register the same mark for the same goods or services), unless the parties specify otherwise in writing. [Note 17.]

If the applicant files an abandonment of the application with prejudice with the written consent of the opposer, and the opposer files a withdrawal of the opposition with prejudice with the written consent of the applicant, the opposition will be dismissed with prejudice, and the application will stand abandoned with prejudice to applicant's right to reregister the same mark for the same goods or services. [Note 18.]

NOTES:

1. *See* 37 C.F.R. § 2.34(b) and 37 C.F.R. § 2.35; TMEP § 806.01(e) and TMEP § 1904.01(a). Compare with TMEP § 1904.09, which discusses the limited ability to transform a § 66(a) application to one under §§ 1 or 44.

2. 37 C.F.R. § 2.68.

3. 37 C.F.R. § 2.135. *See Goodway Corp. v. International Marketing Group Inc.*, 15 USPQ2d 1749, 1750 (TTAB 1990) (applicant's abandonment of certain applications without opposer's written consent resulted in entry of judgment against applicant with respect to such applications); *Grinnell Corp. v. Grinnell Concrete Pavingstones Inc.*, 14 USPQ2d 2065, 2067 (TTAB 1990) (consent required for abandonment without prejudice regardless of motivation for abandonment, i.e., a concession by applicant that it is not owner of mark and that judgment would be unfair to real owner, a non-party to the case); *In re First National Bank of Boston*, 199 USPQ 296, 301 (TTAB 1978) (where abandonment of application and notice of opposition were filed on same day, consent was not required because there was no application to oppose).

See also Rolex Watch USA Inc. v. AFP Imaging Corp., 107 USPQ2d 1626, 1628 (TTAB 2013) (judgment entered against applicant under 37 C.F.R. § 2.135 where it filed an abandonment without opposer's written consent while opposer's appeal was pending even though appeal was rendered moot); *Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1453 (TTAB 1991) (where excepted user abandoned application in concurrent use proceeding, judgment precluded such applicant from obtaining any registration at all, although it may remain in proceeding as defaulting user), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992). *Cf. Kraft Foods, Inc. v. Desnoes & Geddes Ltd.*, 64 USPQ2d 1154, 1157 (TTAB 2002) (although not applicable to the facts of the case where the abandonment was filed after the Board's decision and during the pendency of an appeal, the Board stated "Trademark Rule 2.135 provides that during the pendency of an opposition, if the applicant files an abandonment of the application without the consent of the adverse party, judgment shall be entered against the applicant").

4. *See* 37 C.F.R. § 2.135.

5. 37 C.F.R. § 2.193(c)(1).

6. *Aromatique Inc. v. Lang*, 25 USPQ2d 1359, 1361 (TTAB 1992) (applicant, by abandoning application with prejudice in prior opposition is estopped in subsequent opposition from attempting to register virtually identical mark for identical goods); *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 678 (TTAB 1986) (judgment in first opposition, as a result of abandonment of application without consent, operates as claim preclusion in subsequent opposition so as to bar applicant's subsequent application for an insignificantly modified mark); *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984) (abandonment of application without consent in previous opposition does not operate as collateral estoppel or claim preclusion in subsequent cancellation proceeding between same parties since the two cases involve two distinct marks, and does not operate as issue preclusion because no issues were actually litigated in the prior opposition); *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.*, 200 USPQ 819, 822 (TTAB 1978) (judgment against applicant in prior opposition due to abandonment of application without consent operated as collateral estoppel in subsequent opposition involving same marks and same parties in opposite positions); *In re Communications Technology Corp.*, 182 USPQ 695, 696 (TTAB 1974) (judgment against applicant in prior opposition between applicant and owner of cited registration is not conclusive of likelihood of confusion and does not operate as estoppel in subsequent application for a distinctly different mark).

But cf. Sharp Kabushiki Kaisha v. ThinkSharp Inc., 448 F.3d 1368, 79 USPQ2d 1376, 1379-80 (Fed. Cir. 2006) (applicant with two similar marks under opposition did not defend one, accepting default judgment; default judgment did not preclude applicant's defense of other mark in related opposition); *Zachry Infrastructure LLC v. American Infrastructure Inc.*, 101 USPQ2d 1249, 1254-55 (TTAB 2011) (no estoppel where certain applications expressly abandoned after civil action because they were filed prior to commencement of oppositions on related applications and an applicant faced with oppositions against more

than one application should be able to choose which opposition to defend). *See also Johnson & Johnson v. Bio-Medical Sciences, Inc.*, 179 USPQ 765, 766 (TTAB 1973) (voluntary dismissal of previous counterclaims with prejudice operated as estoppel barring same counterclaims in subsequent proceeding).

7. 37 C.F.R. § 2.135. *See also New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1550-51 (TTAB 2011) (abandonment must be with written consent of all opposers or judgment will be entered for each opposer who has not consented).

8. *See* 37 C.F.R. § 2.126(a) and 37 C.F.R. § 2.126(b).

9. *See* 37 C.F.R. § 2.119(a).

10. *Cf. In re First National Bank of Boston*, 199 USPQ 296, 301 (TTAB 1978) (where opposition and abandonment were filed on same day).

11. *In re First National Bank of Boston*, 199 USPQ 296, 301 (TTAB 1978) (where opposition and abandonment were filed on same day, opposition was not considered to have been pending when abandonment was filed, and opposer's consent was not at issue). *See also 3PMC, LLC v. Huggins*, 115 USPQ2d 1488, 1489 (TTAB 2015) (reaffirming holding in *In re First Nat'l Bank of Boston* that Board "'shall not take cognizance of fractions of a day,' and we will assume that an opposition and an express abandonment, filed the same day, were filed at the same instant. In accordance with our precedent, we conclude that the involved application was not subject to an opposition when it was abandoned and, therefore, Trademark Rule 2.135 does not apply.").

12. *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1080 (TTAB 1992).

13. *Cf. Bank of America National Trust & Savings Association v. First National Bank of Allentown*, 220 USPQ 892, 894 n.6 (TTAB 1984) (opposer elected to adjudicate pleaded issues where applicant had conceded that use was not made until after filing date, and its application was held void ab initio); *Daggett & Ramsdell, Inc. v. Procter & Gamble Co.*, 119 USPQ 350, 350 (TTAB 1958) (applicant in prior opposition consented to judgment and therefore not entitled to registration but in subsequent opposition against same applicant, opposer pressed for determination on merits), *rev'd on other grounds*, 275 F.2d 955, 125 USPQ 236 (CCPA 1960).

14. *See* 37 C.F.R. § 7.25 (Sections of part 2 applicable to extension of protection); TMEP § 1504.05 ("In a § 66(a) application, the examining attorney may not request a remand during an inter partes proceeding.").

15. *See* 37 C.F.R. § 7.30; TMEP § 1904.08.

16. A "cancellation" by the holder of an international registration is a removal of some or all of the goods and services as to all of the designated countries. A "renunciation" is the deletion of all the goods and services to some, but not all, of the designated countries. *See also*TMEP § 1906.01(e) (Limitation, Renunciation, or Cancellation of International Registration).

17. *See Aromatique Inc. v. Lang*, 25 USPQ2d 1359, 1361 (TTAB 1992). *See also Wells Cargo, Inc. v. Wells Cargo, Inc.*, 606 F.2d 961, 203 USPQ 564, 567 (CCPA 1979) (applicant's successor in interest is bound by act of withdrawal of application with prejudice and is barred from again seeking to register same mark for same goods).

18. *Cf. Montana v. United States*, 440 U.S. 147, 159 (1979) (changes in controlling facts essential to a judgment will render collateral estoppel inapplicable in a subsequent action raising the same issues); *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 76 USPQ2d 1310, 1313 (Fed. Cir. 2005) ("A change in trademark usage can constitute a change in transactional facts that avoids preclusion based on the earlier noninfringement decision."); *Bingaman v. Dept. of the Treasury*, 127 F.3d 1431, 1437 (Fed. Cir. 1997) ("Collateral estoppel is subject to exceptions when the circumstances dictate. … Courts have crafted an exception to the collateral estoppel principle when there has been a change in the applicable law between the time of the original decision and the subsequent litigation in which collateral estoppel is invoked."). *See generally* J. Thomas McCarthy, 6 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 32:88 (2020).

602.02 Withdrawal by Respondent

602.02(a) Surrender or Voluntary Cancellation of Registration

37 C.F.R. § 2.134(a) ***Surrender or Voluntary Cancellation of Registration.*** *After the commencement of a cancellation proceeding, if the respondent applies for cancellation of the involved registration under section 7(e) of the Act of 1946 without the written consent of every adverse party to the proceeding, judgment shall be entered against the respondent. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.*

37 C.F.R. § 2.172 ***Surrender for cancellation.*** *Upon application by the owner, the Director may permit any registration to be surrendered for cancellation. The application for surrender must be signed by the owner of the registration, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter. When a registration has more than one class, one or more entire class(es) but fewer than the total number of classes may be surrendered. Deletion of fewer than all the goods or services in a single class constitutes amendment of the registration as to that class (see § 2.173), not surrender. A surrender for cancellation may not subsequently be withdrawn.*

37 C.F.R. § 7.30 ***Effect of cancellation or expiration of international registration.*** *When the International Bureau notifies the Office of the cancellation or expiration of an international registration, in whole or in part, the Office shall cancel, in whole or in part, the corresponding pending or registered extension of protection to the United States. The date of cancellation of an extension of protection or relevant part shall be the date of cancellation or expiration of the corresponding international registration or relevant part.*

A registered extension of protection to the United States of an international registration also is referred to as a "§ 66(a) registration."

A registrant that wishes to voluntarily surrender its registration for cancellation may file in the Office a written application, signed by the registrant, or an attorney as defined in 37 C.F.R. § 11.1 who has an actual or implied written or verbal power of attorney from the owner. [Note 1.] There is no fee for a voluntary surrender for cancellation. [Note 2.] A registrant that wishes to voluntarily cancel its § 66(a) registration may do so by filing such request with either the USPTO or the International Bureau (IB). [Note 3.] However, after the commencement of a cancellation proceeding, if the respondent applies for surrender of its subject registration under Trademark Act § 7(e), 15 U.S.C. § 1057(e), without the written consent of every adverse party to the proceeding, judgment will be entered against the respondent. [Note 4.] The written consent of an adverse party may be signed by the adverse party itself, or by the adverse party's attorney or other authorized representative. [Note 5.]

Once a respondent has filed a voluntary surrender, it may not later withdraw that surrender. [Note 6.]

For information concerning the effect of a judgment of this type, see TBMP § 602.01.

Deletion of an entire class in multiple-class registrations. In a cancellation proceeding against any registration having multiple classes, if the respondent files a request to amend the registration to delete an entire class sought to be cancelled, the request for amendment is, in effect, a voluntary surrender of the registration with respect to that class, and is governed by 37 C.F.R. § 2.134(a). [Note 7.]

Deletion of only some goods and services in a single class is an amendment for Trademark Act §§ 1 and 44 registrations. For a registration under Trademark Act §§ 1 or 44, deletion of some of the goods or services in a single class constitutes an amendment, not a voluntary surrender, of the registration as to that class. [Note 8.] For information about amendments to registrations involved in Board proceedings, see TBMP § 514.

Deletion of only some goods and services in a single class affecting only the registered extension of protection is an amendment for a Trademark Act § 66(a) registration. In a cancellation proceeding against a Trademark Act § 66(a) registration, if the respondent requests a deletion of some of the goods or services in a single class, and such deletion will affect only the registered extension of protection to the United States, the deletion is considered an amendment and may be filed with the USPTO. [Note 9.] The USPTO will notify the IB about the change in the registered extension of protection to the United States. [Note 10.] Similarly, if the USPTO is notified by the IB that a limitation of the list of goods and services affects the registered extension of protection to the United States, but not the international registration, and such limitation results in a deletion of only some of the goods and services in a single class, the deletion is considered an amendment to the § 66(a) registration. [Note 11.]

Deletion of only some goods and services in a single class affecting the international registration is a voluntary surrender of those goods and services for a Trademark Act § 66(a) registration. However, if the respondent requests a cancellation with the IB as to some of the goods and services in a single class in the international registration without the written consent of every adverse party to the proceeding, the request is, in effect, a voluntary cancellation of the § 66(a) registration with respect to those goods or services and judgment will be entered against the registrant as to the deleted goods or services. [Note 12.] In this latter situation, the respondent is not deleting goods and services that affect only the registered extension of protection to the United States but is, instead, deleting goods and services that affect its international registration and all reliant extensions of protection, including the one to the United States that is the subject matter of the cancellation proceeding. For further information about amendments to applications and registrations, see 37 C.F.R. § 2.133; TBMP § 514 and TBMP § 605.03(b).

A partial restriction of an international registration may be due to the "ceasing of effect" of the basic registration. This occurs when the home country registration is limited by the country of origin. The USPTO will restrict any § 66(a) registration when notified by the IB of a partial restriction. The § 66(a) registrant has the option of transforming the deleted goods, services and/or classes into a national application. [Note 13.] Should a respondent involved in a Board cancellation proceeding opt to transform the goods, services and/or classes that are the subject matter of the partial restriction, and that are involved in the Board's cancellation proceeding, the Board proceeding may go forward with respect to the new national registration resulting from the transformation. Alternatively, the Board may dismiss the cancellation without prejudice to the petitioner to bring an opposition against the new national application resulting from the transformation or to petition to cancel the new national registration resulting from the transformation. Should a respondent elect not to transform the goods, services and/or classes that are the subject matter of the partial restriction, and that are involved in the Board's cancellation proceeding, the partial restriction is treated as a cancellation

of the international registration with respect to the deleted goods, services and/or classes. In the latter case, the partial restriction is, in effect, a voluntary cancellation of the § 66(a) registration with respect to those goods, services and/or classes. Where the partial restriction occurs without the written consent of every adverse party, judgment will be entered against the registrant as to the deleted goods, services and/or classes. [Note 14.]

An application for voluntary surrender of a registration that is the subject of a Board inter partes proceeding should be electronically filed with the Board, and should bear at the top of its first page both the registration number and the inter partes proceeding number and title. Registrants must use ESTTA for filing a voluntary surrender where the registration is subject to a petition to cancel. [Note 15.] For further information regarding ESTTA, *see*TBMP § 110. Use of the TEAS system is not appropriate for filing a voluntary surrender of a registration subject to a petition to cancel. The application for voluntary surrender should include proof of service upon every other party to the proceeding. [Note 16.] *See* TBMP § 113.

Other exemplary situations involving a surrender or voluntary cancellation of a registration.

If a registrant whose registration is the subject of a petition for cancellation files a surrender or voluntary cancellation of the registration with the written consent of the petitioner, the petition for cancellation will be dismissed without prejudice, and the registration will be cancelled.

If the registrant files a surrender or voluntary cancellation of the registration with the written consent of the petitioner, and the petitioner files a withdrawal of the petition for cancellation, the petition for cancellation will be dismissed without prejudice, and the registration will be cancelled.

If the registrant files a surrender or voluntary cancellation of the registration with prejudice with the written consent of the petitioner, the petition for cancellation will be dismissed without prejudice (the registration will be cancelled with prejudice to registrant's right to reregister the same mark for the same goods or services), unless the parties specify otherwise in writing.

If the registrant files a surrender or voluntary cancellation of the registration with prejudice with the written consent of the petitioner, and the petitioner files a withdrawal of the petition for cancellation with prejudice with the written consent of the registrant, the petition for cancellation will be dismissed with prejudice, and the registration will be cancelled with prejudice to registrant's right to re-register the same mark for the same goods or services. [Note 17.]

NOTES:

1. *See* TMEP § 1608 (Surrender of Registration for Cancellation).

2. *See* Trademark Act § 7(e), 15 U.S.C. § 1057(e); 37 C.F.R. § 2.172; TMEP § 1403.07 (Surrender or Amendment in Multiple-Class Registrations); TMEP § 1608 (Surrender of Registration for Cancellation). The requirement for a statement that the original certificate has been lost or destroyed has been eliminated.

3. *See*TMEP § 1608. *Cf.*TMEP § 1906.01(e) (a request to cancel the international registration, however, must be filed with the IB).

4. *See* 37 C.F.R. § 2.134(a). *See Harry Winston, Inc. v. Bruce Winston Gem Corp.* , 111 USPQ2d 1419, 1423 (TTAB 2014) (judgment entered against opposers who voluntarily surrendered pleaded registration without applicant's consent where such registration was the subject of a counterclaim to cancel); *Christiane*

E LLC v. International Expedition Inc. , 106 USPQ2d 2042, 2044 (TTAB 2013) (judgment entered against respondent where petitioner's written consent to voluntary surrender not of record and where respondent did not show an extraordinary situation in support of its motion to withdraw its voluntary surrender). *Cf.* 37 C.F.R. § 2.135; *Goodway Corp. v. International Marketing Group Inc.*, 15 USPQ2d 1749, 1750 (TTAB 1990); *Grinnell Corp. v. Grinnell Concrete Pavingstones Inc.*, 14 USPQ2d 2065, 2067 (TTAB 1990) (consent required for abandonment without prejudice regardless of motivation for abandonment, i.e., a concession by applicant that it is not the owner of the mark and that judgment would be unfair to the real owner, a non-party to the case); *In re First National Bank of Boston*, 199 USPQ 296, 301 (TTAB 1978) (where abandonment of application and notice of opposition were filed on the same day, consent was not required because there was no application to oppose).

5. *See* 37 C.F.R. § 2.134(a).

6. 37 C.F.R. § 2.172.

7. *See G&W Laboratories, Inc. v. GW Pharma Ltd.*, 89 USPQ2d 1571, 1574 (TTAB 2009) ("The request to delete a class of goods or services sought to be cancelled is, in effect, a voluntary cancellation of the registration as to the class under Section 7(e) of the Trademark Act.").

8. 37 C.F.R. § 2.172. *See also* TMEP § 1403.07 and TMEP § 1609.03.

9. *See* TMEP § 1609.03 and TMEP § 1904.13(a). *See also*TMEP § 1904.02(c) and TMEP § 1904.02(c)(ii) (explaining the USPTO requirement that identifications in international registrations that provide the basis for a § 66(a) application, and ensuing registered extension of protection, must meet the same standards of specificity as §§ 1 and 44 applications; and explaining the USPTO's policy where the identification in the international registration is indefinite, respectively).

10. *See* TMEP § 1904.13(a).

11. *See*TMEP § 1904.02(e)(ii), TMEP § 1904.02(e)(iii), and TMEP § 1904.15.

12. *See*15 U.S.C. § 1141j(a); TMEP § 1609.03. *Cf. G&W Laboratories, Inc. v. GW Pharma Ltd.*, 89 USPQ2d 1571, 1574 (TTAB 2009) ("The request to delete a class of goods or services sought to be cancelled is, in effect, a voluntary cancellation of the registration as to the class under Section 7(e) of the Trademark Act.").

13. *See*TMEP § 1904.09.

14. 37 C.F.R. § 2.134(a).

15. *See* 37 C.F.R. § 2.126(a) and 37 C.F.R. § 2.126(b).

16. *See* 37 C.F.R. § 2.119(a).

17. *Cf. Montana v. United States*, 440 U.S. 147, 159 (1979) (changes in controlling facts essential to a judgment will render collateral estoppel inapplicable in a subsequent action raising the same issues); *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 76 USPQ2d 1310, 1313 (Fed. Cir. 2005) ("A change in trademark usage can constitute a change in transactional facts that avoids preclusion based on the earlier noninfringement decision."); *Bingaman v. Dep't of the Treasury*, 127 F.3d 1431, 1437 (Fed. Cir. 1997) ("Collateral estoppel is subject to exceptions when the circumstances dictate. … Courts have

crafted an exception to the collateral estoppel principle when there has been a change in the applicable law between the time of the original decision and the subsequent litigation in which collateral estoppel is invoked.”). *See generally* J. Thomas McCarthy, 6 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 32:88 (2020).

602.02(b) Cancellation Under Section 8 or 71; Expiration Under Section 9 or 70

37 C.F.R. § 2.134(b) *After the commencement of a cancellation proceeding, if it comes to the attention of the Trademark Trial and Appeal Board that the respondent has permitted its involved registration to be cancelled under section 8 or section 71 of the Act of 1946, or has failed to renew its involved registration under section 9 of the Act of 1946, or has allowed its registered extension of protection to expire under section 70(b) of the Act of 1946, an order may be issued allowing respondent until a set time, not less than fifteen days, in which to show cause why such cancellation, failure to renew, or expiration should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party and should not result in entry of judgment against respondent as provided by paragraph (a) of this section. In the absence of a showing of good and sufficient cause, judgment may be entered against respondent as provided by paragraph (a) of this section.*

37 C.F.R. § 7.30 ***Effect of Cancellation or expiration of international registration.*** *When the International Bureau notifies the Office of the cancellation or expiration of an international registration, in whole or in part, the Office shall cancel, in whole or in part, the corresponding pending or registered extension of protection to the United States. The date of cancellation of an extension of protection or relevant part shall be the date of cancellation or expiration of the corresponding international registration or relevant part.*

37 C.F.R. § 7.36 ***Affidavit or declaration of use in commerce or excusable nonuse required to avoid cancellation of an extension of protection to the United States.***

(a) *Subject to the provisions of section 71 of the Act, a registered extension of protection shall remain in force for the term of the international registration upon which it is based unless the international registration expires or is cancelled under section 70 of the Act due to cancellation of the international registration by the International Bureau.*

(b) *During the following time periods, the holder of an international registration must file an affidavit or declaration of use or excusable nonuse, or the registered extension of protection will be cancelled under section 71 of the Act:*

(1) *On or after the fifth anniversary and no later than the sixth anniversary after the date of registration in the United States; and*

(2) *Within the year before the end of every ten-year period after the date of registration in the United States.*

(3) *The affidavit or declaration may be filed within a grace period of six months after the end of the deadline set forth in paragraphs (b)(1) and (b)(2) of this section, with payment of the grace period surcharge per class required by section 71(a)(3) of the Act and § 7.6.*

(c) *For the requirements for the affidavit or declaration, see § 7.37.*

37 C.F.R. § 7.41 ***Renewal of international registration and extension of protection.***

(a) *Any request to renew an international registration and its extension of protection to the United States must be made at the International Bureau in accordance with Article 7 of the Madrid Protocol.*

With respect to registrations issued under Trademark Act §§ 1 or 44, 15 U.S.C. § 1051 and 15 U.S.C. § 1126, if it comes to the attention of the Board, during the course of a proceeding, that respondent has permitted its involved registration to be cancelled under Trademark Act § 8, 15 U.S.C. § 1058, or has failed to renew its involved registration under Trademark Act § 9, 15 U.S.C. § 1059, the Board may issue an order allowing respondent time to show cause why the cancellation, or the failure to renew, should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of petitioner and should not result in entry of judgment against respondent. [Note 1.]

Similarly, in the case of a § 66(a) registration, if it comes to the attention of the Board during the course of a proceeding that respondent has allowed its extension of protection to the United States to be cancelled under Trademark Act § 71, 15 U.S.C. § 1141k, [Note 2] or has failed to renew its extension of protection under Trademark Act § 70, 15 U.S.C. § 1141j, such that it has expired [Note 3], the Board may issue an order allowing respondent time to show cause why the cancellation should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of petitioner and should not result in entry of judgment against respondent.

In a cancellation proceeding against any registration having multiple classes, if the respondent permits an entire class which is the subject of the cancellation proceeding to be cancelled under Trademark Act §§ 8 or 71, or fails to renew the registration under Trademark Act § 9 with respect to that class, or has allowed its registered extension of protection to expire under Trademark Act § 70(b), the cancellation or failure to renew with respect to that class is governed by 37 C.F.R. § 2.134(b). [Note 4.]

In a cancellation proceeding against any registration having multiple goods and/or services within a single class, if the respondent permits one or some of the goods or services which is the subject of the cancellation proceeding to be cancelled under Trademark Act §§ 8 or 71 by failing to include a statement of continuing use, or fails to renew the registration under Trademark Act § 9, or has allowed its extension of protection to expire under Trademark Act § 70(b), the cancellation or failure to renew with respect to that good(s) or service(s) is governed by 37 C.F.R. § 2.134(b). [Note 5.]

An order to show cause under 37 C.F.R. § 2.134(b) may be issued by the Board upon motion by the petitioner, or (if the failure to file a § 8 or § 9 affidavit or a § 70 renewal or § 71 affidavit comes to the attention of the Board in another manner) upon the Board's own initiative. [Note 6.] Depending on the particular circumstances, the Board has discretion not to issue an order to show cause. [Note 7.]

For information concerning motions for an order to show cause under 37 C.F.R. § 2.134(b), see TBMP § 535.

The purpose of 37 C.F.R. § 2.134(b), and the policy underlying the issuance of a show cause order, is to prevent a cancellation proceeding respondent whose subject registration comes due, during the course of the proceeding, for a § 8 or § 9 affidavit, or in the case of a § 66(a) registration, a § 71 affidavit or § 70 renewal, from being able to moot the proceeding, and avoid judgment, by deliberately failing to file the required affidavits or renewal applications. [Note 8.] The Board's policy governing application of 37 C.F.R. § 2.134(b) is as follows:

"The paragraph has been modified to provide an opportunity for the respondent in such situation to 'show cause' why judgment should not be entered against it. If respondent submits a showing that the cancellation or expiration was the result of an inadvertence or mistake, judgment will not be entered against it. If respondent submits a showing that the cancellation or expiration was occasioned by the fact that its registered mark had been abandoned and that such abandonment was not made for purposes of avoiding the proceeding but rather was the result, for example, of a two-year period of nonuse which commenced well before respondent

learned of the existence of the proceeding, judgment will be entered against it only and specifically on the ground of abandonment." [Note 9.]

If, in response to an order to show cause a respondent submits a showing that the cancellation of its registration or registered extension of protection under Trademark Act §§ 8 or 71, respectively, or failure to renew the registration under Trademark Act § 9, or that the expiration of the registered extension of protection under Trademark Act § 70(b), was the result of inadvertence or mistake, judgment will not be entered against it by reason of the cancellation. [Note 10.]

If respondent submits a showing that it permitted its registration or registered extension of protection to be cancelled under Trademark Act §§ 8 or 71, respectively, or failed to renew the registration under Trademark Act § 9, or that it allowed the registered extension of protection to expire under Trademark Act § 70(b), because its registered mark had been abandoned, and that the abandonment was not made for purposes of avoiding the proceeding, judgment will be entered against it only and specifically on the ground of abandonment (if abandonment has not been pleaded as a ground for cancellation, petitioner will be allowed to amend its pleading appropriately). [Note 11.]

In those cases where the Board finds that respondent has shown good and sufficient cause why judgment should not be entered against it, petitioner may be given time to decide whether it wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot. [Note 12.] In those cases where the Board enters judgment against the respondent only and specifically on the ground of abandonment, petitioner may be given time to decide if it wishes to go forward to obtain a determination of the remaining issues, or to have the cancellation proceeding dismissed without prejudice as to those issues. [Note 13.]

As noted above, the purpose of 37 C.F.R. § 2.134(b) is to prevent a cancellation proceeding respondent from being able to moot the proceeding, and avoid judgment, by deliberately failing to file a required affidavit of use under Trademark Act §§ 8 or 71, or renewal application under Trademark Act § 9, or by permitting the registered extension of protection to expire under Trademark Act § 70(b). The rule does not provide that an order to show cause "shall" be issued, but rather that an order "may" be issued. Normally, the Board, in the exercise of its discretion under the rule, does not issue a show cause order in those cases where the failure to file a required affidavit under §§ 8 or 71, or renewal application under § 9, or failure to renew the registered extension of protection under § 70(b), occurs after the filing of a petition for cancellation, but before respondent has been notified by the Board. [Note 14.] Rather, the Board issues an action notifying respondent of the filing of the proceeding, advising both parties that the registration has been cancelled under §§ 8 or 71, or has expired under §§ 9 or 70, and allowing petitioner time to elect whether it wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot. *Cf.* TBMP § 602.01 (Withdrawal by Applicant). However, on the rare occasion that a petitioner believes that the respondent had knowledge of the filing of the petition to cancel (notwithstanding the fact that respondent had not been notified by the Board of the commencement of the proceeding and service of the petition to cancel by web link or web address), and that respondent deliberately failed to file a required affidavit of use under §§ 8 or 71, or renewal application under § 9, or permitted the registered extension of protection to expire under Trademark Act § 70(b), in an effort to moot the proceeding, and avoid judgment, the petitioner may file a motion for an order to show cause under 37 C.F.R. § 2.134(b) stating the reasons for its belief. *See*TBMP § 535.

Where, during the course of a proceeding, respondent's registration or registered extension of protection expires or is cancelled, and respondent demonstrates that the cancellation or expiration was not occasioned by respondent's intent to moot the proceeding, and petitioner elects to go forward with the proceeding, "[t]he

expiration of the registration does not extinguish either actual notice or constructive notice [of the registration] during the term of the registration." [Note 15.]

NOTES:

1. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1155 (TTAB 1989); *C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450 (TTAB 1988); *Abraham's Seed v. John One Ten*, 1 USPQ2d 1230, 1232 (TTAB 1986). *Cf. In re Checkers of North America Inc.*, 23 USPQ2d 1451, 1454 (Comm'r 1992), *aff'd sub nom., Checkers Drive-In Restaurants, Inc. v. Comm'r of Patents and Trademarks*, 51 F.3d 1078, 34 USPQ2d 1574, 1580 n.7 (D.C. Cir. 1995); *Global Maschinen GmbH v. Global Banking Systems, Inc.*, 227 USPQ 862, 863 n.1 (TTAB 1985).

2. A § 66(a) registration is subject to the § 71 requirements for affidavits of continued use (or excusable nonuse). A § 71 affidavit is filed with the USPTO, not the IB. *See* Trademark Act § 71, 15 U.S.C. § 1141k; TMEP § 1613 and TMEP § 1904.10.

3. A renewal under Trademark Act § 70, 15 U.S.C. § 1141j, refers to a renewal of the international registration underlying a § 66(a) registration. A § 66(a) registration will be cancelled under § 70 for failure to renew the international registration on which it is based. Renewals of international registrations are filed directly with the International Bureau (IB), not the USPTO. If the IB does not renew the underlying international registration, the IB will notify the USPTO that the international registration has expired. The corresponding extension of protection to the U.S. will expire as of the expiration date of the international registration and the § 66(a) registration will be cancelled by the Office. *See* Trademark Act § 70, 15 U.S.C. § 1141j; TMEP § 1614 and TMEP § 1905.

4. *Cf. Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1110 (TTAB 2015).

5. *Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1110 (TTAB 2015) ("We recognize that Trademark Rule 2.134(b) refers to the cancellation of a registration. Here Plaintiff is not attempting to cancel each registration in its entirety, but to cancel only specific items in Defendant's registrations, and these items are among those that Defendant requested to have deleted as part of its Section 8 filings. Nonetheless, the purpose behind Rule 2.134(b) is to prevent a defendant from mooting a cancellation action. Therefore, we find that Rule 2.134(b) applies to the present situation, where the cancellation proceeding is to cancel only certain goods from a registration, and the defendant deletes those specific goods from its registration as part of its filing a Section 8 affidavit in order to moot the proceeding.").

6. *See C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450, 1452 (TTAB 1988) (motion for order to show cause); *Abraham's Seed v. John One Ten*, 1 USPQ2d 1230, 1232 (TTAB 1986) (show cause order issued where respondent's failure to file § 8 affidavit came to Board's attention following receipt of petitioner's final brief but before final decision).

7. *Jill E. Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *2 (TTAB 2020) (Board found it unnecessary to issue show cause order under Trademark Rule 2.134(b) where respondent's sole owner and member testified during trial that the mark in the expired registration is no longer used and that he does not intend to use it again in the future); *Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1531 (TTAB 2018) (Board exercised discretion not to issue show cause order under Trademark Rule 2.134(b) where respondent's registration expired after petitioner filed its brief on the merits; Board issued final decision on the merits); *Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1110 (TTAB 2015) (where the deletions requested by respondent of the involved goods from the Section 8 declarations were deliberate, and not the result of mistake or inadvertence, and respondent mistakenly

believed that such deletion would moot or partially moot the subject actions, Board exercised discretion not to issue an order to show cause); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1471 (TTAB 2014) (Board exercised discretion not to issue show cause order because the parties had litigated and briefed whether the mark is merely descriptive; sufficient cause to decide the issue on the merits); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1083, n.7 (TTAB 2014) (same), *aff'd*, 112 F.Supp.3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *vacated and remanded on other grounds*, No. 15-1874 (4th Cir. Jan. 18, 2018).

8. *See In re Checkers of North America Inc.*, 23 USPQ2d 1451, 1454 (Comm'r 1992) , *aff'd sub nom. Checkers Drive-In Restaurants, Inc. v. Comm'r of Patents and Trademarks*, 51 F.3d 1078, 34 USPQ2d 1574 (D.C. Cir. 1995) (petitioner should not be deprived of a judgment in its favor by a respondent who lets its registration lapse during a cancellation proceeding); *Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1110 (TTAB 2015); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989) (although judgment entered on ground of abandonment in view of concession that failure to file § 8 affidavit was due to discontinued use of mark, judgment was not entered on ground of likelihood of confusion where respondent showed that failure to file § 8 affidavit with respect to that ground was result of deliberate business decision made prior to commencement of proceeding and not for purposes of avoiding proceeding).

9. *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989) (where registrant stated that failure to file § 8 affidavit, with respect to ground of likelihood of confusion, was result of deliberate business decision made prior to commencement of proceeding and not to avoid judgment, judgment was not entered as to that ground); *C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450, 1452 (TTAB 1988) (failure to renew was unintentional and not due to abandonment); *Abraham's Seed v. John One Ten*, 1 USPQ2d 1230, 1232 (TTAB 1986) (respondent's belief that it was improper to file a § 8 affidavit since "the cancellation action had priority," while erroneous, was treated as sufficient showing of cause to avoid entry of judgment).

10. *See C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450, 1452 (TTAB 1988) (failure to renew was unintentional and not due to abandonment); *Abraham's Seed v. John One Ten*, 1 USPQ2d 1230, 1232 (TTAB 1986) (respondent's belief that it was improper to file a § 8 affidavit since "the cancellation action had priority," while erroneous, was treated as sufficient showing of cause to avoid entry of judgment). *Cf. Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014) (judgment against opposers on counterclaim for failure of opposer to respond to order to show cause regarding expiration of registration).

11. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989) (where registrant stated that failure to file § 8 affidavit, with respect to ground of likelihood of confusion, was result of deliberate business decision made prior to commencement of proceeding and not to avoid judgment, judgment was not entered as to that ground and petitioner was allowed time to advise whether it wished to go forward on that ground).

12. *See Abraham's Seed v. John One Ten*, 1 USPQ2d 1230, 1232 (TTAB 1986) (opted for decision on merits). *Cf. C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450, 1452 (TTAB 1988) (where petitioner moved for show cause order and respondent filed response showing good cause along with uncontested motion to dismiss petition as moot, petition was dismissed as moot).

13. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989). *Cf. United Rum Merchants Ltd. v. Distillers Corp. (S.A.)*, 9 USPQ2d 1481, 1484 n.3 (TTAB 1988); *Bank of America National Trust & Savings Association v. First National Bank of Allentown*, 220 USPQ 892, 894 n.6 (TTAB

1984) (where application was held void ab initio, opposer elected to adjudicate pleaded issues); *Daggett & Ramsdell, Inc. v. Procter & Gamble Co.*, 119 USPQ 350, 350 (TTAB 1958), *rev'd on other grounds*, 275 F.2d 955, 125 USPQ 236 (CCPA 1960).

14. *See Global Maschinen GmbH v. Global Banking Systems Inc.*, 227 USPQ 862, 863 n.1 (TTAB 1985).

15. *Fishking Processors, Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1765 (TTAB 2007) (where, after expiration of the registration during the course of the proceeding, petitioner elected to go forward on its claims, respondent was not precluded from asserting a laches defense).

603 Withdrawal by Interference or Concurrent Use Applicant

37 C.F.R. § 2.68 ***Express abandonment (withdrawal) of application.***

(a) ***Written document required.*** *An applicant may expressly abandon an application by filing a written request for abandonment or withdrawal of the application, signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2). A request for abandonment or withdrawal may not subsequently be withdrawn.*

(b) ***Rights in the mark not affected.*** *Except as provided in § 2.135, the fact that an application has been expressly abandoned shall not affect any rights that the applicant may have in the mark in the abandoned application in any proceeding in the Office.*

37 C.F.R. § 2.135 ***Abandonment of application or mark.***

After the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of the application or of the mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

After the commencement of an interference or concurrent use proceeding, if an applicant whose application is a subject of the proceeding files a written abandonment of its application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. [Note 1.] Any concurrent use proceeding will be dissolved, and registration to applicant will be refused.

If, after the commencement of a concurrent use proceeding involving two or more applicants, one of the applicants files an unconsented abandonment of its application, but not of its common law use of its mark, judgment will be entered against that applicant with respect to the registration sought by it. However, if the abandoning applicant is specified as an excepted concurrent user in any other application involved in the proceeding, the abandoning applicant will remain a party to the proceeding as a concurrent user, and every other applicant to the proceeding who, in its own application, has listed that party as an excepted user will retain the burden of proving its entitlement to registration in view of the acknowledged rights of the abandoning applicant. [Note 2.] On the other hand, if a party to a concurrent use proceeding abandons all rights in its mark and in its application (if any), any remaining party that seeks concurrent registration may move to amend its application to delete the abandoning party as an excepted user. If the abandoning party is the only excepted user specified in a remaining party's application, the remaining party may move to amend its application to seek a geographically unrestricted registration. [Note 3.] *See* TBMP § 1106.05. If the motion is granted, the concurrent use proceeding will be dissolved without prejudice, and the application will be republished, for purposes of opposition, as an application for a geographically unrestricted registration.

If an application which is the subject of an interference or concurrent use proceeding has multiple classes, and the applicant files a request to amend the application to delete a class, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by 37 C.F.R. § 2.135.

A request for abandonment of an application that is the subject of an interference or concurrent use proceeding should be electronically filed with the Board. Applicants must use ESTTA for filing an abandonment of an application involved in an interference or in a concurrent use proceeding. [Note 4.] For further information regarding ESTTA, see TBMP § 110. Use of the TEAS system for filing an abandonment of such an application is not appropriate. The top of its first page should list both the application serial number, and the interference or concurrent use proceeding number and title. The abandonment should include proof of service thereof upon every other party to the proceeding. [Note 5.] *See* TBMP § 113.

If, during the pendency of an interference or concurrent use proceeding involving an application under Trademark Act § 1 or § 44, the Board grants a request by the examining attorney for remand under 37 C.F.R. § 2.130 and the application thereafter becomes abandoned by operation of law, for failure of the applicant to respond to an Office action, or because a final refusal to register is affirmed on appeal, judgment under 37 C.F.R. § 2.135 will not be entered against applicant in the interference, or in the concurrent use proceeding. *See* TBMP § 515 (Motion to Remand Application to Examining Attorney). 37 C.F.R. § 2.135 comes into play only when there is a written abandonment by the applicant. If, after remand under 37 C.F.R. § 2.130, applicant files a written abandonment of its application without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant pursuant to 37 C.F.R. § 2.135. An application under Trademark Act § 66(a) may not be remanded under 37 C.F.R. § 2.130. [Note 6.]

Applications based solely on Trademark Act §§ 44 or 66(a) are not subject to concurrent use registration proceedings. [Note 7.] Applications under § 66(a) are not permitted to have more than one basis. [Note 8.] As a consequence, § 66(a) applications cannot be subject to concurrent use proceedings.

NOTES:

1. 37 C.F.R. § 2.135.

2. *See Fleming Cos. Inc. v. Thriftway Inc.* , 21 USPQ2d 1451, 1456 (TTAB 1991) (although judgment was entered against excepted user in view of abandonment of its application without consent and therefore user was not entitled to a registration, because said party was listed as exception to plaintiff's right to use, plaintiff was required to show entitlement to concurrent registration), *aff'd,* 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992); *Newsday, Inc. v. Paddock Publications, Inc.* , 223 USPQ 1305, 1308 (TTAB 1984) (once concurrent user is acknowledged, even if application owned by user is expressly abandoned, plaintiff is not entitled to unrestricted registration and still must show entitlement to concurrent use registration). *Cf.* 37 C.F.R. § 2.99(d)(3); *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095 (TTAB 1987) (settlement agreement sufficient to show entitlement as to non-defaulting user but still must show entitlement as to defaulting users and may do so through an ex parte type of showing).

3. *See Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307 (TTAB 1984).

4. *See* 37 C.F.R. § 2.126(a) and 37 C.F.R. § 2.126(b).

5. *See* 37 C.F.R. § 2.119(a).

6. *See* 37 C.F.R. § 2.130. *See also* 37 C.F.R. § 7.25 (entitled "Sections of part 2 applicable to extension of protection").

7. *See* 37 C.F.R. § 2.99(g); TMEP § 1207.04(b).

8. *See* 37 C.F.R. § 2.34(b); TMEP § 1904.01(a).

604 Consent to Judgment

If a party to an inter partes proceeding before the Board does not wish to litigate the case, and is willing to accept entry of judgment against itself, the party may file a statement with the Board indicating that it consents to entry of judgment against itself. Upon receipt of such a statement, the Board will enter judgment against the filing party. [Note 1.]

NOTES:

1. *See, e.g., Multisorb Tech, Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1172 (TTAB 2013) (where respondent consented to entry of judgment on one claim which resulted in cancellation of the registration, Board did not enter judgment on remaining claim which related specifically to procurement of the involved registration and which would not bar a new application or form a basis of preclusion to challenge any new such registration).

605 Settlement

605.01 In General

A substantial percentage of the inter partes cases filed with the Board are eventually settled. [Note 1.] The Board encourages settlement, and several aspects of Board practice and procedure, including its discovery practice (*see*TBMP Chapter 400) and its usual willingness to suspend proceedings for reasonable times while parties negotiate for settlement serve to facilitate the resolution of cases by agreement. *See*TBMP § 510.03 and TBMP § 605.02.

1. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42257 (August 1, 2007); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69951 (October 7, 2016).

605.02 Suspension for Settlement Negotiations

37 C.F.R. § 2.117 ***Suspension of proceedings.***

(c) Proceedings may also be suspended sua sponte by the Board, or, for good cause, upon motion or a stipulation of the parties approved by the Board. Many consented or stipulated motions to suspend are suitable for automatic approval by ESTTA, but the Board retains discretion to condition approval on the party or parties providing necessary information about the status of settlement talks, discovery activities, or trial activities, as may be appropriate.

Parties that are negotiating for settlement, and wish to defer further litigation of the case pending conclusion of their negotiations, should remember to file stipulations to extend or suspend the running of the time periods set in the case. The parties must use ESTTA to file their consented motions (using the "consent

motions" option), which in most cases provides an immediate grant of the consented scheduling motion. [Note 1.] For further information regarding ESTTA, see TBMP § 110.

When the Board is notified that parties are negotiating for settlement, the Board may suspend proceedings for a period of up to six months, either upon request or sua sponte, subject to the right of either party to request resumption at any time prior to the expiration of the suspension period. *See* TBMP § 510.03. The suspension period may be further extended upon request, or upon notification to the Board that the parties are still engaged in their settlement negotiations. However, once proceedings have been suspended for over a year, a consented scheduling motion is generally not immediately granted. Rather, the Board may require that the parties submit a report as to the status of their negotiations in order to show good cause for continued suspension. [Note 2.] This report should include a summary of the progress of the parties' negotiations, without disclosure of any confidential information or matter, and an anticipated timetable for resolution. Absent such a report, any subsequent motion to extend or suspend for settlement negotiations may be denied, even though agreed to by the parties. [Note 3.] Even if the parties state that they are engaged in settlement negotiations and wish to postpone discovery and trial, protracted suspension without substantial progress toward resolution of the matter may be taken to indicate that further suspension would not be useful. Consequently, further suspension requests may be denied even though the parties have provided a report on the status of their negotiations. For a discussion of motions to suspend, see TBMP § 510.

The Board generally will not find good cause to suspend proceedings or extend the schedule after an answer is filed but before the scheduled discovery conference has taken place, even upon stipulation or consent. [Note 4.] *See*TBMP § 401.01 (Discovery Conferences); TBMP § 509.01(a) (Motions to Extend Time) and TBMP § 510.03(a) (Suspension). This is because the discovery conference provides the parties with the opportunity to discuss settlement. [Note 5.]

NOTES:

1. *See* 37 C.F.R. § 2.126(a), 37 C.F.R. § 2.126(b), and 37 C.F.R. § 2.117(c).

2. 37 C.F.R. § 2.117(c).

3. *Cf. Central Manufacturing Inc. v. Third Millennium Tech. Inc.*, 61 USPQ2d 1210, 1211 (TTAB 2001) (where opposer's statements that the parties were engaged in settlement negotiations were found to be false and filed in bad faith, opposer was sanctioned with dismissal).

4. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

5. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42245 (August 1, 2007); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69951 (October 7, 2016) ("Many trial cases … involve cooperative parties who engage in useful settlement and discovery planning conferences.").

605.03 Settlement Agreements

605.03(a) In General

When an inter partes proceeding before the Board is settled, the parties should promptly notify the Board of the settlement. It is not necessary that the parties file a copy of their settlement agreement with the Board.

Rather, they may simply file electronically a stipulation stating the desired disposition of the proceeding (i.e., "It is hereby stipulated that the opposition be sustained," "It is hereby stipulated that the petition for cancellation be dismissed with prejudice," or the like). If there is a counterclaim, the stipulation should also state the desired disposition of the counterclaim. If, in a proceeding with a counterclaim, the parties stipulate to the disposition of the claim against which the counterclaim was brought, but there is no stipulation to dispose of the counterclaim, and there is no withdrawal of the counterclaim, consent by one party to entry of judgment against itself on the counterclaim, etc., the counterclaim will go forward, notwithstanding the fact that judgment has been entered on the original claim. *See*TBMP § 606.

If the proceeding is to be dismissed, the stipulation should specify whether the dismissal is to be with prejudice or without prejudice. If no specification is made, the Board, in its action dismissing the proceeding, will simply state that the proceeding is being dismissed "in accordance with the agreement of the parties." However, if the agreement itself also fails to indicate whether the dismissal is to be with or without prejudice, at some later time a dispute may arise between the parties as to whether they intended the dismissal to be with or without prejudice. A clear specification in the stipulation may avoid future trouble.

A settlement agreement may simply call for a party to withdraw with, or without, prejudice, or with, or without, consent. In such a case, the parties need not file a settlement stipulation, because the withdrawal, when filed, will result in a final disposition of the proceeding in accordance with the applicable rules. [Note 1.] See TBMP § 544 for information regarding settlements wherein the parties agree to vacate or set aside a final judgment of the Board.

A settlement stipulation, which is not in accordance with the applicable rules and the statute, will be given no effect by the Board.

NOTES:

1. 37 C.F.R. § 2.134 and 37 C.F.R. § 2.135.

605.03(b) With Amendment of Subject Application or Registration

If a settlement agreement is contingent upon amendment of a defendant's subject application or registration, the request for amendment is governed by 37 C.F.R. § 2.133(a) and should be filed electronically with the Board. *See*TBMP § 514 (Motion to Amend Application or Registration). Applicants must use ESTTA for filing an amendment to an opposed application. [Note 1.] The request should list at the top of the page the Board proceeding number, the number of the subject application or registration, the names of the parties, and a title describing the nature of the document (e.g., "Motion to Amend Application" or "Motion to Amend Registration"). *See*TBMP § 502.02(a) (Form of Motions). The request also should include proof of service thereof upon every other party to the proceeding. [Note 2.] *See*TBMP § 113. Use of the TEAS system is not appropriate for filing an amendment to an application that is the subject of a Board proceeding because the Board has jurisdiction over the opposed application or the registration sought to be cancelled. For information concerning the Board's jurisdiction, *see*TBMP § 102.01 and TBMP § 212.01.

A proposed amendment to a defendant's application or registration must comply with all applicable rules and statutory provisions. *See*TBMP § 514.01. Thus, for example, a proposed amendment to a Trademark Act §§ 1 or 44 application or registration that materially alters the character of the defendant's subject mark, [Note 3] or a proposed amendment to a § 66(a) application or registration that involves an amendment to the mark at all, [Note 4] cannot be approved by the Board. [Note 5.] If a settlement agreement calls for an amendment that may amount to a material change in the defendant's mark, the parties may wish to also

agree that if a request for amendment of the defendant's subject application or registration is denied by the Board, the defendant will abandon that application or voluntarily surrender that registration, and file a new application for registration of the altered mark; and that the plaintiff will not oppose the new application or seek to cancel any registration that matures from the application for the altered mark. See TBMP § 602 (Withdrawal by Opposition or Cancellation Defendant) for a discussion of abandonment of an application and surrender or voluntary cancellation of a registration.

In an opposition to any application having multiple classes, if the applicant files a request to amend the application to delete an opposed class in its entirety, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by 37 C.F.R. § 2.135. Similarly, in a cancellation proceeding against any registration having multiple classes, if the respondent files a request to amend the registration to delete an entire class sought to be cancelled, the request for amendment is, in effect, a voluntary surrender of the registration with respect to that class, and is governed by 37 C.F.R. § 2.134(a). *See*TBMP § 602.01 (Withdrawal by Applicant) and TBMP § 602.02 (Withdrawal by Respondent).

In addition, with respect to a cancellation proceeding against a § 66(a) registration, if the respondent requests cancellation with the International Bureau (IB) as to some of the goods and services in a single class in the international registration without the written consent of every adverse party to the proceeding, the request is, in effect, a voluntary cancellation of the § 66(a) registration with respect to those goods or services and judgment will be entered against the registrant as to the deleted goods or services. [Note 6.] *See* TBMP § 602.02 (Withdrawal by Respondent). However, if the respondent requests a deletion of some of the goods or services in a single class, and such deletion will effect only the registered extension of protection to the United States, the deletion is considered an amendment, and may be filed with the USPTO, subject to 37 C.F.R. § 2.133 (amendment of application or registration during proceedings). Similarly, if the USPTO is notified by the IB that a limitation of the list of goods and services affects the registered extension of protection to the United States, but not the international registration, and such limitation results in a deletion of some of the goods and services in a single class, the deletion is considered an amendment to the § 66(a) registration. [Note 7.] Such a limitation is also subject to 37 C.F.R. § 2.133.

NOTES:

1. *See* 37 C.F.R. § 2.126(a) and 37 C.F.R. § 2.126(b).

2. *See* 37 C.F.R. § 2.119(a).

3. *See* Trademark Act § 7(e), 15 U.S.C. § 1057(e); 37 C.F.R. § 2.72 and 37 C.F.R. § 2.173.

4. The mark in a § 66(a) registration cannot be amended under Trademark Act § 7, 15 U.S.C. § 1057. *See* 37 C.F.R. § 2.72 (providing only for amendments to the mark in § 1 and § 44 applications); *International Bureau's Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol* , at **www.wipo.int/madrid/en/guide**. *See also*TMEP § 1609.02 and TMEP § 1904.02(j); RULES OF PRACTICE FOR TRADEMARK-RELATED FILINGS UNDER THE MADRID PROTOCOL IMPLEMENTATION ACT, 68 Fed. Reg. 55748, 55756 (September 26, 2003).

5. *See* Trademark Act § 7(e), 15 U.S.C. § 1057; 37 C.F.R. § 2.71, 37 C.F.R. § 2.72, 37 C.F.R. § 2.173, and 37 C.F.R. § 2.73; *Vaughn Russell Candy Co. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635, 1636 (TTAB 1998) (material alteration); *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, 1745 (TTAB 1992), *summ. judgment granted in part*, 26 USPQ2d 1926 (TTAB 1993) (expansion of scope of goods); *Mason Engineering and Design Corp. v. Mateson Chem. Corp.*, 225 USPQ 956, 957 (TTAB 1985) (amendment to dates of use not supported by affidavit or declaration).

6. *Cf.* Trademark Act § 70, 15 U.S.C. § 1141j. *Cf.* 37 C.F.R. § 2.172 (for registrations under §§ 1 and 44, a deletion of fewer than all the goods or services in a single class constitutes an amendment of the registration as to that class, not a surrender.).

7. *See*TMEP § 1904.15.

605.03(c) With Amendment of Plaintiff's Pending Application

The plaintiff in an inter partes proceeding before the Board may own a pending application for registration that has been rejected by the examining attorney in view of the defendant's subject registration, or which may be rejected by the examining attorney when and if defendant's subject application matures to registration. In such a case, a settlement agreement may be contingent upon the approval of an amendment to be filed in the plaintiff's application, or acceptance of a consent agreement to be filed therein, and the consequent approval of the application for publication.

The Board has no jurisdiction over a plaintiff's application which is still pending before the examining attorney. [Note 1.] Thus, when the plaintiff in an inter partes proceeding before the Board owns an application which is still pending before the trademark examining attorney, and an amendment or consent agreement is filed in the application pursuant to a settlement agreement between the parties, the amendment should be filed with the examining attorney, not with the Board. The examining attorney should consider the amendment or agreement and take appropriate action (including, if the amendment or consent agreement puts the application in condition for publication, approving the application for publication), notwithstanding the fact that action on the application may previously have been suspended pending the final determination of the inter partes proceeding before the Board. Indeed, if settlement of the inter partes proceeding is contingent upon approval of the amendment, or acceptance of the consent agreement by the examining attorney, proceedings before the Board may be suspended pending action by the examining attorney on the amendment or consent agreement. *See*TBMP § 510.03(a).

NOTES:

1. *See Home Juice Co. v. Runglin Cos.*, 231 USPQ 897, 898 n.7 (TTAB 1986) (Board cannot instruct examining attorney to pass application to registration).

605.03(d) Breach of Settlement Agreement

If an agreement settling an inter partes proceeding before the Board is breached by one of the parties, an adverse party's remedy is by way of civil action. The Board has no jurisdiction to enforce such an agreement. However, while the Board does not have jurisdiction to enforce the contract, agreements to cease use of a mark or not to use a mark in a certain format are routinely upheld and enforced to the extent a party may not obtain a registration for exclusive use that may be precluded by the terms of a settlement agreement. [Note 1.]

NOTES:

1. *See Bausch & Lomb, Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1528 (TTAB 2008) (registration refused where agreement recited the parties' rights to the marks containing a common term and applicant's use was not expressly authorized); *Vaughn Russell Candy Co. and Toymax Inc. v. Cookies in Bloom Inc.*, 47 USPQ2d 1635, 1638 n.6 (TTAB 1998) (registration refused where settlement agreement precluded use of a portion of applicant's mark); *In re Sun Refining and Marketing Co.*, 23 USPQ2d 1072,

1074 (TTAB 1991) (refusal affirmed since settlement agreement containing geographic restrictions clearly showed that applicant was not entitled to unrestricted registration). *Cf. Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *5 (Fed. Cir. 2020) ("Contracting away one's rights to use a trademark does not preclude a petitioner from challenging a mark before the Board.").

605.03(e) Effect of Judgment Based Upon Agreement

For information concerning the effect of agreements and judgments resulting therefrom, see cases cited in the note below. [Note 1.] For information concerning the effect of agreements, including consent judgments, that resolve court challenges to Board decisions under 15 U.S.C § 1071(b) and include agreed vacaturs, see TBMP § 544 and note 13 thereto.

NOTES:

1. *Kimberly-Clark Corp. v. Fort Howard Paper Co.*, 772 F.2d 860, 227 USPQ 36, 39 (Fed. Cir. 1985) (construction of 1924 agreement found that goods in current application not encompassed within agreement, registration permitted); *Chromalloy American Corp. v. Kenneth Gordon (New Orleans), Ltd.*, 736 F.2d 694, 222 USPQ 187, 191 n.4 (Fed. Cir. 1984) (unless principles of res judicata apply, consent given in a decree should be treated as any other contractual consent and as a factor to be taken into consideration in determining likelihood of confusion); *Wells Cargo, Inc. v. Wells Cargo, Inc.*, 606 F.2d 961, 203 USPQ 564, 567 (CCPA 1979) (although agreement can be implied from applicant's withdrawal of application with consent and with prejudice in prior opposition, that agreement was not itself a settlement of the substantive rights of the parties and estoppel does not rest on that agreement but instead on the act of withdrawing the application with prejudice); *Danskin, Inc. v. Dan River, Inc.*, 498 F.2d 1386, 182 USPQ 370, 372 (CCPA 1974) (equitable estoppel barring opposition rested on terms of the agreement between parties in settlement of prior proceeding); *United States Olympic Comm. v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984) (abandonment of application without consent in prior opposition does not operate as res judicata when different marks were involved in subsequent proceeding). *See also Epic Metals Corp. v. H.H. Robertson Co.*, 870 F.2d 1574, 10 USPQ2d 1296, 1299 (Fed. Cir. 1989) (district court erred in construction of consent judgment); *Hartley v. Mentor Corp.*, 869 F.2d 1469, 10 USPQ2d 1138, 1142 (Fed. Cir. 1989) (intent of the parties is generally controlling with respect to preclusive effect of stipulated judgment).

605.03(f) Consent Orders

The Board will dismiss, sustain, etc., a Board inter partes proceeding, if the parties so stipulate and will also enter judgment against a party which submits its written consent to entry of judgment against itself, or which concedes that its case is not well taken. *See*TBMP § 605.03(a). Further, the Board encourages the use of stipulated evidence in Board inter partes proceedings. [Note 1.] *See*TBMP § 705. However, the Board does not issue advisory opinions. Nor does the Board issue consent orders.

NOTES:

1. *See* 37 C.F.R. § 2.123(b).

606 Effect on Counterclaim

If, prior to the determination of a counterclaim, the parties stipulate to the disposition of the claim against which the counterclaim was brought, or the original claim is withdrawn, dismissed for failure to prosecute,

or otherwise disposed of, the counterclaim will nevertheless go forward, unless the parties stipulate to its disposition, or it is withdrawn by the counterclaimant, or one party consents to entry of judgment against itself on the counterclaim, etc. [Note 1.] *Cf.*TBMP § 901.02(a).

NOTES:

1. *See, e.g., Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (opposition dismissed with prejudice; applicant elected to go forward with counterclaim to cancel opposer's registration and had standing to do so). *Cf. Delaware Quarries, Inc. v. PlayCore IP Sub, Inc.*, 108 USPQ2d 1331, 1332 (TTAB 2013) (dismissal of likelihood of confusion claim did not implicate applicant's standing to have asserted its cancellation counterclaim, nor did it moot the proceeding).

Chapter 700 TRIAL PROCEDURE AND INTRODUCTION OF EVIDENCE

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701 Time of Trial

37 C.F.R. § 2.116

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

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

(d) *The assignment of testimony periods corresponds to setting a case for trial in court proceedings.*

(e) *The submission of notices of reliance, declarations and affidavits, as well as the taking of depositions during the assigned testimony periods corresponds to the trial in court proceedings.*

37 C.F.R. § 2.121 ***Assignment of times for taking testimony and presenting evidence.***

(a) *The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's required pretrial disclosures and assigning to each party its time for taking testimony and presenting evidence ("testimony period"). No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. The deadlines for pretrial disclosures and the testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion to reschedule any pretrial disclosure deadline and/or testimony period is denied, the pretrial disclosure deadline or testimony period and any subsequent remaining periods may remain as set. The resetting of the closing date for discovery will result in the rescheduling of pretrial disclosure deadlines and testimony periods without action by any party. The resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party.*

* * * *

(b)(1) *The Trademark Trial and Appeal Board will schedule a testimony period for the plaintiff to present its case in chief, a testimony period for the defendant to present its case and to meet the case of the plaintiff, and a testimony period for the plaintiff to present evidence in rebuttal.*

(2) *When there is a counterclaim, or when proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another of the involved proceedings, or when there is an interference or a concurrent use registration proceeding involving more than two parties, the Board will schedule testimony periods so that each party in the position of plaintiff will have a period for presenting its case in chief against each party in the position of defendant, each party in the position of defendant will have a period for presenting its case and meeting the case of each plaintiff, and each party in the position of plaintiff will have a period for presenting evidence in rebuttal.*

(c) *A testimony period which is solely for rebuttal will be set for fifteen days. All other testimony periods will be set for thirty days. The periods may be shortened or extended by stipulation of the parties approved by the Trademark Trial and Appeal Board, or may be extended upon motion granted by the Board, or by*

order of the Board. If a motion for an extension is denied, the testimony periods and their associated pretrial disclosure deadlines may remain as set.

(d) *When parties stipulate to the rescheduling of a deadline for pretrial disclosures and subsequent testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of subsequent deadlines for pretrial disclosures and testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, shall be submitted to the Board through ESTTA, with the relevant dates set forth and an express statement that all parties agree to the new dates.*

(e) … *[N]o later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. The testimony of a witness may be taken upon oral examination and transcribed, or presented in the form of an affidavit or declaration, as provided in § 2.123. Pretrial disclosure of a witness under this paragraph (e) does not substitute for issuance of a proper notice of examination under § 2.123(c) or § 2.124(b). If a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure.*

On receipt of a properly filed notice of opposition or petition to cancel, or for a concurrent use proceeding which is not based on a court decision or a prior Board decision, *see*TBMP § 1106.04, the Board serves the complaint on the defendant in the form of a link to, or web address for, TTABVUE in the notice advising the parties of the institution of the proceeding. The notice includes a trial order setting deadlines for the answer, discovery conference, initial and expert disclosures, discovery, and each party's required pretrial and rebuttal disclosures, and assigning each party's trial period (referred to as the "testimony period" or "rebuttal period"), during which the party may take testimony and introduce other evidence in the case. [Note 1.] *See*TBMP § 310.01 (oppositions and cancellations); TBMP § 1007 (interferences) and TBMP § 1106.04 (concurrent use proceedings). *See also*TBMP § 403.01.

In the trial order, the Board schedules a 30-day testimony period for the plaintiff to present its case in chief, a 30-day testimony period for the defendant to present its case and to meet the case of the plaintiff, and a 15-day testimony period for the plaintiff to present rebuttal testimony and evidence. [Note 2.] The plaintiff's period for presenting its case in chief is scheduled to open 60 days after the close of the discovery period; the defendant's testimony period is scheduled to open 30 days after the close of the plaintiff's testimony period in chief; and the plaintiff's rebuttal testimony period is scheduled to open 30 days after the close of the defendant's testimony period. [Note 3.] The trial order also schedules the time for pretrial and rebuttal disclosures of witnesses: each party must make pretrial or rebuttal disclosures no later than fifteen days prior to the opening of its testimony or rebuttal period, respectively. [Note 4.]

If there is a counterclaim, or if proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another, or if there is an interference or a concurrent use registration proceeding involving more than two parties, the Board schedules testimony periods as specified in 37 C.F.R. § 2.121(b)(2), i.e., giving each plaintiff a period for presenting its case in chief as against each defendant, giving each defendant a period for presenting its case and meeting the case of each plaintiff, and giving each plaintiff a period for rebuttal. The testimony periods are separated from the discovery period by a 60-day interval, and from each other by 30-day intervals. [Note 5.] In an interference or concurrent use proceeding, a junior party is in the position of plaintiff and a senior party is in the position of defendant. [Note 6.] *See*TBMP § 1005, TBMP § 1007 and TBMP § 1108.

A party may not take testimony or present evidence outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board. [Note 7.]

Testimony periods may be rescheduled, extended, shortened, reopened, or bifurcated by stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board. [Note 8.] See TBMP § 501 and TBMP § 509 regarding stipulations and motions to extend or reopen. A stipulation or consented motion to reschedule a deadline for pretrial disclosures and subsequent testimony periods or to reschedule the closing date for discovery and to reschedule subsequent deadlines for pretrial disclosures and testimony periods must be submitted to the Board through ESTTA and must be presented in the form used in a trial order with the relevant dates set forth, specifying the deadline for each subsequent period, including, as applicable, the deadline for initial, expert and pretrial disclosures, the closing date for discovery and testimony periods, and an express statement that the parties agree to the new dates. [Note 9.] It is preferable, where such a motion is unconsented, that the motion request that the new deadlines be determined, and any period or periods be set to run, from the date of the Board's decision on the motion. *See*TBMP § 509.02.

The resetting of the closing date for discovery results in the automatic rescheduling of pretrial disclosure deadlines and testimony periods, without action by any party. Likewise, the resetting of a party's testimony period results in the automatic rescheduling of the remaining pretrial disclosure deadlines without action by any party. [Note 10.] For information regarding extensions of the discovery period and time to respond to discovery requests, see TBMP § 403.04.

In Board inter partes proceedings, the submission of evidence and testimony during the parties' assigned testimony periods corresponds to the trial in court proceedings. [Note 11.] The trial period commences with the opening of the first testimony period. [Note 12.] *See*TBMP § 504.01. *Cf.*TBMP § 528.02. An oral hearing, if requested, corresponds to oral summation in court proceedings. [Note 13.] *See*TBMP § 802.

The Board may sua sponte enter judgment for the defendant in cases where the plaintiff has not submitted evidence or taken testimony during its assigned testimony period where it is clear that the plaintiff has not offered any other evidence. [Note 14.]

NOTES:

1. *See* 37 C.F.R. § 2.120(a) and 37 C.F.R. § 2.121.

2. *See* 37 C.F.R. § 2.121(b)(1) and 37 C.F.R. § 2.121(c).

3. *See Stagecoach Properties, Inc. v. Wells Fargo & Co.*, 199 USPQ 341, 356 (TTAB 1978) (thirty-day interval between each testimony period), *aff'd*, 685 F.2d 302, 216 USPQ 480 (9th Cir. 1982).

4. *See* 37 C.F.R. § 2.121(e).

5. *See* 37 C.F.R. § 2.121(b)(2) and 37 C.F.R. § 2.121(c). Sample trial schedules can be found in the Appendix of Forms.

6. *See* 37 C.F.R. § 2.99(e).

7. 37 C.F.R. § 2.121(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is amending § 2.121(a) to

clarify that evidence must be presented during a party's testimony period, codifying current Office practice."). *See also Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 71345, at *2 (TTAB 2020) ("a party may introduce testimony and evidence only during its assigned testimony period"); *Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *2 n.3 (TTAB 2020) (parties stipulated that any declaration or affidavit shall be admissible even though executed before and not during the testimony period of a party); *Optimal Chemical Inc. v. Srills LLC*, 2019 USPQ2d 338409, at *3 n.28 (TTAB 2019) (submission of exhibits to the notice of reliance one month after the rebuttal period was untimely; however, since respondent did not object to their timeliness, the procedural objection was waived); *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *4 n.23 (TTAB 2019) (three year old declaration from application file was not of record as trial testimony as it was not executed (taken) during petitioner's testimony period; declaration submitted with summary judgment reply brief that was executed several months before trial was not trial testimony and was not considered because it was not affirmed by other trial testimony that attested to its accuracy), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019); *Baseball America Inc. v. Powerplay Sports*, 71 USPQ2d 1844, 1846 n.8 (TTAB 2004) (documentary evidence submitted outside assigned testimony period given no consideration); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1786 n.4 (TTAB 2002) (parties stipulated that exhibits to their notices of reliance could be submitted after the close of each party's testimony period); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1072 (TTAB 1990) (untimely deposition stricken); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 747 n.4 (TTAB 1986) (opposer's discovery deposition of non-party witness treated as testimony deposition taken by stipulation prior to trial); *Fischer GmbH. v. Molnar & Co.*, 203 USPQ 861, 867 (TTAB 1979) (discovery deposition of non-party inadmissible as evidence under a notice of reliance filed by one party without express or implied consent of adverse party; should have taken deposition during trial period or at least moved to take trial testimony prior to assigned testimony period).

Cf. International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère, 2020 USPQ2d 10892, at *3 n.12 (TTAB 2020) (declarations signed prior to testimony period and submitted by opposers as trial testimony considered to have been properly submitted because applicants did not object to them as untimely and treated them as part of the record by raising substantive objections against them), *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020); *Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to the opening of opposer's testimony period, but applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected on seasonable objection).

8. Fed. R. Civ. P. 6(b); 37 C.F.R. § 2.121(a), 37 C.F.R. § 2.121(c) and 37 C.F.R. § 2.121(d). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is amending § 2.121(c) to add that testimony periods may be shortened by stipulation of the parties approved by the Board or may be extended on motion granted by the Board or order of the Board."). *See, e.g., AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at p.*3 (TTAB 2020) (parties stipulated to an initial trial phase directed to standing, and if standing was resolved in opposer's favor, a subsequent trial phase directed to the remaining issues in the proceeding); *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000) (motion to extend testimony filed on last day with vague references to settlement and no detailed information concerning apparent difficulty in identifying and scheduling its witnesses for testimony denied); *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1760 (TTAB 1999) (motion to extend denied where sparse motion contained insufficient facts on which to find good cause); *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998) (motion to reopen to submit new evidence denied); *Pumpkin Ltd v. The Seed Corps*, 43 USPQ2d 1582, 1588 (TTAB 1997) (motion to reopen filed over three months after close of testimony period, due to a docketing error, denied).

9. *See* 37 C.F.R. § 2.121(d). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is amending § 2.121(d) to add that stipulations to reschedule the deadlines for the closing date of discovery, pretrial disclosures, and testimony periods must be submitted through ESTTA with the relevant dates set forth and an express statement that all parties agree to the new dates. These amendments codify current Office practice.").

10. *See* 37 C.F.R. § 2.121(a). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is amending § 2.121(a) to clarify that evidence must be presented during a party's testimony period. The Office is further amending § 2.121(a) to add that the resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party. These amendments codify current Office practice.").

11. *See* 37 C.F.R. § 2.116(e). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69959 (October 7, 2016) ("The Office is amending § 2.116(e) to add that the submission of notices of reliance, declarations, and affidavits, as well as the taking of depositions, during the testimony period corresponds to the trial in court proceedings. The revision codifies current Office practice and is consistent with amendments relating to declarations and affidavits."); *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) (Board proceedings approximate the proceedings in a courtroom trial); *Time Warner Entertainment Company v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002) (trial in a Board proceeding takes place during the testimony periods).

12. 37 C.F.R. § 2.121(a).

13. 37 C.F.R. § 2.116(f).

14. 37 C.F.R. § 2.132(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (October 7, 2016) ("The Office is amending § 2.132(a) to clarify that, if a plaintiff has not submitted evidence and its time for taking testimony has expired, the Board may grant judgment for the defendant sua sponte.").

702 Pretrial Disclosures; Manner of Trial; and Introduction of Evidence

37 C.F.R. § 2.121 ***Assignment of times for taking testimony and presenting evidence.***

(a) *... The resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party.*

(e) *A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. However, no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. The testimony of a witness may be taken upon oral examination and transcribed, or presented in the form of an affidavit or declaration, as provided in § 2.123. Pretrial disclosure of a witness under this paragraph (e) does not*

substitute for issuance of a proper notice of examination under § 2.123(c) or § 2.124(b). If a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure. When a party fails to make required pretrial disclosures, any adverse party or parties may have remedy by way of a motion to the Board to delay or reset any subsequent pretrial disclosure deadlines and/or testimony periods. A party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. When testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion to strike, as provided in §§ 2.123 and 2.124.

37 C.F.R. § 2.123(e)(3) *If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.*

(i) *A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e).*

(ii) *A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

Fed. R. Civ. P. 26(a)(3) Pretrial Disclosures.

(A) ***In General.*** *In addition to the disclosures required by Rule 26(a)(1) and (2), a party must provide to the other parties and promptly file the following information about the evidence that it may present at trial other than solely for impeachment:*

(i) *the name and, if not previously provided, the address and telephone number of each witness — separately identifying those the party expects to present and those it may call if the need arises;*

(ii) *the designation of those witnesses whose testimony the party expects to present by deposition and, if not taken stenographically, a transcript of the pertinent parts of the deposition; and*

(iii) *an identification of each document or other exhibit, including summaries of other evidence — separately identifying those items the party expects to offer and those it may offer if the need arises.*

702.01 Pretrial Disclosures

Pretrial disclosures are governed by 37 C.F.R. § 2.121(e) and Fed. R. Civ. P. 26(a)(3) with one exception: the Board does not require pretrial disclosure of each document or other exhibit that a party plans to introduce at trial as provided by Fed. R. Civ. P. 26(a)(3)(A)(iii). [Note 1.] Disclosures allow parties to know prior to trial the identity of trial witnesses, thus avoiding surprise witnesses. [Note 2.]

Because the trial schedule in a Board proceeding employs alternating testimony periods with gaps between them, the due dates for pretrial disclosures will be different for each party and will be specified in the Board's notice instituting the proceeding. [Note 3.] Under 37 C.F.R. § 2.121(e), the party scheduled to present evidence must make pretrial disclosures no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board. Witnesses who are expected to or may testify must be disclosed under Fed. R. Civ. P. 26(a)(3)(A). [Note 4.]

In making its pretrial disclosures, the party must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony

if the need arises. [Note 5.] The party must disclose general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. [Note 6.]

Pretrial disclosure of a witness under 37 C.F.R. § 2.121(e) does not substitute for issuance of a proper notice of examination under 37 C.F.R. § 2.123(c) or 37 C.F.R. § 2.124(b). [Note 7.]

If a party does not plan to take testimony from any witnesses in any form, it must so state in its pretrial disclosure. [Note 8.]

When a party fails to make required pretrial disclosures, any adverse party or parties may have remedy by way of a motion to the Board to delay or reset any subsequent pretrial disclosure deadlines and/or testimony periods. [Note 9.]

A party may object to improper or inadequate pretrial disclosures. [Note 10.] *See*TBMP § 533.02(b).

The pretrial disclosure requirement cannot simply be ignored because some information about a testifying individual may be known by the adverse party or parties. [Note 11.]

A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. [Note 12.] Thus, each document or other exhibit that a party plans to introduce at trial does not need to be disclosed to the other party. [Note 13.] A party planning to introduce an adverse party's discovery deposition, or part thereof, need not disclose such plans. [Note 14.] For further information regarding the submission of discovery depositions under notice of reliance, see TBMP § 704.09.

If pretrial disclosures or the notice of examination of witnesses served pursuant to 37 C.F.R. § 2.123(c) are improper or inadequate with respect to any witness, an adverse party may move to quash a noticed testimony deposition of that witness before the deposition occurs. [Note 15.] The adverse party may also cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all relevant circumstances. [Note 16.] When testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion to strike. [Note 17.] A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with 37 C.F.R. § 2.121(e). [Note 18.] On the other hand, a motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony. [Note 19.]

If the deficiencies in the pretrial disclosure are technical in nature, the parties are encouraged to resolve the matter between themselves, or to bring the matter to the Board's attention promptly for resolution for judicial economy and before the parties incur the expense associated with taking a testimonial deposition. The Board allows parties to cure timely, but technically deficient matters. [Note 20.]

A party making a pretrial disclosure is not required to file routinely a copy of such disclosure with the Board. In this regard, the Board's practice varies slightly from that set forth in Fed. R. Civ. P. 26(a)(3)(A). Alerting

the Board to a party's witness list is not a purpose of the pretrial disclosure requirement, as the Board does not preside at the taking of testimony or at a pretrial conference. [Note 21.]

Parties may stipulate to waive the requirement for pretrial disclosures in ACR cases. [Note 22.]

The resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party. [Note 23.]

For information on pretrial disclosure of expert witnesses, see TBMP § 401.03 or for motions to strike the testimony of an expert witness, see TBMP § 533.02(b).

NOTES:

1. *See* 37 C.F.R. § 2.121(e). *Accord Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1103 (TTAB 2018).

2. *Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1372 (TTAB 2011) and *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009) (citing MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42257-58 (August 1, 2007)). *See, e.g., Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1099-1104 (TTAB 2018) (opposer's motion to strike pretrial disclosure of the identity of three witnesses denied--no surprise where one witness had been identified in initial and supplemental initial disclosures, and failure to disclose in supplemental initial disclosures the identities of the other two found substantially justified and harmless when applicant ascertained the identities shortly before serving pretrial disclosures, but applicant had listed the subject matter of their testimony in initial disclosures, and the record showed that opposer was aware of the witnesses and the pertinent information covered in their testimony declarations); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1267 (TTAB 2015) (both parties are required to serve initial disclosures identifying witnesses having discoverable information and to serve pretrial disclosures naming the witnesses expected to testify at trial); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1655 (TTAB 2014) (identity of trial witnesses may not be designated as confidential) *,appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016); *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012) (witness first identified in pretrial disclosure and not previously identified in initial disclosures, discovery responses or supplements resulted in unfair surprise and was neither harmless nor substantially justified); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327 (TTAB 2011) (failure to identify witnesses during discovery but named in pretrial disclosures resulted in unfair surprise to adversary).

3. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

4. 37 C.F.R. § 2.121(e). *Accord Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1100-01 (TTAB 2018). *See Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1267 (TTAB 2015); *Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1371-72 n.1 (TTAB 2011) ("A party is expected to disclose all witnesses it expects to call as well as those that it may call if the need arises").

5. 37 C.F.R. § 2.121(e). *See Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1099-1104 (TTAB 2018) (pretrial disclosures identifying three witnesses sufficient under the circumstances); *Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1371 (TTAB 2011) (pretrial disclosure adequate and sufficient); *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444-45 (TTAB 2009)

(under Trademark Rules, petitioner is required to name any witnesses from whom it intended to take testimony, or even might take testimony, if needed; 37 C.F.R. § 2.121(e) contemplates that contact information of a witness may previously have been provided to the party receiving a disclosure and need not be repeated). *Cf. Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *2-3 (TTAB 2020) (respondent's motion to strike rebuttal witness for failure to disclose denied where petitioner substituted its legal assistant for its previously disclosed attorney for same authentication purpose).

6. 37 C.F.R. § 2.121(e). *See Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1099-1104 (TTAB 2018) (applicant's pretrial disclosures identifying three witnesses sufficient under the circumstances); *See Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1300 (TTAB 2015) (respondent's pretrial disclosures defective to the extent that they fail to summarize the types of documents and things respondent intended to introduce as exhibits to his testimony; all forty-six exhibits attached thereto and all portions of respondent's testimony referring to the attached exhibits not considered); *Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1371 (TTAB 2011) (pretrial disclosure adequate and sufficient).

7. 37 C.F.R. § 2.121(e).

8. 37 C.F.R. § 2.121(e).

9. 37 C.F.R. § 2.121(e).

10. *See* 37 C.F.R. § 2.121(e) and 37 C.F.R. § 2.123(e)(3). *See also Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1655 (TTAB 2014) (identity of trial witnesses may not be designated as confidential), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016); *Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1372-73 n.4 (TTAB 2011). *Cf. Societe Des Produits Nestle S.A. v. Taboada*, 2020 USPQ2d 10893, at *7 (TTAB 2020) (objection that evidence was not adequately disclosed in pretrial disclosures overruled as untimely when first raised in trial brief; objection is curable and should have been made via motion to strike promptly after testimony declaration and exhibits were filed); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *1 n.2 (TTAB 2019) (petitioner's objection to respondent's erroneous reference to Fed. R. Evid. 702 in its second amended pretrial disclosures overruled as harmless; error did not void the disclosures or any of the referenced testimony because of clarification in an earlier disclosure of the error and none of its disclosed witnesses were experts).

11. *See Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009).

12. 37 C.F.R. § 2.121(e). *Accord Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1300 n.4 (TTAB 2015).

13. 37 C.F.R. § 2.121(e).

14. *See* 37 C.F.R. § 2.120(k)(1) ("The discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party.").

15. 37 C.F.R. § 2.121(e). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.121(e) to add that a party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. The amendment codifies current Office practice.").

16. 37 C.F.R. § 2.123(e)(3).

17. 37 C.F.R. § 2.121(e). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.121(e) to add that when testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion to strike…"). *See also Azalea Health Innovations, Inc. v. Rural Health Care, Inc.*, 125 USPQ2d 1236, 1240-41 (TTAB 2017) (granting opposer's motion to strike discovery deposition transcripts of non-party witnesses submitted by applicant under notice of reliance to impeach the witnesses' declaration trial testimony, where there was no stipulation to allow the non-party witnesses' discovery depositions, applicant did not elect oral cross-examination of the witnesses on their testimonial declarations, and applicant did not file a motion seeking Board approval to use the discovery depositions, or a motion claiming exceptional circumstances). *Cf. Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *2-3 (TTAB 2020) (respondent's motion to strike declaration of rebuttal witness denied where petitioner substituted its legal assistant for its previously disclosed attorney for same authentication purpose); *Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1099-1104 (TTAB 2018) (denying opposer's motion to strike pretrial disclosure of the identity of three witnesses where one witness had been identified in initial and supplemental initial disclosures and failure to disclose earlier the identities of the other two found substantially justified and harmless).

18. 37 C.F.R. § 2.123(e)(3)(i). *See Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1099-1104 (TTAB 2018) (denying opposer's motion to strike pretrial disclosure of the identity of three witnesses where one witness had been identified in initial and supplemental initial disclosures and failure to disclose earlier the identities of the other two found substantially justified and harmless); *Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1300 (TTAB 2015) (respondent's improper service of pretrial disclosures at counsel for petitioner's former address held harmless to the extent the disclosure identified a single witness, respondent himself); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1655 (TTAB 2014) (identity of trial witnesses may not be designated as confidential), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327-28 (TTAB 2011) (Opposer's failure to name one witness until original pretrial closures and twenty-six witnesses until supplement to amended pretrial disclosures was neither harmless nor substantially justified and motion to quash granted as to twenty-six witnesses but testimony of one witness, identified months before in original pretrial disclosure, not excluded provided adverse party be given an opportunity to take a discovery deposition); *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009) (failure to disclose testimony witness in initial disclosures considered as a relevant circumstance in determining whether to strike testimony deposition). *Cf. Empresa Cubana Del Tabaco d.b.a Cubatabaco v. General Cigar Co., Inc.*, 2020 USPQ2d 10988, at *3 (TTAB 2020) (supplemental expert report stricken as untimely and improper supplementation under Fed. R. Civ. P. 26(e) because failure to disclose supplemental report not substantially justified or harmless).

19. 37 C.F.R. § 2.123(e)(3)(ii).

20. *See Carl Karcher Enterprise, Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1372-73 n.4 (TTAB 2011). *Cf. Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327 (TTAB 2011) (applicant could not cure surprise without moving to quash, or seeking to reopen discovery, or engaging in unplanned preparation to cross-examine witnesses identified for the first time in pretrial disclosures).

21. *See Carl Karcher Enterprises Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1372-73 (TTAB 2011).

22. *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2002 n.5 (TTAB 2015) (where neither party served pretrial disclosures and the parties' ACR stipulation did not provide for the exchange of pretrial disclosures, motion to strike witness declaration denied).

23. 37 C.F.R. § 2.121(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.121(a) to add that the resetting of a party's testimony period will result in the rescheduling of the remaining pretrial disclosure deadlines without action by any party. These amendments codify current Office practice.").

702.02 Introduction of Evidence

37 C.F.R. § 2.122(a) ***Applicable rules.*** *Unless the parties otherwise stipulate, the rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part. When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

37 C.F.R. § 2.120(k)(7) *When a written disclosure, a discovery deposition, or part thereof, or an answer to an interrogatory, or an admission, or an authenticated produced document has been made of record by one party in accordance with the provisions of paragraph (k)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

Unless the parties otherwise stipulate, the introduction of evidence in inter partes proceedings before the Board is governed by the Federal Rules of Evidence, the relevant portions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the rules of practice in trademark cases (i.e., the provisions of Part 2 of Title 37 of the Code of Federal Regulations). [Note 1.] *Cf.*TBMP § 101.01 and TBMP § 101.02. When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. [Note 2.]

Within the parameters of these rules, there are a number of ways to introduce evidence into the record in a proceeding before the Board. Evidence may be introduced either in the form of testimony depositions taken by a party during its testimony period or in the form of affidavits or declarations subject to the right of the adverse party to conduct cross-examination. Documents and other exhibits may be made of record with appropriate identification and introduction by the witness during the course of the testimony deposition or in a testimony affidavit or declaration. See generally TBMP § 703.01 regarding affidavits, declarations and oral testimony depositions and TBMP § 703.02 regarding testimony depositions on written questions. *See also* TBMP § 704.13 regarding introducing testimony from another proceeding, and TBMP § 530 regarding motions to use testimony from another proceeding. Certain specified types of evidence, including official records and printed publications as described in 37 C.F.R. § 2.122(e) and discovery responses under 37 C.F.R. § 2.120(k), may, but need not, be introduced in connection with the testimony of a witness. Such evidence may instead be made of record by filing the materials with the Board under cover of a notice of reliance during the testimony period of the offering party. [Note 3.] See generally TBMP § 704.02 regarding the types of evidence that may be submitted by notice of reliance and the requirements for the introduction of such evidence by notice of reliance. In addition, the parties may enter into a wide variety of stipulations concerning the timing and/or introduction of specified matter into evidence. *See*TBMP § 705 regarding stipulated evidence. For example, the parties may stipulate that matter otherwise improper for a notice of reliance (such as documents obtained by production under Fed. R. Civ. P. 34) may be introduced in that manner, that a party may rely on its own discovery responses or that notices of reliance can be filed after

the testimony periods have closed. There may also be circumstances where improperly offered or otherwise noncomplying evidence may nevertheless be deemed stipulated into the record where, for example, no objection to the evidence is raised and/or the nonoffering party treats the evidence as being of record. [Note 4.] See generally TBMP § 704 regarding the introduction of other evidence, and TBMP § 704.11 n.9 regarding materials deemed stipulated into the record.

A discussion of the time and manner of taking testimony depositions, presenting testimony in affidavit or declaration form, and introducing evidence is presented in the sections that follow.

NOTES:

1. 37 C.F.R. § 2.122(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is amending § 2.122(a) to clarify the heading of the paragraph and to specify that parties may stipulate to rules of evidence for proceedings before the Board."). *See also Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (citing TBMP § 702.02 to support a finding that Board did not abuse its discretion in determining that a party submitted no evidence).

2. 37 C.F.R. § 2.122(a) and 37 C.F.R. § 2.120(k)(7). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) (amended effective January 14, 2017 to codify current Board practice). *See, e.g., Nazon v. Ghiorse*, 119 USPQ2d 1178, 1181 n.6 (TTAB 2016) ("Once evidence is properly of record, it may be relied on by any party for any purpose.").

3. *See Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1786 n.4 (TTAB 2002) (notices of reliance must be filed before closing date of party's testimony period).

4. *See, e.g., International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *3 n.12 (TTAB 2020) (declarations signed prior to testimony period and submitted by opposers as trial testimony considered to have been properly submitted because applicants did not object to them as untimely, and, in fact, treated them as part of the record by raising substantive objections against them), *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020); *Optimal Chemical Inc. v. Srills LLC*, 2019 USPQ2d 338409, at *14 n.90 (TTAB 2019) (Board considered Internet evidence for the truth of the matters asserted where the petitioner did not object and opined on its accuracy in its rebuttal testimony and rebuttal brief); *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1787 n.5 (TTAB 2018) (because petitioner referred to and relied on respondent's initial disclosures in presenting its case-in-chief, Board considered them stipulated into record); *WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1038 (TTAB 2018) (portions of Internet evidence deemed stipulated into record where both parties submitted printouts via notices of reliance and each accepted as fact those portions); *Executive Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1176 n.9 (TTAB 2017) ("because both parties introduced responses to document requests by notice alone and neither party objected, we will treat the responses as being stipulated into the record"); *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1603, n.3 (TTAB 2010), *aff'd-in-part, rev'd-in-part and remanded on other grounds*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012).

702.03 Manner of Trial

Because the Board is an administrative tribunal, its rules and procedures differ in some respects from those prevailing in the federal district courts. [Note 1.] *See*TBMP § 102.03 regarding Board proceedings in general and TBMP § 502.01 regarding motions that may be filed at the Board. For example, in lieu of live testimony,

proceedings before the Board are conducted in writing, and the Board's actions in a particular case are based on the written record therein. [Note 2.] The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board, by affidavit or declaration, or on oral examination or written questions, and the affidavits, declarations and written deposition transcripts, together with any exhibits thereto, are then submitted to the Board. [Note 3.]

Depositions may be noticed for any reasonable place in the United States. [Note 4.] As a result, parties do not have to travel to the offices of the Board, or to the geographic area surrounding the Board's offices, to take their testimony. Plaintiffs also have the option of presenting witness testimony in affidavit or declaration form subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination of that witness. [Note 5.] Any redirect and recross is to be taken at the same time as the oral cross-examination. [Note 6.] *See*TBMP § 703.01(b) and TBMP § 703.01(h). Depositions and oral cross-examinations of deponents and affiants must be noticed for a reasonable place. [Note 7.] Depositions and oral cross-examinations may be conducted by telephone or videoconference if the parties so agree. [Note 8.] A party to a proceeding before the Board need never come to the offices of the Board at all, unless the party wishes to argue its case at oral hearing at the offices of the Board, or unless otherwise ordered by the Board.

An oral hearing is held only if requested by a party to the proceeding. [Note 9.] *See*TBMP § 802.02.

Submissions made during the course of an inter partes proceeding are stored in electronic form and are available for viewing on the Board home page of the USPTO website via TTABVUE (**http://ttabvue.uspto.gov**). Filings in Board proceedings are made electronically via ESTTA, and in the rare circumstances that filing in paper form is permitted under the rules, such paper submissions are scanned into the electronic record. The electronic record constitutes the official record of the proceeding. *See*TBMP § 120. No document, exhibit, etc., whether submitted electronically or as paper, will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules, *see*TBMP § 706, [Note 10], or the parties stipulate or otherwise treat the evidence as being of record, *see*TBMP § 702.02.

For a further discussion regarding viewing and obtaining Board records, see TBMP § 121.

If the parties to a proceeding desire to obtain a final resolution of a proceeding prior to the scheduled trial period, they may consider Accelerated Case Resolution ("ACR"). For information on ACR, see TBMP § 528.05(a)(2), TBMP § 702.04 and TBMP § 705.

NOTES:

1. *See Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976). For a general discussion of inter partes proceedings before the Board, see *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015).

2. 37 C.F.R. § 2.191. *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015).

3. *See B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *3 n.6 (TTAB 2019) ("Under the amended Rules, trial testimony is still not 'in court' or taken 'live' before the Board.");

Hewlett-Packard Co. v. Healthcare Personnel Inc., 21 USPQ2d 1552, 1553 (TTAB 1991); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976).

4. *See* 37 C.F.R. § 2.123(a)(1) and 37 C.F.R. § 2.123(c). *See, e.g.*, *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *1 n.3 (TTAB 2019) (Board ordinarily finds the vicinity of the witness' place of business or domicile to be a reasonable place for oral cross-examination). *Cf. USPS v. RPost Communication Ltd.*, 124 USPQ2d 1045, 1047-48 (TTAB 2017) (notice of election of oral cross-examination requiring declarants to travel from Washington, DC, where they live and work, to Santa Monica, CA quashed because not noticed for reasonable place).

5. 37 C.F.R. § 2.123(a)(1). *See Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *3 (TTAB 2019) (a respondent who takes testimony by declaration bears the expense of producing its witnesses for oral cross-examination while a petitioner must schedule the witnesses and bear the expense of the court reporter); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1166 (TTAB 2017) (party seeking oral cross-examination of affiant or declarant bears cost of its own travel and attorney expenses, the court reporter, and, if necessary, the venue). *Cf. WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037 (TTAB 2018) (opposer's objection to applicant's testimony declarations overruled where applicant provided notice to opposer via pretrial disclosures about witnesses and the subject matter of their anticipated testimony, testimony declarations were timely served, and opposer had opportunity but chose not to cross-examine the witnesses).

6. *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *4-5 (TTAB 2020) (overruling objection to redirect examination of a testimony declarant after oral cross-examination).

7. *See Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *1 n.3 (TTAB 2019) (Board ordinarily finds the vicinity of the witness' place of business or domicile to be a reasonable place for oral cross-examination). *Cf. USPS v. RPost Communication Ltd.*, 124 USPQ2d 1045, 1047-48 (TTAB 2017) (notice of election of oral cross-examination requiring declarants to travel from Washington, DC, where they live and work, to Santa Monica, CA quashed because not noticed for reasonable place).

8. *See Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *3 (TTAB 2019) (granting petitioner's alternate motion to take oral cross-examination by telephone or remotely by other means, due to concern about travel and accommodation expense); *USPS v. RPost Communication Ltd.*, 124 USPQ2d 1045, 1048 (TTAB 2017) (notice of election of oral cross-examination of declarants quashed because not noticed for reasonable place, but applicant may accept opposer's offer to make witnesses available for oral cross-examination by videoconference or telephone, thus alleviating some concern about travel and attorney expenses).

9. *See* 37 C.F.R. § 2.129(a).

10. *See* 37 C.F.R. § 2.123(k).

702.04 Accelerated Case Resolution

702.04(a) In General

Accelerated Case Resolution ("ACR") is an alternative to typical Board inter partes proceedings with full discovery, trial and briefing, in which parties to a Board proceeding can obtain a determination of the claims and defenses in their case in a shorter time period than contemplated in the typical Board proceeding. The

form of ACR can vary, but the process generally approximates a summary bench trial or cross-motions for summary judgment and accompanying evidentiary submissions that the parties agree to submit in lieu of creating a traditional trial record [Note 1] and traditional briefs at final hearing. Other approaches to accelerating resolution of a case include simplifying proceedings through the use of fact stipulations and stipulations regarding the admissibility of certain evidence. [Note 2.] Clearly worded stipulations are vital, regardless of the ACR form. [Note 3.] Oral hearings generally are available in ACR cases in accordance with 37 C.F.R. § 2.129(a). *See*TBMP § 802. If parties agree to conduct the case as an ACR case and to utilize the bench trial or cross-motions for summary judgment model, and the Board approves trial of the case by ACR, the Board generally will render a final decision within fifty (50) days following the completion of briefing.

By reducing the complexity of a case and total time expended in litigating a case, ACR is a more efficient and economical alternative to the typical Board inter partes proceeding. Not all Board cases involve complicated or disputed facts or require the full discovery and trial periods set out by the Trademark Rules, to arrive at a final determination. Parties may therefore save time and expense by focusing only on those issues genuinely in dispute, and opting for ACR early in the proceeding. For example, if the parties stipulate to facts, no time need be spent proving those facts (although there may be some typical costs involved in preparing and exchanging documents and other materials that illustrate for the involved parties that facts are not genuinely in dispute and therefore can be stipulated). When the issues in a proceeding are limited, savings can be even greater, because all aspects of the proceeding, including discovery, trial and briefing, are focused on such limited matters. While many of the changes to the Board's rules in 2017 were adopted with an eye towards smoother and more efficient inter partes proceedings, parties are encouraged to continue to explore whether ACR is useful to them, and to craft stipulations that work for them and accelerate the timing of the Board's final decision. [Note 4.]

The Board is willing to consider almost any claim under ACR unless the complexity or novelty of the facts and/or legal theory of the case requires a full trial. However, the most appropriate cases for ACR are those in which, for example, little discovery is necessary, the parties are able to stipulate to many facts, each party expects to rely on the testimony of one or two witnesses, or the overall record will not be extensive. [Note 5.] ACR may not be suited to cases that generate a large record, complicated factual or legal issues, or cases where the parties are unwilling to stipulate to any matters (i.e., limitations on discovery or trial schedules, the absence of any genuine dispute about particular facts, or entry of evidence into the record).

ACR presently can be implemented only by consent of the parties and agreement by a Board attorney or judge, and will not be approved by unilateral motion of one party. ACR can also be implemented by all parties accepting an invitation or suggestion from a Board attorney or judge to participate in the process. [Note 6.] The parties are required to discuss the possibility of using ACR in their discovery conference and may seek the assistance of the Board in structuring their case so that it qualifies for ACR and the Board's objective to render a decision within fifty days (50) from the completion of briefing. [Note 7.]

Parties seeking to optimize their chances for early determination of their case and savings in their resources are advised to opt for ACR early in the proceeding. To opt for ACR, the parties may jointly file a statement indicating their desire to proceed under ACR along with a proposed modified schedule which may include an abbreviated discovery period and/or briefing period under any form of ACR. The assigned attorney may, and likely will, then convene a conference by telephone to discuss the proceeding with the parties and explore how they wish to proceed under ACR. The parties may seek Board assistance when contemplating ACR to determine which form of ACR to follow and/or determine the discovery, trial and briefing schedule. Any modified discovery, trial and briefing schedule, including limits on discovery or discovery devices or trial, must be negotiated by the parties and approved by the Board. If, however, the parties choose to follow the traditional discovery and trial schedule, but merely wish to stipulate to particular facts or that particular

items of evidence shall be considered by the Board, they may so agree and file their written agreement with the Board without need of a conference with a Board attorney. While this approach yields efficiency and savings, since prescribed discovery procedures and discovery and trial schedules are unchanged, a conference with a Board attorney typically would not be necessary.

The parties may limit discovery in a number of ways. For example, parties may limit the number of interrogatories, requests for production and requests for admissions as well as the number and duration of discovery depositions. They may exchange more extensive disclosures in lieu of formal discovery, or stipulate to facts and the exchange of certain documents, or propound interrogatory requests only on particular issues. If the parties are unable to agree on discovery limits, they will not have optimized any cost and time savings available through ACR. When discovery devices (e.g., number of depositions, document requests, or interrogatory requests) are limited, practice is necessarily more focused and cost efficient.

Parties which agree to conduct the proceeding under ACR and which have stipulated to limited discovery may still take testimonial depositions or introduce testimony by affidavit or declaration, subject to the right of the nonoffering party to cross-examine the witness. By limiting the number or duration of testimonial depositions, or by introducing testimony by affidavit or declaration, they may realize additional savings in cost and time. They may also agree that the offering party may use discovery depositions at trial.

Parties may also agree under ACR to forego pretrial disclosures. Furthermore, if an ACR stipulation is silent on the issue of pretrial disclosures and no pretrial disclosures were in fact filed by either party, the Board will interpret the stipulation as waiving this requirement. [Note 8.]

The standards of proof in an ACR proceeding are the same as the standards of proof in a traditional Board proceeding. In either an opposition or cancellation, the burden of proof remains with the plaintiff, who must establish its case by a preponderance of the evidence. [Note 9.] In a concurrent use proceeding, the burden of proof remains with the applicant, who is in the position of the plaintiff. [Note 10.]

A final decision rendered under ACR may be appealed in the same manner and under the same time frames as non-ACR decisions by the Board. [Note 11.] For further information regarding appeals of inter partes decisions, see TBMP Chapter 900.

Parties to cancellation proceedings involving only claims of abandonment or nonuse (or both) are encouraged to agree to ACR. [Note 12.]

Please Note: Some of the cases cited in this section established efficiencies later codified in amended 37 C.F.R. § 2.123(a)(1), effective January 14, 2017, which allows parties to present direct testimony by affidavit or declaration subject to cross-examination by the adverse party.

NOTES:

1. *See, e.g., Societe Des Produits Nestle S.A. v. Taboada*, 2020 USPQ2d 10893, at *2 (TTAB 2020); *Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *2-3 (TTAB 2020); *Stawski v. Lawson*, 129 USPQ2d 1036, 1039 (TTAB 2018), *appeal dismissed*, No. 19-1617 (Fed. Cir. December 19, 2019); *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1787 (TTAB 2018); *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1602 (TTAB 2018); *TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1411 (TTAB 2018); *Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016); *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2002 (TTAB 2015); *Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1304 (TTAB 2014); *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2016 (TTAB 2014); *Frito-Lay North*

America, Inc. v. Princeton Vanguard, LLC, 109 USPQ2d 1949, 1950 (TTAB 2014), *vacated and remanded on other grounds, Princeton Vanguard , LLC v. Frito-Lay North. America., Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015), *original decision aff'd, Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 124 USPQ2d 1184 (TTAB 2017) *appeal dismissed without prejudice sub nom. Snyder's- Lance, Inc. v. Frito-Lay North America, Inc.*, 414 F. Supp. 3d 822, 2019 USPQ2d 401574 (W.D.N.C. 2019), *reversed and remanded on other grounds*, 991 F.3d 512 (4th Cir. 2021); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1827-28 (TTAB 2012); *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 676 (TTAB 1986). *See also Acuff-Rose Music, Inc. v. Jostens, Inc.*, 155 F.3d 140, 47 USPQ2d 1953, 1954-55 (2d Cir. 1998).

2. *See, e.g., Societe Des Produits Nestle S.A. v. Taboada*, 2020 USPQ2d 10893, at *2 (TTAB 2020) (per ACR stipulation, opposer withdrew some claims with prejudice; applicant stipulated as to opposer's standing; parties agreed to rely on materials submitted with summary judgment briefs as trial evidence with the right to supplementation during trial; parties reserved the right to object to evidence on substantive grounds); *Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *2-3 (TTAB 2020) (parties waived disclosures and discovery, stipulated to facts, and filed their testimony and evidence with their main briefs in lieu of trial); *Stawski v. Lawson*, 129 USPQ2d 1036, 1039-40 (TTAB 2018) (per ACR stipulation in concurrent use proceeding, "all office records, matters of public record, affidavits, declaratitons and the like incorporated in or annexed as exhibits to the prior or final motions, affidavits or declarations shall be deemed to have been properly filed pursuant to notice of reliance under Trademark Rule 2.122(e)." Parties also agree to forego traditional trial and oral hearing, and to submit evidence with their briefs), *appeal dismissed*, No. 19-1617 (Fed. Cir. December 19, 2019); *Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016) (parties stipulated to forgo reply briefing and that they could rely on the materials submitted in connection with previously filed motions for summary judgment); *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2002 (TTAB 2015) (parties filed ACR stipulation to present all testimony by declaration and to submit discovery responses and documents produced in discovery as exhibits without the need for accompanying testimony); *Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913, 1916 (TTAB 2015) (parties filed ACR stipulation, agreed to forego discovery, waived disclosures, stipulated to facts and attached documents, filed briefs with additional evidence); *Inter IKEA Systems B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1738 (2014) (parties filed joint stipulation that testimony could be submitted by declaration or affidavit subject to cross-examination upon request, and all documents produced in response to a request for production of documents were deemed authentic business records and were admissible subject to any objections other than authenticity); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 (TTAB 2014) (parties' stipulation under ACR provided limitations on discovery, excluded the filing of motions for summary judgment and the use of expert testimony, streamlined the methods for introduction of evidence during trial, stipulated to fact regarding no actual confusion), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016); *Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1186 (TTAB 2014) (stipulation to the admission and use of produced documents and waiver of objections based on authenticity or hearsay); *Sheetz of Delaware Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1344 (TTAB 2013) (parties stipulated under ACR that they could rely on the materials submitted in support of and against opposer's previously filed motion for summary judgment, that testimony could be submitted by declaration, that pretrial disclosures were not required, and that all evidence may be submitted through declarations or notices of reliance); *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1547 (TTAB 2012) (parties filed a joint stipulation of undisputed facts); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676 (TTAB 2007) (parties stipulated to the entire record: 13 paragraphs of facts, including applicant's dates of first use, channels of trade for applicant, extent and manner of applicant's use, recognition by others of applicant's use, as well as the dates, nature and extent of descriptive use by the opposer's parent company; the admissibility of business records, government documents, marketing materials and Internet printouts and to forgo trial).

3. *See Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1602 n.3 (TTAB 2018) ("To obtain the full benefit of ACR, it is important that parties draft clearly-worded stipulations regarding procedures, claims and defenses, and the factual record.").

4. *See TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1412 (TTAB 2018) (highlighting continued utility of ACR following 2017 rules changes).

5. *See Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1828 (TTAB 2012) (for claim of likelihood of confusion, parties' stipulations included priority, pleaded registration, and "lawn seed" and "grass seed" as legally identical descriptions of goods).

6. *See Societe Des Produits Nestle S.A. v. Taboada*, 2020 USPQ2d 10893, at *2 (TTAB 2020) (parties agreed to ACR at Board's suggestion made in prior Board order denying motion for partial summary judgment); *Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at * 1-2 (TTAB 2020) (Board identified case as eligible for expedited cancellation pilot; after Board case conference, parties agreed to litigate the proceeding as an expedited cancellation using ACR procedures); *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1787 (TTAB 2018) (Board identified case as candidate for pilot expedited cancellation proceeding, suggested same to parties during their discovery conference, and parties agreed to participate); *Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016); *Hewlett-Packard Development Co. v. Vudu Inc.*, 92 USPQ2d 1630, 1634 n.6 (TTAB 2009) (in granting partial summary judgment, the Board suggested the parties may seek to use ACR on the remaining disputed issues without the need for a formal trial).

7. *See Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913, 1916 (TTAB 2015) (early election of ACR, no motion practice, utilized conference with Board attorney for dispute re: stipulation, from notice to briefing less than a year, resulting in clean and concise record); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 n.3 (TTAB 2014) (ACR proceeding experienced delay in issuing decision due to precedential nature of decision and the number and nature of objections), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1829-30 n.9 (TTAB 2012) (although the parties crafted and proceeded with their own ACR approach, better practice is to contact the assigned Board attorney when the parties elect to pursue ACR); *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1762 (TTAB 2009).

8. *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2002 n.5 (TTAB 2015) ("While parties are obligated to identify trial witnesses in their pretrial disclosures, there is no indication in the record that either party served pretrial disclosures in this ACR case (and the parties' ACR Stipulation does not provide for the exchange of pretrial disclosures)." No basis for motion to strike and declaration at issue considered).

9. *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. ___, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049, 2056 (2015) (party opposing registration bears the burden of proof); *Dan Robbins & Associates, Inc. v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100, 105 (CCPA 1979); *Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016).

10. *See Stawski v. Lawson*, 129 USPQ2d 1036, 1038 (TTAB 2018), *appeal dismissed*, No. 19-1617 (Fed. Cir. December 19, 2019).

11. *See* 37 C.F.R. § 2.145.

12. *See Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at pp. *1-2 (TTAB 2020) (Board identified case as eligible for expedited cancellation pilot; after Board case conference, parties agreed to litigate the proceeding as an expedited cancellation using ACR procedures); *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1787 (TTAB 2018) (case decided under expedited cancellation pilot using ACR procedures).

702.04(b) ACR using Summary Judgment Briefs

For a case prosecuted on the summary judgment model of ACR, the trial and briefing periods occur in one phase. That is, the summary judgment briefs and accompanying evidentiary submissions encompass both the trial and briefing periods. Because the parties have, in essence, agreed to create the record for the case by their summary judgment submissions, testimony will be presented by affidavit or declaration, and any exhibits referenced by the affiants or declarants.

In addition to filing summary judgment briefs, the parties should file a joint stipulation of undisputed facts, and, as attachments or exhibits to their briefs, any materials that, in a typical trial, could be submitted by notice of reliance (the notice of reliance itself need not be filed). The parties are free to enter into other stipulations regarding the submission of evidence. [Note 1.] For example, they may agree that documents and things produced in response to requests for production may be submitted as exhibits without the need for accompanying testimony. The stipulations regarding the submission of evidence remove any question about the admissibility of the evidence, but the parties may reserve the right to object to the evidence on substantive grounds such as competency, relevancy or materiality, or the weight to be accorded particular items of evidence. [Note 2.] A party may not raise objections to the admissibility of evidence that it has stipulated into the record. [Note 3.] To obtain the full benefit of ACR, parties should draft clearly-worded stipulations about procedures, evidence, and the factual record. [Note 4.] Parties may stipulate to facts, supported by the record, that underlie necessary legal determinations such as whether the plaintiff has an entitlement to a statutory cause of action to bring the proceeding (formerly referred to as "standing"), *see* TBMP § 309.03(b), or whether confusion is likely. [Note 5.] However, because the Board makes determinations of the law governing a registration dispute, the Board is not bound by the parties' stipulations or agreements with respect to questions of law. [Note 6.]

ACR summary judgment briefs may be presented either as cross motions for summary judgment or as a single motion for summary judgment. If the parties stipulate to ACR and file cross motions for summary judgment, each party is entitled to file a response to the other's motion and a reply in support of its own motion. [Note 7.] If the parties stipulate to ACR and the summary judgment motion is in the form of a single motion by plaintiff, then defendant may file a brief in response and only plaintiff is entitled to file a reply. [Note 8.] In the absence of a stipulation to the contrary, the parties are limited to 25 pages for the ACR summary judgment briefs, inclusive of table of contents and cases, index of cases, description of the record, statement of the issues, recitation of facts, argument and summary. [Note 9.] Reply briefs are limited to 10 pages unless otherwise stipulated [Note 10.] and arguments should be restricted to rebuttal of the adverse party's case in chief.

In using the summary judgment form of ACR, the parties must provide a stipulation that the Board may resolve any genuine disputes of material fact that may be presented by the record or which may be discovered by the panel considering the case at final hearing. [Note 11.]

If the parties decide early in the case to use the ACR motion for summary judgment model, they should file a stipulation with the Board selecting the ACR summary judgment model and setting forth the negotiated schedule for discovery and any limitation on discovery, submission of stipulations, and briefing. [Note 12.]

For more information regarding ACR motions for summary judgment, see TBMP § 528.05(a)(2).

NOTES:

1. *See, e.g., TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1411 (TTAB 2018); *Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016).

2. *See, e.g., TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1411 (TTAB 2018).

3. *See Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2009) (by stipulating to introduction of affidavit and its exhibits into evidence, applicant waived its right to object to the admissibility of exhibits attached to affidavit), *aff'd on other grounds*, *Creative Arts by Calloway, LLC v. Brooks*, No. 09-cv-10488 (S.D.N.Y. Dec. 27, 2012), *dismissed*, slip op. No. 13-147 (2d Cir. Mar. 7, 2013).

4. *See Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1602 n.3 (TTAB 2018) (parties had "somewhat different views" about language in their stipulation, Board emphasized importance of drafting "clearly-worded stipulations" so parties may "obtain the full benefit of ACR").

5. *Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *3 n.6 (TTAB 2020) ("while the parties may not stipulate to a plaintiff's standing in the absence of supporting facts, thereby creating standing where none otherwise exists, the parties may stipulate as to the facts which would support standing, eliminating the need for separate proof of those facts.").

6. *Cf. Sanford's Estate v. Commissioner of Internal Revenue*, 308 U.S. 39, 51 (1939) ("We are not bound to accept, as controlling, stipulations as to questions of law") (citing Swift & Co. v. Hocking Valley Railway Co., 243 U.S. 281, 289 (1917)); *Technicon Instruments Corp. v. Alpkem Corp.*, 866 F.2d 417, 9 USPQ2d 1540, 1543 (Fed. Cir. 1989) ("If the stipulation is to be treated as an agreement concerning the legal effect of admitted facts, it is obviously inoperative, since the court cannot be controlled by agreement of counsel on a subsidiary question of law.") (quoting *Swift & Co. v. Hocking Valley Railway Co.*, 243 U.S. 281, 289 (1917)); *Julius Forstmann & Co. v. United States*, 26 CCPA 336, 338 (CCPA 1939) ("in attempting to stipulate facts, it is clear that litigants improperly circumscribe the freedom of the judicial function, it is elementary that such stipulations [of law] are not binding upon the court"); *Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *3 n.6 (TTAB 2020) ("while the parties may not stipulate to a plaintiff's standing in the absence of supporting facts, thereby creating standing where none otherwise exists, the parties may stipulate as to the facts which would support standing, eliminating the need for separate proof of those facts.").

7. 37 C.F.R. § 2.127(a) and 37 C.F.R. § 2.127(e)(1).

8. 37 C.F.R. § 2.127(a) and 37 C.F.R. § 2.127(e)(1).

9. 37 C.F.R. § 2.127(a). *But see Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775 (TTAB 2013) (parties' ACR agreement provided that "the page limit for the parties' briefs shall be the page limit permitted for trial briefs pursuant to Trademark Rule 2.128(b).").

10. 37 C.F.R. § 2.127(a). *But see Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775 (TTAB 2013) (parties' ACR agreement provided that "the page limit for the parties' briefs shall be the page limit permitted for trial briefs pursuant to Trademark Rule 2.128(b).").

11. *See, e.g., TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1411 (TTAB 2018); *Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016).

12. *See, e.g., Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775 (TTAB 2013) (pursuant to their ACR stipulation, parties agreed to forgo discovery and reliance on expert testimony).

702.04(c) ACR Conversion - Summary Judgment Briefs

In circumstances where the parties have already filed summary judgment briefs, the Board may, in appropriate cases, invite the parties to agree to the Board's treatment of the summary judgment briefs and evidence as the final records and briefs. [Note 1.] Alternatively, the parties may stipulate to treating the summary judgment briefs and evidence as the record and final briefs on the case, even in the absence of an invitation to do so extended by the Board. [Note 2.]

In either case, the parties must stipulate that the Board may resolve any genuine disputes of material fact that may be presented by the record or which may be discovered by the panel considering the case at final hearing.

For more information regarding ACR motions for summary judgment, see TBMP § 528.05(a)(2).

NOTES:

1. *See, e.g., Daniel J. Quirk Inc. v. Village Car Company*, 120 USPQ2d 1146, 1147 and 1147 n.5 (TTAB 2016); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1950 (TTAB 2014) (after suggestion by Board in order denying motion for summary judgment, parties stipulated to forego trial and rely on evidence submitted in support of the motions for summary judgment, supplemented by expert declarations, trial briefs and an oral hearing), *vacated and remanded on other grounds, Princeton Vanguard , LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015), *original decision aff'd*, *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 124 USPQ2d 1184 (TTAB 2017), *dismissed without prejudice sub nom. Snyder's-Lance, Inc. v. Frito-Lay North America, Inc.*, 414 F. Supp. 3d 822, 2019 USPQ2d 401574 (W.D.N.C. 2019), *reversed and remanded on other grounds*, 991 F.3d 512 (4th Cir. 2021).

2. *See, e.g., Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016); *Freeman v. National Association of Realtors*, 64 USPQ2d 1700, 1701 (TTAB 2002) (parties stipulated that case would be decided on petitioner's motion for summary judgment and respondent's response); *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 676 (TTAB 1986) (parties stipulated that cross motions for summary judgment would be treated as testimony, evidence and briefs at final hearing).

702.04(d) ACR using Stipulated Record and Trial Briefs

Under the stipulated record and trial briefs ACR model, the case proceeds to final decision on an evidentiary record that has been stipulated to, in whole or in substantial part. Thus, the parties must be prepared to stipulate to the admissibility of most of the record. They may, however, reserve the right to object in trial briefs on substantive grounds to particular evidence such as on the grounds of competency, relevancy or materiality. Testimony periods may not be needed for cases prosecuted on the stipulated record model (with or without stipulated facts), if the evidentiary record has been stipulated to by the parties. [Note 1.] Essentially, the parties are agreeing to an abbreviated trial on the merits.

Just as with any non-ACR case, the Board will decide disputed facts as part of the final decision.

The Board has found that cases that proceed along the ACR stipulated record model, involving many stipulated facts and stipulated evidence, yield highly effective records because evidentiary submissions are focused on the disputed facts. Stipulations of fact are useful but are not required in an ACR case prosecuted on a stipulated record.

Parties which agree to conduct the proceeding under ACR and which have stipulated to limited discovery may still take testimonial depositions or introduce testimony by affidavit or declaration, subject to the right of the nonoffering party to cross-examine the witness. However, by limiting the number or duration of testimonial depositions or testimony in affidavit or declaration form, they may realize additional savings in cost and time. They may also agree to use discovery depositions at trial.

Parties using this form of ACR and who agree to forgo the testimony period should file a stipulation indicating such an intention, along with their stipulations to the record with respect to facts, evidence and testimony (e.g., using discovery depositions in lieu of testimonial depositions). [Note 2.] To obtain the full benefit of ACR, parties should draft clearly-worded stipulations. Parties may stipulate to facts, supported by the record, that underlie necessary legal determinations such as whether the plaintiff has an entitlement to a statutory cause of action to bring the proceeding (formerly referred to as "standing"), *see*TBMP § 309.03(b), or whether confusion is likely. However, because the Board makes determinations of the law governing a registration dispute, the Board is not bound by the parties' stipulations or agreements with respect to questions of law. [Note 4.]

Stipulations regarding the submission of evidence promote efficiency by removing any question about the admissibility of the evidence, while still allowing the parties to reserve the right to object to the evidence on substantive grounds such as competency, relevancy or materiality. [Note 5.] A party may not raise objections to the admissibility of evidence that it has stipulated into the record. [Note 6.]

As with regular trial briefs, the parties are limited to 55 pages for the ACR trial briefs under the stipulated record model, inclusive of table of contents, index of cases, description of the record, statement of issues, recitation of the facts, argument and summary. [Note 7.] Unless counterclaims are involved, only the plaintiff may file a reply brief, and it is limited to 25 pages consisting solely of a rebuttal of the adverse party's case in chief. [Note 8.] *See*TBMP § 801.

For additional information regarding stipulated evidence and ACR, see TBMP § 705.

NOTES:

1. *See, e.g., Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *2 (TTAB 2020) (parties stipulated to file testimony and documentary evidence submitted together with their main briefs in lieu of trial); *Lebanon Seaboard Corporation v. R & R Turf Supply, Inc.*, 101 USPQ2d 1826, 1828 (TTAB 2012) (parties stipulated to a schedule that did not include testimony periods, but resulted in the concurrent submission of briefs and supporting evidence); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties selected ACR and agreed to forgo trial by stipulating to use evidence submitted in support of opposer's motion for summary judgment as trial evidence and allowing for any additional evidence to be submitted with their trial briefs on the case); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties stipulated to the entirety of the record and agreed to forgo trial).

2. *See, e.g., Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913, 1916 (TTAB 2015) (early election of ACR, no motion practice, utilized conference with Board attorney for dispute re stipulation, resulted in clean and concise record, and the time frame from notice to briefing took less than a year); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 (TTAB 2014) (parties' stipulation under ACR provided limitations on discovery, excluded the filing of motions for summary judgment and the use of expert testimony, streamlined the methods for introduction of evidence during trial, stipulated to fact regarding no actual confusion), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016); *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1547 (TTAB 2012) (parties filed a joint stipulation of undisputed facts and a stipulation to seek a determination through ACR); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties agreed to forgo trial by stipulating to use evidence submitted in support of opposer's motion for summary judgment as trial evidence and allowing for any additional evidence to be submitted with their trial briefs on the case); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties stipulated to the entirety of the record and stipulated to forgo trial); *Zimmerman v. National Association of Realtors*, 70 USPQ2d 1425, 1427 (TTAB 2004) (in addition to reliance on a discovery deposition of one of the parties, the parties stipulated that the evidentiary record from an earlier Board case would be considered); *Devries v. NCC Corp.*, 227 USPQ 705, 708 (TTAB 1985) (parties stipulated to waive trial periods and stipulated to the following: petitioner's pleaded registration; each party's responses to certain interrogatories and requests for production of documents served upon it by the other party; and stipulated facts and affidavit testimony, with attached exhibits).

But see Lebanon Seaboard Corp. v. R&R Turf Supply Inc., 101 USPQ2d 1826, 1830 (TTAB 2012) (parties who stipulated to certain facts and issues, yet also submitted evidence to prove these points, have gone to needless effort and expense and the Board unnecessarily must review this evidence).

3. *Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *3 n.6 (TTAB 2020) ("while the parties may not stipulate to a plaintiff's standing in the absence of supporting facts, thereby creating standing where none otherwise exists, the parties may stipulate as to the facts which would support standing, eliminating the need for separate proof of those facts.").

4. *Sanford's Estate v. Commissioner of Internal Revenue*, 308 U.S. 39, 51 (1939) ("We are not bound to accept, as controlling, stipulations as to questions of law") (*citingSwift & Co. v. Hocking Valley Railway Co.*, 243 U.S. 281, 289 (1917)); *Technicon Instruments Corp. v. Alpkem Corp.*, 866 F.2d 417, 9 USPQ2d 1540, 1543 (Fed. Cir. 1989); ("If the stipulation is to be treated as an agreement concerning the legal effect of admitted facts, it is obviously inoperative, since the court cannot be controlled by agreement of counsel on a subsidiary question of law.") (*quotingSwift & Co. v. Hocking Valley Railway Co.*, 243 U.S. 281, 289 (1917)); *Julius Forstmann & Co. v. United States*, 26 CCPA 336, 338 (CCPA 1939) ("in attempting to stipulate facts, it is clear that litigants improperly circumscribe the freedom of the judicial function, it is elementary that such stipulations [of law] are not binding upon the court"); *Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *3 n.6 (TTAB 2020) ("while the parties may not stipulate to a plaintiff's standing in the absence of supporting facts, thereby creating standing where none otherwise exists, the parties may stipulate as to the facts which would support standing, eliminating the need for separate proof of those facts.").

5. *See Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties agreed to reserve the right to object to facts and documents on the bases of relevance, materiality and weight). *See also Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1376 (Fed. Cir. 2018) (the parties waived objections to the admissibility of the evidence, without prejudice to their rights to argue the probative value of such evidence, in order to take advantage of the Board's Accelerated Case Resolution procedure).

6. *See Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2009) (by stipulating affidavit and exhibits thereto into evidence, applicant waived its right to object to the admissibility of exhibits attached to affidavit), *aff'd on other grounds*, *Creative Arts by Calloway, LLC v. Brooks*, No. 09-cv- 10488 (S.D.N.Y. Dec. 27, 2012), *dismissed*, slip op. No. 13-147 (2d Cir. March 7, 2013).

But see Gemological Institute of America, Inc. v. Gemology Headquarters International, LLC, 111 USPQ2d 1559, 1561 (TTAB 2014) (parties' stipulation provided for the admission into evidence of specific dated expert reports and accompanying exhibits and an expert discovery deposition transcript, but did not provide for the admission into evidence of any supplemental expert reports or additional expert testimony by affidavit or declaration, in view thereof, supplemental expert report not admissible on this basis).

7. 37 C.F.R. § 2.128(b).

8. 37 C.F.R. § 2.128(b).

702.04(e) Utilizing Stipulations in Non-ACR Board cases

37 C.F.R. § 2.123(b) ***Stipulations.*** *If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. The parties may stipulate in writing what a particular witness would testify to if called; or any relevant facts in the case may be stipulated in writing.*

37 C.F.R. § 2.127(e)(2) *If any motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion be considered at trial as trial evidence, which may be supplemented by additional evidence during trial.*

Parties may utilize stipulations of facts and evidence to realize cost efficiencies in non-ACR cases. For example, they may stipulate to the entire record, to portions of the record, or to particular facts. [Note 1.] The parties are reminded that the Board is not bound by stipulations as to questions of law. [Note 2.] If any motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion be considered at trial as trial evidence, which may be supplemented by additional evidence during trial. [Note 3.] Parties may stipulate to ACR-type efficiencies at any stage of a proceeding in order to expedite the remainder of the trial schedule.

*See*TBMP § 705 regarding stipulated evidence.

Please Note: Some of the cases cited in this section established principles later codified in amended 37 C.F.R. § 2.123(a)(1), effective January 14, 2017, which allows parties to unilaterally present direct testimony by affidavit or declaration subject to cross-examination by the adverse party.

NOTES:

1. *See* 37 C.F.R. § 2.123(b) and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.123(b) … to clarify that parties may stipulate to any relevant facts."). *See, e.g., The Brooklyn Brewery Corporation v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, at *2 (TTAB 2020) (parties stipulated to admission of evidence: documents produced through discovery may be submitted under notice of reliance without witness testimony and will be deemed authentic business records; documents submitted in conjunction with an earlier-filed summary judgment motion deemed admitted into record; and the admission of testimony and

related exhibits by declaration, and of discovery depositions and related exhibits by notice of reliance), *appeal filed*, No. 20-2277 (Fed. Cir. Sept. 16, 2020); *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *3 (TTAB 2020) (parties stipulated to the admissibility and authenticity of evidence); *Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *1-2, nn.8, 10 and 11 (TTAB 2020) (parties stipulated to admissibility of interrogatory responses through notice of reliance, and to withdraw certain paragraphs from two testimony declarations), *appeal filed*, No. 3:20-cv-00400-MHL (E.D. Va. June 5, 2020); *AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at *3-5, *4-5 nn. 13, 14, & 20 (TTAB 2020) (parties stipulated to bifurcate the proceeding into two phases, with the initial phase directed to standing, and if opposer was found to have standing, the second phase directed to remaining issues; stipulation as to expert testimony and stipulation as to authenticating evidence as business records); *Hanscomb Consulting, Inc. v. Hanscomb Ltd.*, 2020 USPQ2d 10085,at *2 (TTAB 2020) (parties stipulated to treat discovery responses and documents produced in earlier Board proceeding as discovery responses and documents produced in response to discovery requests in present Board proceeding); *Milwaukee Electric Tool Corp. v. Freud America, Inc.*, 2019 USPQ2d 460354, at *2 (TTAB 2019) (parties stipulated to admissibility of certain declarations and exhibits submitted by each party on summary judgment), *complaint filed*, No. 20-cv-109 (M.D.N.C. Feb. 3, 2020); *Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *1 n.5 (TTAB 2019) (parties stipulated to treat discovery responses provided in prior federal civil action as responses to discovery propounded in Board proceeding, and to introduce the discovery depositions of certain witnesses taken in the Board proceeding as trial testimony in lieu of taking their testimonial depositions); *Noble House Home Furnishings, LLC v. Floorco Enterprises*, LLC, 118 USPQ2d 1413, 1416 (TTAB 2016) (parties stipulated that testimony may be introduced by affidavit or declaration in lieu of testimonial depositions and that the documents exchanged during discovery are authentic and may be made of record by either party); *Ayoub, Inc. v. ACS Ayoub Carpet Services*, 118 USPQ2d 1392, 1394 (TTAB 2016) (parties stipulated to submission of testimony by declaration, to the use of any Fed. R. Civ. P. 30(b)(6) discovery deposition transcripts in their case-in-chief or rebuttal, and to the authenticity of all documents produced by either party during discovery); *N.Y. Yankees Partnership v. IET Products & Services, Inc.*, 114 USPQ2d 1497, 1500 (TTAB 2015) (parties stipulated that witness testimony would be submitted solely by declaration and without cross-examination); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1426 (TTAB 2014) (stipulation to submission of witness declarations and discovery depositions, the authenticity of certain documents, retail prices of opposers' goods, the fact that advertisements and news articles refer to opposers, and press clippings are representative of the media in which opposers advertise); *Inter IKEA Systems B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1738 (2014) (parties filed joint stipulation that testimony could be submitted by declaration or affidavit subject to cross-examination upon request, and all documents produced in response to a request for production of documents were deemed authentic business records and were admissible subject to any objections other than authenticity); *Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1186 (TTAB 2014) (stipulation to the admission and use of certain produced documents and waiver of objections based on authenticity or hearsay as to those documents); *Miller v. Miller*, 105 USPQ2d 1615, 1617 n.6 (TTAB 2013) (parties stipulated to testimony by affidavit and provided a stipulation of undisputed facts); *Blackhorse v. Pro-Football Inc.*, 111 USPQ2d 1080, 1084-85 (TTAB 2014) (parties stipulated that the record of a prior proceeding may be submitted into evidence under notice of reliance reserving the right to object based on relevance) *aff'd*, 112 F. Supp. 3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *vacated and remanded on other grounds*, 709 F. App'x 183 (4th Cir. 2018) (mem.); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1563 (TTAB 2011) (parties stipulated to authenticity of produced documents and to the introduction of testimony in affidavit or declaration form, with certain guidelines), *rev'd on other grounds*, slip op. No. 11-3684 (D.N.J. August 29, 2017); *Kistner Concrete Products Inc. v. Contech Arch Technologies Inc.*, 97 USPQ2d 1912, 1915 (TTAB 2011) (parties stipulated to authenticity of produced documents); *Brooks v. Creative Arts by Calloway*, LLC, 93 USPQ2d 1823, 1824-25 (TTAB 2010) (parties stipulated to admission of various testimony declarations and to facts), *aff'd on other grounds*, *Creative Arts by Calloway, LLC v. Brooks*, No. 09-cv-10488 (S.D.N.Y. Dec. 27, 2012), *dismissed*, slip op.

No. 13-147 (2d Cir. March 7, 2013); *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1044 (TTAB 2009) (parties stipulated to introduce testimony by declaration and to live cross-examination); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1585 (TTAB 2008) (parties stipulated to testimony by declaration, with exhibits); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1847 n.5 (TTAB 2008) (stipulation to use discovery depositions as trial testimony); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (stipulation to use evidence and exhibits submitted in connection with a motion for summary judgment at trial); *Domino's Pizza Inc. v. Little Caesar Enterprises Inc.*, 7 USPQ2d 1359, 1360 (TTAB 1988) (stipulations to facts by applicant, testimony by affidavit by opposer, and use of certain testimonial depositions taken in prior civil action); *Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.*, 222 USPQ 1012, 1013 (TTAB 1984) (stipulated to the filing of facts and exhibits on behalf of each party during each party's testimony period); *Hayes Microcomputer Products, Inc. v. Business Computer Corp.*, 219 USPQ 634, 635 (TTAB 1983) (parties stipulated to facts, legal conclusions and testimony, including cross-examination and redirect examination with respect to stipulated testimony).

2. *Sanford's Estate v. Commissioner of Internal Revenue*, 308 U.S. 39, 51 (1939) ("We are not bound to accept, as controlling, stipulations as to questions of law") (*citingSwift & Co. v. Hocking Valley Railway Co.*, 243 U.S. 281, 289 (1917)); *Technicon Instruments Corp. v. Alpkem Corp.*, 866 F.2d 417, 9 USPQ2d 1540, 1543 (Fed. Cir. 1989); ("If the stipulation is to be treated as an agreement concerning the legal effect of admitted facts, it is obviously inoperative, since the court cannot be controlled by agreement of counsel on a subsidiary question of law.") (*quotingSwift & Co. v. Hocking Valley Railway Co.*, 243 U.S. 281, 289 (1917); *Julius Forstmann & Co. v. United States*, 26 CCPA 336, 338 (CCPA 1939), ("in attempting to stipulate facts, it is clear that litigants improperly circumscribe the freedom of the judicial function, it is elementary that such stipulations [of law] are not binding upon the court"); *Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *3 n.6 (TTAB 2020) ("while the parties may not stipulate to a plaintiff's standing in the absence of supporting facts, thereby creating standing where none otherwise exists, the parties may stipulate as to the facts which would support standing, eliminating the need for separate proof of those facts.").

3. 37 C.F.R. § 2.123(e)(2). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69967 (October 7, 2016) ("The Office is amending § 2.127(e)(2) to add that if a motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion be considered at trial as trial evidence, which may be supplemented by additional evidence during trial. The revision codifies an approach used by parties in proceedings incorporating ACR-type efficiencies at trial.").

702.05 Overly Large Records

The Board notes that in recent years there has been a trend regarding the introduction of irrelevant and/or cumulative evidence at trial. [Note 1.] The Board views parties who engage in this practice with disfavor. [Note 2.] The introduction of such evidence impedes the orderly administration of the case, and obscures the impact of truly relevant evidence. In addition to diminishing the effectiveness of a party's evidentiary record, "papering" the Board causes delays in rendering a final decision. Parties should submit only relevant, non-cumulative evidence. [Note 3.] For all evidence submitted under notice of reliance, the notice must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. [Note 4.] Failure to do so, however, is a curable procedural defect that does not necessitate reopening a party's testimony period. [Note 5.] For a discussion of the requirements for evidence submitted under notice of reliance, see TBMP § 704.02.

The Board may require the parties to take steps to assist with organizing the evidence such as preparing and filing tables summarizing testimony and other evidence and specifying 1) the probative value of particular facts or testimony and 2) the location in the record of such facts or testimony. [Note 6.] Deposition transcripts must contain a word index, listing the pages where the words appear in the deposition. [Note 7.]

Pursuant to 37 C.F.R. § 2.120(j)(2), the Board may require the parties to meet with the Board for a pretrial conference where the Board has determined that the case has the potential to become overly contentious and/or involve the creation by the parties of excessive records. [Note 8.] See TBMP § 502.06(b) for more information about pretrial conferences.

NOTES:

1. *See, e.g., Societe Des Produits Nestle S.A. v. Taboada*, 2020 USPQ2d 10893, at *5, n.18 (TTAB 2020) (given parties' ACR stipulation, opposer's refiling of numerous portions of its summary judgment evidence was duplicative and unnecessary); *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1803 (TTAB 2018) (the parties introduced into the record thousands of pages of testimony and other evidence without regard to what they needed to prove), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Sheetz of Delaware Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1344 n.5 (TTAB 2013) ("While we commend the parties for agreeing to efficiencies intended to facilitate the introduction of evidence at trial, ideally, [ACR] cases do not merely facilitate introduction of more evidence, but should also limit the amount of evidence placed before the Board."); *Corporacion Habanos S.A. v. Guantanamera Cigars, Co.*, 102 USPQ2d 1085, 1091 (TTAB 2012) (another case which does not warrant a record of this size); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1873 (TTAB 2011) (overly large records tax the resources of the Board and are entirely unnecessary); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591-92 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential) (Board expressed frustration with sizeable record and overzealous litigation); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1218 (TTAB 2011) (with its supplemental notice of reliance, plaintiff resubmitted the first 25 items listed in its first notice of reliance, needlessly adding bulk to the record and wasting Board resources); *Stuart Spector Designs Ltd. v. Fender Musical Instruments, Corp.*, 94 USPQ2d 1549, 1552 (TTAB 2009) ("voluminous" evidence of record); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495 (TTAB 2005) ("It is simply inconceivable to the Board that the issues herein warranted either a record of this size or the large number of motions relating thereto."). *See also United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991) ("The case was neither prosecuted nor defended based on any clear theory of the case. Neither party made a concise and compelling evidentiary showing, and neither was judicious in the introduction of only relevant testimony and evidence.").

2. *See, e.g., RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1803 (TTAB 2018) ("Simply put, the parties introduced into the record thousands of pages of testimony and other evidence without regard to what they needed to prove, apparently in the hope that in wading through it, we might find something probative. This is not productive. 'Judges are not like pigs, hunting for truffles buried in briefs.'") *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Sheetz of Delaware Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341, 1344 n.5 (TTAB 2013) ("A larger record is not necessarily a better record."); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential) ("Even counsel at the oral hearing acknowledged that the present record is of a magnitude generally reserved for district court litigation."); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495 (TTAB 2005) ("It is simply inconceivable to the Board that the issues herein warranted either a record of this size or the large number of motions relating thereto.").

3. *See, e.g., Societe Des Produits Nestle S.A. v. Taboada*, 2020 USPQ2d 10893, at *5, n.18 (TTAB 2020) (given parties' ACR stipulation, opposer's refiling of numerous portions of its summary judgment evidence was duplicative and unnecessary); *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1803 (TTAB 2018) (thousands of pages of testimony and other evidence without regard to what needed to be proved, is not productive. "Neither party made a concise and compelling evidentiary showing, and neither was judicious in the introduction of only relevant testimony and evidence."), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1040 n.19 (TTAB 2010) ("It is not necessary for the parties to introduce every document obtained from an Internet search especially when it includes duplicative and irrelevant materials."); *Blue Man Productions v. Tarmann*, 75 USPQ2d 1811, 1814 (TTAB 2005) (foreign language materials submitted with no translation), *rev'd on other grounds*, slip op No. 05-2037 (D.D.C. Apr. 3, 2008).

4. 37 C.F.R. § 2.122(g). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69652, 69964 (October 7, 2016) (" … a notice must indicate generally the relevance of the evidence offered and associate it with one or more issues in the proceeding, but failure to do so with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order. The amendment codifies current case law and Office practice."). *See, e.g., Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1164 (TTAB 2017) (failure to delineate the relevant element of a claim or defense for specific pages in the notice of reliance as required under Trademark Rule 2.122(g) is "particularly problematic because of the sheer volume of pages").

5. 37 C.F.R. § 2.122(g). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69652, 69964 (October 7, 2016) ("The Office is adding new § 2.122(g) detailing the requirement for admission of evidence by notice of reliance. Section 2.122(g) provides that a notice must indicate generally the relevance of the evidence offered and associate it with one or more issues in the proceeding, but failure to do so with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order. The amendment codifies current case law and Office practice."). *See, e.g., Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1164 (TTAB 2017) (failure to comply with Trademark Rule 2.122(g) is a curable defect that can be remedied without reopening party's testimony period).

6. *See AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at *12 (TTAB 2020) (parties required to file an appendix of all testimony and documentary evidence, explaining relevance, location in record where found, and TTABVUE docket entry and page number where evidentiary item appears; parties required to add electronic bookmarks to any testimony or evidence filed as a PDF document in ESTTA); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1592 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential) (after oral hearing, Board required parties to submit a joint index and amended briefs with citations to the joint index); *Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1635-36 (TTAB 2011) (tables of evidence required).

7. 37 C.F.R. § 2.123(g)(3). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.123(g)(3) to add that deposition transcripts must contain a word index, listing the pages where the words appear in the deposition.").

8. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69951 (October 7, 2016) ("The existing rule for convening a pretrial conference because of the complexity of issues is amended so that it is limited to exercise only by the Board, upon the Board's initiative.").

703 Taking and Introducing Testimony

703.01 Affidavits, Declarations and Oral Testimony Depositions

703.01(a) In General

In addition to submission of evidence under notices of reliance, parties may introduce evidence in the form of testimony depositions taken by a party during its assigned testimony period, or in the form of affidavit or declaration testimony submitted during its testimony period, subject to the right of the adverse party to conduct cross-examination. The submission of evidence and testimony during the parties' assigned testimony periods corresponds to the trial in court proceedings. [Note 1.] For information concerning submission of evidence by notice of reliance, see TBMP § 704.

Testimony is taken out of the presence of the Board, by affidavit or declaration, or on oral examination or written questions, and the affidavits, declarations and written deposition transcripts, together with any exhibits thereto, are then submitted to the Board. *See*TBMP § 702. *See also*TBMP § 502.01. During a party's testimony period, testimony is taken by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness testifying (either willingly or under subpoena) on behalf of the party.

Testimony affidavits, declarations and depositions are the means by which a party may present the testimony of its witnesses and also introduce into the record those documents and other exhibits that may not be made of record by notice of reliance. *See generally*TBMP § 704 describing types of evidence admissible by notice of reliance. However, only evidence admissible under the applicable rules of evidence may properly be adduced during a testimony deposition or presented by affidavit or declaration; inadmissibility is a valid ground for objection. [Note 2.] *See*TBMP § 707.03. In addition, once evidence has properly been made of record, any party may refer to it for any purpose permitted by the Federal Rules of Evidence. [Note 3.]

Declarations or affidavits from the application file, that form part of the record, are not trial testimony under 37 C.F.R. § 2.122(b)(2). [Note 4.]

For a comparison of testimony depositions and discovery depositions, see TBMP § 404.09.

NOTES:

1. 37 C.F.R. § 2.116(e). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69959 (October 7, 2016) ("The Office is amending § 2.116(e) to add that the submission of notices of reliance, declarations, and affidavits, as well as the taking of depositions, during the testimony period corresponds to the trial in court proceedings. The revision codifies current Office practice and is consistent with amendments relating to declarations and affidavits."). *See Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *3-4 (TTAB 2019) (absent stipulation or Board order, "a testimony affidavit or declaration must be taken–that is, executed–during the assigned testimony period, as required by Rule 2.121(a)"), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *2 (TTAB 2019) (during its testimony period a party may take the testimony of a witness, by affidavit or declaration, or by deposition upon oral examination, or, if the witness is located in a foreign country, by deposition upon written questions); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1786 n.4 (TTAB 2002) ("trial testimony depositions are noticed and taken during the party's assigned testimony period").

For a general discussion of Board inter partes proceedings, see *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015).

2. *See* 37 C.F.R. § 2.122(a) and 37 C.F.R. § 2.123(l); *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *3 (TTAB 2019) (declaration testimony submitted during opposer's testimony period is trial testimony, not hearsay, and "the equivalent of live testimony 'in court.'").

3. 37 C.F.R. § 2.122(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.122(a) consistent with § 2.120(k)(7), to add that when evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. The amendments codify current Office practice."). *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC* , 2020 USPQ2d 10596, at *12 (TTAB 2020) (citing Trademark Rule 2.122(a)); *Nazon v. Ghiorse* , 119 USPQ2d 1178, 1181 n.6 (TTAB 2016) ("Once evidence is properly of record, it may be relied on by any party for any purpose."). *See also Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC* , 129 USPQ2d 1027, 1030 n.29 (TTAB 2018) (party may rely on testimony from a discovery deposition already made of record by adverse party-no need to resubmit), *reversed and remanded on other grounds* , 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), *petition for rehearing en banc denied* , 2020 USPQ2d 11438 (Fed. Cir. 2020); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.* , 221 USPQ 1191, 1192 n.7 (TTAB 1984) (once filed, testimony depositions are of record for both parties for all relevant purposes; adversary's discovery responses, once filed, are considered to be in evidence for both parties for all purposes permitted by the Federal Rules of Evidence). 37 C.F.R. § 2.120(k)(7).

4. *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *4, n.23 (TTAB 2019) (declaration submitted in application file during prosecution not considered trial testimony since it was dated over three years prior to petitioner's testimony period; declaration submitted with summary judgment reply brief that was executed several months before trial was not trial testimony and was not considered because it was not affirmed by other trial testimony that attested to its accuracy), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019).

703.01(b) Form of Testimony

37 C.F.R. § 2.123

(a)(1) *The testimony of witnesses in inter partes cases may be submitted in the form of an affidavit or a declaration pursuant to § 2.20 and in conformance with the Federal Rules of Evidence, filed during the proffering party's testimony period, subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination of that witness as provided under paragraph (c) of this section if such witness is within the jurisdiction of the United States, or conduct cross-examination by written questions as provided in § 2.124 if such witness is outside the jurisdiction of the United States, and the offering party must make that witness available; or taken by deposition upon oral examination as provided by this section or by deposition upon written questions as provided by § 2.124.*

(2) *Testimony taken in a foreign country shall be taken by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within twenty days from the date of*

service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.

(b) ***Stipulations.*** *If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. The parties may stipulate in writing what a particular witness would testify to if called; or any relevant facts in the case may be stipulated in writing.*

Ordinarily, the testimony of a witness may be taken by affidavit, declaration or on oral examination pursuant to 37 C.F.R. § 2.123, or by deposition on written questions pursuant to 37 C.F.R. § 2.124. [Note 1.] For information concerning testimony depositions on written questions, see TBMP § 703.02.

A party may unilaterally choose to submit the trial testimony of any witness or witnesses of any party in the form of an affidavit or declaration pursuant to 37 C.F.R. § 2.20 and in conformance with the Federal Rules of Evidence, subject to the right of any adverse party to cross-examine the witness orally if the witness is within the jurisdiction of the United States, or by written questions pursuant to 37 C.F.R. § 2.124 if the witness is not within the jurisdiction of the United States. [Note 2.] The affidavit or declaration must be under oath and subject to cross-examination. [Note 3.] In addition, the offering party must make the witness available for cross-examination if elected. [Note 4.] As with cross-examination at oral testimony depositions, the party cross-examining the affiant or declarant must pay its own travel and attorney expenses. [Note 5.] The proffering party has and continues to bear the expense of producing its witness. [Note 6.] However, the party seeking oral cross-examination of an affiant or declarant must cover the expense of the court reporter. [Note 7.] Any redirect and recross is to be taken at the same time as the oral cross-examination, with the party who originally sought oral cross-examination bearing the cost of the court reporter. [Note 8.]

The Board ordinarily finds the vicinity of the witness' place of business or domicile to be a reasonable place for oral cross-examination of an affiant or declarant. [Note 9.] By stipulation or upon motion for good cause, oral cross-examination of a witness located within the jurisdiction of the United States may be conducted by telephone or other remote means. [Note 10.]

The testimony of a witness ordinarily may also be taken by deposition on written questions. [Note 11.] However, testimony taken in a foreign country must be taken: by deposition on written questions, unless the Board, on motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness. [Note 12.] *See*TBMP § 404.03(b), TBMP § 520, TBMP § 531 and TBMP § 703.02.

If a declaration or affidavit of a witness in a foreign country is offered, the proffering party must make the witness available for cross-examination by written questions. [Note 13.] A party seeking cross-examination by written questions of an affiant or declarant outside the jurisdiction of the United States must cover the expense of the court reporter or other official to swear in the witness, record the answers and to create a written transcript of the examination. [Note 14.] See TBMP § 703.02(g) for information on cross-examination of the witness by written questions, including the procedures for redirect and recross by written questions.

In addition, if a party serves notice of the taking of a testimony deposition on written questions of a witness who is, or will be at the time of the deposition, present within the United States (or any territory that is under the control and jurisdiction of the United States), any adverse party may, within 20 days from the date of service of the notice, file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination. [Note 15.] What constitutes good cause to take an oral deposition is determined on a case-by-case basis. [Note 16.] *See*TBMP § 531.

Parties may stipulate that depositions may be taken in a foreign country by oral examination. [Note 17.] The parties should determine whether the taking of the oral deposition will be permitted by the foreign country, and, if so, what procedure must be followed. [Note 18.] *See*TBMP § 703.01(g).

The parties may also stipulate in writing to any relevant facts in the case, or what a particular witness would testify to if called, or that a party may use a discovery deposition as testimony. [Note 19.] See TBMP § 702.04(e) regarding stipulations.

NOTES:

1. *See* 37 C.F.R. § 2.123(a)(1) and 37 C.F.R. § 2.123(a)(2). Effective January 14, 2017, the Office amended these rules by allowing a unilateral option for trial testimony by affidavit or declaration subject to the right of oral cross-examination by the adverse party or parties. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69951 (October 7, 2016). *See Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *4 n.21 (TTAB 2019) (referencing TBMP § 703.01(a)), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *2 (TTAB 2019).

2. 37 C.F.R. § 2.123(a)(1). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.123(b) to remove the requirement for written agreement of the parties to submit testimony in the form of an affidavit, as provided in amendments to § 2.123(a)(1), and to clarify that parties may stipulate to any relevant facts."). *See Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *2 (TTAB 2019) (amended Trademark Rules provide for testimony by declaration, even in the absence of a stipulation); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *2 (TTAB 2019) (the method of cross-examination of a witness who presented testimony by affidavit or declaration depends on whether the witness is located in the United States or outside the jurisdiction of the United States); *Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *2 (TTAB 2019) (if the offering party submits trial testimony in the form of an affidavit or declaration of a foreign witness, the adverse party may elect to take and bear the expense of cross-examination by written questions of that witness).

3. *See* 37 C.F.R. § 2.123(a)(1); *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045 (2015) (Supreme Court focused on fact that Board proceedings require testimony to be under oath and subject to cross-examination); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) (concerning the unilateral option of permitting submission of witness testimony by affidavit or declaration, "The new procedure retains what the Supreme Court focused on in *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045 (2015): That testimony be under oath and subject to cross-examination. The ability to elect cross-examination of the witness in the new unilateral procedure maintains the fairness and weightiness of Board proceedings."); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *2 (TTAB 2019) (testimony by declaration or affidavit is subject to the right of the adverse party to elect cross-examination); *Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *2 (TTAB 2019) (same); *Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1102 (TTAB 2018) ("[T]he right to seek cross examination is integral to the right to offer testimony by declaration."); *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790, 1790 n.16 (TTAB 2018) (statements made in defendant's initial disclosures about attached documents are not properly sworn or otherwise verified under Trademark Rule 2.20 and thus are not testimony; defendant could have introduced additional documents through testimony of potential witness listed in initial disclosure, subject to cross-examination, but defendant chose not to do so); *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790 n.18 (TTAB 2018) (unsworn statement, submitted with duplicate copies of initial disclosures, simply "declaring" use of the mark during the relevant

period not considered because defendant's statement that "the foregoing is true and correct" is not in affidavit form).

See also WeaponX Performance Products. Ltd. v. Weapon X Motorsports, Inc., 126 USPQ2d 1034, 1037 (TTAB 2018) (opposer's objection to applicant's testimony declarations overruled where applicant provided notice to opposer via pretrial disclosures about witnesses and the subject matter of their anticipated testimony, testimony declarations were timely served, and opposer had opportunity but chose not to cross-examine the witnesses).

4. 37 C.F.R. § 2.123(a)(1); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *2-3 (TTAB 2019) (party offering witness testimony by declaration or affidavit bears the expense of producing witnesses for oral cross-examination for witness within jurisdiction of the United States); *Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *2 (TTAB 2019) (party offering foreign witness testimony by declaration or affidavit must make witness available for cross-examination by written questions); *Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1104 n.9 (TTAB 2018) ("when choosing a declarant, the proffering party must weigh its ability to make the declarant available for cross examination, or risk the Board's refusal to consider the testimony.").

5. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) ("Even with oral testimony depositions, the party cross-examining the witness must pay its own travel expense and its own attorney expenses. … The goal of the final rule is to minimize the ability of a party seeking cross-examination to thwart the other party's efforts to rein in the cost of litigation by opting for testimony by affidavit or declaration."); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *3 (TTAB 2019) (petitioner's counsel alternatively sought to take oral cross-examination remotely due to travel and accommodation expense); *USPS v. RPost Communication Ltd.*, 124 USPQ2d 1045, 1047 and 1047 n.1 (TTAB 2017) (party seeking oral cross-examination of affiant or declarant must pay its own travel and attorney expenses including, if necessary, cost of lodging and procuring accommodation for the deposition); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1166-67 (TTAB 2017) (only new costs to party seeking oral cross-examination of affiant or declarant are that of court reporter and the venue if necessary).

6. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) ("The proffering party has had and will retain the expense of producing its witness."); *USPS v. RPost Communication Ltd.*, 124 USPQ2d 1045, 1047 and 1047 n.1 (TTAB 2017) (party proffering affiant or declarant for oral cross-examination has and continues to bear expense of producing the witness, as with cross-examination at oral testimony depositions).

7. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) ("The provision that the party seeking oral cross-examination must bear the expense of oral cross-examination is intended to cover the expense of the court reporter. … The goal of the final rule is to minimize the ability of a party seeking cross-examination to thwart the other party's efforts to rein in the cost of litigation by opting for testimony by affidavit or declaration."); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *3 (TTAB 2019) (party seeking to orally cross-examine declarant bears the expense of the court reporter); *USPS v. RPost Communication Ltd.*, 124 USPQ2d 1045, 1047 and 1047 n.1 (TTAB 2017) (same); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1166-67 (TTAB 2017) (only new costs to party seeking oral cross-examination of affiant or declarant are that of court reporter and the venue if necessary).

8. *See* 37 C.F.R. § 2.123(a)(1). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) ("Any redirect and recross is to

be taken at the same time, with the party the originally sought cross-examination bearing the cost of the court reporter. The goal of the final rule is to minimize the ability of a party seeking cross-examination to thwart the other party's efforts to rein in the cost of litigation by opting for testimony by affidavit or declaration."); *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *4-5 (TTAB 2020) (overruling objection to redirect examination of a testimony declarant after oral cross-examination); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *3 (TTAB 2019) (any redirect and recross examination are to be taken at the same time as oral cross-examination).

9. *See Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *1 n.3 (TTAB 2019) (vicinity of the witness's place of business or domicile is a reasonable place for cross-examination); *U.S. Postal Serv. v. RPost Communications Ltd.*, 124 USPQ2d 1045, 1047 n.2 (TTAB 2017) (same).

10. *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *3 (TTAB 2019) (the Board's rules do not mandate that oral cross-examination of a declarant or affiant be in person; by stipulation of the parties or upon motion for good cause, oral cross-examination may be conducted by telephone or other remote means); *USPS v. RPost Communication Ltd.*, 124 USPQ2d 1045, 1047-48 (TTAB 2017) (oral cross-examination of witness may be taken by telephone or other remote means). *See also Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (party unable to attend a trial testimony deposition in person may attend by telephone by stipulation or on motion); *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552 (TTAB 1991) (motion of counsel to attend trial deposition by telephone granted).

11. *See* 37 C.F.R. § 2.123(a)(1) and 37 C.F.R. § 2.124; *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990) (party obtained subpoena from United States district court to compel testimony deposition on written questions of adverse party's United States witness after unsuccessfully attempting to take testimony deposition on written questions on notice alone).

12. 37 C.F.R. § 2.123, 37 C.F.R. § 2.123(a)(2), and 37 C.F.R. § 2.124. *See Empresa Cubana Del Tabaco v. General Cigar Co.* , 2019 USPQ2d 227680, at *2 (TTAB 2019) (when direct testimony of a witness outside of the United States is offered by affidavit or declaration, the method of cross-examination available is written questions; there is no exception to take oral cross-examination of a declarant or affiant outside of the United States upon motion for good cause). With respect to discovery depositions, see 37 C.F.R. § 2.120(c)(1); *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998); *Orion Group Inc. v. Orion Insurance Co.*, 12 USPQ2d 1923, 1925-26 (TTAB 1989) (good cause shown to take oral deposition of witness in England under the circumstances and since fares to England were not that much greater than fares within the United States and no translation was required).

13. *See* 37 C.F.R. § 2.123(a) and 37 C.F.R. § 2.123(a)(2); *Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *2 (TTAB 2019) (party offering foreign witness testimony by declaration or affidavit must make witness available for cross-examination by written questions).

14. *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *3 n.8 (TTAB 2019) (expense of a court reporter (or other officer) is the same whether cross-examination is taken orally or by written questions).

15. 37 C.F.R. § 2.123(a)(2). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) ("The Office is further amending § 2.123(a)(1) to move to § 2.123(a)(2) a provision permitting a motion for deposition on oral examination of a witness in the United States whose testimonial deposition on written questions has been noticed.").

16. *See Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990), *corrected at* 19 USPQ2d 1479 (TTAB 1990) (good cause shown to take oral deposition of expert witness,

during rebuttal testimony period); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980) (good cause shown where deponents were former employees of respondent and present employees of petitioner and were being deposed for first time during rebuttal period).

17. 37 C.F.R. § 2.123(a)(2). *See Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *1 n.8 (TTAB 2019) (parties may stipulate that depositions be taken in a foreign country by oral examination).

18. *See Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *3 n.12 (TTAB 2019) (party seeking to take a deposition in a foreign country should first determine whether it will be permitted by the foreign country, and, if so, what procedure must be followed).

19. 37 C.F.R. § 2.123(b). *See Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *1 n.5 (TTAB 2019) (parties stipulated to introduce the discovery depositions of certain witnesses as trial testimony in lieu of taking their testimonial depositions); *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009) (discovery deposition may be filed by notice of reliance if parties have stipulated to introduction of the deposition); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1847 n.5 (TTAB 2008) (stipulation to use discovery depositions as trial testimony); *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties stipulated to 13 paragraphs of facts involving such issues as applicant's dates of first use and the extent and manner in which a designation is used and advertised, the channels of trade for such use, and recognition by third parties of such use; and the dates, nature and extent of descriptive uses of designation by opposer's parent company); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990) (stipulation for use of discovery deposition as testimony deposition); *Oxy Metal Industries Corp. v. Transene Co.*, 196 USPQ 845, 847 n.20 (TTAB 1977) (litigation expenses can be saved where parties agree to introduce all uncontroverted facts by affidavit or stipulated facts and provide balance through deposition testimony).

703.01(c) Time for Taking Trial Testimony

37 C.F.R. § 2.121 ***Assignment of times for taking testimony and presenting evidence.*** *(a) The Trademark Trial and appeal Board will issue a trial order … assigning to each party its time for taking testimony and presenting evidence ("testimony period"). No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. …*

A party may take trial testimony only during its assigned testimony period, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board. [Note 1.] *See*TBMP § 701.

For information concerning the assignment of testimony periods, and the rescheduling, extension, and reopening thereof, see TBMP § 509 and TBMP § 701.

NOTES:

1. *See* 37 C.F.R. § 2.121(a); *Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *2 n.3 (TTAB 2020) (parties stipulated that any declaration or affidavit shall be admissible even though executed before and not during the testimony period of a party); *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *3-4 (TTAB 2019) (absent stipulation or Board order, "a testimony affidavit or declaration must be taken--that is, executed--during the assigned testimony period, as required by Rule 2.121(a)"), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019). *See also Fossil Inc.*

v. Fossil Group, 49 USPQ2d 1451, 1454 n.1 (TTAB 1998) (parties stipulated that testimony deposition of applicant's witness could be taken prior to its testimony period on the same day as opposer's witness to achieve efficiencies in time and cost). *Cf. International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *3 n.12 (TTAB 2020) (declarations signed prior to testimony period and submitted by opposers as trial testimony considered to have been properly submitted because applicants did not object to them as untimely, and, in fact, treated them as part of the record by raising substantive objections against them), *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020); *Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to the opening of opposer's testimony period, and applicant first raised a timeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected on seasonable objection).

703.01(d) Time and Place of Oral Testimony Deposition

37 C.F.R. § 2.123

(a)(1) *The testimony of witnesses in inter partes cases may be submitted in the form of an affidavit or a declaration pursuant to § 2.20 and in conformance with the Federal Rules of Evidence, filed during the proffering party's testimony period, subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination of that witness as provided under paragraph (c) of this section if such witness is within the jurisdiction of the United States, or conduct cross-examination by written questions as provided in § 2.124 if such witness is outside the jurisdiction of the United States, and the offering party must make that witness available; or taken by deposition upon oral examination as provided by this section; or by deposition upon written questions as provided by § 2.124.*

(2) *Testimony taken in a foreign country shall be taken: by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate;*

* * * *

(c) ***Notice of examination of witnesses.*** *Before the oral depositions of witnesses shall be taken by a party, due notice in writing shall be given to the adverse party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available. When a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election.*

An oral testimony deposition upon direct examination may be noticed for any reasonable time during the deposing party's testimony period. [Note 1.] When a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election. [Note 2.] A testimony deposition may not be taken outside the deposing party's testimony period except by stipulation of the parties approved by the Board, or, on motion, by order of the Board. [Note 3.] *See* TBMP § 701.

An oral testimony deposition to be taken in the United States may be noticed for any reasonable place. [Note 4.] A party may not take oral testimony depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available. [Note 5.]

A testimony deposition may not be noticed for a place in a foreign country, unless the deposition is to be taken on written questions as provided by 37 C.F.R. § 2.124, or unless the Board, on motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination. [Note 6.] *See* TBMP § 703.01(b). The motion for good cause to take an oral deposition under 37 C.F.R. § 2.123(a)(2) concerns direct examination testimony taken in a foreign country by oral deposition rather than by written questions. This portion of the rule is not applicable to cross-examination testimony by an affiant or declarant. [Note 7.] The available method for cross-examination of a witness outside the United States is by written questions pursuant to 37 C.F.R. § 2.124. [Note 8.]

If the parties so stipulate in writing, a testimony deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition. [Note 9.]

NOTES:

1. *See* 37 C.F.R. § 2.123(a)(1) and 37 C.F.R. § 2.123(c); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1786 n.4 (TTAB 2002) ("trial testimony depositions are noticed and taken during the party's assigned testimony period").

2. 37 C.F.R. § 2.123(c).

3. *See* 37 C.F.R. § 2.121(a) and *Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451, 1454 n.1 (TTAB 1998) (stipulation that testimony deposition of applicant's witness could be taken prior to its testimony period on the same day as opposer's witness to achieve efficiencies in time and cost). *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to the opening of opposer's testimony period, and applicant first raised a timeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected on seasonable objection).

4. *See* 37 C.F.R. § 2.123(c); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *1 n.3 (TTAB 2019) (the vicinity of the witness' place of business or domicile has been found to be a reasonable place for oral cross-examination of an affiant or declarant); *USPS v. RPost Communication Ltd.*, 124 USPQ2d 1045, 1047-48 (TTAB 2017) (notice of election of oral cross-examination of declarants quashed because requiring them to travel from Washington, DC, where they live and work, to Santa Monica, CA, is not a reasonable place).

5. *See* 37 C.F.R. § 2.123(c).

6. *See* 37 C.F.R. § 2.123(a), 37 C.F.R. § 2.123(a)(2) and 37 C.F.R. § 2.123(c); *Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *2 n.9, *3 (TTAB 2019) (the rules allow for a motion to take oral direct trial testimony of a witness outside the jurisdiction of the United States upon a showing of good cause; notices of election of oral cross-examination of foreign witnesses are of no effect).

7. *Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *1 n.8, *2 (TTAB 2019).

8. 37 C.F.R. § 2.123(a)(1), 37 C.F.R. § 2.123(a)(2), and 37 C.F.R. § 2.124(b)(3). *See Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *1 n.8, *2 (TTAB 2019) (the method of cross-examination available when direct testimony of a witness outside of the United States is offered by affidavit or declaration is written questions; the trademark rules do not provide an exception to take oral cross-examination of a declarant or affiant outside of the United States upon motion for good cause).

9. 37 C.F.R. § 2.123(b).

703.01(e) Notice of Oral Deposition and Notice of Election of Oral Cross-Examination of Affiant or Declarant

37 C.F.R. § 2.123(b) ***Stipulations.*** *If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. The parties may stipulate in writing what a particular witness would testify to if called; or any relevant facts in the fact may be stipulated in writing.*

37 C.F.R. § 2.123(c)**Notice of examination of witnesses.** *Before the oral depositions of witnesses shall be taken by a party, due notice in writing shall be given to the adverse party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available. When a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election. Upon motion for good cause by any party, or upon its own initiative, the Board may extend the periods for electing and taking oral cross-examination. When such election has been made but cannot be completed within that testimony period, the Board, after the close of that testimony period, shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the oral cross-examination(s).*

Before a party may take the oral testimony deposition upon direct examination of a witness, the party must give due (i.e., reasonable) notice in writing to every adverse party. [Note 1.] *See*TBMP § 533.02(a). *Cf.*TBMP § 404.05. In assessing whether a party gave reasonable notice of a deposition, the Board counts calendar days, not business days. [Note 2.]

The notice must specify the time and place the depositions will be taken, the cause or matter in which they are to be used, and the name and address of each witness to be examined. [Note 3.] *Cf.*TBMP § 404.05.

For information concerning the raising of an objection to a testimony deposition on the ground of improper or inadequate notice, *see* 37 C.F.R. § 2.123(e)(3), TBMP § 533.02, and TBMP § 707.03(b)(2).

If the parties so stipulate in writing, an oral testimony deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition. [Note 4.]

Unlike a deposition transcript, a notice of oral deposition need not be filed with the Board. [Note 5.] However, if a certified copy of the notice of deposition is, for some reason, required for use before a federal district

court, the notice of deposition must be filed with the Board via ESTTA for purposes of certification. [Note 6.] *See*TBMP § 122 and TBMP § 703.01(f)(2).

A party who elects to take oral cross-examination of an affiant or declarant must serve the notice of such election on the adverse party and file a copy of the notice of election with the Board within 20 days from the date of service of the affidavit or declaration, and the party must complete the oral cross-examination within 30 days from the date of service of the notice of election. [Note 7.] On motion for good cause, or on its own initiative, the Board may extend the periods for electing and taking oral cross-examination. When a party has elected to take oral cross-examination of an affiant or declarant, but cannot complete the cross-examination within that testimony period, the Board, after the close of that testimony period, will suspend or reschedule proceedings in the matter to allow for the orderly completion of the oral cross-examination(s). [Note 8.] The notice of election of oral cross-examination of a declarant or affiant to be taken in the United States must be noticed for a reasonable time and place. [Note 9.] Oral cross-examination is not available for an affiant or declarant that is not within the jurisdiction of the United States and must be taken by written questions pursuant to 37 C.F.R. § 2.124. [Note 10.] For information concerning taking depositions in foreign countries, see TBMP § 703.01.

NOTES:

1. 37 C.F.R. § 2.123(c). *See Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 (TTAB 2007) (six calendar days is reasonable notice); *Gaudreau v. American Promotional Events, Inc.*, 82 USPQ2d 1692, 1696 (TTAB 2007) (two days notice prior to the close of the testimony period was unreasonable); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000) (one and two-day notices were not reasonable without compelling need for such haste; three-day notice was reasonable); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 (TTAB 1999) (two-day notice was not reasonable); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998) (one-day notice for deposition of expert witness was short but not prejudicial where party gave notice "as early as possible" and moreover offered to make witness again available at a future date); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1074 (TTAB 1990) (24 hours not sufficient time to prepare for deposition); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (two-day notice of deposition, although short, was not unreasonable where deposition was held a short distance from applicant's attorney's office and where no specific prejudice was shown).

2. *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 (TTAB 2007).

3. *See* 37 C.F.R. § 2.123(c). *See also Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169 (TTAB 1984) (testimony not considered where notice failed to specify name of party being deposed), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984); *O. M. Scott & Sons Co. v. Ferry-Morse Seed Co.*, 190 USPQ 352, 353 (TTAB 1976) (testimony stricken where notice identified one witness and indicated that "possibly others will testify" and where opposer proceeded to take testimony of unidentified witness, applicant objected, did not cross-examine the witness, and moved to strike testimony).

4. 37 C.F.R. § 2.123(a)(1) and 37 C.F.R. § 2.123(b).

5. *See* 37 C.F.R. § 2.123(f).

6. *See* 37 C.F.R. § 2.126(a) and 37 C.F.R. § 2.126(b).

7. *See* 37 C.F.R. § 2.123(c); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *3 (TTAB 2019) (oral cross-examination must be completed within 30 days of service of the notice of election). *Cf. WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037 (TTAB 2018) (opposer's objection to applicant's testimony declarations overruled where applicant provided notice to opposer via pretrial disclosures about witnesses and the subject matter of their anticipated testimony, testimony declarations were timely served, and opposer had opportunity but chose not to cross-examine the witnesses).

8. *See* 37 C.F.R. § 2.123(c) and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is further amending § 2.123(c) to add that, when a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election. The Office is further amending § 2.123(c) to add that the Board may extend the periods for electing and taking oral cross-examination and, when necessary, shall suspend or reschedule proceedings in the matter to allow for the orderly completion of oral cross-examination(s) that cannot be completed within a testimony period."). *Cf. Empresses Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *3 (TTAB 2019) (parties' joint request to extend deadlines to serve notice of cross-examination on written questions of the Cuban declarants, as well as redirect questions granted).

9. *See Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *1 n.3 (TTAB 2019) (the vicinity of the witness' place of business or domicile has been found to be a reasonable place for oral cross-examination of an affiant or declarant). *Cf. Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1110 (TTAB 2018) ("the Board issued an order granting an intervening motion to quash the notice of election of cross-examination as to the location of the cross-examination"); *USPS v. RPost Communication Ltd.*, 124 USPQ2d 1045, 1047 n.2, 1048 (TTAB 2017) (notice of election of oral cross-examination requiring declarants who live and work in Washington, DC to travel to Santa Monica, CA quashed because not noticed for reasonable place, which ordinarily, would be in the vicinity of the witness' place of business or domicile).

10. 37 C.F.R. § 2.123(a)(1), 37 C.F.R. § 2.123(a)(2), and 37 C.F.R. § 2.124(b)(3). *See Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *1 n.8, *2 (TTAB 2019) (the method of cross-examination available when direct testimony of a witness outside of the United States is offered by affidavit or declaration is written questions; the trademark rules do not provide an exception to take oral cross-examination of a declarant or affiant outside of the United States upon motion for good cause).

703.01(f) Securing Attendance of Unwilling Adverse Party or Non-party for Testimony Deposition

Please Note: This section only pertains to testimony depositions, as a party who takes testimony by affidavit or declaration must make the witness available for cross-examination under 37 C.F.R. § 2.123(a) and 37 C.F.R. § 2.123(a)(2). *See*TBMP § 703.01(b).

703.01(f)(1) In General

Normally, during a party's testimony period, testimony depositions are taken, by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness who is willing to appear voluntarily to testify on behalf of the party. These testimony depositions may be taken, at least in the United States, on notice alone.

However, where a party wishes to take the testimony of an adverse party or non-party, or an official or employee of an adverse party or non-party, and the proposed witness is not willing to appear voluntarily to testify, the deposition may not be taken on notice alone. Rather, the party that wishes to take the deposition must take steps, discussed below, to compel the attendance of the witness. [Note 1.] If the witness resides in a foreign country, the party may not be able to take the deposition. *See*TBMP § 703.01(f)(2) (securing attendance of unwilling witness residing in United States), TBMP § 703.01(f)(3) (securing attendance of unwilling witness residing in foreign country), and TBMP § 703.02 (testimony depositions on written questions).

NOTES:

1. *See Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *3 n.12 (TTAB 2019) (to the extent the nonparty employee witnesses located outside the United States are not willing to appear voluntarily to testify during respondent's testimony period, the deposition may not be taken on notice alone, but respondent must take steps to compel their attendance); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990) (after unsuccessfully attempting to take testimony deposition on written questions of adverse party's officer on notice alone, opposer obtained subpoena from U.S. district court ordering appearance); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976) (it is incumbent on deposing party to have a subpoena issued from the U.S. district court where witness is located and have same properly served on witness with sufficient time to apprise him that he is under order to appear). *See also Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 55 n.7 (TTAB 1983) (no adverse inference can be drawn from adverse party's failure to appear and produce requested documents at testimony deposition where party attempted to secure attendance by notice alone), *aff'd*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984).

703.01(f)(2) Unwilling Witness Residing in United States

If a party wishes to take the trial testimony of an adverse party or non-party (or an official or employee of an adverse party or non-party) residing in the United States, and the proposed witness is not willing to appear voluntarily to testify, the party wishing to take the testimony must secure the attendance of the witness by subpoena pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45. [Note 1.] *Cf.*TBMP § 404.03(a)(2) (securing attendance of non-party residing in U.S. at discovery deposition).

The subpoena must be issued, pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45, from the United States district court in the federal judicial district where the witness resides or is regularly employed. [Note 2.] Occasionally district courts may request a "matter number" for the issuance of a subpoena. If that is the case, the requesting party should obtain one from the court or determine whether the Board's proceeding number will satisfy the court. If, for any reason, a certified copy of the notice of deposition is required in connection with the subpoena, such as for purposes of a motion to quash the subpoena, or a motion to enforce the subpoena, the interested party should contact the clerk of the court to determine whether the court will require a formal certified copy (i.e., a certified copy bearing a USPTO seal) of the notice. [Note 3.] A certified copy of a notice of deposition is a copy prepared by the party noticing the deposition, and certified by the USPTO as being a true copy of the notice of deposition filed in the proceeding before the Board. A copy of a notice of deposition cannot be certified by the USPTO unless it has been filed in the Board proceeding. For information relating to USPTO certification of a notice of deposition, see TBMP § 122.

If a person named in a subpoena compelling attendance at a testimony deposition fails to attend the deposition, or refuses to answer a question propounded at the deposition, the deposing party must seek enforcement from the United States district court that issued the subpoena. Similarly, any request to quash a subpoena

must be directed to the United States district court that issued the subpoena. The Board has no jurisdiction over depositions by subpoena. [Note 4.]

NOTES:

1. *See Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583-84 (TTAB 1976).

2. *Cf.* 37 C.F.R. § 2.120(b).

Please Note: To the extent that the 2013 amendments to Fed. R. Civ. P. 45(a)(2) and Fed. R. Civ. P. 45(f) conflict with 35 U.S.C. § 24, § 24 is controlling. *See* 37 C.F.R. § 2.116(a) ("Except as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure.").

3. **Please Note:** The Board no longer provides verified copies of filings.

4. *See, e.g., In re Johnson & Johnson*, 59 F.R.D. 174, 178 USPQ 201, 201 (D. Del. 1973) (no power to grant protective order with respect to depositions taken by subpoena); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 n.3 (TTAB 1987) (no authority to quash subpoena); *PRD Electronics Inc. v. Pacific Roller Die Co.*, 169 USPQ 318, 319 n.3 (TTAB 1971) (opposer's allegation in its brief that applicant defied a subpoena to produce witnesses is a matter opposer should have pursued before the court that issued the subpoena). *Cf. Ate My Heart v. GA GA Jeans*, 111 USPQ2d 1564, 1565 n.5 (TTAB 2014) (notice of deposition of unwilling non-party witness must include subpoena, and related motions must be filed with district court that issued subpoena, not Board).

703.01(f)(3) Unwilling Witness Residing in Foreign Country

There is no certain procedure for obtaining, in a Board inter partes proceeding, the trial testimony deposition of a witness who resides in a foreign country, is an adverse party or a non-party (or an official or employee of an adverse party or non-party), and is not willing to appear voluntarily to testify. However, the deposing party may be able to obtain the testimony deposition of such a witness through the letter rogatory procedure or The Hague Convention letter of request procedure. [Note 1.]

For information concerning these procedures, see TBMP § 404.03(c)(2) and TBMP § 703.01(g).

The U.S. Court of Appeals for the Fourth Circuit has held, however, that a district court has the power to issue a subpoena for a trial deposition noticed under Fed. R. Civ. P. 30(b)(6), requiring a foreign corporate applicant to produce an appropriate representative in the United States for testimony on the subjects identified in the subpoena, regardless of the domicile of the representative. [Note 2.]

The deposition of an unwilling witness (adverse party or non-party) who resides in a foreign country may not be taken on notice alone; steps must be taken to compel the unwilling witness to appear. [Note 3.]

NOTES:

1. *See Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *3 n.12 (TTAB 2019) (quoting TBMP § 703.01(f)(3)); *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d

1859, 1862 (TTAB 2009) (attendance of non-party witness residing outside the United States could not be compelled).

2. *Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises Ltd.*, 511 F.3d 437, 85 USPQ2d 1385 (4th Cir. 2007), *cert. denied*, 128 S. Ct. 2508 (2008).

3. *See Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *3 n.12 (TTAB 2019) (steps must be taken to compel attendance of Cuban declarants).

703.01(g) Persons Before Whom Depositions May be Taken

37 C.F.R. § 2.123(d) ***Persons before whom depositions may be taken.*** *Depositions may be taken before persons designated by Rule 28 of the Federal Rules of Civil Procedure.*

Fed. R. Civ. P. 28. Persons Before Whom Depositions May Be Taken.

(a) ***Within the United States.***

(1) ***In General.*** *Within the United States or a territory or insular possession subject to United States jurisdiction, a deposition must be taken before:*

(A) *an officer authorized to administer oaths either by federal law or by the law in the place of examination; or*

(B) *a person appointed by the court where the action is pending to administer oaths and take testimony.*

(2) ***Definition of "Officer."*** *The term "officer" in Rules 30, 31 and 32 includes a person appointed by the court under this rule or designated by the parties under Rule 29(a).*

(b) ***In a Foreign Country.***

(1) ***In General.*** *A deposition may be taken in a foreign country:*

(A) *under an applicable treaty or convention;*

(B) *under a letter of request, whether or not captioned a "letter rogatory";*

(C) *on notice, before a person authorized to administer oaths either by federal law or by the law in the place of examination; or*

(D) *before a person commissioned by the court to administer any necessary oath and take testimony.*

(2) ***Issuing a Letter of Request or a Commission.*** *A letter of request, a commission, or both may be issued:*

(A) *on appropriate terms after an application and notice of it; and*

(B) *without a showing that taking the deposition in another manner is impracticable or inconvenient.*

(3) ***Form of a Request, Notice, or Commission.*** *When a letter of request or any other device is used according to a treaty or convention, it must be captioned in the form prescribed by that treaty or convention. A letter of request may be addressed "To the Appropriate Authority in [name of country]." A deposition notice or a commission must designate by name or descriptive title the person before whom the deposition is to be taken.*

(4) ***Letter of Request--Admitting Evidence.*** *Evidence obtained in response to a letter of request need not be excluded merely because it is not a verbatim transcript, because the testimony was not taken*

under oath, or because of any similar departure from the requirements for depositions taken within the United States.

(c) ***Disqualification.*** *A deposition must not be taken before a person who is any party's relative, employee, or attorney; who is related to or employed by any party's attorney; or who is financially interested in the action.*

Depositions in Board inter partes proceedings may be taken before the persons described in Fed. R. Civ. P. 28. [Note 1.]

Thus, in the United States (or in any territory or insular possession subject to the jurisdiction of the United States) a testimony deposition in a Board proceeding "must be taken before an officer authorized to administer oaths either by federal law or by the law in the place of examination; or before a person appointed by the court where the action is pending to administer oaths and take testimony." [Note 2.] As a practical matter, Board proceeding depositions taken in the United States are usually taken before a court reporter who is authorized to administer oaths in the jurisdiction where the deposition is taken.

In a foreign country, a testimony deposition in a Board proceeding may be taken pursuant to Fed. R. Civ. P. 28(b). This means, for example, that a testimony deposition in a Board proceeding taken of a willing witness in a foreign country usually may be taken on notice before a U.S. consular official, or before anyone authorized by the law of the foreign country to administer oaths therein. Some countries, however, may prohibit the taking of testimony within their boundaries for use in any other country, including the United States, even though the witness is willing; or may permit the taking of testimony only if certain procedures are followed. [Note 3.] A party which wishes to take a testimony deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of American Citizen Services, U.S. Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed. The testimony of an unwilling adverse party or non-party witness may be taken in a foreign country, if at all, only by the letter rogatory procedure, or by the letter of request procedure provided under the Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters, or by any other procedure provided for the purpose by any future treaty into which the United States may enter. [Note 4.] *Cf.*TBMP § 404.03(c) (concerning discovery deposition of non-party residing in foreign country) and TBMP § 703.01(f)(3) (securing attendance of unwilling witness residing in foreign country). If the parties so stipulate in writing (and if permitted by the laws of the foreign country, in the case of a deposition to be taken in a foreign country), a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition. [Note 5.]

NOTES:

1. 37 C.F.R. § 2.123(d).

2. *See* Fed. R. Civ. P. 28(a).

3. *See* 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil § 2083 (3d ed. 2020).

4. *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 n.5 (TTAB 2009). *See also Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *3 n.12 (TTAB 2019) (party that wishes to take a deposition in a foreign country should first determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed).

5. 37 C.F.R. § 2.123(b).

703.01(h) Examination of Witnesses

37 C.F.R. § 2.123(e) ***Examination of witnesses.***

(1) *Each witness before providing oral testimony shall be duly sworn according to law by the officer before whom the deposition is to be taken. Where oral depositions are taken, every adverse party shall have a full opportunity to cross-examine each witness. When testimony is proffered by affidavit or declaration, every adverse party will have the right to elect oral cross-examination of any witness within the jurisdiction of the United States. For examination of witnesses outside the jurisdiction of the United States, see § 2.124.*

(2) *The deposition shall be taken in answer to questions, with the questions and answers recorded in their regular order by the officer, or by some other person (who shall be subject to the provisions of Rule 28 of the Federal Rules of Civil Procedure) in the presence of the officer except when the officer's presence is waived on the record by agreement of the parties. The testimony shall be recorded and transcribed, unless the parties present agree otherwise. Exhibits which are marked and identified at the deposition will be deemed to have been offered into evidence, without any formal offer thereof, unless the intention of the party marking the exhibits is clearly to the contrary.*

(3) *If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.*

(i) *A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with 2.121(e).*

(ii) *A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

(4) *All objections made at the time of an oral examination to the qualifications of the officer taking the deposition, or to the manner of taking it, or to the evidence presented, or to the conduct of any party, and any other objection to the proceedings, shall be noted by the officer upon the deposition. Evidence objected to shall be taken subject to the objections.*

37 C.F.R. § 2.123(g) ***Form of deposition.*** *(1) The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. The deposition must be in written form. The questions propounded to each witness must be consecutively numbered unless the pages have numbered lines. Each question must be followed by its answer. The deposition transcript must be submitted in full-sized format (one page per sheet), not condensed (multiple pages per sheet).*

Fed. R. Civ. P. 30(b)(4) By Remote Means. *The parties may stipulate — or the court may on motion order — that a deposition be taken by telephone or other remote means. For the purpose of this rule and Rules 28(a), 37(a)(2), and 37(b)(1), the deposition takes place where the deponent answers the questions.*

Before providing oral testimony, a witness whose testimony deposition is being taken for use in a Board inter partes proceeding must be duly sworn, according to law, by the officer before whom the deposition is to be taken. [Note 1.] *See*TBMP § 703.01(g).

Testimony by affidavit or declaration pursuant to 37 C.F.R. § 2.20 must be made in conformance with the Federal Rules of Evidence. The testimony affidavit is a sworn statement, signed and dated, while the declaration permits a comparable alternative unsworn statement, signed and dated. Both options are under penalty of perjury, and statements in Board proceedings are subject to 18 U.S.C. § 1001. [Note 2.]

The deposition is taken in answer to questions, and the questions and answers are recorded in order by the officer, or by some other person (who is subject to the provisions of Fed. R. Civ. P. 28) in the presence of the officer, except when the officer's presence is waived on the record by agreement of the parties. The deposition testimony is recorded and transcribed, unless the parties present agree otherwise. [Note 3.]

The Board does not accept videotape testimony. [Note 4.] An affidavit, declaration or testimony deposition must be submitted to the Board in written form via ESTTA, unless ESTTA is unavailable due to technical problems, or under extraordinary circumstances. [Note 5.]

On stipulation of the parties, or on motion granted by the Board, a deposition may be taken or attended by telephone or other remote means. [Note 6.] A deposition taken by telephone or other remote means is taken in the district and at the place where the witness is to answer the questions propounded to him or her. [Note 7.]

Exhibits which are marked and identified at the deposition will be deemed to have been offered in evidence, even if no formal offer thereof is made, unless the intention of the party marking the exhibits is clearly to the contrary. [Note 8.]

Regardless of the form of the direct testimony, every adverse party must be given an opportunity to cross-examine the witness, and the proffering party may conduct redirect examination of a witness following cross-examination. [Note 9.] For information concerning cross-examination of witnesses on written questions, see TBMP § 703.02. If pretrial disclosures or the notice of deposition served by a party is improper or inadequate with respect to the witness, an adverse party may file a motion to quash before the deposition is scheduled to take place, or alternatively, cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence. [Note 10.] When testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial or rebuttal disclosure, the remedy for any adverse party is the prompt filing of a motion to strike. [Note 11.] For information concerning the raising of an objection to a testimony deposition on the ground of improper or inadequate pretrial disclosures or notice, see 37 C.F.R. § 2.121(e), 37 C.F.R. § 2.123(e)(3), TBMP § 533.02, TBMP § 707.03(b)(2) and TBMP § 707.03(b)(3).

All objections made at the time of the taking of a testimony deposition as to the qualifications of the officer taking the deposition, the manner of taking the deposition, the evidence presented, the conduct of any party, or any other objection to the proceedings, are noted by the officer upon the deposition. Evidence objected to is taken subject to the objections. [Note 12.] *See*TBMP § 707.03.

Questions to which an objection is made ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information that is, for example, privileged, trade secret or otherwise protected from disclosure by the protective order in place for the case. *See*TBMP § 404.09. For information concerning the propounding party's recourse if a witness not only objects to, but also refuses to answer, a particular question, see TBMP § 404.09 and TBMP § 707.03(d).

For further information concerning the raising of objections to testimony depositions, affidavits and declarations, see TBMP § 533 and TBMP § 707.03.

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken may be used like any other deposition. [Note 13.]

For information concerning depositions of witnesses in foreign countries, see TBMP § 703.01(g).

NOTES:

1. 37 C.F.R. § 2.123(e)(1). *See Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPQ2d 1382, 1384 (TTAB 2000) (objection to deposition taken in Honduras that officer designated in notice did not take deposition and that the transcript did not show due administration of the oath overruled where the person who conducted the deposition had authority to do so under Honduran law and the oath was administered in standard manner under Honduran law). *Cf. TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790 (TTAB 2018) (statements made in defendant's initial disclosures about attached documents are not properly sworn or otherwise verified under Trademark Rule 2.20 and thus are not testimony); *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790 n.18 (TTAB 2018) (unsworn statement, submitted with duplicate copies of initial disclosures, "declaring" use of the mark during the relevant period not considered although parties agreed to present testimony by affidavit, because defendant's "declaration," at the end of the statement, that "the foregoing is true and correct," is not in affidavit form).

2. *See*28 U.S.C. § 1746. *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) (in response to a comment, "the Office has adopted language in the final rule directed to the concerns expressed regarding affidavit testimony by explicitly requiring that the affidavit or declaration pursuant to § 2.20 be made in conformance with the Federal Rules of Evidence. Regarding the concern raised about affidavit or declaration testimony being 'duly sworn' and under penalty of perjury, the testimony affidavit is a sworn statement, while the declaration permits a comparable alternative unsworn statement. *See* 28 U.S.C. § 1746. Either option is under penalty of perjury, and statements in Board proceedings are subject to 18 U.S.C. § 1001."); *M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd.*, 2019 USPQ2d 149090, at *2-3 (TTAB 2019) (motion to strike testimony declaration of foreign witness made under 28 U.S.C. § 1746 granted because the original declaration and substitute declaration by foreign witness did not refer to the laws of the United States as to penalty of perjury); *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790 (TTAB 2018) (statements made in defendant's initial disclosures about attached documents are not properly sworn or otherwise verified under Trademark Rule 2.20 and thus are not testimony); *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790 n.18 (TTAB 2018) (unsworn statement, submitted with duplicate copies of initial disclosures, "declaring" use of the mark during the relevant period not considered although parties agreed to present testimony by affidavit, because defendant's "declaration," at the end of the statement, that "the foregoing is true and correct," is not in affidavit form). *See also Optimal Chemical Inc. v. Srills LLC*, 2019 USPQ2d 338409, at *3 n.37 (TTAB 2019) (declaration that lacked signature and date not considered).

3. 37 C.F.R. § 2.123(e)(2).

4. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) (Board considered but rejected suggestion of allowing videotape depositions: "The Board has never accepted video testimony …. The current online filing system is not able to accept video testimony however, this possibility may be considered in subsequent rulemakings as TTAB's online systems are enhanced."); *USPS v. RPost Communication Ltd.*, 124 USPQ2d 1045, 1047 n.3 (TTAB 2017) (Board does not accept video testimony; transcripts must be submitted).

5. 37 C.F.R. § 2.123(g) and 37 C.F.R. § 2.126.

6. *See* Fed. R. Civ. P. 30(b)(4); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *3 (TTAB 2019) (granting petitioner's alternate motion to take oral cross- examination by telephone or other remote means due to travel and accommodation expense); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (noting parties may resolve conflict concerning the scheduling of deposition where travel for one party is involved, by conducting deposition by telephone or other electronic means); *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1552-53 (TTAB 1991) (Board granted request to attend deposition by telephone, noting that trademark rules do not specifically provide for or prohibit depositions by telephone and that federal court practice favors use of technological benefits). *Cf. USPS v. RPost Communication Ltd.*, 124 USPQ2d 1045 (TTAB 2017) (notice of election of oral cross-examination of declarants quashed because not noticed for reasonable place, but applicant may accept opposer's offer to make witnesses available for oral cross-examination by videoconference or telephone, thus alleviating some concern about travel and attorney expenses).

7. Fed. R. Civ. P. 30(b)(4).

8. 37 C.F.R. § 2.123(e)(2). *Cf. Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835, 1838 n.4 (TTAB 1989) (decided prior to the rule change which eliminated "formal" introduction of exhibits, but exhibits still not excluded).

9. *See* 37 C.F.R. § 2.123(a)(1). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) (concerning the unilateral option to submit testimony by affidavit or declaration, "The new procedure retains what the Supreme Court focused on in *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045 (2015): That testimony be under oath and subject to cross examination. The ability to elect cross-examination of the witness in the new unilateral procedure maintains the fairness and weightiness of Board proceedings."); *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *4-5 (TTAB 2020) (overruling objection to redirect examination of a testimony declarant after oral cross-examination); *Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1102 (TTAB 2018) ("[T]he right to seek cross examination is integral to the right to offer testimony by declaration."). *Cf. TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790, 1790 n.16 (TTAB 2018) (defendant could have introduced additional documents through the testimony of an individual who had been identified in initial disclosures as a potential witness, subject to cross-examination, but defendant chose not to do so); *WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037 (TTAB 2018) (opposer's objection to applicant's testimony declarations overruled where applicant provided notice to opposer via pretrial disclosures about witnesses and the subject matter of their anticipated testimony, testimony declarations were timely served, and opposer had opportunity but chose not to cross-examine the witnesses).

10. 37 C.F.R. § 2.121(e) and 37 C.F.R. § 2.123(e)(3). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.121(e) to add that a party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. The amendment codifies current Office practice.").

11. 37 C.F.R. § 2.121(e). *Cf. Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *4-5 (TTAB 2020) (overruling objection to redirect examination of a testimony declarant after oral cross-examination); *WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037 (TTAB 2018) (opposer's objection to applicant's testimony declarations overruled where applicant provided notice to opposer via pretrial disclosures about witnesses and the subject matter of their anticipated testimony, testimony declarations were timely served, and opposer had opportunity but chose not to cross-examine the witnesses).

12. 37 C.F.R. § 2.123(e)(4).

13. 37 C.F.R. § 2.123(a)(1) and 37 C.F.R. § 2.123(b).

703.01(i) Form of Deposition and Exhibits

37 C.F.R. § 2.123 ***Trial testimony in inter partes cases.***

(f)(2) Certification and filing of deposition. *If any of the foregoing requirements of paragraph (f)(1) of this section are waived, the certificate shall so state. The officer shall sign the certificate and affix thereto his or her seal of office, if he or she has such a seal. The party taking the deposition, or its attorney or other authorized representative, shall then promptly file the transcript and exhibits in electronic form using ESTTA. If the nature of an exhibit precludes electronic transmission via ESTTA, it shall be submitted by mail by the party taking the deposition, or its attorney or other authorized representative.*

(g) Form of deposition.

(1) *The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. The deposition must be in written form. The questions propounded to each witness must be consecutively numbered unless the pages have numbered lines. Each question must be followed by its answer. The deposition transcript must be submitted in full-sized format (one page per sheet), not condensed (multiple pages per sheet).*

(2) *Exhibits must be numbered or lettered consecutively and each must be marked with the number and title of the case and the name of the party offering the exhibit. Entry and consideration may be refused to improperly marked exhibits.*

(3) *Each deposition must contain a word index and an index of the names of the witnesses, giving the pages where the words appear in the deposition and where witness examination and cross-examination begin, and an index of the exhibits, briefly describing their nature and giving the pages at which they are introduced and offered in evidence.*

37 C.F.R. § 2.125(e) *Each transcript shall comply with § 2.123(g) with respect to arrangement, indexing and form.*

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.*
* * * *

Please Note: As with all submissions to the Board, all forms of testimony and exhibits thereto must be filed via ESTTA except if ESTTA is unavailable due to technical problems, or under extraordinary circumstances. [Note 1.] Although the USPTO has not specified requirements for the form of exhibits attached to affidavit or declaration testimony, parties are encouraged to use as a guide the form requirements set out for exhibits to depositions in 37 C.F.R. § 2.123(g)(2) and the mailing requirements for certain exhibits set out in 37 C.F.R. § 2.123(f)(2). In addition, parties are reminded that documents submitted under affidavit or declaration but not identified therein cannot be considered as exhibits. [Note 2.]

A deposition must be submitted to the Board in written form. [Note 3.] The Board does not accept videotape depositions. [Note 4.]

Parties must file depositions and exhibits thereto electronically through ESTTA unless ESTTA is unavailable due to technical problems, or under extraordinary circumstances. [Note 5.] See TBMP § 106.03, TBMP § 106.09 and TBMP § 110 for further information about ESTTA. Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible. [Note 6.] Exhibits pertaining to a paper submission must be filed on paper and must comply with the requirements for a paper submission. [Note 7.]

The pages of a deposition must be numbered consecutively and the name of the witness must be written plainly and conspicuously at the top of each page. Unless the pages have numbered lines, the questions asked of each witness must be numbered consecutively. Each question must be followed by its answer. Deposition transcripts must be submitted through ESTTA in an electronic format (e.g., PDF) that displays the document in full-size with one page per sheet, rather than in condensed format with multiple pages per sheet [Note 8], and in at least 11-point type and double-spaced. [Note 9.]

Deposition exhibits must be numbered or lettered consecutively, and each exhibit must be marked with the number and title of the case, and the name of the party who is offering the exhibit. The Board may not consider exhibits that are not properly marked. [Note 10.]

Deposition transcripts also must contain a word index listing the pages where the words appear in the deposition, an index of the names of the witnesses listing the pages where witness examination and cross-examination begin, and an index of exhibits with a brief description of the exhibit and the pages where they are introduced and offered in evidence. [Note 11.]

ESTTA exhibits may be in PDF, TIFF or TXT format. PDF is preferred, and should be used, if possible. Files should be formatted in letter size (8.5” x 11”), and should be rendered at 300 dpi resolution. ESTTA will accept either color or black and white PDF documents for uploading. A best practice for electronic

exhibits submitted in PDF form is to use a separator page for each exhibit and to assign a bookmark to that page with an alpha-numeric designation (such as A, B,C or 1, 2, 3) for easy navigation and location of the exhibit.

Exhibits that are large, bulky, valuable, or breakable may be photographed or otherwise reproduced so that an appropriate paper or digitized image of the exhibits can be filed with the Board in lieu of the originals. The originals should, of course, be shown to every adverse party. Exhibits consisting of video or audio recordings of commercials, demonstrations, etc., may be transferred to an appropriate electronic format such as a DVD or CD for submission to the Board. [Note 12.] When making a submission of an exhibit on CD or DVD, parties are advised to include in the accompanying ESTTA filing, a ''placeholder'' exhibit page to indicate the CD or DVD exhibit, and to mail the CD or DVD to the Board.

CD, DVD, USB drive, etc. ("physical media") submissions should not be used for exhibits that can be submitted via ESTTA as image or text files. Physical media should only be used when filing via ESTTA is not possible.

Each party is responsible for ensuring that its submissions are clear and legible, with each page displayed so it can be read from top to bottom. [Note 13.] Problems with image quality sometimes arise when poor quality documents are scanned or when the quality of legible documents is degraded in the scanning process; these problems typically arise in documents (or parts of documents) featuring graphical material, as opposed to text. Quality can sometimes be significantly degraded when color documents are scanned in black and white or when contrast settings used in scanning are not appropriate for graphical material. If legibility of material in color or grayscale is important, the party is urged to scan the file in color or adjust the scanner's contrast settings to achieve acceptable results prior to filing. Users can check the quality of their submission in TTABVUE after filing. TTABVUE contains the same images that the Board will use in considering the submission. If the TTABVUE image is not of acceptable quality, the user should not assume that the Board will be able to view and consider it appropriately.

Confidential portions of the deposition and confidential exhibits must be submitted in accordance with 37 C.F.R. § 2.126(c). Confidential materials must be filed through ESTTA using the "CONFIDENTIAL" option or, where appropriate, under separate paper cover. For further information concerning the submission of confidential information, see TBMP § 703.01(p) and TBMP § 703.02(l).

In the unlikely event that a party must file a testimony deposition or exhibits on paper, the party is to follow the requirements set out in 37 C.F.R. § 2.126(b), reproduced at the beginning of this subsection.

For information concerning deposition objections based on errors or irregularities in form, see TBMP § 707.03(c).

NOTES:

1. *See* 37 C.F.R. § 2.126(a) and 37 C.F.R. § 2.126(b).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office has not set out in the final rule any specific requirements regarding the form of exhibits. The Board and the parties have experience with such submissions in connection with summary judgment motions and ACR procedures as described in the TBMP at sections 528.05(b) and 702.04, which do not specify requirements for the form of exhibits, and this has not created problems. Notably, documents submitted under an affidavit or declaration but not identified therein cannot be considered

as exhibits. The parties are encouraged to be guided by the form requirements set out for exhibits to depositions in § 2.123(g)(2) and the mailing requirements for certain exhibits set out in § 2.123(f)(2).").

3. 37 C.F.R. § 2.123(g)(1). *See USPS v. RPost Communication Ltd.*, 124 USPQ2d 1045, 1047 n.3 (TTAB 2017) ("No matter how the cross-examination is conducted, transcripts must be submitted pursuant to Trademark Rules 2.123(f)(2) and (g).").

4. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) (Board considered but rejected suggestion of allowing videotape depositions: "The Board has never accepted video testimony …. The current online filing system is not able to accept video testimony however, this possibility may be considered in subsequent rulemakings as TTAB's online systems are enhanced."); *USPS v. RPost Communication Ltd.*, 124 USPQ2d 1045, 1047 n.3 (TTAB 2017) (Board does not accept video testimony; transcripts must be submitted).

5. *See* 37 C.F.R. § 2.126(a), 37 C.F.R. § 2.126(a)(1), and 37 C.F.R. § 2.126(b).

6. 37 C.F.R. § 2.126(a)(1); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("The Office is adding new § 2.126(a)(2) to require that exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible. The amendment codifies the use of electronic filing."). *See Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *1 n.6 (TTAB 2020) (the Board noted multiple blank pages of an exhibit attached to a testimony affidavit; party who introduces documents must ensure they are complete and legible), *appeal filed*, No. 3:20-cv-00400-MHL (E.D. Va. June 5, 2020); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013) (citing *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) ("It is reasonable to assume that it is opposer's responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible….")), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351-52 (TTAB 2014) (duty of the party making submissions to the Board via ESTTA to ensure that they have been entered into the trial record), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014). *See also Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1563 n.7 (TTAB 2011) (opposer filed exhibits separately under a notice of reliance but the proper procedure is to attach exhibits to the copy of the transcript being filed), *rev'd on other grounds*, slip op. No. 11-3684 (D.N.J. August 29, 2017); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 n.9 (TTAB 2011) (same).

7. 37 C.F.R. § 2.123(g)(2). *See Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1563 n.7 (TTAB 2011) (opposer filed exhibits separately under a notice of reliance but the proper procedure is to attach exhibits to the copy of the transcript being filed), *rev'd on other grounds*, slip op. No. 11-3684 (D.N.J. August 29, 2017); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 n.9 (TTAB 2011) (same).

8. 37 C.F.R. § 2.123(g)(1). *See, e.g., Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 129 USPQ2d 1027, 1030 n.33 (TTAB 2018) (condensed version of transcript submitted).

9. 37 C.F.R. § 2.126(a)(1).

10. 37 C.F.R. § 2.123(g)(2). *See AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at *12 (TTAB 2020) (due to anticipated voluminous record, parties directed to bookmark any exhibits intended to be submitted in PDF form and to identify the exhibits consecutively in the bookmarks "by an alpha-numeric

designation …such as A,B,C, etc. or 1,2,3, etc.”). *Cf. Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPQ2d 1382, 1384 (TTAB 2000) (these requirements are for the convenience of the Board; improperly marked exhibits considered); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (the Board has discretion to consider improperly marked exhibits).

11. 37 C.F.R. § 2.123(g)(3).

12. *See Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *3 n.4 (TTAB 2020) (a party that wishes to submit audio or video files must record the files on an appropriate medium such as CD-ROM or DVD and physically file it with the Board); *Pierce-Arrow Society v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at *1 n.8 (TTAB 2019) (Board considered video documentary submitted on CD-ROM); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1654-55 (TTAB 2014) (parties may not override Trademark Rule 2.126 provisions for form of submissions by agreement; however, video and audio recordings of evidence such as commercials may be submitted on CD-ROM), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016).

13. *See* 37 C.F.R. § 2.126(a)(2) and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) (“The Office is adding new § 2.126(a)(2) to require that exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible. The amendment codifies the use of electronic filing.”). *See also Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *1 n.6 (TTAB 2020) (the Board noted multiple blank pages of an exhibit attached to a testimony affidavit; party who introduces documents must ensure they are complete and legible), *appeal filed*, No. 3:20-cv-00400-MHL (E.D. Va. June 5, 2020); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013) (*citing Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) (“It is reasonable to assume that it is opposer’s responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible….”)), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351-52 (TTAB 2014) (duty of the party making submissions to the Board via ESTTA to ensure that they have been entered into the trial record), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014).

703.01(j) Signature of Deposition by Witness

37 C.F.R. § 2.123(e)(5) *When the oral deposition has been transcribed, the deposition transcript shall be carefully read over by the witness or by the officer to the witness, and shall then be signed by the witness in the presence of any officer authorized to administer oaths unless the reading and the signature be waived on the record by agreement of all parties.*

The signing of an oral deposition transcript by the witness is governed by 37 C.F.R. § 2.123(e)(5). The deposition transcript does not have to be signed in the presence of the officer before whom the oral deposition was taken. It may be signed in the presence of any officer authorized to administer oaths. If the parties choose an alternative method of signing, such as by using real-time transcription software on tablets that allows the deponent to sign when the deposition concludes, but while the deponent is still under oath, they are encouraged to memorialize their agreement, on the record, at the beginning of the deposition.

Reading and signature cannot be waived by mere agreement of the witness; the agreement of every party is required. [Note 1.]

NOTES:

1. *See* 37 C.F.R. § 2.123(e)(5). *See also Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPQ2d 1382, 1383 (TTAB 2000) (where witness did not sign his deposition, the defect was curable and party allowed time to file and serve a signed copy). *Cf. Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2002) (depositions which were not signed and included no waiver were nevertheless considered where no objections were made).

703.01(k) Certification and Filing of Trial Testimony

37 C.F.R. § 2.123(f) ***Certification and filing of deposition.***

(1) *The officer shall annex to the deposition his or her certificate showing:*

(i) *Due administration of the oath by the officer to the witness before the commencement of his or her deposition;*

(ii) *The name of the person by whom the deposition was taken down, and whether, if not taken down by the officer, it was taken down in his or her presence;*

(iii) *The presence or absence of the adverse party;*

(iv) *The place, day, and hour of commencing and taking the deposition;*

(v) *The fact that the officer was not disqualified as specified in Rule 28 of the Federal Rules of Civil Procedure.*

(2) *If any of the foregoing requirements in paragraph (f)(1) are waived, the certificate shall so state. The officer shall sign the certificate and affix thereto his or her seal of office, if he has such a seal. The party taking the deposition, or its attorney or other authorized representative, shall then promptly file the transcript and exhibits in electronic form using ESTTA. If the nature of an exhibit precludes electronic transmission via ESTTA, it shall be submitted by mail by the party taking the deposition, or its attorney or other authorized representative.*

37 C.F.R. § 2.125 ***Filing and service of testimony.***

(a) *One copy of the declaration or affidavit prepared in accordance with § 2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Trademark Trial and Appeal Board during the assigned testimony period.*

(b) *One copy of the transcript of each testimony deposition taken in accordance with § 2.123, or § 2.124 together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party within thirty days after completion of the taking of that testimony. If the transcript with exhibits is not served on each adverse party within thirty days or within an extension of time for the purpose, any adverse party which was not served may have remedy by way of a motion to the Trademark Trial and Appeal Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate. If the deposing party fails to serve a copy of the transcript with exhibits on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take any such other action as may be deemed appropriate.*

* * * *

(d) *One certified transcript and exhibits shall be filed with the Trademark Trial and Appeal Board. Notice of such filing shall be served on each adverse party and a copy of each notice shall be filed with the Board.*

The certification and filing of a deposition are governed by 37 C.F.R. § 2.123(f). The certified transcript, with exhibits, must be filed promptly with the Board via ESTTA. [Note 1.] See TBMP § 106 and TBMP § 110 for more information about using ESTTA. However, if the nature of the exhibit, such as CDs or DVDs, precludes electronic transmission via ESTTA, the party (or its attorney or other authorized representative) shall mail the exhibit to the Board at its mailing address, i.e., Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451, Alexandria, Virginia 22313-1451. [Note 2.]

The Board interprets "promptly file," in 37 C.F.R. § 2.123(f)(2) which concerns the filing of transcripts and exhibits, as meaning filed at any time prior to the submission of the case for final decision. Therefore, the Board will accept transcripts of testimony depositions filed at any time prior to the submission of the case for final decision. [Note 3.] The submitting party should file the testimony deposition transcript with the Board under separate cover, under a notice of filing, rather than under notice of reliance. [Note 4.] However, notice of the filing of the certified transcript, and accompanying exhibits, with the Board must be served on each adverse party. A copy of each such notice must also be filed with the Board. [Note 5.] In addition, one copy of the deposition transcript, together with copies, duplicates, or photographs of the exhibits thereto, must be served on each adverse party within 30 days after completion of the taking of the testimony, or within an extension of time for the purpose. [Note 6.]

The filing of an affidavit or declaration prepared in accordance with 37 C.F.R. § 2.123 is governed by 37 C.F.R. § 2.125(a). A party who takes testimony by affidavit or declaration must serve a copy of the declaration or affidavit along with copies of exhibits on each adverse party at the same time the party submits the declaration or affidavit to the Board during the party's assigned testimony period. [Note 7.] The submitting party should file the testimony affidavit or declaration with the Board under separate cover, rather than under notice of reliance. [Note 8.]

For information concerning the service of trial testimony and the remedy that an adverse party may have if it is not timely served with a copy of the affidavit, declaration or deposition and exhibits, see TBMP § 703.01(m).

For information concerning submission of evidence by notice of reliance, see TBMP § 704.

NOTES:

1. *See* 37 C.F.R. § 2.123(f)(2) and 37 C.F.R. § 2.125(d) (formerly 37 C.F.R. § 2.125(c)).

Please Note: Although the USPTO has not specified requirements for the form of exhibits attached to affidavit or declaration testimony, parties are encouraged to use as a guide the form requirements set out for exhibits to depositions in 37 C.F.R. § 2.123(g)(2) and the mailing requirements for certain exhibits set out in 37 C.F.R. § 2.123(f)(2). In addition, parties are reminded that documents submitted under affidavit or declaration but not identified therein cannot be considered as exhibits. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016).

2. *See* 37 C.F.R. § 2.123(f)(2). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("If the nature of an exhibit, such as CDs or DVDs, precludes electronic transmission via ESTTA, it shall be submitted by mail.").

3. *See* NOTICE OF FINAL RULEMAKING, 63 Fed. Reg. 48081 (September 9, 1998), and comments and responses published in the notice in regard to amendment of 37 C.F.R. § 2.123(f) and 37 C.F.R. § 2.125(c) (now 37 C.F.R. § 2.125(d)). *See also Grote Industries, Inc. v. Truck-Lite Co., LLC* , 126 USPQ2d 1197,

1201 (TTAB 2018) (copies of oral testimony transcripts may be filed with the Board at any time before the case is submitted for final decision), *complaint filed* , No. 18-CV-599-LJV-MJR (W.D.N.Y May 4, 2018); *Syngenta Crop Protection Inc. v. Bio-Chek LLC* , 90 USPQ2d 1112, 1115 (TTAB 2009) (testimony must be taken during the offering party's testimony period, but need not be submitted during the party's testimony period; transcript must be served within thirty days after completion of the taking of that testimony); *Hewlett-Packard Co. v. Human Performance Measurement, Inc.* , 23 USPQ2d 1390, 1392 n.6 (TTAB 1991) (the wording "promptly filed" in an earlier version of 37 C.F.R. § 2.125(d) (formerly 37 C.F.R. § 2.125(c)) was construed as meaning filed at any time prior to final hearing).

4. *Compare* 37 C.F.R. § 2.125(b)*with* 37 C.F.R. § 2.122(e). *See, e.g., Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009) (not appropriate to submit testimony under a notice of reliance); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1786 n.4 (TTAB 2002) (testimony depositions are not filed by notice of reliance but instead are filed under cover of notice of filing which must also be served on each adverse party); *Paramount Pictures Corp. v. Romulan Invasions*, 7 USPQ2d 1897, 1898 n.2 (TTAB 1988); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191, 1192 n.7 (TTAB 1984) (notices of reliance on testimony depositions and exhibits introduced in connection with testimony depositions are unnecessary and superfluous); *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116, 1117 n.1 (TTAB 1982) (notice of reliance on exhibits introduced in connection with testimony superfluous). *Cf. WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037, 1037-38 n.12 (TTAB 2018) (Board denied opposer's motion to strike testimony declarations that had been filed and served as exhibits to applicant's notice of reliance; materials listed normally filed under notice of reliance).

5. *See* 37 C.F.R. § 2.125(d) (formerly 37 C.F.R. § 2.125(c)). *See also Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1786 n.4 (TTAB 2002) (testimony depositions are not filed by notice of reliance but instead are filed under cover of notice of filing which must also be served on each adverse party).

6. *See* 37 C.F.R. § 2.125(b) (formerly 37 C.F.R. § 2.125(a)).

7. *See* 37 C.F.R. § 2.123(a)(1) and 37 C.F.R. § 2.125(a). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.125 to renumber paragraphs (a) through (e) as (b) through (f) and to add new § 2.125(a) to require that one copy of a declaration or affidavit prepared in accordance with § 2.123, with exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Board during the assigned testimony period."). *Cf. Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *1 n.2 (TTAB 2019) (motion to strike testimonial declarations for improper service denied because defect in service and any prejudice was remedied by additional notice of, as well as electronic links to, the testimonial declarations, and petitioner was already aware of and had the opportunity to review the declarations); *WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037 (TTAB 2018) (Board denied opposer's motion to strike testimony declarations that had been filed and served as exhibits to applicant's notice of reliance, as doing otherwise would elevate form over substance. "Although the better practice would have been for Applicant to file and serve separately copies of the [witnesses'] testimony declarations, instead of attaching them as exhibits to its notice of reliance, Applicant's failure to do so is of no consequence.").

8. *Compare* 37 C.F.R. § 2.125(a)*with* 37 C.F.R. § 2.122(e). *See Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *2-3 (TTAB 2019) (opposer's submission of testimonial declaration under a notice of reliance was unnecessary, and not the preferred approach, but harmless). *Cf. WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037 (TTAB 2018) (Board

denied opposer's motion to strike testimony declarations that had been filed and served as exhibits to applicant's notice of reliance, as doing otherwise would elevate form over substance. "Although the better practice would have been for Applicant to file and serve separately copies of the [witnesses'] testimony declarations, instead of attaching them as exhibits to its notice of reliance, Applicant's failure to do so is of no consequence.").

703.01(l) Trial Testimony Must be Filed

37 C.F.R. § 2.123(h) ***Depositions must be filed.*** *All depositions which are taken must be duly filed in the Office. On refusal to file, the Office at its discretion will not further hear or consider the contestant with whom the refusal lies; and the Office may, at its discretion, receive and consider a copy of the withheld deposition, attested by such evidence as is procurable.*

37 C.F.R. § 2.125 ***Filing and service of testimony.***

(a) One copy of the declaration or affidavit prepared in accordance with § 2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Trademark Trial and Appeal Board during the assigned testimony period.

All trial testimony depositions that are taken in a Board inter partes proceeding must be filed with the Board, and, when filed, automatically constitute part of the evidentiary record in the proceeding. [Note 1.] If a party which took a testimony deposition refuses to file it, the Board, in its discretion, may refuse to further hear or consider the party's case, or may receive and consider a copy of the withheld deposition, attested by such evidence as is procurable. [Note 2.]

A party who takes testimony by affidavit or declaration must serve a copy of the declaration or affidavit along with copies of exhibits on each adverse party at the same time the party submits the declaration or affidavit to the Board during the party's assigned testimony period. [Note 3.]

For information concerning the procedure to file trial testimony, see TBMP § 703.01(k).

NOTES:

1. *See* 37 C.F.R. § 2.123(h). *See also e.g., Order Sons of Italy in America v. Memphis Mafia, Inc.*, 52 USPQ2d 1364, 1366 n.4 (TTAB 1999); *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390, 1392 n.6 (TTAB 1991) (opposer was not prejudiced by transcript of testimony deposition filed for first time with applicant's brief on the case because opposer should have assumed it would become part of the record); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191, 1192 n.7 (TTAB 1984). *Cf. An Evening at the Trotters, Inc. v. A Nite at the Races, Inc.*, 214 USPQ 737, 738 n.2 (TTAB 1982) (deposition which had not been filed but was not completed and was not referred to by either party was considered terminated and omitted by stipulation).

2. 37 C.F.R. § 2.123(h). *See Motion Picture Association of America Inc. v. Respect Sportswear Inc.*, 83 USPQ2d 1555, 1558 (TTAB 2007) (because opposer did not argue that testimony and exhibits which applicant failed to file were adverse to applicant, and case was fully briefed and ready for decision, Board decided case without testimony or exhibits).

3. *See* 37 C.F.R. § 2.123 and 37 C.F.R. § 2.125(a). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.125 to renumber paragraphs (a) through (e) as (b) through (f) and to add new § 2.125(a) to require that one copy of a declaration or affidavit prepared in accordance with § 2.123, with exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Board during the assigned testimony period."). *Cf. Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *1 n.2 (TTAB 2019) (motion to strike testimonial declarations for improper service denied because defect in service and any prejudice was remedied by additional notice of, as well as electronic links to, the testimonial declarations, and petitioner was already aware of and had the opportunity to review the declarations); *WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037 (TTAB 2018) (Board denied opposer's motion to strike testimony declarations that had been filed and served as exhibits to applicant's notice of reliance, as doing otherwise would elevate form over substance).

703.01(m) Service of Trial Testimony

37 C.F.R. § 2.125 ***Filing and service of testimony.***

(a) *One copy of the declaration or affidavit prepared in accordance with § 2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Trademark Trial and Appeal Board during the assigned testimony period.*

(b) *One copy of the transcript of each testimony deposition taken in accordance with § 2.123 or § 2.124, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party within thirty days after completion of the taking of that testimony. If the transcript with exhibits is not served on each adverse party within thirty days or within an extension of time for the purpose, any adverse party which was not served may have remedy by way of a motion to the Trademark Trial and Appeal Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate. If the deposing party fails to serve a copy of the transcript with exhibits on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take any such other action as may be deemed appropriate.*

A party who takes testimony by affidavit or declaration must serve a copy of the declaration or affidavit along with copies of exhibits on each adverse party at the same time the party submits the declaration or affidavit to the Board during the party's assigned testimony period. [Note 1.]

One copy of the transcript of a testimony deposition, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, must be served on each adverse party within 30 days after completion of the taking of the testimony, or within an extension of time for the purpose. [Note 2.]

The requirement that a copy of the testimony affidavit, declaration or deposition transcript, with exhibits, be served on every adverse party within the time specified in 37 C.F.R. § 2.125(a) and 37 C.F.R. § 2.125(b)is intended to ensure that each adverse party will have the testimony before it has to offer its own evidence, or, if the testimony in question is rebuttal testimony, to ensure that each adverse party will have the testimony before it has to prepare its brief on the case. [Note 3.] If a copy of the testimony affidavit, declaration or deposition transcript, with exhibits, is not served on each adverse party within that time, any adverse party that was not served may have remedy by way of a motion to the Board to reset its testimony and/or briefing periods, as may be appropriate, or to compel service of the testimony affidavit, declaration or deposition transcript, with exhibits. [Note 4.]

If a party that took a deposition fails to serve a copy of the transcript, with exhibits, on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may take any of the actions mentioned in 37 C.F.R. § 2.125(b). [Note 5.]

NOTES:

1. *See* 37 C.F.R. § 2.123(a)(1) and 37 C.F.R. § 2.125(a). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.125 to renumber paragraphs (a) through (e) as (b) through (f) and to add new § 2.125(a) to require that one copy of a declaration or affidavit prepared in accordance with § 2.123, with exhibits, shall be served on each adverse party at the time the declaration or affidavit is submitted to the Board during the assigned testimony period."). *Cf. Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *7 n.30 (TTAB 2020) (advising parties not to wait until the last day of their testimony period to file a testimony affidavit or declaration to allow time to cure curable defects), *appeal filed*, No. 3:20-cv-00400-MHL (E.D. Va. June 5, 2020); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *1 n.2 (TTAB 2019) (motion to strike testimonial declarations for improper service is denied because defect in service and any prejudice was remedied by additional notice of, as well as electronic links to, the testimonial declarations, and petitioner was already aware of and had the opportunity to review the declarations).

2. 37 C.F.R. § 2.125(b) (formerly 37 C.F.R. § 2.125(a)). *See Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009).

3. *See Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *1 n.2 (TTAB 2019) (motion to strike testimonial declarations for improper service is denied because defect in service and any prejudice was remedied by additional notice of, as well as electronic links to, the testimonial declarations, and petitioner was already aware of and had the opportunity to review the declarations); *Techex, Ltd. v. Dvorkovitz*, 220 USPQ 81, 82 n.2 (TTAB 1983) (opposer's objection to introduction of deposition overruled where opposer had been given time to request additional time for rebuttal in light of late-served copy of transcript but failed to do so); *S. S. Kresge Co. v. J-Mart Industries, Inc.*, 178 USPQ 124, 125 n.3 (TTAB 1973) (applicant's objection in its brief to opposer's introduction of exhibits which were allegedly missing from service copy of deposition transcript was untimely).

4. 37 C.F.R. § 2.125(b) (formerly 37 C.F.R. § 2.125(a)); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009) (resetting adverse party's testimony and/or briefing periods, or compelling service of transcript); *Techex, Ltd. v. Dvorkovitz*, 220 USPQ 81, 83 (TTAB 1983).

5. *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009) (striking of testimony). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending renumbered § 2.125(b) to add a cross-reference to § 2.124 and to clarify that the paragraph applies to testimony depositions, including depositions on written questions.").

703.01(n) Correction of Errors in Trial Testimony Deposition

37 C.F.R. § 2.125(c) *The party who takes testimony is responsible for having all typographical errors in the transcript and all errors of arrangement, indexing and form of the transcript corrected, on notice to each adverse party, prior to the filing of one certified transcript with the Trademark Trial and Appeal Board.*

The party who takes testimony is responsible for serving on each adverse party one copy of the corrected transcript or, if reasonably feasible, corrected pages to be inserted into the transcript previously served.

A party that takes testimony is responsible for having any errors in the transcript corrected, on notice to each adverse party, prior to the filing of the certified transcript with the Board. [Note 1.]

If the witness, upon reading the transcript, discovers that typographical or transcription errors need to be corrected, or that other corrections are necessary to make the transcript an accurate record of what the witness actually said during the taking of his or her testimony, the witness should make a list of all such corrections and forward the list to the officer before whom the deposition was taken. The officer, in turn, should correct the transcript by redoing the involved pages. Alternatively, if there are not many corrections to be made, the witness may correct the transcript by writing each correction above the original text that it corrects, and initialing the correction. Although parties sometimes attempt to correct errors in transcripts by simply inserting a list of corrections at the end of the transcript, this is not an effective method of correction. The Board does not enter corrections for litigants, and the list of corrections is likely to be overlooked and/or disregarded. While corrections may be made in a transcript, to make the transcript an accurate record of what the witness said during the taking of his or her testimony, material changes in the text are not permitted -- the transcript may not be altered to change the testimony of the witness after the fact. [Note 2.]

If corrections are necessary, the party that took the deposition must serve on every adverse party a copy of the corrected transcript or, if reasonably feasible, corrected pages to be inserted into the transcript previously served. [Note 3.]

If errors are discovered after the transcript has been filed with the Board, a list of corrections, signed by the witness, should be submitted to the Board (and served on every adverse party), together with a request for leave to correct the errors. Alternatively, the parties may stipulate that specified corrections may be made. If the request is granted, or if the parties so stipulate, the party that took the deposition should file a substitute, corrected transcript with the Board.

NOTES:

1. 37 C.F.R. § 2.125(c) (formerly 37 C.F.R. § 2.125(b)); *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390, 1392 n.6 (TTAB 1991) (objection to corrections served four days after filing and less than two weeks prior to due date for reply brief overruled since remedy lies in requesting extension of briefing period rather than having Board exclude the evidence).

2. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1325 (TTAB 1992) (any substantive changes made to testimony deposition on written questions would not be considered); *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 333 n.4 (TTAB 1985) (Board gave no consideration to response or corrected response when the correction, which changed the percentage of opposer's business income derived from licensing, was substantive); and *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116, 1117 n.2 (TTAB 1982) (change in testimony from "designing that type of game..." to "designing that Simon Says type of game..." was substantive in nature and not permitted). *Cf. Hollywood Casino LLC v. Chateau Celeste, Inc.*, 116 USPQ2d 1988, 1996 (TTAB 2015) (on summary judgment, Board gave no consideration to a Fed. R. Civ. P. 30(b)(6) discovery deposition errata sheet because it resulted in substantive changes to witness' testimony).

3. *See* 37 C.F.R. § 2.125(c) (formerly 37 C.F.R. § 2.125(b)). *See also Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390, 1392 n.6 (TTAB 1991).

703.01(o) Objections to Testimony Affidavits, Declarations and Depositions

For information concerning objections to testimony affidavits, declarations and depositions, see TBMP § 707.03 and TBMP § 533.

703.01(p) Confidential or Trade Secret Material

37 C.F.R. § 2.116(g) *The Trademark Trial and Appeal Board's standard protective order is automatically imposed in all inter partes proceedings unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. The standard protective order is available at the Office's web site. No material disclosed or produced by a party, presented at trial, or filed with the Board, including motions or briefs which discuss such material, shall be treated as confidential or shielded from public view unless designated as protected under the Board's standard protective order, or under an alternative order stipulated to by the parties and approved by the Board, or under an order submitted by motion of a party granted by the Board. The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.*

37 C.F.R. § 2.125(f) *Upon motion by any party, for good cause, the Trademark Trial and Appeal Board may order that any part of an affidavit or declaration or a deposition transcript or any exhibits that directly disclose any trade secret or other confidential research, development, or commercial information may be filed under seal and kept confidential under the provisions of § 2.27(e). If any party or any attorney or agent of a party fails to comply with an order made under this paragraph, the Board may impose any of the sanctions authorized by § 2.120(h).*

37 C.F.R. § 2.126(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.*

Except for materials filed under seal pursuant to a protective order, the files of proceedings before the Board, including all filings by the parties and exhibits thereto are available for public viewing on the USPTO website via TTABVUE at **http://ttabvue.uspto.gov/**. In addition, a link to TSDR, in which reside the records of the files of subject applications and registrations, is available from TTABVUE. [Note 1.] *See* TBMP § 122.02 and TBMP § 412.05. Therefore, only the particular exhibits or deposition transcript pages of the testimony affidavit, declaration or deposition that disclose confidential information should be filed under seal pursuant to a protective order. If a party over-designates material as confidential, the Board will not be bound by the party's designation, and will treat as confidential only testimony and evidence that is truly confidential and commercially sensitive trade secrets. [Note 2.] *Cf.* TBMP § 801.03. In addition, upon motion by any party, for good cause, the Board may order that any part of an affidavit or declaration or a testimony transcript or any exhibits that directly discloses any trade secret or other confidential research, development, or commercial information may be filed under seal and kept confidential under the provisions of 37 C.F.R. § 2.27(e). Failure to comply with this order may result in imposition of any of the sanctions authorized by 37 C.F.R. § 2.120(h). [Note 3.] *See*TBMP § 502.02.

In accordance with 37 C.F.R. § 2.126(c), a party who submits testimony or associated exhibits containing confidential information under seal or designated as confidential in ESTTA, must submit the testimony or associated exhibits using the "Confidential" selection in ESTTA or, where appropriate, under separate paper

cover. The party must mark both the submission and its cover "confidential," and must identify the case number and parties. The party also must concurrently submit for the public record a redacted version of the testimony or associated exhibit. [Note 4.] A rule of reasonableness dictates what information should be redacted, and only in very rare instances should an entire submission be deemed confidential. [Note 5.] In cases where a redacted version has not been provided, the confidentiality of the information may be deemed waived. [Note 6.] Where, in any publicly accessible filing, a party has cited, quoted from, or described, without redaction, testimony or documents that it has designated as confidential, or that its adversary has designated as confidential and the adversary has not subsequently objected, the Board may treat this as a waiver of the claim of confidentiality as to the content and subject matter of the pertinent materials. [Note 7.] For material or testimony that has been designated confidential and which cannot be viewed on TTABVUE, the parties should include TTABVUE entry and page numbers for both the redacted and confidential versions of the submission when referencing such material in a brief. [Note 8.] *See*TBMP § 801.03.

In addition, in the confidential submission, 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 submissions when the Board is preparing a final decision, and will reduce the likelihood that the Board inadvertently may include confidential matter in a final decision or an order on a motion. For further information regarding the filing of confidential matter and information regarding ESTTA, see TBMP § 110 and TBMP § 412.04.

If ESTTA is unavailable due to technical problems, or extraordinary circumstances exist, a party may file an affidavit, declaration or testimony, and associated exhibits, in paper form. A submission made in paper form must include a written explanation of such technical problems or extraordinary circumstances, or it will not be considered. [Note 9.] Paper submissions are scanned into TTABVUE and designated "confidential." After scanning and designating as "confidential," the Board retains the confidential paper submissions for a short period of time before disposing of the confidential paper submissions in an appropriate manner. Confidential testimony and exhibits submitted in paper are disposed of shortly after the proceeding is terminated.

If a party submits confidential material using ESTTA, the filer should select "CONFIDENTIAL Opposition, Cancellation or Concurrent Use" under "File Documents in a Board Proceeding." Filings made using this option will not be made available for public viewing, although an entry will be made on the publicly-available docket sheet in TTABVUE. Electronic filing using ESTTA is preferred for submissions containing confidential material. *See*TBMP § 120.02 and TBMP § 412.04.

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 10.] For further information on protective orders, see TBMP § 412.

For further information regarding confidential materials, see TBMP § 120.02 and TBMP § 412.

NOTES:

1. 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., Ayoub, Inc. and Ayoub Supply, LLC v. ACS Ayoub Carpet Service*, 118 USPQ2d 1392, 1398 n.39 (TTAB 2016) (party allowed time to file redacted version of material marked as "confidential" but not submitted under seal because "it is the general policy of the Board that all papers in a proceeding be public"); *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).

2. 37 C.F.R. § 2.116(g) and 37 C.F.R. § 2.126(c). *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., The Brooklyn Brewery Corporation v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, at *2 n.13 (TTAB 2020) (Board exercised discretion to "treat as not confidential that material which cannot reasonably be considered confidential" because the "Board must be able to discuss the evidence of record, … so that the parties and a reviewing court will know the basis of the Board's decisions."), *appeal filed*, No. 20-2277 (Fed. Cir. Sept. 16, 2020); *AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at *12 (TTAB 2020) (parties reminded to limit confidential designation to truly confidential or commercially sensitive materials); *Optimal Chemical Inc. v. Srills LLC*, 2019 USPQ2d 338409, at *2 n.13 (TTAB 2019) ("to the extent the parties have improperly designated testimony and evidence as confidential, the Board may disregard the confidential designation when appropriate"); *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1804 n.9 and 1806 n.13-15, 25 (TTAB 2018) (Board not bound by designation; specific examples of improper and over-designation) *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1475 (TTAB 2017) (same); *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1511 n.6 (TTAB 2017) (same); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.12 (TTAB 2012) (where party designated entire testimony deposition confidential, Board allowed party time to file a redacted version); *Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (in pretrial order, parties reminded to refrain from improperly designating evidence or a show cause order may issue); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 (TTAB 2008). *See also General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179, 1181 (TTAB 2008) (although entire deposition was marked confidential, the Board's decision referred to selective portions that appeared to not be truly confidential).

3. *See* 37 C.F.R. § 2.125(f) (formerly 37 C.F.R. § 2.125(e)). *Cf. AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at *5 nn.17-19 (TTAB 2020) (party had been required to resubmit three different witness testimony or discovery depositions with only truly confidential material redacted); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1237-1238 n. 24 (TTAB 2015) (party that submitted entire discovery deposition designated as confidential was ordered to resubmit separate public and confidential copies), *dismissed per stipulation sub nom Kraft Heinz Foods Co. v. Boulder Brands USA, Inc.* Case No. 2:15-0681 (W.D. Pa. May 22, 2017).

4. 37 C.F.R. § 2.126(c). *See Ayoub, Inc. and Ayoub Supply, LLC v. ACS Ayoub Carpet Service*, 118 USPQ2d 1392, 1398 n.39 (TTAB 2016) (party allowed time to file redacted version of material marked as "confidential" but not submitted under seal); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014); *Duke University v. Haggar 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).

5. *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011), judgment set aside on other grounds, 110 USPQ2d 1679 (TTAB 2014) (non-precedential) (excessive markings

of various information as confidential complicates record and often indicates that matter is improperly designated or not useful to case).

6. *See, e.g., Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1633 n.6 (TTAB 2007).

7. *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1475 n.17 (TTAB 2017).

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

9. *See* 37 C.F.R. § 2.126(b). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69966 (October 7, 2016) (discussing the procedure for paper filings).

10. 37 C.F.R. § 2.116(g).

703.02 Testimony Depositions on Written Questions

703.02(a) Depositions on Written Questions: When Available

37 C.F.R. § 2.123

(a)(1) *The testimony of witnesses in inter partes cases may be submitted in the form of an affidavit or a declaration pursuant to § 2.20 and in conformance with the Federal Rules of Evidence, filed during the proffering party's testimony period, subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination of that witness as provided under paragraph (c) of this section if such witness is within the jurisdiction of the United States, or conduct cross-examination by written questions as provided in § 2.124 if such witness is outside the jurisdiction of the United States, and the offering party must make that witness available; or taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by § 2.124.*

(2) *Testimony taken in a foreign country shall be taken: by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness, If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within twenty days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.*

(b) ***Stipulations.*** *If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. The parties may stipulate in writing what a particular witness would testify to if called; or any relevant facts in the case may be stipulated in writing.*

Ordinarily, the testimony of a witness may be taken by affidavit, declaration or on oral examination pursuant to 37 C.F.R. § 2.123, or by deposition on written questions pursuant to 37 C.F.R. § 2.124. [Note 1.] For information concerning testimony by affidavit, declaration or oral depositions, see TBMP § 703.01. However, testimony taken in a foreign country must be taken: by deposition on written questions, unless the Board, on motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate;

or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness. [Note 2.] *See*TBMP § 703.01(b).

In addition, if a party serves notice of the taking of a testimony deposition on written questions of a witness who is, or will be at the time of the deposition, present within the United States (or any territory which is under the control and jurisdiction of the United States), any adverse party may, within 20 days from the date of service of the notice, file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination. [Note 3.] *See*TBMP § 703.01(b). What constitutes good cause to take an oral deposition is determined on a case-by-case basis. [Note 4.] See TBMP § 531.

NOTES:

1. 37 C.F.R. § 2.123(a)(1) and 37 C.F.R. § 2.123(a)(2). *See Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *4 n.21 (TTAB 2019) (noting the three manners for taking testimony, affidavit or declaration, oral deposition, or testimony on written questions), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *2 (TTAB 2019) (during its testimony period a party may take the testimony of a witness, by affidavit or declaration, or by deposition upon oral examination, or, if the witness is located in a foreign country, by deposition upon written questions).

2. *See* 37 C.F.R. § 2.123(a)(2). *Cf. Empresa Cubana Del Tabaco v. General Cigar Co.* , 2019 USPQ2d 227680, at *2 (TTAB 2019) (the method of cross-examination available when direct testimony of a witness outside of the United States is offered by affidavit or declaration is written questions; there is no good cause exception to take oral cross-examination). With respect to discovery depositions, *see* 37 C.F.R. § 2.120(c)(1); *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998); *Orion Group Inc. v. Orion Insurance Co.*, 12 USPQ2d 1923, 1925-26 (TTAB 1989) (good cause shown to take oral deposition of witness in England under the circumstances and since fares to England were not that much greater than fares within the United States and no translation was required).

3. *See* 37 C.F.R. § 2.123(a)(2) (formerly 37 C.F.R. § 2.123(a)(1)); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD, 81 Fed. Reg. 69950, 69964 (October 7, 2016) ("The Office is further amending § 2.123(a)(1) to move to § 2.123(a)(2) a provision permitting a motion for deposition on oral examination of a witness in the United States whose testimonial deposition on written questions has been noticed."). *See also Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990), corrected at 19 USPQ2d 1479 (TTAB 1990) (good cause shown to take oral deposition of expert witness during rebuttal testimony period); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980) (good cause shown where deponents were former employees of respondent and present employees of petitioner and were being deposed for first time during rebuttal period).

4. *See Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980).

703.02(b) Depositions on Written Questions: Before Whom Taken

37 C.F.R. § 2.142(a) *A deposition upon written questions may be taken before any person before whom depositions may be taken as provided by Rule 28 of the Federal Rules of Civil Procedure.*

A deposition on written questions, like a deposition on oral examination, may be taken before the persons described in Fed. R. Civ. P. 28. [Note 1.] For further information, see TBMP § 703.01(g).

NOTES:

1. *See* 37 C.F.R. § 2.124(a). *See, e.g., Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *3 n.8 (TTAB 2019) (both the procedure for oral cross-examination or cross-examination on written questions require a court reporter or other officer to swear in the witness, record the answers and to create a written transcript of the examination).

703.02(c) Depositions on Written Questions: When Taken

37 C.F.R. § 2.121 ***Assignment of times for taking testimony and presenting evidence. (a)*** *The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's required pretrial disclosures and assigning to each party the time for taking testimony and presenting evidence ("testimony period"). No testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. The deadlines for pretrial disclosures and the testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. ...*

37 C.F.R. § 2.124(b)(1) *A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.*

37 C.F.R. § 2.124(b)(3) *A party desiring to take cross-examination, by written questions, of a witness who has provided testimony by affidavit or declaration shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board.*

* * * *

37 C.F.R. § 2.124(d)(1) *… Within twenty days from the date of service of the notice of taking direct examination or service of a testimony affidavit or declaration, any adverse party may serve cross-questions upon the party who proposes to take the deposition. …*

37 C.F.R. § 2.124(d)(2) *... Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written question.*

A party may take trial testimony only during its assigned testimony period, except by stipulation of the parties approved by the Board, or, on motion, by order of the Board. [Note 1.] *See*TBMP § 701. For information concerning the assignment of testimony periods, and the rescheduling, extension, and reopening thereof, see TBMP § 509 and TBMP § 701.

A party that desires to take a testimony deposition on written questions must serve notice thereof on each adverse party within 10 days from the opening date of the deposing party's testimony period, as originally set or as reset. [Note 2.]

A party that desires to take cross-examination, by written questions, of a witness who has provided affidavit or declaration testimony must serve notice thereof on each adverse party, and file a copy of the notice (but not a copy of the questions) with the Board, within twenty days from the date of service of the affidavit or declaration. [Note 3.]

On receipt of written notice that one or more testimony depositions are to be taken on written questions, the Board will generally suspend or reschedule other proceedings in the case to allow for the orderly completion of the depositions on written questions. [Note 4.]

For information concerning the time for taking a discovery deposition, see TBMP § 404.01.

NOTES:

1. 37 C.F.R. § 2.121(a).

2. 37 C.F.R. § 2.124(b)(1). *See Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652, 1652 (TTAB 1990) (notice of testimony depositions on written questions, while served eight months after testimony period originally opened, were nonetheless timely, having been served within 10 days of "opening" of testimony period as last reset).

3. 37 C.F.R. § 2.124(b)(3) and 37 C.F.R. § 2.124(d)(1). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is adding new § 2.124(b)(3) to provide that a party desiring to take cross-examination by written questions of a witness who has provided testimony by affidavit or declaration shall serve notice on each adverse party and file a copy of the notice with the Board."), and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES: CORRECTION, 81 Fed. Reg. 89382 December 6, 2016) (further clarification necessary to "clearly incorporate the timing for cross-examination upon written questions of testimony by affidavit or declaration.").

4. 37 C.F.R. § 2.124(d)(2). *See Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *3 (TTAB 2019) (proceedings suspended to allow for completion of the cross-examination on written questions of Cuban declarants); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990); *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990).

703.02(d) Depositions on Written Questions: Place of Deposition

A testimony deposition on written questions may be taken at any reasonable place. [Note 1.] *Cf.* TBMP § 703.01(d). An adverse party may attend the taking of the deposition and the party who proffered affidavit or declaration testimony may attend the cross-examination on written questions if it so desires, not for the purpose of participating (its participation will have occurred previously, through its service of cross questions, redirect questions, recross questions, and objections, if any, pursuant to 37 C.F.R. § 2.124(d)(1), but rather merely for the purpose of observing.

For information concerning the place where a discovery deposition upon written questions is taken, see TBMP § 404.03(b), TBMP § 404.03(c), and TBMP § 404.04.

NOTES:

1. *Cf.* 37 C.F.R. § 2.123(c). *Cf. also* 37 C.F.R. § 2.123(b) regarding stipulations as to place, manner and notice of depositions.

703.02(e) Depositions on Written Questions: Notice of Deposition

37 C.F.R. § 2.124

(b)(1) *A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.*

* * * *

(3) *A party desiring to take cross-examination, by written questions, of a witness who has provided testimony by affidavit or declaration shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board.*

(c) *Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.*

(d)(1) *Every notice served on any adverse party under the provisions of paragraphs (b)(1) and (2) of this section, for the taking of direct examination, shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Every notice served on any adverse party under the provisions of paragraph (b)(3) of this section, for the taking of cross-examination, shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the cross-examination. Within twenty days from the date of service of the notice of taking direct examination or service of a testimony affidavit or declaration, any adverse party may serve cross questions upon the party who proposes to take the deposition. ...*

To take a testimony deposition on written questions, a party must serve notice thereof on each adverse party within 10 days from the opening date of its testimony period, as originally set or as reset. [Note 1.] The notice must state the name and address of the witness, and it must be accompanied both by the name or descriptive title of the officer before whom the deposition is to be taken and the written questions to be propounded on behalf of the deposing party. [Note 2.] A copy of the notice, but not of the questions, must be filed with the Board. [Note 3.]

A party desiring to take cross-examination, by written questions, of an affiant or declarant must serve on each adverse party notice of the cross-examination within 20 days from date of service of the affidavit or declaration. [Note 4.] The notice must state the name or descriptive title of the officer before whom the deposition will be taken, and must include a copy of the written questions to be propounded at cross-examination. [Note 5.] The party must file a copy of the notice, but not the questions, with the Board. [Note 6.]

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner, and when so taken, may be used like any other deposition. [Note 7.]

For information concerning the notice of deposition in the case of a discovery deposition on written questions, see TBMP § 404.07(d).

NOTES:

1. 37 C.F.R. § 2.124(b)(1). *See Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990).

2. 37 C.F.R. § 2.124(b)(1), 37 C.F.R. § 2.124(c), and 37 C.F.R. § 2.124(d)(1).

3. 37 C.F.R. § 2.124(b)(1).

4. 37 C.F.R. § 2.124(b)(3) and 37 C.F.R. § 2.124(d)(1). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.124(b)(3) to provide that a party desiring to take cross-examination by written questions of a witness who has provided testimony by affidavit or declaration shall serve notice on each adverse party and file a copy of the notice with the Board."), and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES: CORRECTION, 81 Fed. Reg. 89382 (December 6, 2016) (further clarification necessary to "clearly incorporate the timing for cross-examination upon written questions of testimony by affidavit or declaration.").

5. 37 C.F.R. § 2.124(c) and 37 C.F.R. § 2.124(d)(1).

6. 37 C.F.R. § 2.124(b)(3). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.124(b)(3) to provide that a party desiring to take cross-examination by written questions of a witness who has provided testimony by affidavit or declaration shall serve notice on each adverse party and file a copy of the notice with the Board.").

7. 37 C.F.R. § 2.123(b).

703.02(f) Depositions on Written Questions: Securing Attendance of Unwilling Witness

A party who takes testimony by affidavit or declaration must make the witness available for cross-examination under 37 C.F.R. § 2.123(a)(1) and 37 C.F.R. § 2.123(a)(2). *See* TBMP § 703.01(b).

For information concerning securing the attendance of an unwilling witness, see TBMP § 703.01(f) (for a testimony deposition) and TBMP § 404.03 (for a discovery deposition).

703.02(g) Depositions on Written Questions: Examination of Witness

37 C.F.R. § 2.124

(b)(1) *A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.*

* * * *

(3) *A party desiring to take cross-examination, by written questions, of a witness who has provided testimony by affidavit or declaration shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board.*

(c) *Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.*

(d)(1) *Every notice served on any adverse party under the provisions of paragraphs (b)(1) and (2) of this section, for the taking of direct examination, shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Every notice served on any adverse party under the provisions of paragraph (b)(3) of this section, for the taking of cross-examination, shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the cross-examination. Within twenty days from the date of service of the notice of taking direct examination or service of a testimony affidavit or declaration, any adverse party may serve cross questions upon the*

party who proposes to take the deposition. Any party who serves cross questions, whether in response to direct examination questions or under paragraph (b)(3) of this section, shall also serve every other adverse party. Within ten days from the date of service of the cross questions, the party who proposes to take the deposition, or who earlier offered testimony of the witness by affidavit or declaration, may serve redirect questions on every adverse party. Within ten days from the date of service of the redirect questions, any party who served cross questions may serve recross questions upon the party who proposes to take the deposition or who earlier offered testimony of the witness by affidavit or declaration; any party who serves recross questions shall also serve every other adverse party. Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.

(2) *Upon motion for good cause by any party, or upon its own initiative, the Trademark Trial and Appeal Board may extend any of the time periods provided by paragraph (d)(1) of this section. Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written questions.*

(3) *Service of written questions, responses, and cross-examination questions shall be in accordance with § 2.119(b).*

(e) *Service of written questions, responses, and cross-examination questions shall be in accordance with § 2.119(b).*

A party which desires to take a testimony deposition on written questions must, within 10 days from the opening date of its testimony period, as originally set or as reset, serve notice thereof on each adverse party. [Note 1.] *See*TBMP § 703.02(e).

The notice must be accompanied by the written questions to be propounded on behalf of the deposing party. [Note 2.] A copy of the notice, but not of the questions, must be filed with the Board. [Note 3.]

Within 20 days from the date of service of the notice of taking direct examination on written questions, any adverse party may serve cross questions on the deposing party. Likewise, a party desiring to take cross-examination, by written questions, of an affiant or declarant must serve on each adverse party notice of the cross-examination within 20 days from the date of service of the testimony affidavit or declaration. [Note 4.] The notice of cross-examination by written questions must state the name or descriptive title of the officer before whom the deposition will be taken, and must include a copy of the written questions to be propounded at cross-examination. [Note 5.] The party must file a copy of the notice, but not the questions, with the Board. [Note 6.]

Any party who serves cross questions, whether in response to direct examination questions, or on cross-examination of a witness who has provided affidavit or declaration testimony, must also serve copies of them on every other adverse party. Within 10 days from the date of service of the cross questions, the deposing party, or the party who had offered affidavit or declaration testimony, may serve redirect questions on every adverse party. Within 10 days from the date of service of the redirect questions, any party that served cross questions may serve recross questions on the deposing party or the party who earlier provided affidavit or declaration testimony. A party that serves recross questions on the deposing party must also serve copies thereof on every other adverse party. [Note 7.]

Written objections to questions may be served on the party that propounded the questions. A party that serves objections on a propounding party must also serve a copy of the objections on every other adverse

party. In response to objections, substitute questions may be served on the objecting party within 10 days from the date of service of the objections. The substitute questions must also be served on every other adverse party. [Note 8.]

On motion for good cause filed by any party, or on its own initiative, the Board may extend any of the time periods specified in 37 C.F.R. § 2.124(d)(1), that is, the time periods for serving cross questions, redirect questions, recross questions, objections, and substitute questions. Further, on receipt of written notice that one or more testimony depositions are to be taken on written questions, the Board will suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions on written questions. [Note 9.] *See*TBMP § 703.02(c).

Within 10 days after the last date when questions, objections, or substitute questions may be served, the deposing party must mail a copy of the notice and copies of all the questions to the officer designated in the notice. A copy of the notice and of all the questions mailed to the officer must also be served on every adverse party. The officer designated in the notice shall read the examination questions to the witness, shall take the testimony of the witness in response to the questions, and shall record each answer immediately after the corresponding question. [Note 10.]

Service of written questions, responses, and cross-examination questions must be by email unless the parties stipulate to another method, or under certain other limited circumstances. [Note 11.] For information concerning alternative methods of service under those limited circumstances, see 37 C.F.R. § 2.119(b) and TBMP § 113.04.

An adverse party may attend the taking of the deposition and the party who proffered affidavit or declaration testimony may attend the cross-examination on written questions if it so desires, not for the purpose of participating (its participation will have occurred previously, through its service of cross questions, redirect questions, recross questions, and objections, if any, pursuant to 37 C.F.R. § 2.124(d)(1)), but rather merely for the purpose of observing. Any attempt to engage the witness during the deposition or cross-examination may constitute sanctionable conduct.

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, on any notice, and in any manner. When so taken, the deposition may be used like any other deposition. [Note 12.]

NOTES:

1. 37 C.F.R. § 2.124(b)(1).

2. 37 C.F.R. § 2.124(d)(1).

3. 37 C.F.R. § 2.124(b)(1).

4. 37 C.F.R. § 2.124(b)(3) and 37 C.F.R. § 2.124(d)(1). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.124(b)(3) to provide that a party desiring to take cross-examination by written questions of a witness who has provided testimony by affidavit or declaration shall serve notice on each adverse party and file a copy of the notice with the Board."), and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE; CORRECTION, 81 Fed. Reg.

89382 (December 6, 2016) (further clarification necessary to "clearly incorporate the timing for cross-examination upon written questions of testimony by affidavit or declaration.").

5. 37 C.F.R. § 2.124(c) and 37 C.F.R. § 2.124(d)(1).

6. 37 C.F.R. § 2.124(b)(3). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending § 2.124(b)(3) to provide that a party desiring to take cross-examination by written questions of a witness who has provided testimony by affidavit or declaration shall serve notice on each adverse party and file a copy of the notice with the Board.").

7. 37 C.F.R. § 2.124(d)(1). *See Fischer GmbH. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE; CORRECTION, 81 Fed. Reg. 89382 (December 6, 2016) (further clarification necessary to "clearly incorporate the timing for cross-examination upon written questions of testimony by affidavit or declaration.").

8. 37 C.F.R. § 2.124(d)(1). *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990).

9. 37 C.F.R. § 2.124(d)(2). *See Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *3 (TTAB 2019) (parties' joint request to extend deadlines to serve notice of cross-examination on written questions, as well as redirect questions granted; proceedings suspended to allow for completion of the cross-examination on written questions of declarants).

10. 37 C.F.R. § 2.124(e). *See Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *3 n.8 (TTAB 2019) ("the court reporter or other officer designated in the notice of examination will read the cross-examination questions to the witness and record the answers for later creation of a written transcript"); *Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028, 1030 (TTAB 2017) (deposing official should state the number of each question before asking it).

11. *See* 37 C.F.R. § 2.119(b) and 37 C.F.R. § 2.124(d)(3). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is adding new § 2.124(d)(3) to provide that service of written questions, responses, and cross-examination questions shall be in accordance with § 2.119(b).").

12. *See* 37 C.F.R. § 2.123(b).

703.02(h) Depositions on Written Questions: Form, Signature and Certification of Deposition

37 C.F.R. § 2.124(e) *Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.*

The officer before whom a deposition on written questions is taken shall record each answer immediately after the corresponding question. [Note 1.]

For further information on the form for a deposition taken in an inter partes proceeding before the Board, see 37 C.F.R. § 2.123(g) and 37 C.F.R. § 2.126, and TBMP § 703.01(i).

For information concerning signature of a deposition taken in an inter partes proceeding before the Board, see 37 C.F.R. § 2.123(e)(5) and TBMP § 703.01(j).

After the officer designated in the notice of deposition has taken a deposition on written questions, the officer must certify the transcript of the deposition. *See* 37 C.F.R. § 2.124(e). For information concerning certification of a deposition taken in an inter partes proceeding before the Board, see 37 C.F.R. § 2.123(f), and TBMP § 703.01(k).

When the transcript has been certified, the officer should mail the transcript and exhibits to the party that took the deposition. [Note 2.]

NOTES:

1. *See* 37 C.F.R. § 2.124(e); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *3 n.8 (TTAB 2019) ("the court reporter or other officer designated in the notice of examination will read the cross-examination questions to the witness and record the answers for later creation of a written transcript"); *Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028, 1030 (TTAB 2017) (deposing official should state the number of each question before asking it).

2. *See* 37 C.F.R. § 2.124(e).

703.02(i) Depositions on Written Questions: Service, Correction and Filing of Deposition

37 C.F.R. § 2.124(f) *The party who took the deposition shall promptly serve a copy of the transcript, copies of documentary exhibits, and duplicates or photographs of physical exhibits on every adverse party. It is the responsibility of the party who takes the deposition to assure that the transcript is correct (see § 2.125(c)). If the deposition is a discovery deposition, it may be made of record as provided by § 2.120(k). If the deposition is a testimonial deposition, the original, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be filed promptly with the Trademark Trial and Appeal Board.*

The party that took the deposition on written questions must promptly serve a copy of the transcript, with exhibits, on every adverse party. [Note 1.] *See*TBMP § 703.01(m). The party that took the deposition must also assure that the transcript is correct. [Note 2.] For information concerning correction of errors in a deposition taken in a Board inter partes proceeding, see TBMP § 703.01(n).

If the deposition is a testimony deposition upon written questions, the original, with exhibits, must be filed promptly with the Board. [Note 3.] By "promptly" the Board means that the transcript, with exhibits, may be filed at any time prior to submission of the case for final decision. *See*TBMP § 703.01(k).

NOTES:

1. 37 C.F.R. § 2.124(f). *Cf.* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office has not set out in the final rule any specific requirements regarding the form of exhibits. The Board and the parties have experience with such submissions in connection with summary judgment motions and ACR procedures as described in the TBMP at sections 528.05(b) and 702.04, which do not specify requirements for the form of exhibits, and this has not created problems. Notably, documents submitted under an affidavit or declaration but not identified therein cannot be considered as exhibits. The parties are encouraged to be guided by the form requirements set out for exhibits to depositions in § 2.123(g)(2) and the mailing requirements for certain exhibits set out in § 2.123(f)(2).").

2. 37 C.F.R. § 2.124(f) and 37 C.F.R. § 2.125(c) (formerly 37 C.F.R. § 2.125(b)).

3. *See* 37 C.F.R. § 2.124(f).

703.02(j) Testimony Depositions on Written Questions Must be Filed

37 C.F.R. § 2.123(h) ***Depositions must be filed.*** *All depositions which are taken must be duly filed in the Office. On refusal to file, the Office at its discretion will not further hear or consider the contestant with whom the refusal lies; and the Office may, at its discretion, receive and consider a copy of the withheld deposition, attested by such evidence as is procurable.*

While the offering of a discovery deposition in evidence is voluntary, all trial testimony depositions that are taken in a Board inter partes proceeding must be filed with the Board, and, when filed, automatically constitute part of the evidentiary record in the proceeding. [Note 1.] *See*TBMP § 703.01(l).

See, with respect to making a discovery deposition of record, 37 C.F.R. § 2.120(j) and TBMP § 704.09.

NOTES:

1. *See* 37 C.F.R. § 2.123(h); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191, 1192 n.7 (TTAB 1984) (testimony depositions and exhibits introduced in connection with depositions must be filed with the Board and are automatically of record for both parties for all relevant purposes).

703.02(k) Depositions on Written Questions: Objections to Deposition

37 C.F.R. § 2.124

(d)(1) ... *Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.*

* * * *

(g) *Objections to questions and answers in depositions upon written questions may be considered at final hearing.*

Written objections to questions propounded for a deposition on written questions may be served on the party that propounded the questions. Any party that serves written objections on a propounding party must also serve a copy of the objections on every other adverse party. [Note 1.] *See*TBMP § 703.02(g).

Unless waived, objections to questions and answers in depositions on written questions, as in oral depositions, generally are considered by the Board at final hearing. [Note 2.]

For further information concerning the raising of objections to oral trial testimony depositions, see TBMP § 707.03 and TBMP § 533.

For information concerning the raising of objections to discovery depositions, see TBMP § 404.08. For information concerning the raising of objections to a notice of reliance on a discovery deposition, see TBMP § 707.02 and TBMP § 532.

NOTES:

1. 37 C.F.R. § 2.124(d)(1).

2. 37 C.F.R. § 2.124(g). *See Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028, 1030 (TTAB 2017) (objection to depositions on written questions for failure to timely mail copy of notice and questions to designated officer deemed waived because objectionable testimony addressed on merits in brief and objections were not renewed in brief); *Bayer Consumer Care AG v. Belmora LLC*, 110 USPQ2d 1623, 1628 (TTAB 2014) (objections to written cross-examination questions sustained on ground they exceed scope of direct testimony on written questions), *rev'd on other grounds*, 84 F. Supp. 3d 490 (E.D. Va. 2015), *vacated and remanded* 819 F.3d 697 (4th Cir. 2016), *cert denied*, 137 S. Ct. 1202 (2017), *aff'd on remand*, 338 F. Supp. 3d 1477 (E.D. Va. 2018), *district court decision vacated and remanded*, 2021 USPQ2d 126 (4th Cir. 2021) (Board decision upheld by 4th Circuit), *petition for rehearing en banc filed*, No. 18-2183, 18-2232 (4th Cir. March 2, 2021); *Nahshin v. Product Source International LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013) (objections to portions of depositions on written questions deemed waived), *aff'd*, 112 F. Supp. 3d 383 (E.D. Va. 2015); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (objections to questions based on relevancy and materiality will be deferred until final hearing).

703.02(l) Depositions on Written Questions: Confidential or Trade Secret Material

For information concerning the protection of confidential or trade secret material forming part of a testimony affidavit or declaration or oral deposition transcript or exhibits thereto, see 37 C.F.R. § 2.125(f) and 37 C.F.R. § 2.126(c); TBMP § 703.01(p). 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 1.] For further information on protective orders, see TBMP § 412.

NOTES:

1. 37 C.F.R. § 2.116(g).

703.02(m) Depositions on Written Questions: Utility

A deposition on written questions is a cumbersome, time-consuming procedure. It requires that cross questions, redirect questions, recross questions, and objections all be framed and served before the questions

on direct examination have even been answered. Moreover, it deprives an adverse party of the right to confront the witness and ask follow-up questions on cross-examination. [Note 1.] *See*TBMP § 703.02(g).

Nevertheless, depositions on written questions have some utility. They may be the only means by which a deposition may be taken in a foreign country. [Note 2.] *See*TBMP § 404.03(c) (discovery deposition of non-party residing in foreign country), TBMP § 703.01(b) (Form of Testimony), TBMP § 703.01(f)(3) (Unwilling Witness Residing in a Foreign Country), and TBMP § 703.02(a) (Depositions on Written Questions – When Available). Moreover, the deposition on written questions is generally less expensive than the deposition on oral examination and is usually more convenient for the witness.

NOTES:

1. *See* 37 C.F.R. § 2.124(d)(1). *See also Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, 1080 (TTAB 1990), *corrected*, 19 USPQ2d 1479 (TTAB 1990); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980); *Fischer GmbH v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979); *Orion Group Inc. v. Orion Insurance Co.*, 12 USPQ2d 1923, 1926 (TTAB 1989) (motion to take discovery deposition in foreign country orally).

2. *See* 37 C.F.R. § 2.120(c)(1), 37 C.F.R. § 2.123(a)(1) and 37 C.F.R. § 2.123(a)(2). *Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *1 (TTAB 2019) (quoting TBMP 703.02(m)). *Cf. Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises Ltd.*, 511 F.3d 437, 85 USPQ2d 1385 (4th Cir. 2007), *cert. denied*, 128 S. Ct. 2508 (2008) (district court has the power to issue a subpoena for a trial deposition noticed under Fed. R. Civ. P. 30(b)(6), requiring a foreign corporate applicant to produce an appropriate representative in the United States for testimony on the subjects identified in the subpoena, regardless of the domicile of the representative).

704 Introducing Other Evidence

704.01 In General

As noted earlier in this chapter, evidence in an inter partes proceeding before the Board can be introduced in a number of ways. Prior sections of this chapter discuss the introduction of testimony with accompanying exhibits. *See generally*TBMP § 702 and TBMP § 703. The following sections discuss other forms of evidence and the methods available for their introduction. Parties are cautioned, however, not to submit cumulative evidence in support of their pleaded claims. *See*TBMP § 702.05 (Overly Large Records).

704.02 Notice of Reliance – Generally

37 C.F.R. § 2.122(g) ***Notices of reliance.*** *The types of evidence admissible by notice of reliance are identified in paragraphs (d)(2) and (e)(1) and (2) of this section and § 2.120(k). A notice of reliance shall be filed during the testimony period of the party that files the notice. For all evidence offered by notice of reliance, the notice must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. Failure to identify the relevance of the evidence, or associate it with issues in the proceeding, with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order.*

Certain types of evidence need not be introduced in connection with the testimony of a witness but may instead be made of record by filing the materials with the Board under cover of one or more notices of reliance during the testimony period of the offering party. Normally, exhibits filed under a notice of reliance

consist of pleaded registrations and pleaded applications, printed publications, official records, Internet materials, an adverse party's written disclosures and certain written discovery responses, and discovery depositions of an adverse party. [Note 1.] A notice of reliance is essentially a cover sheet for the materials sought to be introduced. As the title suggests, the notice of reliance serves to notify opposing parties that the offering party intends to rely on the materials submitted thereunder in support of its case. A party need not disclose the evidence it intends to submit under notice of reliance in its pretrial disclosures. [Note 2.] Under 37 C.F.R. § 2.122(g), the notice of reliance must include a description and the general relevance of the proffered materials, and it must associate the materials with one or more issues in the case. [Note 3.] For example, if the claim is likelihood of confusion, the propounding party should associate the materials with a relevant likelihood of confusion factor. Further, if the same document is submitted to support more than one element of a claim or defense, the propounding party should indicate the specific element or fact supported by the document in a group of documents. Failure to do so with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order. [Note 4.] Even if an adverse party fails to lodge a timely objection, the Board may sua sponte decline to consider the proffered evidence if the notice of reliance does not specify the relevance of the materials and identify the issues. [Note 5.]

A discussion of the types of evidence that may be submitted by notice of reliance and the requirements for introduction of such evidence by notice of reliance can be found in the sections that follow.

NOTES:

1. *See generally* 37 C.F.R. § 2.122(d)(2), 37 C.F.R. § 2.122(e)(1), 37 C.F.R. § 2.122(e)(2), and 37 C.F.R. § 2.120(k). *See also WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037-38 n.12 (TTAB 2018) (listing materials normally filed under notice of reliance).

2. 37 C.F.R. § 2.121(e). *Accord Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1300 n.4 (TTAB 2015).

3. 37 C.F.R. § 2.122(g). Effective January 14, 2017, the Board added new subsection (g) to 37 C.F.R. § 2.122 detailing the requirements for admission of evidence by notice of reliance. This amendment effectively overruled any prior case law stating that an offering party is not required to specify the general relevance of certain types of evidence submitted under notice of reliance such as discovery deposition excerpts and answers to interrogatories.

See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("To alleviate any uncertainty, this final rule adds a paragraph to the requirements for a notice of reliance, specifically, to require that the notice indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. In an effort to curtail motion practice on this point, the rule explicitly states any failure of a notice of reliance to meet this requirement will be considered a curable procedural defect. This codifies the holding in *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014)."). *See, e.g., STX Financing, LLC v. Terraza*, 2020 USPQ2d 10989, at *4 (TTAB 2020) (motions to strike exhibits to applicant's notice of reliance for failure to indicate the general relevancy granted with leave to cure); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1163 (TTAB 2017) (granting motion to strike notices of reliance with leave to cure where relevancy description "so general as to be meaningless," and for insufficiently explaining association of documents with particular facts relevant to particular claims and defenses; description in other notices of reliance acceptable because "sufficiently narrow or focused").

4. 37 C.F.R. § 2.122(g). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("To alleviate any uncertainty, this final rule adds a paragraph to the requirements for a notice of reliance, specifically, to require that the notice

indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. In an effort to curtail motion practice on this point, the rule explicitly states any failure of a notice of reliance to meet this requirement will be considered a curable procedural defect. This codifies the holding in *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014)."). *See STX Financing, LLC v. Terraza*, 2020 USPQ2d 10989, at *4 (TTAB 2020) (motions to strike exhibits to applicant's notice of reliance for failure to indicate the general relevancy granted with leave to cure); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1163 (TTAB 2017) (granting motion to strike notices of reliance with leave to cure where relevancy description "so general as to be meaningless," and for insufficiently explaining association of documents with particular facts relevant to particular claims and defenses; description in other notices of reliance acceptable because "sufficiently narrow or focused").

5. *See, e.g., Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1040 (TTAB 2010).

704.03 Applications and Registrations

704.03(a) Subject of Proceeding

37 C.F.R. § 2.122

(b) ***Application and registration files.***

(1) *The file of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose in accordance with paragraph (b)(2) of this section.*

(2) *The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony. Statements made in an affidavit or declaration in the file of an application for registration, or in the file of a registration, are not testimony on behalf of the applicant or registrant. Establishing the truth of these or any other matters asserted in the files of these applications and registrations shall be governed by the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part.*

The file of an application or registration that is the subject of a Board inter partes proceeding forms part of the record of the proceeding without any action by the parties, and reference may be made to the file by any party for any relevant and competent purpose. [Note 1.] The Board discourages filing a copy of the subject application or subject registration because it is of record. [Note 2.]

However, the fact that the subject application or registration file is automatically part of the record in a proceeding does not mean that an allegation of a date of use or that the specimens filed therein are evidence on behalf of the applicant or registrant in the inter partes proceeding. The alleged date of use of the mark and the specimens in an application or registration file are not evidence in an inter partes proceeding, on behalf of the applicant or registrant, unless the alleged date of use is established by competent evidence and the specimens are identified and introduced in evidence as exhibits during the testimony period. [Note 3.] *See*TBMP § 704.04.

Likewise, statements made in an affidavit or declaration in the file of an application or registration are not testimony. [Note 4.] Although part of the record of the proceeding, such statements constitute hearsay (except for statements falling under Fed. R. Evid. 801(d)). [Note 5.] However, self-authenticating exhibits (e.g., printed publications, Internet printouts with the URL and date) attached to affidavits or declarations in applications or registrations may have evidentiary value for what they show on their face. [Note 6.]

Evidence submitted during the prosecution of an application with respect to the acquired distinctiveness of a mark under Trademark Act § 2(f), 15 U.S.C. § 1052(f), is evidence on behalf of the applicant or registrant without any action by the parties. [Note 7.] Nonetheless, such evidence is subject to the Federal Rules of Evidence, the Federal Rules of Civil Procedure, and the relevant provisions of Title 28 of the United States Code and the provisions of title 37 of the Code of Federal Regulation. [Note 8.]

For further information concerning the probative value of applications and registrations, see TBMP § 704.03(b).

NOTES:

1. 37 C.F.R. § 2.122(b)(1). *See The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1283 (Fed. Cir. 1984); *Cleveland-Detroit Corp. v. Comco (Machinery) Ltd.*, 277 F.2d 958, 125 USPQ 586, 586-87 (CCPA 1960) (application file automatically forms part of record on appeal); *International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *21 n.161 (TTAB 2020) ("[t]he 'Letter of Protest Memorandum' is automatically part of the record in this [opposition] proceeding as it forms a part of the prosecution file for Applicants' application."), *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020); *Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1530 n.10 (TTAB 2018) (printouts from the file records of the subject registration unnecessary); *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1510 (TTAB 2017) ("the record automatically includes the pleadings (but not the exhibits thereto), and the application files for the challenged registrations."); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1923 (TTAB 2011) (record includes pleadings and registration file for respondent's mark), *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); *Venture Out Properties LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1889 n.8 (TTAB 2007) (applications automatically of record); *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1106 n.4 (TTAB 2007) (respondent's introduction of a certified copy of his registration sought to be cancelled is superfluous); *Uncle Ben's Inc. v. Studenberg International Inc.*, 47 USPQ2d 1310, 1311 n.2 (TTAB 1998) (notice of reliance on application file not necessary as it is automatically of record); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1547 n.6 (TTAB 1990) (submission of portions of application unnecessary since file is automatically of record), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). *See also Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1107 (TTAB 2015) (plaintiff's pleaded registration is of record by operation of Trademark Rule 2.122(b)(1) because it is the subject of a counterclaim). *Cf. WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018) (plaintiff's pleaded pending application is not automatically of record).

2. *Anthony's Pizza & Pasta International Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1274 n.6 (TTAB 2009) (not necessary for respondent to file a status and title copy of its registration because registration is automatically of record), *aff'd*, 415 F. App'x 222 (Fed. Cir. 2010); *Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009) (respondent's registration file is automatically part of the record of the proceeding and need not be introduced under a notice of reliance); *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1106 n.4 (TTAB 2007) (respondent's introduction of a certified copy of his registration sought to be cancelled is

superfluous); *Venture Out Properties LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1889 n.8 (TTAB 2007) (applications automatically of record and need not be introduced again).

3. 37 C.F.R. § 2.122(b)(2). *See UMG Recordings, Inc. v. O'Rourke*, 92 USPQ2d 1042, 1047 (TTAB 2009) (dates of use not evidence); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1960 (TTAB 2008) (alleged date of use in application not evidence); *Baseball America, Inc. v. Powerplay Sports, Ltd.*, 71 USPQ2d 1844, 1848 n.10 (TTAB 2004) (dates of use and specimens not evidence); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993) (without proof of use, application filing date, not dates of use alleged in the application, is the earliest use date on which the applicant may rely), *recon. denied*, 36 USPQ2d 1328 (TTAB 1994).

4. 37 C.F.R. § 2.122(b)(2). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("In response to Cold War Museum Inc. v. Cold War Air Museum Inc., 56 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009), this final rule makes clear that while the file history of the subject application or registration is of record, statements in affidavits or declarations in the file are not testimony."). *See also Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *4, *4 n.23 (TTAB 2019) (declaration submitted in application file during prosecution not considered trial testimony since it was dated over three years prior to petitioner's testimony period), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019).

5. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("Now that testimony by affidavit or declaration is unilaterally available, it is necessary to clearly distinguish material residing in an application or registration from testimony introduced in the proceeding."). *See Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *4 (TTAB 2019) (statements in application file declaration were considered admissions), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019); *Daniel J. Quirk Inc. v. Village Car Company*, 120 USPQ2d 1146, 1149 n.14 (TTAB 2016) (statements made in affidavit filed in connection with respondent's office action response constitute admissions against interest and fall within hearsay exception under Fed. R. Evid. 801(d)(2)). *See also EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597, 599 (TTAB 1982) (statements made in an application constitute admissions and may be considered as evidence, albeit not conclusive evidence, of the truth of the assertions therein), *aff'd*, 706 F.2d 1213, 217 USPQ 986 (Fed. Cir. 1983) (citing *Bakers Franchise Corp. v. Royal Crown Cola Co.*, 404 F.2d 985, 160 USPQ 192 (CCPA 1969)); *Maremont Corp. v. Airlift Corp.*, 463 F.2d 1114, 174 USPQ 395, 396 (CCPA 1972)).

6. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016).

7. *The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009).

8. 37 C.F.R. § 2.122(b)(2). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016).

704.03(b) Not Subject of Proceeding – In General

The file of a particular application or registration that is not the subject of a proceeding may be made of record either in connection with testimony or by notice of reliance as described below.

704.03(b)(1) Registration Not Subject of Proceeding

704.03(b)(1)(A) Registration Owned by Party

37 C.F.R. § 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).*

(2) *A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance in accordance with paragraph (g) of this section, which shall be accompanied by a copy (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. The notice of reliance shall be filed during the testimony period of the party that files the notice.*

A party that wishes to rely on its ownership of a federal registration of its mark that is not the subject of a proceeding before the Board may make the registration of record by offering evidence sufficient to establish that the registration is still subsisting, and that it is owned by the party which seeks to rely on it. [Note 1.] This may be done in a number of different ways.

A federal registration *owned by the plaintiff* in an opposition or cancellation proceeding, and pleaded by the plaintiff in its complaint, will be received in evidence and made part of the record in the proceeding if the complaint (either as originally filed or as amended) is accompanied by (a) an original or a photocopy of the registration prepared and issued by the Office showing both the current status of and current title to the registration; or (b) a current copy of information from the electronic database records of the Office such as (i) TSDR showing the current status and title (owner) of the registration and, if TSDR does not reflect the current owner of the registration, a copy of information from the Trademark Assignment Recordation Branch database demonstrating an assignment to the current owner of the registration; or (ii) TESS along with a copy of any records from the Trademark Assignment Recordation Branch database showing an assignment to the current owner of the registration. [Note 2.] The Board does not take judicial notice of a party's registration. [Note 3.] A plaintiff which pleads ownership of an application in its complaint must, in order to rely on the subsequently issued registration, make the registration of record. However, the plaintiff does not have to amend its pleading to assert the registration. The pleading of the 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 4.] However, if the registration issues after the plaintiff's testimony period closes, even if the defendant has admitted that the plaintiff is the owner of the application and the plaintiff has introduced a copy of the application into evidence, the Board will not consider the registration. [Note 5.]

Please Note: Except under limited circumstances, requests to record an assignment of a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) registration must be filed directly with the International Bureau. [Note 6.] The International Bureau will notify the USPTO of any changes in ownership recorded in the International Register, and the USPTO will record only those assignments or other documents transferring title that have been recorded in the International Register. [Note 7.]

A federal registration *owned by any party* to a Board inter partes proceeding will be received in evidence and made part of the record in the proceeding if that party files, during its testimony period, a notice of reliance on the registration, accompanied by (a) a copy of the registration prepared and issued by the Office showing both the current status of and current title to the registration; or (b) a current printout or copy of information from the electronic database records of the Office such as (i) TSDR showing the current status and title (owner) of the registration and, if TSDR does not reflect the current owner of the registration, a printout or copy of the information from the Trademark Assignment Recordation Branch database demonstrating an assignment to the current owner of the registration; or (ii) TESS along with a copy of any records from the Trademark Assignment Recordation Branch database showing an assignment to the current owner of the registration. [Note 8.]

If a party chooses to make its registration of record by submitting a status and title copy prepared by the Office, the party's submission, with a notice of reliance on its registration, of an *order* for status and title copies of the registration is not sufficient to make the registration of record. Although that procedure was once permitted, it is no longer allowed. [Note 9.] The status and title copies themselves must accompany the notice of reliance. [Note 10.] However, the status and title copies need not be certified. [Note 11.] Additionally, a party need not submit the original status and title copy; a photocopy is sufficient. [Note 12.]

The registration copies "prepared and issued by the United States Patent and Trademark Office showing both the current status of and current title to the registration," as contemplated by 37 C.F.R. § 2.122(d), are printed copies of the registration on which the Office has entered the information it has in its records, at the time it prepares and issues the status and title copies, about the current status and title of the registration. That information includes information about the renewal, cancellation, publication under Trademark Act § 12(c), 15 U.S.C. § 1062(c); affidavits or declarations under Trademark Act § 8, Trademark Act § 15, and Trademark Act § 71, 15 U.S.C. § 1058, 15 U.S.C. § 1065 and 15 U.S.C. § 1141; and recorded documents transferring title. [Note 13.] Plain copies of the registration are not sufficient. [Note 14.]

The issuance date of status and title copies filed with a complaint must be reasonably contemporaneous with the filing date of the complaint. Status and title copies filed under a notice of reliance during the offering party's testimony period must have been issued at a time reasonably contemporaneous with the filing of the complaint, or thereafter. [Note 15.]

When it comes to the attention of the Board that there has been an Office error in the preparation of a registration status and title copy made of record in an inter partes proceeding, that is, that the status and title copy does not accurately reflect the status and title information which the Office has in its records, the Board will take judicial notice of the correct facts as shown by the records of the Office. [Note 16.] Further, when a federal registration owned by a party has been properly made of record in an inter partes proceeding, and the status of the registration changes between the time it was made of record and the time the case is decided, the Board, in deciding the case, will take judicial notice of, and rely on, the current status of the registration, as shown by the records of the Office. [Note 17.]

As an alternative to submitting status and title copies of registrations, 37 C.F.R. § 2.122(d) allows a party to submit copies of its registrations taken from the Office's electronic database records such as TSDR or TESS.

A federal registration owned by any party to a Board inter partes proceeding may be made of record by that party by appropriate identification and introduction during the taking of testimony, that is, by introducing a copy of the registration as an exhibit to testimony, made by a witness having knowledge of the current status and title of the registration, establishing that the registration is still subsisting, and is owned by the offering party. [Note 18.]

A federal registration *owned by a plaintiff* (including a counterclaimant) will be deemed by the Board to be of record in an inter partes proceeding if the defendant's answer to the complaint contains admissions sufficient for the purpose, i.e., admission to the current existence of the registration and the plaintiff's ownership of the registration. [Note 19.]

Similarly, a registration *owned by any party* to the proceeding may be deemed by the Board to be of record in the proceeding, even though the registration was not properly introduced in accordance with the applicable rules, if the adverse party in its brief, or otherwise, treats the registration as being of record. [Note 20.]

Finally, a registration *owned by any party* to the proceeding may be made of record in the proceeding by stipulation of the parties. [Note 21.]

When a subsisting registration on the Principal Register has been properly made of record by its owner in a Board inter partes proceeding, the certificate of registration is entitled to certain statutory evidentiary presumptions. [Note 22.]

In contrast, a subsisting registration on the Supplemental Register, even when properly made of record by its owner, is not entitled to any statutory presumptions, and is not evidence of anything except that the registration issued. [Note 23.]

Expired or Cancelled Registrations. Although an expired or cancelled registration may be made of record by any of the methods described above, such a registration is not evidence of anything except that the registration issued; it is not evidence of any presently existing rights in the mark shown in the registration, or that the mark was ever used. [Note 24.]

State Registrations. A state registration owned by a party to a Board inter partes proceeding may be made of record therein by notice of reliance under 37 C.F.R. § 2.122(e), or by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties. *See* TBMP § 704.07.

However, a state registration (whether owned by a party, or not) is incompetent to establish that the mark shown therein has ever been used, or that the mark is entitled to federal registration. [Note 25.]

Foreign Registrations. A foreign registration owned by a party to a Board inter partes proceeding may be made of record in the same manner as a state registration, but a foreign registration is not evidence of the use, registrability, or ownership of the subject mark in the United States. [Note 26.]

Making the file history of the registration of record. If a party owns a registration that is not the subject of the proceeding and wishes to make of record the registration file history (rather than just the certificate of registration), or a portion thereof, it may do so by: (1) filing, during its testimony period, a copy of the file history, or the portion it wishes to introduce, together with a notice of reliance thereon as an official record pursuant to 37 C.F.R. § 2.122(e) (*see* TBMP § 704.07; or (2) appropriate identification and introduction of a copy of the file history, or portion thereof, during the taking of testimony; or (3) stipulation of the parties, accompanied by a copy of the file history, or portion thereof. The registration file or a portion thereof may be taken from the Office's electronic database records.

The file history of a registration owned by another party, but not the subject of the proceeding, may be made of record in the same manner. [Note 27.] Copies of official records of the USPTO need not be certified. [Note 28.]

NOTES:

1. *See Alcan Aluminum Corp. v. Alcar Metals Inc.*, 200 USPQ 742, 744 n.5 (TTAB 1978) (plain copies of registrations introduced through testimony which established ownership of the registrations but failed to establish that they were currently subsisting were not considered); *Maybelline Co. v. Matney*, 194 USPQ 438, 440 (TTAB 1977) (pleaded registration was not considered of record where testimony introduced original certificate of registration into evidence but failed to establish current status and title); *Peters Sportswear Co. v. Peter's Bag Corp.*, 187 USPQ 647, 647 (TTAB 1975) (mere fact that copies show that registration originally issued to opposer does not establish that title still resides in opposer). *Compare United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1043 (TTAB 2014) (non-status and title copies of pleaded registration attached to notice of opposition considered of record when issue date "reasonably contemporaneous" with filing date of notice of opposition; two others originally attached to notice of opposition considered of record when printed from USPTO electronic database records showing current status and title and submitted under notice of reliance), *with id.* at 1041-42 (non-status and title copies of four pleaded registrations attached to notice of opposition insufficient to make of them record when issue dates "are not substantially contemporaneous with filing of notice of opposition," and opposer did not otherwise establish current status and title such as by testimony or notice of reliance on copies of registration taken from USPTO electronic database records showing current status and title; applicant's admission in answer that opposer is the owner of the pleaded registrations does not establish their status, as opposer did not plead validity of registrations in notice of opposition).

2. 37 C.F.R. § 2.122(d)(1); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) (effective January 14, 2017, "[t]he Board amended § 2.122(d) by replacing the word 'printout' with the word 'copy' to broaden the manner in which a registration may be attached to include, for example, printouts or downloads. The Office has retained the slightly different wording in § 2.122(d)(1) and (2) but the wording does not have different meanings."). *See Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (not of record where opposer's copies of registrations submitted with notice of opposition did not show current status or title); *Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1601 (TTAB 2014) (opposer failed to comply with "'simple and clear' directives of Trademark Rule 2.122(d)" by submitting plain copy of registration attached to notice of opposition – registration not of record); *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); *Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1539-40 (TTAB 2010) (pleaded registrations not of record where registration numbers were inputted in the ESTTA protocol but copies of registrations were not attached as exhibits); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1654 (TTAB 2010) (opposer may file a notice of reliance on a registration prepared by the Office showing both the current status and current title to the registration or a current printout of information from Office electronic database records showing the current status and title of the registrations), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009) (printouts from TSDR (formerly TARR) database of pleaded registrations submitted with notice of reliance sufficient to enter registrations in evidence; Board noted that "To the extent that there may appear to be a discrepancy between Trademark Rule 2.122(d)(1) and Trademark Rule 2.122(d)(2) in that the former allows for proof of a pleaded registration by the submission of USPTO records with a pleading while the latter appears to preclude use of such records during trial, there is no sound basis for the distinction."); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487, 1488 n.3 (TTAB 1990); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 684 n.6 (TTAB 1984); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983) (photocopy of registration did not contain status and title information); *Acme Boot Co. v. Tony and Susan Alamo Foundation, Inc.*, 213 USPQ 591, 592 (TTAB 1980) (handwritten notations on registration certificate insufficient to show status of registration); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of*

Hawaii, Inc., 204 USPQ 144, 146 (TTAB 1979). *Cf. FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (registration resulting from opposer's unpleaded application akin to third-party registration, and may be made of record through notice of reliance for purposes other than the basis of the opposition, i.e., for "whatever probative value" it may have). *Compare United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1043 (TTAB 2014) (non-status and title copy of pleaded registration attached to notice of opposition considered of record when issue date "reasonably contemporaneous" with filing date of notice of opposition; two others originally attached to notice of opposition considered of record when printed from USPTO electronic database records showing current status and title and submitted under notice of reliance), *with id.* at 1041-42 (non-status and title copies of four pleaded registrations attached to notice of opposition insufficient to make of them record when issue dates "are not substantially contemporaneous with filing of notice of opposition," and opposer did not otherwise establish current status and title such as by testimony or notice of reliance on copies of registration taken from USPTO electronic database records showing current status and title; applicant's admission in answer that opposer is the owner of the pleaded registrations does not establish their status, as opposer did not plead validity of registrations in notice of opposition).

3. *See UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1046 (TTAB 2009) ("The Board does not take judicial notice of registrations that reside in the Patent and Trademark Office.") (citing *Corporate Fitness Programs Inc. v. Weider Health and Fitness Inc.*, 2 USPQ2d 1682, 1683-84, n.3 (TTAB 1987)); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1485 n.4 (TTAB 2007).

The Federal Circuit, in *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681 (Fed. Cir. 2010) exercised its discretion to take judicial notice of a third party's registrations. Although the court took judicial notice of a third-party registration in that case, the Board does not take judicial notice of either third-party registrations or a party's own registration[s] insofar as the Trademark Rules of Practice specify, as discussed above, how to make such registrations of record in an inter partes proceeding.

4. *See United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1040 n.3 (TTAB 2014) (when an opposer pleads ownership of an underlying application, opposer may make of record subsequently issued registration of that application without amending pleading); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1563 n.6 (TTAB 2011) (an applicant is on notice that an opposer intends to rely on a registration that matured from a pleaded application), *rev'd on other grounds*, slip op, No. 11-3684 (D.N.J. August 29, 2017); *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 n. 12 (TTAB 2009); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1920 (TTAB 2006); *DC Comics v. Pan American Grain Manufacturing Co.*, 77 USPQ2d 1220, 1223 n.6 (TTAB 2005); *M & T Chemicals Inc. v. Stepan Chemical Co.*, 150 USPQ 570, 571 (TTAB 1966).

5. *See UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009).

6. 37 C.F.R. § 7.22 and 37 C.F.R. § 7.23.

7. *See*TMEP § 1906.01(a) and TMEP § 1906.01(a)(i).

8. 37 C.F.R. § 2.122(d)(2). *See Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1654 (TTAB 2010) (opposer may file a notice of reliance on a registration prepared by the Office showing both the current status and current title to the registration or a current printout of information from Office electronic database records showing the current status and title of the registrations), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1041-43 (TTAB 2014) (non-status and title copies of two pleaded registrations originally attached to notice of opposition considered

of record when printed from USPTO electronic database records showing current status and title and submitted under notice of reliance, but four others not considered of record when issue dates "are not substantially contemporaneous with filing of notice of opposition," and opposer did not otherwise establish current status and title such as by testimony or notice of reliance on copies of registration taken from USPTO electronic database records showing current status and title; applicant's admission in answer that opposer is the owner of the pleaded registrations does not establish their status, as opposer did not plead validity of registrations in notice of opposition); *Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1601 (TTAB 2014) (opposer failed to comply with "'simple and clear' directives of Trademark Rule 2.122(d)" by submitting plain copy of registration attached to notice of opposition – registration not of record); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009) (printouts from TSDR (formerly TARR) database of pleaded registrations submitted with notice of reliance sufficient to enter registrations in evidence; Board noted that "To the extent that there may appear to be a discrepancy between Trademark Rule 2.122(d)(1) and Trademark Rule 2.122(d)(2) in that the former allows for proof of a pleaded registration by the submission of USPTO records with a pleading while the latter appears to preclude use of such records during trial, there is no sound basis for the distinction."); *UMG Recordings, Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009) (notice of reliance on registration certificate which issued after applicant filed its brief untimely; that applicant also admitted opposer owned the application that matured into the registration did not dictate that the resulting registration would be of record whenever it issued); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (untimely notice of reliance on status and title copy of registration filed after close of testimony period); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 531 n.3 (TTAB 1986).

See also Sheller-Globe Co. v. Scott Paper Co., 204 USPQ 329, 331 (TTAB 1979); *Volkswagenwerk AG v. Clement Wheel Co.*, 204 USPQ 76, 80-81 (TTAB 1979); *W. R. Grace & Co. v. Red Owl Stores, Inc.*, 181 USPQ 118, 120 (TTAB 1973).

Cf. Ricardo Media Inc. v. Inventive Software, LLC, 2019 USPQ2d 311355, at *1 n.5 (TTAB 2019) (unpleaded registration submitted under notice of reliance may be considered, like third-party registrations, for whatever probative value it may have under the du Pont factors); *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (registration resulting from opposer's unpleaded application akin to third-party registration, and may be made of record through notice of reliance for purposes other than the basis of the opposition, i.e., for "whatever probative value" it may have).

9. *See* 37 C.F.R. § 2.122(d); Notice of Final Rulemaking, 48 Fed. Reg. 23122 (May 23, 1983); *In re Inter-State Oil Co.*, 219 USPQ 1229, 1230 n.1 (TTAB 1983).

10. *See Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1461 n.4 (TTAB 1992).

11. 37 C.F.R. § 2.122(e). Status and title copies need not be certified. *See Industrial Adhesive Co. v. Borden, Inc.* , 218 USPQ 945, 947 (TTAB 1983) (copies do not have to be certified but must contain status and title information). For the cost of a copy of a registration showing status and title, see 37 C.F.R. § 2.6(b)(4). At present, the Office provides both certified and uncertified copies of trademark documents. *See*TMEP § 111.

12. 37 C.F.R. § 2.122(d).

13. *See Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983); *Acme Boot Co. v. Tony and Susan Alamo Foundation, Inc.*, 213 USPQ 591, 592 (TTAB 1980) (handwritten notations on registration certificate not sufficient); *Peters Sportswear Co. v. Peter's Bag Corp.*, 187 USPQ 647, 647 (TTAB 1975) (constitutes prima facie showing of status and title).

14. *See Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1601 (TTAB 2014) (opposer failed to comply with "'simple and clear' directives of Trademark Rule 2.122(d)" by submitting plain copy of registration attached to notice of opposition – registration not of record); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009) (printouts from TSDR (formerly TARR) database of pleaded registrations submitted with notice of reliance sufficient to make registrations of record; Board noted that "To the extent that there may appear to be a discrepancy between Trademark Rule 2.122(d)(1) and Trademark Rule 2.122(d)(2) in that the former allows for proof of a pleaded registration by the submission of USPTO records with a pleading while the latter appears to preclude use of such records during trial, there is no sound basis for the distinction."). *See also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947-48 (photocopy of registration without status and title information insufficient to establish prima facie showing); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116-17 (TTAB 2009) (copy of registration certificate insufficient). *Compare United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1043 (TTAB 2014) (non-status and title copies of pleaded registration attached to notice of opposition considered of record when issue date "reasonably contemporaneous" with filing date of notice of opposition; two others considered of record when printed from USPTO electronic database records showing current status and title and submitted under notice of reliance), *with id.* at 1041-42 (non-status and title copies of four pleaded registrations attached to notice of opposition insufficient to make of them record when issue dates "are not substantially contemporaneous with filing of notice of opposition," and opposer did not otherwise establish current status and title such as by testimony or notice of reliance on copies of registration taken from USPTO electronic database records showing current status and title; applicant's admission in answer that opposer is the owner of the pleaded registrations does not establish their status, as opposer did not plead validity of registrations in notice of opposition).

15. *See Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1601 n.2 (TTAB 2014) (plain copy of registration attached to notice of opposition indicating issuance five years before such filing not "reasonably contemporaneous"); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000) (status and title copies prepared three years prior to opposition not reasonably contemporaneous); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460 (TTAB 1992); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (whether notice of reliance on status and title copy of registration prepared four years earlier is sufficiently recent goes to the competency, not the admissibility, of the registration); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487, 1488 n.3 (TTAB 1990) (status and title copies from 1963 not reasonably contemporaneous with filing of opposition in 1986); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 146 (TTAB 1979) (status and title copy of registration prepared two months prior to filing of opposition is reasonably contemporaneous); *Volkswagenwerk AG v. Clement Wheel Co.*, 204 USPQ 76, 81-82 (TTAB 1979); *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735, 736 (TTAB 1976). *Compare United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1043 (TTAB 2014) (non-status and title copy of pleaded registration attached to notice of opposition considered of record when issue date approximately four months prior to filing date of notice of opposition; two others originally attached to notice of opposition considered of record when printed from USPTO electronic database records showing current status and title and submitted under notice of reliance), *with id*. at 1041-42 (non-status and title copies of four pleaded registrations attached to notice of opposition insufficient to make of them record when issue dates were "years earlier" and opposer did not otherwise establish current status and title such as by testimony or notice of reliance on copies of registration taken from USPTO electronic database records showing current status and title).

16. *See Duffy-Mott Co. v. Borden, Inc.*, 201 USPQ 846, 847 n.5 (TTAB 1978) (USPTO error in identification of owner).

17. *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1425 n.19 (TTAB 2014) (judicial notice taken of changes in title and status of pleaded and proven registrations); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1460 n.4 (TTAB 2014) (judicial notice taken of status of pleaded registration made of record, but no further consideration because registration had been cancelled); *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1192 n.9 (TTAB 2007) (judicial notice taken of current status of a registration owned by a party properly made of record, when status of registration changed between the time it was made of record and time case decided); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1487-88 n.10-12 (TTAB 2007) (Board confirmed Trademark Act §§ 8 and 15 affidavits that were filed after submission of opposer's registrations during testimony period); *Parfums de Coeur, Ltd. v. Lazarus*, 83 USPQ2d 1012, 1014 n. 4 (TTAB 2007) (Board confirmed filing of Trademark Act §§ 8 and 15 affidavits that occurred subsequent to submission of registrations); *Tea Board of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1896 n.25 (TTAB 2006) (judicial notice taken of renewal of registration); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002) (review of Office automated records subsequent to filing of status and title copy of registration revealed that Trademark Act §§ 8 and 15 affidavits had been accepted and acknowledged); *Ultratan Suntanning Centers Inc. v. Ultra Tan International AB*, 49 USPQ2d 1313, 1314, n.6 (TTAB 1998) (same); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 147 (TTAB 1979) (status and title copy need not be updated after it is submitted; judicial notice of filing of Trademark Act §§ 8 and 15 affidavits); *Duffy-Mott Co. v. Borden, Inc.*, 201 USPQ 846, 847 n.5 (TTAB 1978); *Volkswagenwerk AG v. Clement Wheel Co.*, 204 USPQ 76, 80 n.3 (TTAB 1979).

18. 37 C.F.R. § 2.122(d)(2). *See Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1654 (TTAB 2010) (opposer may introduce registrations through witness testifying that registrations are still subsisting and are owned by opposer), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 332 n.2 (TTAB 1985) (no probative value where testimony established opposer's ownership of registration, but not current status); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 684 n.6 (TTAB 1984) (identification by witness as having come from opposer's files insufficient to establish ownership and status); *Acme Boot Co. v. Tony and Susan Alamo Foundation Inc.*, 213 USPQ 591, 592 (TTAB 1980).

See also Sheller-Globe Co. v. Scott Paper Co., 204 USPQ 329, 331 n.2 (TTAB 1979); *Alcan Aluminum Corp. v. Alcar Metals Inc.*, 200 USPQ 742, 744 n.5 (TTAB 1978); *Groveton Papers Co. v. Anaconda Co.*, 197 USPQ 576, 577 n.2 (TTAB 1977); *Maybelline Co. v. Matney*, 194 USPQ 438, 440 (TTAB 1977); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976); *American Manufacturing Co., v. Phase Industries, Inc.*, 192 USPQ 498, 500 (TTAB 1976); *West Point-Pepperell, Inc. v. Borlan Industries Inc.*, 191 USPQ 53, 54 (TTAB 1976).

19. *See Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (admission only of ownership and not validity was not sufficient); *Tiffany & Co. v. Columbia Industries, Inc.*, 455 F.2d 582, 173 USPQ 6, 8 (CCPA 1972) (Board erred in refusing to consider registrations of record when applicant admitted "the registrations referred to in the notice of opposition" in its answer); *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) (applicant effectively admitted active status and ownership of certain specifically identified registrations); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487, 1488 n.3 (TTAB 1990) (not of record where although applicant admitted that copies attached to opposition were "true copies" applicant did not admit to status and title of those registrations). *Cf. United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1041-42 (TTAB 2014) (non-status and title copies of four registrations attached to notice of opposition not of record despite applicant's admission in answer that opposer is the owner of them, as opposer did not plead validity of registrations in notice of opposition); *Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1602

(TTAB 2014) (applicant's admission that opposer "is listed" as the owner insufficient to establish opposer's current ownership of pleaded registration); *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009) (applicant admitted opposer's ownership of pleaded application; admission did not make resulting registration automatically of record and registration still had to be introduced); *Demon International LC v. Lynch*, 86 USPQ2d 1058, 1060 (TTAB 2008) (applicant's statement in answer that he "does not dispute the filing" of opposer's application not an admission of opposer's ownership of subsequently issued registration and registration's validity).

20. *See Crown Radio Corp. v. Soundscriber Corp.*, 506 F.2d 1392, 184 USPQ 221, 222 (CCPA 1974) (after filing its answer, respondent filed a "paper" in which respondent admitted existence of petitioner's registration; admission was sufficient to overcome respondent's 37 C.F.R. § 2.132 motion for default judgment); *Local Trademarks Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1157 (TTAB 1990) (applicant conceded ownership and validity in trial brief); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 684 n.6 (TTAB 1984) (applicant's treatment of pleaded registrations as properly of record in its trial brief was deemed a stipulation as to current status and title); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 948 (TTAB 1983) (admission in brief). *See also Jockey International, Inc. v. Frantti*, 196 USPQ 705, 706 n.5 (TTAB 1977); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 392 (TTAB 1976); and *West Point-Pepperell, Inc. v. Borlan Industries Inc.*, 191 USPQ 53, 54 (TTAB 1976).

21. *See* 37 C.F.R. § 2.123(b); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 948 (TTAB 1983); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 774 n.2 (TTAB 1979).

22. *See, e.g.*, Trademark Act § 7(b), 15 U.S.C. § 1057(b); *CTS Corp. v. Cronstoms Manufacturing, Inc.*, 515 F.2d 780, 185 USPQ 773, 774 (CCPA 1975) (prima facie evidence of registrant's right to use the mark on the identified goods); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, 274 (CCPA 1974) (prima facie evidence of validity of registration, ownership of mark and exclusive right to use it); and *In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 950 (TTAB 1986) (prima facie evidence of registrant's continuous use of the mark). *See also* Trademark Act § 7(c), 15 U.S.C. § 1057(c) (conferring, contingent on the registration of a mark on the Principal Register, and subject to certain specified exceptions, constructive use priority dating from the filing of the application for registration of the mark); *Jimlar Corp. v. The Army and Air Force Exchange Service*, 24 USPQ2d 1216, 1217 n.5 (TTAB 1992) (opposer's constructive use date on ITU application was subsequent to applicant's); *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) (constructive use dates intended to give ITU applicants superior rights to others who adopt the mark after filing date).

See also Andrea Radio Corp. v. Premium Import Co., 191 USPQ 232, 234 (TTAB 1976); *David Crystal, Inc. v. Glamorise Foundations, Inc.*, 189 USPQ 740, 741 (TTAB 1975); *Johnson & Johnson v. E. I. du Pont de Nemours & Co.*, 181 USPQ 790, 791 (TTAB 1974); *Gates Rubber Co. v. Western Coupling Corp.*, 179 USPQ 186, 189-90 (TTAB 1973).

23. *See McCormick & Co. v. Summers*, 354 F.2d 668, 148 USPQ 272, 276 (CCPA 1966) (registration on Supplemental Register is not evidence of constructive notice of ownership nor evidence of exclusive right to use); *In re Medical Disposables Co.*, 25 USPQ2d 1801, 1805 (TTAB 1992); and *Copperweld Corp. v. Arcair Co.*, 200 USPQ 470 (TTAB 1978). *See also Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232 (TTAB 1976); *Aloe Creme Laboratories, Inc. v. Johnson Products Co.*, 183 USPQ 447 (TTAB 1974); *Nabisco, Inc. v. George Weston Ltd.*, 179 USPQ 503 (TTAB 1973); and *Aloe Creme Laboratories, Inc. v. Bonne Bell, Inc.*, 168 USPQ 246 (TTAB 1970).

24. *See Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("a canceled registration does not provide constructive notice of anything"); *A&H Sportswear*

Co. v. Yedor, 2019 USPQ2d 111513, at *5 n.4 (TTAB 2019) ("a cancelled registration is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act"); *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1606 (TTAB 2018) (a cancelled registration is only evidence that the registration issued, and is not evidence of use of the mark at any time); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1956 n.9 (TTAB 2014) (cancelled and expired registrations are not probative), *vacated and remanded on other grounds*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015), *original decision aff'd*, *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 124 USPQ2d 1184 (TTAB 2017), *dismissed without prejudice sub nom. Snyder's-Lance, Inc. v. Frito-Lay North America, Inc.*, 414 F. Supp. 3d 822, 2019 USPQ2d 401574 (W.D.N.C. 2019), *reversed and remanded on other grounds*, 991 F.3d 512 (4th Cir. 2021); *Time Warner Entertainment Company v. Jones*, 65 USPQ2d 1650, 1653 n.6 (TTAB 2002) (status and title copy of expired registration); *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1746-47 (TTAB 1987) (parties stipulated to introduction of photocopy of expired registration having no probative value other than that it issued); *United States Shoe Corp. v. Kiddie Kobbler Ltd.*, 231 USPQ 815, 818 n.7 (TTAB 1986) (expired "Act of 1920" registration had no probative value); *Sinclair Manufacturing Co. v. Les Parfums de Dana, Inc.*, 191 USPQ 292, 294 (TTAB 1976) (lapsed registration of affiliated company is not evidence of use of mark at any time); *Bonomo Culture Institute, Inc. v. Mini-Gym, Inc.*, 188 USPQ 415, 416 (TTAB 1975) (expired registration is incompetent evidence of any existing rights in mark). *Cf. Nike Inc. v. Maher*, 100 USPQ2d 1018, 1021 (TTAB 2011) (limited probative value of expired third-party registration is further limited to the short time it was registered).

See also Borden, Inc. v. Kerr-McGee Chemical Corp., 179 USPQ 316, 316 n.2 (TTAB 1973), *aff'd without opinion*, 500 F.2d 1407, 182 USPQ 307 (CCPA 1974); *Unitec Industries, Inc. v. Cumberland Corp.*, 176 USPQ 62, 63 (TTAB 1972); *Monocraft, Inc. v. Leading Jewelers Guild*, 173 USPQ 506, 508 (TTAB 1972).

25. *See, e.g., Faultless Starch Co. v. Sales Producers Associates, Inc.*, 530 F.2d 1400, 189 USPQ 141, 142 n.2 (CCPA 1976) (state registrations do not establish use); *Kraft, Inc. v. Balin*, 209 USPQ 877, 880 (TTAB 1981) (although parties stipulated to introduction of state registration, said registration is incompetent to prove anything material to opposition proceeding); *Plak-Shack, Inc. v. Continental Studios of Georgia, Inc.*, 204 USPQ 242, 246 (TTAB 1979) (incompetent as evidence of use of a mark); *Stagecoach Properties, Inc. v. Wells Fargo & Co.*, 199 USPQ 341, 352 (TTAB 1978) (incompetent evidence to establish use of the mark), *aff'd*, 685 F.2d 302, 216 USPQ 480 (9th Cir. 1982). *See also Econo-Travel Motor Hotel Corp. v. Econ-O-Tel of America, Inc.*, 199 USPQ 307, 390 (TTAB 1978); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 390 (TTAB 1976); *State Historical Society of Wisconsin v. Ringling Brothers-Barnum & Bailey Combined Shows, Inc.*, 190 USPQ 25, 26 n.2 (TTAB 1976); *Old Dutch Foods, Inc. v. Old Dutch Country House, Inc.*, 180 USPQ 659, 660 n.6 (TTAB 1973); *Philip Morris Inc. v. Liggett & Myers Tobacco Co.*, 139 USPQ 240, 243-44 (TTAB 1963).

Cf. with respect to ex parte appeals, *In re Anania Associates, Inc.*, 223 USPQ 740, 742 (TTAB 1984) (argument that applicant's state registration for the mark must be taken as prima facie evidence of distinctiveness rejected); *In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984); *In re Illinois Bronze Powder & Paint Co.*, 188 USPQ 459 (TTAB 1975).

26. *See Societe Anonyme Marne et Champagne v. Myers*, 250 F.2d 374, 116 USPQ 153, 156 (CCPA 1957); *Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610, 1618 (TTAB 1988). *See also Nabisco, Inc. v. George Weston Ltd.*, 179 USPQ 503, 507 (TTAB 1973); *Barash Co. v. Vitafoam Ltd.*, 155 USPQ 267, 267 n.3 (TTAB 1967), *aff'd*, 427 F.2d 810, 166 USPQ 88 (CCPA 1970). *Cf. In re Hag AG*, 155 USPQ 598, 599 (TTAB 1967).

27. *See Harzfeld's, Inc. v. Joseph M. Feldman, Inc.*, 184 USPQ 692, 693 n.4 (TTAB 1974) (file history of petitioner's registration not of record where respondent noticed it but failed to file a copy of it).

28. 37 C.F.R. § 2.122(e).

704.03(b)(1)(B) Third-Party Registration

37 C.F.R. § 2.122(e) ***Printed publications and official records.***

(1) *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant in a particular proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered in accordance with paragraph (g) of this section. The notice of reliance shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.*

A party to an inter partes proceeding before the Board may introduce, as part of its evidence in the case, a registration owned by a third party not involved in the proceeding. [Note 1.]

A party that wishes to make such a third-party registration of record in a Board inter partes proceeding may do so by filing, during its testimony period, a plain copy of the registration, a printout or a copy of information of the registration from the Office's electronic database records, together with a notice of reliance thereon specifying the registration and indicating generally its relevance and associating the registration with one or more issues in the case. [Note 2.]

A party to a Board inter partes proceeding may also make a third-party registration of record by introducing a copy of it as an exhibit to testimony, or by stipulation of the parties. [Note 3.]

It is not necessary that the copy of the third-party registration submitted with a notice of reliance (or with testimony or a stipulation) be certified, nor need it be a current status and title copy prepared by the Office; a plain copy (or legible photocopy) of the registration itself, or the electronic equivalent thereof, that is, a printout of the registration from the electronic records of the Office's automated search system is all that is required. [Note 4.]

As stated in TBMP § 704.03(b)(1) above, a current status and title copy of a registration prepared by the Office (or other appropriate proof of current status and title), or a current printout or copy of information from the Office's electronic database records showing the current status and title of the registration, submitted with a notice of opposition or petition to cancel, is necessary when the owner of a registration on the Principal Register seeks to make the registration of record for the purpose of relying on the presumptions accorded to a certificate of registration pursuant to Trademark Act § 7(b), 15 U.S.C. § 1057(b). However, the § 7(b) presumptions accorded to a registration on the Principal Register accrue only to the benefit of the owner of the registration, and hence come into play only when the registration is made of record by its owner, or when the registration is cited by an examining attorney (in an ex parte case) as a reference under Trademark Act § 2(d), 15 U.S.C. § 1052(d), against a mark sought to be registered. [Note 5.]

Thus, when third-party registrations are made of record, the party offering them may not rely on the Trademark Act § 7(b), 15 U.S.C. § 1057(b), presumptions. Normally, third-party registrations are offered merely to show that they issued, and a plain copy of the registration is sufficient for that purpose. [Note 6.]

On the other hand, a party may not make a third-party registration of record simply by introducing a list of third-party registrations that includes it; or by filing a trademark search report in which the registration is mentioned; or by filing a printout, from a private company's data base, of information about the registration; or by filing a notice of reliance together with a reproduction of the mark as it appeared in the Official Gazette for purposes of publication; or by referring to the registration in its brief or pleading. The Board does not take judicial notice of registrations in the Office. [Note 7.] *Cf.*TBMP § 528.05(d) (for purposes of responding to a summary judgment motion only, a copy of a trademark search report may be sufficient to raise a genuine dispute of material fact as to the nature and extent of third-party use of a particular designation).

Even when a third-party federal registration has been properly made of record, its probative value is limited, particularly when the issue to be determined is likelihood of confusion, and there is no evidence of actual use of the mark shown in the registration. [Note 8.] Nevertheless, third-party registrations may be entitled to some weight to show the meaning of a mark, or a portion of a mark, in the same manner as a dictionary definition. [Note 9.]

A state registration, whether or not owned by a party, has very little, if any, probative value in a proceeding before the Board. [Note 10.] *See, e.g.,*TBMP § 704.03(b)(1)(A).

Making file history of third-party registration of record. The file history of a third-party registration (rather than just the certificate of registration), or a portion thereof, may be made of record by: (1) filing, during the offering party's testimony period, a copy of the file history, or the portion it wishes to introduce, together with a notice of reliance thereon as an official record pursuant to 37 C.F.R. § 2.122(e) (*see*TBMP § 704.07); or (2) appropriate identification and introduction of a copy of the file history, or portion thereof, during the taking of testimony; or (3) stipulation of the parties, accompanied by a copy of the file history, or portion thereof. The file history, or portion thereof, may be obtained from the Office's electronic database records, such as TSDR.

It is not necessary that the copy of the registration file, or portions thereof, be certified. [Note 11.] However, third-party registration histories are of very limited probative value. [Note 12.]

NOTES:

1. 37 C.F.R. § 2.122(e)(1). *See* STX Financing, LLC v. Terraza, 2020 USPQ2d 10989, at *1 (TTAB 2020) (screenshots of third-party registrations obtained from TESS database submitted under notice of reliance constitute "official records" and not "Internet materials"; therefore, it was unnecessary to provide the access date or URL); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 n.11 (TTAB 2011) (third-party registrations admissible under notice of reliance); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1110 (TTAB 2007). *Cf. Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *1 n.5 (TTAB 2019) (unpleaded registration may be considered, like third-party registrations, for whatever probative value it may have under the du Pont factors); *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (registration resulting from opposer's unpleaded application akin to third-party registration, and may be made of record through notice of reliance for purposes other than the basis of the opposition, i.e., for "whatever probative value" it may have).

2. 37 C.F.R. § 2.122(e); 37 C.F.R. § 2.122(g). *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992) (printouts of third-party registrations obtained from private search reports are neither printed publications nor official records); *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151, 153 n.2 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308, 309 n.5 (TTAB 1976) (reference to third-party registrations in answer, without filing copies with a notice of reliance, was insufficient to make them of record).

3. *See Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1047 (TTAB 2017) (overruling objection to third- party registrations attached as exhibits to declaration testimony).

4. *See* 37 C.F.R. § 2.122(e); *STX Financing, LLC v.Terraza*, 2020 USPQ2d 10989, at *1 (TTAB 2020) (screenshots of third-party registrations obtained from TESS database submitted under notice of reliance sufficient); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 n.11 (TTAB 2011) (not necessary to submit title and status copies of third-party registrations prepared by Office; plain copies from the USPTO's electronic database would have sufficed); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998) (incomplete excerpts of registrations from internal USPTO trademark database system was insufficient); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992). *See also Interbank Card Association v. United States National Bank of Oregon*, 197 USPQ 123, 124 n.6 (TTAB 1977).

5. *See* Trademark Act § 7(b), 15 U.S.C. § 1057(b); *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1144 (TTAB 1986) (wholly owned subsidiary of owner of registrations may not rely on registrations to prove priority); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 950 (TTAB 1986) (claim that mark in cited registration is not in use is an impermissible collateral attack on the validity of the registration in an ex parte proceeding); *In re H & H Products*, 228 USPQ 771, 773 (TTAB 1986) (registrations are entitled to presumption that marks have overcome any inherent nondistinctiveness); *Yamaha International Corp. v. Stevenson*, 196 USPQ 701, 702 (TTAB 1979) (opposer could not rely on § 7(b) presumptions where registration is owned by its parent company); *Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc.*, 174 USPQ 473, 475-76 (TTAB 1972) (although petitioner can rely on its wholly-owned subsidiary's use of a mark, petitioner cannot rely on the registrations owned by its wholly-owned subsidiary for statutory presumptions); *Joseph S. Finch & Co. v. E. Martinoni Co.*, 157 USPQ 394, 395 (TTAB 1968) (opposer cannot rely on registrations owned by its parent or its parent's subsidiaries).

6. *See Merritt Foods Co. v. Americana Submarine*, 209 USPQ 591, 593 n.16 (TTAB 1980); *Hiram Walker & Sons, Inc. v. Milstone*, 130 USPQ 274, 276 (TTAB 1961).

7. *See, e.g., Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (listing of third-party marks downloaded from Office database does not make registrations of record); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1829 n.8 (TTAB 2012) (summary of search results from USPTO's electronic database is not an official record of the Office); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1217 (TTAB 2011) (summaries of search results for third-party registrations are not official records and have not been considered); *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007) (third-party registrations mentioned in trial brief); *Truescents, LLC v. Ride Skin Care, LLC*, 81 USPQ2d 1334, 1337 (TTAB 2006) (listing of applications and registrations obtained from Office's electronic database); *In re Dos Padres, Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998) (listings from commercial trademark search reports); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994) (search report from private company's database); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1885 (TTAB 1993) (trademark search report wherein registrations are mentioned); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992) (trademark search reports from private companies are neither printed publications nor official records); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 (TTAB 1990) (search report), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 532 (TTAB 1986) (reference to third-party registrations in a brief). *See also National Fidelity Life Insurance v. National Insurance Trust*, 199 USPQ 691 (TTAB 1978); *Wella Corp. v. California Concept Corp.*, 192 USPQ 158 (TTAB 1976), *rev'd on other grounds*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); *W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976).

The Federal Circuit, in *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681 (Fed. Cir. 2010), exercised its discretion to take judicial notice of a third party's registrations. Although the court took judicial notice of a third-party's registrations in that case, as discussed above the Board does not take judicial notice of either third-party registrations or a party's own registration[s] insofar as the Trademark Rules of Practice specify how to make such registrations of record in an inter partes proceeding.

8. *See AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) (not evidence of what happens in the market place or consumer familiarity); *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *1 n.5 (TTAB 2019) (unpleaded registration may be considered, like third-party registrations, for whatever probative value it may have under the du Pont factors); *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (registration resulting from opposer's unpleaded application akin to third-party registration, and may be made of record through notice of reliance for purposes other than the basis of the opposition, i.e., for "whatever probative value" it may have); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351 n.10 (TTAB 2014) (third-party registrations do not constitute evidence of use, thus of limited probative value to show mark is weak), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014); *In re the Dot Communications Network LLC*, 101 USPQ2d 1062, 1067 (TTAB 2011) (limited probative value in view of the current market conditions which are very different from when registrations issued); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1222 (TTAB 2011) (third-party registrations for same term are not evidence of use in the marketplace); *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1028 (TTAB 2011) (little probative value because they tell nothing about whether the marks are being used or the manner of such use); *Nike, Inc. v. WNBA Enterprises, LLC*, 85 USPQ2d 1187, 1200 (TTAB 2007) (not evidence of use); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2002) (not evidence of use or that consumers have been exposed to them); *Red Carpet Corp. v. Johnstown American Enterprises, Inc.*, 7 USPQ2d 1404, 1406 (TTAB 1988) (not evidence of use to show public awareness of the marks).

See also Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (may not be given any weight in determining strength of a mark); *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289, 291 n.12 (CCPA 1977) (little evidentiary value in determining scope of protection); *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588 (TTAB 1975) (little weight on likelihood of confusion), *aff'd*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976); *Conde Nast Publications Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 USPQ 422, 424-25 (CCPA 1975) (little weight on question of likelihood of confusion); *Spice Islands, Inc. v. Frank Tea and Spice Co.*, 505 F.2d 1293, 184 USPQ 35, 38 (CCPA 1974) (do not control determination of whether marks are so similar that they are likely to cause confusion); *Tivo Brands, LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1117 (TTAB 2018) (in dilution case, not probative of whether opposer's use of its mark is substantially exclusive); *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151, 153 n.2 (TTAB 1983) (third-party registration only establishes what appears on its face, that application was made claiming adoption and use and that registration was granted), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984).

Cf. In re Alpha Analytics Investment Group LLC, 62 USPQ2d 1852, 1856 (TTAB 2002) (registrations under Trademark Act § 2(f) or on the Supplemental Register, although not conclusive evidence, may be probative evidence of mere descriptiveness). *Cf. also Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1221 (TTAB 2011) (while third-party registrations based on use in commerce may suggest listed goods and services are of the type which may emanate from a single source, third party registrations based on international registrations are not evidence that the marks have been used in the United States for the stated goods and services); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (third-party registrations may have some probative value to the extent that they may serve to suggest that goods or services are of a type which may emanate from the same source).

9. *See Juice Generation, Inc. v. GS Enterprises, LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-74 (Fed. Cir. 2015) (evidence of extensive number of third-party registrations to be considered); *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) (evidence of third party registrations may be given some weight similar to dictionary evidence); *Conde Nast Publications Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 USPQ 422, 425 (CCPA 1975). *See also American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1029 (TTAB 2011) (may indicate that a mark, or portion of a mark, is descriptive or suggestive); *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1028 (TTAB 2011) (to indicate a commonly registered expression with a suggestive meaning); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011) (probative of meaning of term, not probative that term is commercially weak), *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); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2002) (that a term is adopted to convey a particular suggestive meaning); *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1277 (TTAB 1992) (to show the sense in which the term is employed in the marketplace); *United Foods Inc. v. J.R. Simplot Co,*, 4 USPQ2d 1172, 1174 (TTAB 1987) (to show ordinary usage of a term and descriptive or suggestive significance); *Bottega Veneta, Inc. v. Volume Shoe Corp,*, 226 USPQ 964, 968 (TTAB 1985) (to show geographic significance of terms).

10. *See Allstate Insurance Co. v. DeLibro*, 6 USPQ2d 1220, 1223 (TTAB 1988) (third-party state registrations "are of absolutely no probative value" on the question of likelihood of confusion).

11. 37 C.F.R. § 2.122(e).

12. *See Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 397 n.11 (TTAB 1979) (specimens from third-party registration files are not evidence of the fact that the specimens filed in the underlying applications or even with Trademark Act § 8 affidavits are in use today or that such specimens have ever been used to the extent that they have made an impression on the public).

704.03(b)(2) Application Not Subject of Proceeding

37 C.F.R. § 2.122(e) ***Printed publications and official records.***

(1) *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant in a particular proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered in accordance with paragraph (g) of this section. The notice of reliance shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.*

A party to a proceeding before the Board may introduce, as part of its evidence in the case, a copy of an application that is not the subject of the proceeding, by filing, during its testimony period, a copy of the application file, or of the portions which it wishes to introduce, together with a notice of reliance thereon specifying the application and indicating generally its relevance as well as associating the application with one or more issues in the case. [Note 1.] It is not necessary that the copy of the application, or portions

thereof, filed under a notice of reliance be certified. [Note 2.] The copy of the application, or portion thereof, may be obtained from the TSDR database accessible on the Office's website.

An application that is not the subject of the proceeding may also be made of record by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties. [Note 3.]

An application made of record in a Board inter partes proceeding, whether owned by a party or not, is generally of very limited probative value. [Note 4.] *See*TBMP § 704.04. However, if the application is owned by a party to the proceeding, the allegations made and documents and things filed in the application may be used as evidence against the applicant, that is, as admissions against interest and the like. *See*TBMP § 704.04. [Note 5.]

NOTES:

1. *See* 37 C.F.R. § 2.122(e); 37 C.F.R. § 2.122(g). *See STX Financing, LLC v. Terraza*, 2020 USPQ2d 10989, at *1-2 (TTAB 2020) (screenshots of applications obtained from TESS database sufficient; selected screenshots of Office actions from the file history of opposer's pleaded applications admissible); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351 n.10 (TTAB 2014) (copies of third-party applications constitute official records), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014); *Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1933 (TTAB 2013) (opposer's objection sustained; applicant's mere listing of third-party applications in brief not properly made of record); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103 (TTAB 2007) (portion of the file history of petitioner's pleaded registration submitted); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231 (TTAB 1992) (copy of drawing from abandoned application); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (copies of third-party applications); and *St. Louis Janitor Supply Co. v. Abso-Clean Chemical Co.*, 196 USPQ 778, 780 n.4 (TTAB 1977) (file history of petitioner's application). *Cf. Chutter, Inc. v. Great Concepts, LLC*, 119 USPQ2d 1865, 1867 n.3 (TTAB 2016) (in ruling on motion for summary judgment, Board noted that the mere listing of an application number in the electronic record does not make that application of record).

2. *See* 37 C.F.R. § 2.122(e); *STX Financing, LLC v. Terraza*, 2020 USPQ2d 10989, at *1-2 (TTAB 2020) (screenshots of applications obtained from the TESS database submitted constitute official records and need not be certified; selected screenshots of Office Actions from the file history of opposer's pleaded applications admissible); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1350 (TTAB 2014) (plain copies of third-party applications from USPTO's electronic databases admissible as official records), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014).

3. *See WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018) (plaintiff's pleaded pending application is not automatically of record, and may be introduced as evidence at trial by filing under notice of reliance a copy thereof showing current status and title, or through witness testimony about its status).

4. *See Ricardo Media Inc. v. Inventive Software*, LLC, 2019 USPQ2d 311355, at *1 n.5 (TTAB 2019) (unpleaded application, made of record by notice of reliance, like third-party applications, are of limited probative value); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1956 n.9 (TTAB 2014) ("The applications are not evidence of anything except that they were filed."), *vacated and remanded on other grounds*, *Princeton Vanguard , LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015), *original decision aff'd*, *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 124 USPQ2d 1184 (TTAB 2017), *dismissed without prejudice sub nom. Snyder's-Lance,*

Inc. v. Frito-Lay North America, Inc., 414 F. Supp. 3d 822, 2019 USPQ2d 401574 (W.D.N.C. 2019), *reversed and remanded on other grounds*, 991 F.3d 512 (4th Cir. 2021); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1360 (TTAB 2014) (evidence only that applications were filed, thus incompetent to show common third-party use), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (evidence only of the filing of the application); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 396 n.10 (TTAB 1979) (claim of ownership of a registration in an application is not competent evidence of ownership of the registration); *Lasek & Miller Associates v. Rubin*, 201 USPQ 831, 833 n.3 (TTAB 1978) (petitioner's application file is proof only of filing, not of any facts alleged in the application); and *St. Louis Janitor Supply Co. v. Abso-Clean Chemical Co.*, 196 USPQ 778, 780 n.4 (TTAB 1977) (incompetent to prove use). *See also Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1606 (TTAB 2018) (abandoned application only probative to show it had been filed); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 397 n.11 (TTAB 1979) (specimens from third-party registration files are not evidence of the fact that the specimens filed in the underlying applications or even with Trademark Act § 8 affidavits are in use today or that such specimens have ever been used to the extent that they have made an impression on the public); *Continental Specialties Corp. v. Continental Connector Corp.*, 192 USPQ 449, 451 (TTAB 1976); *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232, 234 n.6 (TTAB 1976).

5. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) (statements falling under Fed. R. Evid. 801(d) do not constitute hearsay).

704.04 Statements and Things in Application or Registration

37 C.F.R. § 2.122

(b) ***Application and registration files.***

(1) *The file of each application or registration specified in a notice of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose in accordance with paragraph (b)(2) of this section.*

(2) *The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony. Statements made in an affidavit or declaration in the file of an application for registration, or in the file of a registration, are not testimony on behalf of the applicant or registrant. Establishing the truth of these or any other matters asserted in the files of these applications and registrations shall be governed by the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part.*

The file of a particular application or registration that is the subject of the proceeding is of record in a Board inter partes proceeding by operation of 37 C.F.R. § 2.122(b)(1). *See*TBMP § 704.03(a). [Note 1.] However, statements made in an affidavit or declaration in the file of an application or registration are not testimony; rather, such matter constitutes hearsay, except for statements falling under Fed. R. Evid. 801(d)). [Note 2.]

Likewise, the allegation of a date of use of a mark made in the application or registration is not evidence in the proceeding on behalf of the applicant or registrant and the specimen in the application or registration, without more, is not evidence on behalf of the applicant or registrant. [Note 3.] The date of use must be established by competent evidence, properly adduced at trial, [Note 4] and the specimen in an application or registration file is not evidence in an inter partes proceeding, on behalf of the applicant or registrant, unless it has been identified and introduced in evidence as an exhibit during the testimony period. [Note 5.]

Similarly, the allegations of use in a third-party registration do not constitute evidence that the mark shown therein has actually been used. [Note 6.]

The allegations and statements made and documents and things filed in an application or registration may be used as evidence *against* the applicant or registrant, that is, as admissions against interest and the like. [Note 7.]

Self-authenticating exhibits (e.g., printed publications, Internet printouts with the URL and date) attached to affidavits or declarations in applications or registrations may have evidentiary value for what they show on their face. [Note 8.]

NOTES:

1. *See The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009).

2. 37 C.F.R. § 2.122(b)(2); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("Now that testimony by affidavit or declaration is unilaterally available, it is necessary to clearly distinguish material residing in an application or registration from testimony introduced in the proceeding. … Although part of the record of the proceeding, such material constitutes hearsay (except for statements falling under Fed. R. Evid. 801(d)), further compounded by the fact that the affidavits or declarations were not subject to contemporaneous cross-examination.). *See Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *4, n.23 (TTAB 2019) (declaration submitted in application file during prosecution not considered trial testimony since it was dated over three years prior to petitioner's testimony period; statements in application file declaration were considered admissions), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019).

3. 37 C.F.R. § 2.122(b)(2). *See, e.g., UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1047 (TTAB 2009) (allegations in application are not evidence); *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007) (pending applications are evidence only that they were filed on a certain date; they are not evidence of use of the marks); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993) (in the absence of proof of use, the filing date of the application, rather than the dates of use alleged in the application, is treated as the earliest use date on which applicant may rely); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 396 n.10 (TTAB 1979); (an application is not evidence of anything on behalf of applicant except that it was filed); *Omega SA v. Compucorp*, 229 USPQ 191, 195 (TTAB 1985) (allegations and documents in application file not evidence unless and to the extent they have been identified and introduced in evidence during testimony). *See also The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009).

4. 37 C.F.R. § 2.122(b)(2). *See Baseball America, Inc. v. Powerplay Sports, Ltd.*, 71 USPQ2d 1844, 1848, n.10 (TTAB 2004) (dates of use in application not evidence of such use); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993) (in the absence of proof, the filing date of the

application and not the dates of use alleged in the application is treated as the earliest use date on which an applicant may rely); *Omega SA v. Compucorp*, 229 USPQ 191, 193 n.10 (TTAB 1985) (applicant may rely on presumption that its mark was in use as of filing date of application in absence of any proof of earlier use); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.4 (TTAB 1985) (statements and materials in registration file bearing on respondent's dates of use not evidence on behalf of respondent unless properly introduced); *Textron Inc. v. Arctic Enterprises, Inc.*, 178 USPQ 315 (TTAB 1973) (applicant cannot rely on dates of use alleged in application).

5. 37 C.F.R. § 2.122(b)(2). *See Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607, 613 n.7 (TTAB 1981) (specimens in application not evidence on behalf of respondent); *Dap, Inc. v. Century Industries Corp.*, 183 USPQ 122, 123 (TTAB 1974) (applicant cannot rely on specimens filed with application to delineate nature and use of its goods).

6. 37 C.F.R. § 2.122(b)(2). *See Alpha Industries, Inc. v. Alpha Microsystems*, 223 USPQ 96, 96 (TTAB 1984) (Board will not take judicial notice of statements made in third-party applications regarding use). *See also e.g., Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1622 (TTAB 1989); *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1142 (TTAB 1986) (registrations owned by opposer's parent corporation are third-party registrations and opposer cannot rely on those registrations to prove priority); *Economics Laboratory, Inc. v. Scott's Liquid Gold, Inc.*, 224 USPQ 512, 514 (TTAB 1984); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 397 n.11 (TTAB 1979) (specimens from third-party registration files are not evidence of the fact that the specimens filed in the underlying applications or even with Trademark Act § 8 affidavits are in use today or that such specimens have ever been used to the extent that they have made an impression on the public).

7. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) (statements falling under Fed. R. Evid. 801(d) do not constitute hearsay). *See Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *4-5 (TTAB 2019) (statements in application file declaration were considered admissions; disclaimer of "LEAF" may be considered an admission by Petitioner that the term is merely descriptive of its cigar wraps), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019); *Daniel J. Quirk Inc. v. Village Car Company*, 120 USPQ2d 1146, 1149 n.14 (TTAB 2016) (statements made in affidavit filed in connection with respondent's office action response constitute admissions against interest and fall within hearsay exception under Fed. R. Evid. 801(d)(2)); *Bass Pro Trademarks, LLC v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1851 (TTAB 2008) (disclaimer may be considered an admission that term is merely descriptive); *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 961 n.5 and n.11 (TTAB 1985) (date of first use asserted by opposer in its application may be considered as admission against interest; in evaluating "Morehouse" type defense, Board relied on specimens and other materials in applicant's application as evidence of the nature of applicant's services to find that those services were not "substantially identical" to the goods in applicant's subsisting registration); *Sunbeam Corp. v. Battle Creek Equipment Co.*, 216 USPQ 1101, 1102 n.3 (TTAB 1982) (applicant's claim of distinctiveness in its application is an admission by applicant that term is descriptive); *Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607, 613 n.7 (TTAB 1981) (specimens in respondent's registration may be used as admission against interest of relationship between respondent's and petitioner's goods).

See also, e.g., Hydro-Dynamics Inc. v. George Putnam & Co., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) (applicant which seeks to prove date of first use earlier than that stated in its application must do so by heavier burden of clear and convincing evidence, rather than a preponderance of the evidence, because of the change of position from one "considered to have been made against interest at the time of filing of the application"); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1283 (Fed. Cir. 1984) (applicant's earlier contrary position before the examining attorney as to the meaning

of its mark as demonstrated by statements in the application illustrating the variety of meanings that may be attributed to, and commercial impression projected by, applicant's mark, may be relevant); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978) (fact that party took position in its application inconsistent with its position in inter partes proceeding may be considered as evidence "illuminative of shade and tone in the total picture confronting the decision maker"); *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) (in application for mark in typed form, specimens in application may be used to illustrate one form in which mark may actually be used in order to show similarity with opposer's mark); *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *7 (TTAB 2019) (petitioner's statements in application file declaration found inconsistent with present position defending counterclaim and supported a contrary conclusion), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019); *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1102 n.38 (TTAB 2018) (witness testimony of earlier use date not clear and convincing but use date in application weakly corroborated by submissions in record); *American Rice, Inc. v. H.I.T. Corp.*, 231 USPQ 793, 798 (TTAB 1986) (fact that opposer took position in its application regarding descriptiveness of term inconsistent with its position in inter partes proceeding may be considered as evidence, although earlier inconsistent position does not give rise to an estoppel).

8. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016).

704.05 Exhibits to Pleadings or Briefs

704.05(a) Exhibits to Pleadings

37 C.F.R. § 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 C.F.R. § 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).*

Exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached, and must be properly identified and introduced in evidence as exhibits during the testimony period. [Note 1.] However, there are two exceptions to this rule.

The first exception is a current status and title copy, prepared by the Office, of a plaintiff's pleaded registration. When a plaintiff submits an original or photocopy of a status and title copy, prepared and issued by the Office, of its pleaded registration as an exhibit to its complaint, the registration will be received in evidence and made part of the record without any further action by plaintiff. [Note 2.]

The second exception is a current printout or copy of information from the electronic database records of the USPTO showing the current status and title of a plaintiff's pleaded registration. When a plaintiff submits a printout or 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 3.] *See*TBMP §

704.03(b)(1)(A). The printout or copy of the information may be taken from (a) TSDR showing the current status and title (owner) of the registration and, if the TSDR printout or copy of the information does not reflect the current owner of the registration, a printout or copy of the information from the Trademark Assignment Recordation Branch database demonstrating an assignment to the current owner of the registration; or (b) TESS along with a copy of records from the Trademark Assignment Recordation Branch database showing and assignment to the current owner of the registration.

NOTES:

1. 37 C.F.R. § 2.122(c). *See Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1510 n.5 (TTAB 2017) (exhibits to the petition for cancellation consisting of copies of patents, photographs of certain goods identified in the involved registrations, packaging for certain of the identified goods and Internet materials not considered); *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2016 n.5 (TTAB 2014) (materials attached to answer not considered).

2. *See* 37 C.F.R. § 2.122(c) and 37 C.F.R. § 2.122(d)(1).

3. *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 n.4 (TTAB 2008). *Cf. Chutter, Inc. v. Great Concepts, LLC*, 119 USPQ2d 1865, 1867 n.3 (TTAB 2016) ("The mere listing of an application number in the electronic record does not make that application of record."); *Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1539-40 (TTAB 2010) (pleaded registrations not of record where registration numbers were inputted in the ESTTA protocol but copies of registrations were not attached as exhibits).

704.05(b) Exhibits to Briefs

Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony. [Note 1.]

Evidence which was timely filed during the parties' trial periods need not and should not be resubmitted with a party's brief. [Note 2.]

If, after the close of the time for taking testimony, a party discovers new evidence that it wishes to introduce in its behalf, the party may file a motion to reopen its testimony period. However, the moving party must show not only that the proposed evidence has been newly discovered, but also that it could not have been discovered earlier through the exercise of reasonable diligence. *See*TBMP § 509.01(b).

NOTES:

1. *See, e.g., Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 71345, at *2 (TTAB 2020) (exhibits attached to brief not considered); *Norris v. PAVE: Promoting Awareness, Victim Empowerment*, 2019 USPQ2d 370880, at *2 (TTAB 2019) (inserted screenshots and hypertext link within the text of reply brief, if not previously and properly introduced into the record, not considered); *Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, at *2 n.8 (TTAB 2019) (no consideration given to appendixes attached to brief summarizing decisions of federal agencies and articles); *Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1116 (TTAB 2009); *Bass Pro Trademarks LLC v. Sportsman Warehouse, Inc.*, 89 USPQ2d 1844, 1848 (TTAB 2008); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008); *Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741, 1748 (TTAB 2006) (excerpts from novel not considered); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 748 n.5 (TTAB 1986) (third-party

registrations attached to brief not considered); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1009 n.18 (TTAB 1984) (copy of Canadian Opposition Board decision attached to brief not considered); *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018, 1019 (TTAB 1983); *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 112 n.3 (TTAB 1978); *Astec Industries, Inc. v. Barber-Greene Co.*, 196 USPQ 578, 580 n.3 (TTAB 1977); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 391 n.10 (TTAB 1976). *See also L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254, 255 (TTAB 1975); *American Crucible Products Co. v. Kenco Engineering Co.*, 188 USPQ 529, 531 (TTAB 1975); *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588, 589 n.1 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 185 USPQ 61, 61 n.2 (TTAB 1975), *aff'd*, 530 F.2d 1396, 189 USPQ 138 (CCPA 1976); *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429, 430 n.3 (TTAB 1973).

Compare, Hard Rock Café Licensing Corp. v. Elsea, 48 USPQ2d 1400, 1405 (TTAB 1998) (dictionary definitions attached to applicant's brief were the proper subject of judicial notice); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (evidence which had been timely filed was not objectionable when a reproduction of the evidence was later attached to a trial brief) with TBMP § 704.12 regarding judicial notice.

2. *See Norris v. PAVE: Promoting Awareness, Victim Empowerment*, 2019 USPQ2d 370880 at *2 (TTAB 2019) (not necessary to submit duplicates of material that is already in record); *Corporacion Habanos SA v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1092 (TTAB 2012) (same); *Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ 2d 1112, 1116 (TTAB 2009); *Life Zone, Inc. v. Middleman Group, Inc.*, 87 USPQ2d 1953, 1955 n.4 (TTAB 2008) (attaching previously-filed evidence to a brief is neither a courtesy nor a convenience to the Board).

704.06 Statements in Pleadings or Briefs

704.06(a) Statements in Pleadings

Statements made in pleadings cannot be considered as evidence on behalf of the party making them; such statements must be established by competent evidence during the time for taking testimony. [Note 1.]

However, statements in pleadings may have evidentiary value as admissions against interest by the party that made them. [Note 2.]

NOTES:

1. *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010) (assertions in answer not evidence unless supported by evidence introduced at trial or except as admission against interest); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1547 n.6 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Times Mirror Magazines, Inc. v. Sutcliff*, 205 USPQ 656, 662 (TTAB 1979) (statements in answer referring to sales of applicant's magazines were not considered).

2. *See Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010) (assertions in answer not evidence unless supported by evidence introduced at trial or except as admission against interest); *Maremont Corp. v. Air Lift Co.*, 463 F.2d 1114, 174 USPQ 395, 396 n.4 (CCPA 1972) (pleadings in prior proceeding available as evidence, although not conclusive evidence, against the pleader); *Bakers Franchise Corp. v. Royal Crown Cola Co.*, 404 F.2d 985, 160 USPQ 192, 193 (CCPA 1969) (admission contained in pleading of one action may be evidence against pleader in another action); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d

1545, 1548 n.6 (TTAB 1990) (pleadings have evidentiary value only to the extent they contain opponent's admissions against interest), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 196 USPQ 711, 714 (TTAB 1977) (admissions in answer regarding meaning of mark); *Brown Co. v. American Stencil Manufacturing Co.*, 180 USPQ 344, 345 n.5 (TTAB 1973) (applicant having admitted in its answer that it did not use mark prior to a certain date was estopped from later contending that it has an earlier date of use).

704.06(b) Statements in Briefs

Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. [Note 1.] Statements in a brief have no evidentiary value, except to the extent that they may serve as admissions against interest by the party that made them. [Note 2.]

NOTES:

1. *See Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (agreeing with the Board that factual statements made in a brief are not evidence introduced at trial); *In re Simulations Publications, Inc.*, 521 F.2d 797, 798, 187 USPQ 147, 148 (CCPA 1975) ("Statements in a brief cannot take the place of evidence."). *Cf. Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005) ("Attorney argument is no substitute for evidence."); *Martahus v. Video Duplication Services. Inc.*, 424 F.3d 417, 27 USPQ2d 1846, 1849 (Fed. Cir. 1993) ("mere attorney arguments unsubstantiated by record evidence are suspect at best"); *In re Simulations Publications, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975) (where appellant argued that the magazines at issue deal with unrelated subject matter, the court held that "[s]tatements in a brief cannot take the place of evidence"); *Performance Open Wheel Racing, Inc. v. United States Auto Club Inc.*, 2019 USPQ2d 208901, at *8 n.62 (TTAB 2019) (attorney argument unsupported by any testimony or evidence does not have any probative value).

2. *See, e.g., Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *8 (TTAB 2019) (statements in brief regarding term "grabba" considered admissions), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019); *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010) (assertions in brief not evidence unless supported by evidence introduced at trial or except as admission against interest); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008) (broad and general statements in brief regarding marketing experience not supported by any evidence and cannot be accorded evidentiary value or consideration); *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007) (no consideration given to reference in brief to third-party registrations not of record); *Schering-Plough HealthCare Products, Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1328 (TTAB 2007) (lack of evidence undercuts contentions in brief); *DC Comics v. Pan American Grain Manufacturing Co.*, 77 USPQ2d 1220, 1224 n.5 (TTAB 2005) (by acknowledging in its brief on the case that a label was provided to opposer by applicant, applicant stipulated to its authenticity and to its admission into the record); *Baseball America, Inc. v. Powerplay Sports, Ltd.*, 71 USPQ2d 1847, 1847 (TTAB 2004) (factual assertions in brief not supported by competent evidence not considered); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1462 n.5 (TTAB 1992) (additional revenue figures provided in trial brief not considered); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1547 n.6 (TTAB 1990) (reliance in brief on unproven statements made in application), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018, 1019 (TTAB 1983); *Abbott Laboratories v. Tac Industries, Inc.*, 217 USPQ 819, 823 (TTAB 1981) (factual statements regarding certain scientific matter which cannot be deemed to be public knowledge not considered); *Hecon Corp. v. Magnetic Video Corp.*, 199 USPQ 502, 507 (TTAB 1978); *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 112 n.3 and 113 (TTAB 1978).

See also In re Teledyne Indus., Inc., 696 F.2d 968, 971, 217 USPQ 9, 11 (Fed. Cir. 1982) (in absence of evidence in the record, mere argument of counsel cannot rebut prima facie case of functionality).

Cf. Martahus v. Video Duplication Services Inc., 3 F.3d 417, 27 USPQ2d 1846, 1849 (Fed. Cir. 1993) (without copies of relevant documentation including relevant portions of application file, not possible to determine validity of opposer's allegations that applicant took inconsistent position in its application).

704.07 Official Records

37 C.F.R. § 2.122(e) ***Printed publications and official records.***

(1) *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant in a particular proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered in accordance with paragraph (g) of this section. The notice of reliance shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.*

(2) *Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided.*

A party that wishes to introduce an official record in evidence in a Board inter partes proceeding may do so, if the official record is competent evidence and relevant to an issue in the proceeding, by filing a notice of reliance thereon during its testimony period. The notice of reliance must specify the official record and the pages to be read; indicate generally the relevance of the material being offered and associate it with one or more issues in the case; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence. [Note 1.]

The term "official records" as used in 37 C.F.R. § 2.122(e)(1) refers not to a party's company business records, but rather to the records of public offices or agencies, or records kept in the performance of duty by a public officer. [Note 2.] These official records are considered self-authenticating, and as such, require no extrinsic evidence of authenticity as a condition to admissibility. [Note 3.] Electronic versions of applications and registrations printed from the USPTO's databases are official records. [Note 4.]

For examples of cases concerning the admissibility of specific documents, by notice of reliance, as "official records" under 37 C.F.R. § 2.122(e)(1), see cases cited in the note below. [Note 5.] For information concerning the admissibility of official records obtained through the Internet, see TBMP § 704.08.

For information concerning establishing the authenticity, under the Federal Rules of Evidence, of an official record, see Fed. R. Evid. 901(a), Fed. R. Evid. 901(b)(7), and Fed. R. Evid. 902(4). The latter rule provides, in effect, that extrinsic evidence of authenticity as a condition precedent to admissibility is not required with respect to a properly certified copy of an official record, and describes the requirements for proper certification. However, a copy of an official record of the USPTO need not be certified to be offered in evidence by notice of reliance. [Note 6.]

In lieu of the actual "official record or a copy thereof," the notice of reliance may be accompanied by an electronically generated document (or a copy thereof) which is the equivalent of the official record, and whose authenticity is established under the Federal Rules of Evidence. [Note 7.] *Cf.*TBMP § 704.08.

Although official records may be made of record by notice of reliance under 37 C.F.R. § 2.122(e), it is not mandatory that they be introduced in this manner. They may, alternatively, be made of record by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties. [Note 8.] These latter two methods may also be used to introduce types of official records that are not admissible by notice of reliance under 37 C.F.R. § 2.122(e). [Note 9.]

For information concerning the raising of objections to notices of reliance and materials filed thereunder, see TBMP § 533 and TBMP § 707.02.

Materials improperly offered under 37 C.F.R. § 2.122(e) may nevertheless be considered by the Board if the adverse party (parties) does not object to their introduction or itself treats the materials as being of record. [Note 10.]

NOTES:

1. *See* 37 C.F.R. § 2.122(e) and 37 C.F.R. § 2.122(g). *See also Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1920 (TTAB 2006) (registration not considered because opposer did not explain in notice of reliance what registration pertained to or why it was submitted); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992) (trademark search reports are not official records); *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 361 n.3 (TTAB 1978) (notice of reliance on official records is untimely when filed after oral hearing), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164, 165 (TTAB 1984) (relevance of third-party registrations sufficiently indicated); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (official records are records prepared by a public officer); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (submission of duplicate copies of third-party registrations with brief was not untimely where the evidence had been timely filed during course of proceeding); *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (untimely notice of reliance on official records filed after expiration of testimony period not considered).

2. *See Christian Faith Fellowship Church v. Adidas AG*, 841 F.3d 986, 120 USPQ2d 1640, 1642-43 (Fed. Cir. 2016) (business record exception applied to personal check with preprinted address); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1929 (TTAB 2009); *Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009) (company invoices not official records); *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.3 (TTAB 2007) (opposer's file copy of documents from Board proceeding, such as applicant's opposition brief to opposer's summary judgment motion, do not constitute official records); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (party's own file copies of documents from a Board proceeding are not official records); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (official records are records prepared by a public officer). *See also* Fed. R. Evid. 902(4).

3. *See Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979).

4. *See Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1352 n.13 (TTAB 2014) (third-party applications printed from USPTO's electronic database admissible under notice of reliance as official records; status and title copies not required), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213,

1217, 1219 (TTAB 2011) (electronic versions of the registrations printed from USPTO databases, showing the URL and date they were printed, are official records); *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1038 (TTAB 2010) (the Office's files are in electronic form and accessible to all via the Internet, and to that extent they are both official records and in general circulation).

5. *Southwestern Management, Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1013 (TTAB 2015) ("Proclamation of Delmonico's Day of Mayor Rudolph Giuliani" found on the wall of party's restaurant at the time the party purchased the business – no; listing of telephone area codes published online by North American Numbering Plan Administration - yes), *aff'd*, 651 F. App'x 917 (Fed. Cir. 2016) (mem.); *Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1108 n.14 (TTAB 2015) (sales history reports – no, however, because non-offering party treated as being of record, Board construed exhibit as having been stipulated into the record by the parties); *United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1046-47 (TTAB 2014) (certificate of incorporation – yes); *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1603 n.2 (TTAB 2010) (corporate annual reports not printed from the Internet – no), *aff'd-in-part, rev'd-in-part and remanded on other grounds*, 668 F.3d 1356, 101 USPQ2d 1713, 1718 (Fed. Cir. 2012) (print versions of annual reports - no); *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1826 (TTAB 2010) (applicant's copies of legal briefs that do not reflect they were received by court -- no), *aff'd on other grounds*, *Creative Arts by Calloway, LLC v. Brooks*, No. 09-cv-10488 (S.D.N.Y. Dec. 27, 2012), *dismissed*, slip op. No. 13-147 (2d Cir. March 7, 2013); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1929 (TTAB 2009) (printouts of abandoned applications obtained from Trademark Status and Document Retrieval (TSDR) database, formerly Trademark Document Retrieval (TDR) database - yes); *UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009) (trademark application file -- yes); *Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (office actions from trademark application and patent application from USPTO files -- yes); *Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009) (United States Postal Service form completed by publisher/mailer of catalogues with "no official markings or signature" -- no); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1485 (TTAB 2007) (copies of registration from USPTO's electronic records -- yes); *Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (annual reports, financial statements, advertising invoices and other advertising documents -- no); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1508 (TTAB 2000) (copy of Board's decision on summary judgment in prior opposition -- yes; purported copy of brief in support of summary judgment motion in prior proceeding which did not reflect that it was received by the Board but appeared to be merely applicant's file copy of the document -- no); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 n.3 (TTAB 1993) (trademark search report -- no); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992) (trademark search reports -- no); *Burns Philip Food Inc. v. Modern Products Inc.*, 24 USPQ2d 1157, 1159 n.3 (TTAB 1992) (trademark search report -- no; third-party registrations -- yes), *aff'd*, 1 F.3d 1252, 28 USPQ2d 1687 (Fed. Cir. 1993); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.5 (TTAB 1985) (copy of cancellation proceeding file -- yes; party's file copies of documents filed in the USPTO -- no); *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 332 n.3 (TTAB 1985) (letters between counsel for parties, and list of party's licensees -- no); *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164, 165 (TTAB 1984) (third-party registrations -- yes); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (portions of an agreement between applicant and a third party, press release, list of foreign trademark registrations, and a shipping document for applicant's product -- no); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (copy of letter from Amtrak to applicant congratulating applicant for having an appointment as an Amtrak agent, copy of a "Passenger Sales Agency Agreement" between the International Air Transport Association and applicant, etc. -- no); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (brochures and other promotional literature -- no); *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (certified copies of corporate records maintained by Secretary of State of Missouri -- yes); *Hovnanian Enterprises, Inc. v. Covered Bridge Estates, Inc.*, 195 USPQ 658, 663

n.3 and 664 (TTAB 1977) (plat plan, deed of realty, and confirmatory assignment -- not admissible by notice of reliance as official record because not properly authenticated); *Quaker Oats Co. v. Acme Feed Mills, Inc.*, 192 USPQ 653, 654 n.9 (TTAB 1976) (third-party registrations -- yes); *Harzfeld's, Inc. v. Joseph M. Feldman, Inc.*, 184 USPQ 692, 693 n.4 (TTAB 1974) (file history of party's registration -- yes); *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467, 468 n.3 (TTAB 1973) (drawings from federal trademark applications -- yes); *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123, 125 (TTAB 1971) (certificate of good standing from a United States district court -- yes).

6. *See* 37 C.F.R. § 2.122(e).

7. *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992).

8. *See Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984); *Hayes Microcomputer Products, Inc. v. Business Computer Corp.*, 219 USPQ 634, 637 n.3 (TTAB 1983); *Regent Standard Forms, Inc. v. Textron Inc.*, 172 USPQ 379, 380-81 (TTAB 1971).

9. *Cf. Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (since adverse party did not object to notice of reliance on annual reports, treated as stipulated into the record), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (an agreement between applicant and a third party, press releases, and a shipping document, although not acceptable for a notice of reliance, may be introduced in connection with competent testimony); *Minnesota Mining & Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433, 434 (TTAB 1973) (while annual reports and booklets and brochures do not constitute printed publications and are therefore not appropriate for introduction by notice of reliance, they may be introduced in connection with testimony of someone who is familiar with them and can explain the nature and use of such materials).

10. *See, e.g., U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307, 1309 n.4 (TTAB 1990) (improper subject matter but adverse party expressly agreed to its authenticity and accuracy); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (neither party objected to the notice of reliance on annual reports by the other); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (improper subject matter and improper rebuttal considered where no objection was raised); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n.3 and 4 (TTAB 1984) (improper subject matter deemed stipulated into record where no objection was raised); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (improper subject matter deemed stipulated into record where adverse party did not object and specifically referred to the matter in its brief); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (untimely notice of reliance filed prior to testimony period considered where no objection was raised and error was not prejudicial). *Cf. Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (improper subject matter excluded where although there was no objection, no agreement could be inferred) and *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (improper subject matter excluded, although adverse party did not object to the material).

704.08 Printed Publications

37 C.F.R. § 2.122(e) ***Printed publications and official records.***

(1) *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant in a particular proceeding, and official records, if the publication or official record is competent evidence and*

relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered in accordance with paragraph (g) of this section. The notice of reliance shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

(2) *Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided.*

704.08(a) Traditional Printed Publications

Certain types of printed publications may be introduced into evidence in a Board inter partes proceeding by notice of reliance. Specifically, printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, if the publication is competent evidence and relevant to an issue in the proceeding, may be introduced in evidence by filing a notice of reliance thereon during the testimony period of the offering party. [Note 1.] The notice must specify the printed publication, including information sufficient to identify the source and the date of the publication, and the pages to be read; indicate generally the relevance of the material being offered and associate it with one or more issues in the case; and be accompanied by the printed publication or a copy of the relevant portion thereof. [Note 2.]

In lieu of the actual "printed publication or a copy of the relevant portion thereof," the notice of reliance may be accompanied by an electronically generated document which is the equivalent of the printed publication or relevant portion, as, for example, by a printout from the LexisNexis or Westlaw computerized library of an article published in a newspaper or magazine of general circulation. [Note 3.]

In case of reasonable doubt as to whether printed publications submitted by notice of reliance under 37 C.F.R. § 2.122(e) are "available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue" in the proceeding, the burden of showing that they are so available lies with the offering party. [Note 4.] The offering party need only make such a showing if its adversary has challenged its submission; it need not make such a showing as part of its original submission.

For examples of cases concerning the admissibility of specific materials, by notice of reliance, as "printed publications" under 37 C.F.R. § 2.122(e), see cases cited in the note below. [Note 5.]

Printed publications made of record by notice of reliance under 37 C.F.R. § 2.122(e) are admissible and probative only for what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters. [Note 6.] While printed publications made of record by notice of reliance and without witness testimony cannot be considered for proving the truth of the matter, they may have some relevance for what they show on their face, regardless of whether the statements are true or false. [Note 7.]

Although the types of printed publications described above may be made of record by notice of reliance under 37 C.F.R. § 2.122(e), they may, alternatively, be made of record by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties. [Note 8.] These latter two methods

may also be used for the introduction of printed publications that are not admissible by notice of reliance under 37 C.F.R. § 2.122(e). [Note 9.]

For information concerning the raising of objections to notices of reliance and materials filed thereunder, see TBMP § 533 and TBMP § 707.02.

Materials improperly offered under 37 C.F.R. § 2.122(e) may nevertheless be considered by the Board if the adverse party (parties) does not object to their introduction or itself treats the materials as being of record. [Note 10.]

The party who submits printed publications must ensure that the evidence is legible, with each page displayed so it can be read from top to bottom, and that the evidence has been entered into the record. [Note 11.] The submitting party must also ensure that such evidence is complete. [Note 12.]

NOTES:

1. 37 C.F.R. § 2.122(e) and 37 C.F.R. § 2.122(g) . *See Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (while subject matter may be of interest to the general public such materials are not necessarily in general circulation); *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164, 165 n.5 (TTAB 1984) (objection that applicant failed to indicate relevance of materials overruled); *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 361 n.3 (TTAB 1978) (notice of reliance on printed material filed after oral hearing untimely), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (duplicates of printed publications submitted with brief which had been properly filed by notice of reliance during testimony period considered); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (rule provides safeguard that party against whom evidence is offered is readily able to corroborate or refute authenticity of what is proffered); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n.10 (TTAB 1976) (plaintiff's catalogs and house publications not considered because it was not shown they are "available to the general public in libraries or in general circulation;" advertisements permitted if publication in which they appeared and dates are provided to allow party to verify authenticity); *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467, 468 n.3 (TTAB 1973) (publication shown to be available in public library properly submitted under 37 C.F.R. § 2.122(e), even though it may constitute hearsay or be of dubious relevance).

2. *See* 37 C.F.R. § 2.122(e) and 37 C.F.R. § 2.122(g). *See also Panda Travel Inc. v. Resort Option Enterprises Inc.*, 94 USPQ2d 1789, 1793 (TTAB 2009) (statement that documents are introduced to show use of opposer's marks sufficient to indicate relevance); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1857 (TTAB 2007) (article from a trade magazine is admissible under 37 C.F.R. § 2.122(e) because "[o]n its face, it identifies the publication and the date published"); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1813 (TTAB 2005) (general statement of relevance sufficient for a collection of materials), *rev'd on other grounds*, slip op. No. 05-2037 (D.D.C. Apr. 3, 2008); *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1721 n.50 (TTAB 1999) (excerpts that were unidentified as to either source or date were not considered, as the extent to which such material is genuine and available to the public could not be ascertained), *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); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998) (finding it sufficient that copies of the excerpted articles contained notations either on the copies themselves or in the notice of reliance as to the source and date of the copied articles, but noting that a proffered excerpt from a newspaper or periodical is lacking in foundation and, thus, is not admissible as evidence to the extent that it is an incomplete or illegible copy, is unintelligible because it is in a language other than English, or is not

fully identified as to the name and date of the published source); *Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (printed advertisement not identified with the specificity required to be considered a printed publication); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (notice of reliance received without appended copy of printed publication).

3. *See Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1166 (TTAB 2017) (citing *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013) (Board "routinely accepts printouts of articles obtained from the LexisNexis database, when filed under notice of reliance, so long as the date and source of each article are clear.")), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *International Association of Fire Chiefs, Inc. v. H. Marvin Ginn Corp.*, 225 USPQ 940, 942 n.6 (TTAB 1985) (NEXIS printout of excerpted stories published in newspapers, magazines, etc. are admissible because excerpts identify their dates of publication and sources and since complete reports, whether through the same electronic library or at a public library, are available for verification), *rev'd on other grounds*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

Cf. In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (electronic excerpts are not hearsay because articles were not used to support the truth of the statements therein but to show descriptive usage of term); *R. J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 USPQ 169, 174-75 (TTAB 1985) (printouts from databases which themselves comprise abstracts or syntheses of published documents unlike the actual text of the documents, are hearsay as to the context of a term).

4. *See Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1217-1218 (TTAB 2011) ("Certainly if these materials are in general circulation it was incumbent on plaintiff to show this in response to defendant's objection."); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (private promotional literature is not presumed to be publicly available within the meaning of the rule).

5. *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1165 (TTAB 2017) (financial reports generally no, but financial report included as a segment of a newswire service report from Lexis/Nexis database - yes, if date and source of each article is clear; press releases - no); *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1506 n.185 (TTAB 2017) (articles now available only through subscription to The New York Times archives – yes), *appeal dismissed per stipulation*, No. 17-00345 (E.D. Va. August 24, 2017); *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1466 (TTAB 2013) (magazine article explaining the results of a consumer brand awareness survey – yes), *aff'd*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1929 (TTAB 2009) (annual reports - no; opposer's file copies of financial reports submitted to SEC - no); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009) (foreign publications without a showing that publications are in general circulation in the United States - no; Spanish language publication shown to be in general circulation in the United States - yes; press clippings - no; distribution of in-house publications/catalogs and auction catalogs to retailers, trade shows, guitar clinics and individuals upon request does not constitute "general circulation"); *Hiraga v. Arena*, 90 USPQ2d 1102, 1104 (TTAB 2009) (invoices and annual catalog - no); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1956-59 (TTAB 2008) (brochures, periodic newsletters, materials used in seminars and conferences showing topics of discussion, recently created marketing materials, materials used in radio ads and interviews, testimonials from customers in affidavit form - no); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886, n.6 (TTAB 2008) (letters and emails - no); *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1914 (TTAB 2007) (excerpt from wine atlas - yes; certificate awarded to defendant from Italian government - no; copy of disciplinary rules governing wine production in geographic area - no); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (annual reports,

financial statements, advertising invoices and other advertising documents - no); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1500 (TTAB 2005) (opposer's newsletters and brochures - no); *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1722 n.54 (TTAB 1999) (advertisements in newspapers or magazines available to the general public in libraries or in general circulation - yes), *rev'd*, 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); *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1403 (TTAB 1998) (press releases, press clippings, studies prepared for a party, affidavits or declarations, or product information - no); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 n.5 (TTAB 1992) (trademark search reports - no); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (annual reports - no); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (conference papers, dissertations, and journal papers - no); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (press releases-- no); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n.4 (TTAB 1984) (annual reports - no); *Logicon, Inc. v. Logisticon, Inc.*, 205 USPQ 767, 768 n.6 (TTAB 1980) (annual report even if in some libraries, or available on request - no; magazine articles - yes); *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (promotional literature - no); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (promotional literature - no); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n.10 (TTAB 1976) (catalogs and other house publications - no); *Andrea Radio Corp. v. Premium Import Co.*, 191 USPQ 232, 234 (TTAB 1976) (annual reports, promotional brochures, price list, reprints of advertisements, and copies of advertising mats - no); *Manpower, Inc. v. Manpower Information Inc.*, 190 USPQ 18, 21 (TTAB 1976) (telephone directory pages, indexes from United States Code Annotated, and dictionary pages - yes); *Litton Industries, Inc. v. Litronix, Inc.*, 188 USPQ 407, 408 n.5 (TTAB 1975) (annual reports - no); *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443, 445 (TTAB 1974) (credit card applications, handouts, and flyers - no; articles from trade publications and other magazines - yes); *Minnesota Mining & Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433, 434 (TTAB 1973) (annual reports, product booklets, and product brochures - no); *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429, 430 n.2 (TTAB 1973) (article from "Memoirs of the University of California" - no, since publication not shown to be available to the general public).

6. *See, e.g., In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (articles are not used to support the truth of the statements therein but to show descriptive usage of term); *Gravel Cologne, Inc. v. Lawrence Palmer, Inc.*, 469 F.2d 1397, 176 USPQ 123, 123 (CCPA 1972) (advertisement from newspaper only showed promotion of the product on the day the publication issued); *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *2 (TTAB 2019) (unaccompanied by testimony, articles from printed publications may not be considered for the truth of the matters asserted but are admissible for what they show on their face); *Schiedmayer Celesta GmbH v. Piano Factory Group, Inc.*, 2019 USPQ2d 341894, at *8 n.14 (TTAB 2019) (printed publications not admissible for the truth of the matters asserted therein), *appeal filed*, No. 20-1196 (Fed. Cir. Dec. 3, 2019); *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790-91 (TTAB 2018) (newspaper articles and blog post submitted with no supporting testimony or other evidence are hearsay; "residual hearsay" exception of Fed. R. Evid. 807(a) does not apply); *Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1399 n.65 (TTAB 2016) (telephone directory listings themselves are not hearsay; while the Yellow Pages display advertisements may not be considered for the truth of the matters asserted therein, they do show on their face that the public may have been exposed to the advertisements); *City Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1672 (TTAB 2013) (testimony failed to expand the probative value of business brochure prepared by third-party; document is admissible solely for what it shows on its face and cannot be considered to prove the truth of any matter stated therein); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1734 n.8 (TTAB 2012) (noting that printed publications submitted in

a foreign language without translations are of limited probative value); *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2010) (truth of matters asserted in printed publications not considered; printed publications considered as showing continued consumer exposure of opposer's mark in connection with opposer's name), *aff'd on other grounds* , *Creative Arts by Calloway, LLC v. Brooks*, No. 09-cv-10488 (S.D.N.Y. Dec. 27, 2012), *dismissed*, slip op. No. 13-147 (2d Cir. March 7, 2013); *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1037 n.14 (TTAB 2010); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 n.7 (TTAB 2009) (printed publications probative only for what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters); *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008) (newspaper article probative only for what it shows on its face, not for the truth of the matters contained therein); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (annual report considered stipulated into evidence only for what it showed on its face), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1721 n.50 (TTAB 1999) (evidence of the manner in which the term is used in the articles and of the fact that the public has been exposed to the articles and may be aware of the information contained therein), *rev'd*, 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); *Logicon, Inc. v. Logisticon, Inc.*, 205 USPQ 767, 768 n.6 (TTAB 1980) (magazine article limited to what it showed on its face); *Volkswagenwerk AG v. Ridewell Corp.*, 201 USPQ 410 (TTAB 1979) (advertisement submitted with notice of reliance only showed that advertisement appeared on that date in that journal and does not show customer familiarity with marks nor actual sales); *Food Producers, Inc. v. Swift & Co.*, 194 USPQ 299, 301 n.2 (TTAB 1977) (publications limited to their face value because no opportunity to ascertain basis for information or confront and cross-examine individuals responsible therefor); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n.10 (TTAB 1976) (advertisements were only probative of fact that opposer advertised its goods under the mark in the publications on those dates); *Litton Industries, Inc. v. Litronix, Inc.*, 188 USPQ 407, 408 n.5 (TTAB 1975) (even if annual reports were admissible as printed publications, they would only be probative of fact that they are opposer's annual reports for the years shown thereon); *Otis Elevator Co. v. Echlin Manufacturing Co.*, 187 USPQ 310, 312 n.4 (TTAB 1975) (magazine article showed only that the goods under the mark were the subject of the article in that publication); *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443, 445 (TTAB 1974) (articles from trade publications admissible to show that they appeared in the publication on a certain date and that they contained certain information, but not that the information is true).

7. *Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *2, *11 (TTAB 2020) ("[S]uch materials are frequently competent to show, on their face, matters relevant to trademark claims (such as public perception), regardless of whether the statements are true or false"; third-party documentary evidence corroborates pervasive use by others in the industry) (quoting *Harry Winston S.A. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1428 (TTAB 2014)); *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *2 (TTAB 2019) ("sometimes what Internet printouts and printed publications show on their face is relevant to trademark cases, including likelihood of confusion cases"); *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *6-7 (TTAB 2019) (third-party references are probative evidence that the relevant public perceives the terms "grabba" and "grabba leaf" to, at a minimum, immediately convey information about an ingredient or characteristic of tobacco, or tobacco products, including cigar wraps; urban dictionary definition probative when considered in context of third-party use in record), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019); *Ayoub, Inc. v. ACS Ayoub Carpet Service*, 118 USPQ2d 1392, 1399 n.62, 1403 (TTAB 2016) (although website printouts and printed materials could not be considered for the truth of the matter, these multiple sources did corroborate third-party use); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1427-28 (TTAB 2014) (although printed publications were not considered for the truth

of the matter, "such publications can be used to demonstrate promotion of the mark by its owner, public perceptions of the mark by others, and other issues relevant to this proceeding.").

8. *See Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 846 (TTAB 1984) (objection on ground that no notice of reliance was filed was not well taken where party had introduced the materials in connection with testimony); *Hayes Microcomputer Products, Inc. v. Business Computer Corp.*, 219 USPQ 634, 635 n.3 (TTAB 1983) (same).

9. *See, e.g., Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (annual reports), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (copies of agreements, press releases, shipping documents and foreign registrations); *Minnesota Mining & Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433, 434 (TTAB 1973) (annual reports, product booklets and brochures).

10. *See, e.g., Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1108 n.14 (TTAB 2015) (because non-offering party treated sales history reports as being of record, Board construed exhibit as having been stipulated into the record by the parties); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886 n.6 (TTAB 2008) (letters and emails considered as stipulated into the record because opposer treated materials as being of record, setting forth in its brief that such materials are part of the evidence of record); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1485 (TTAB 2007) (Internet evidence considered because party stipulated at deposition that it would not contest the authenticity of web pages and treated the evidence as being of record, stating in its brief that the Internet evidence is part of other party's evidence of record); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1266 (TTAB 2003) (documents construed as being offered under 37 C.F.R. § 2.122(e) and deemed to be of record despite lack of information as to source and date since applicant did not object to the materials and moreover treated them as of record; however, probative value of such materials necessarily limited due to lack of information as to source and date); *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 n.3 (TTAB 1999) (plaintiff did not object to introduction of curriculum vitae, advertising literature, printout of page from website by notice of reliance and treated materials as of record); *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307, 1309 n.4 (TTAB 1990) (opposer's improper subject matter considered where applicant expressly agreed to its authenticity and accuracy); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (neither party objected to the annual reports submitted by the other party), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (matter improper for notice of reliance and for rebuttal considered); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58 (TTAB 1984) (annual reports and responses to document production request considered); *Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (various documents constituting improper subject matter considered where no objection was raised and adverse party specifically addressed the materials in its brief); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (untimely, but no objection or prejudice).

Cf. Original Appalachian Artworks Inc. v. Streeter, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (improper subject matter excluded where adverse party, while not objecting to the improperly offered materials, did not treat the materials as being of record); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (improper subject matter excluded, although no objection).

11. 37 C.F.R. § 2.126(a)(2); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("The Office is adding new § 2.126(a)(2) to require that exhibits pertaining to an electronic submission must be made electronically as an attachment

to the submission and must be clear and legible. The amendment codifies the use of electronic filing.”). *See, e.g., RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1806 n.16 (TTAB 2018) (“Illegible evidence is given no consideration.”), *aff’d*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff’d*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021). *See also Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013) (citing *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) (“It is reasonable to assume that it is opposer’s responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible … .”)), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351-52 (TTAB 2014) (duty of the party making submissions to the Board via ESTTA to ensure that they have been entered into the trial record), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014).

12. *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1506 n.185 (TTAB 2017) (opposer failed to introduce full copies of the articles into evidence in its rebuttal notice of reliance so Board relied on copies submitted with applicant’s notices of reliance), *appeal dismissed per stipulation*, No. 17-00345 (E.D. Va. August 24, 2017).

704.08(b) Internet Materials

37 C.F.R. § 2.122(e) ***Printed publications and official records.***

(2) *Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided.*

In *Safer, Inc. v. OMS Investments, Inc.* , 94 USPQ2d 1031 (TTAB 2010) (“*Safer* ”), the Board changed its practice regarding Internet evidence, holding that if a document obtained from the Internet identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL), it may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation in accordance with 37 C.F.R. § 2.122(e). [Note 1.] Effective January 14, 2017, the Board amended 37 C.F.R. § 2.122(e) to add a new subsection (2) to codify the Board’s decision in *Safer*. [Note 2.] Providing only a web address or a hyperlink without the material attached is not sufficient to introduce it into the record. [Note 3.] For information about Internet materials in ex parte appeals, see TBMP § 1208.03.

A document obtained from the Internet must be publicly available; that is, it must identify its date of publication or the date it was accessed and printed, and its source (URL) either on its face or on the notice of reliance cover sheet. [Note 4.] As with traditional printed publications submitted by notice of reliance, the propounding party must indicate in the notice of reliance generally the relevance of those materials and associate the materials with one or more issues in the case. [Note 5.] *See*TBMP § 704.02 and TBMP § 704.08(a).

Internet documents that may be introduced by notice of reliance include websites, advertising, business publications, annual reports, and studies or reports prepared for or by a party or non-party, as long as they can be obtained through the Internet as publicly available documents. This expands the types of documents that can be introduced by notice of reliance beyond printed publications in general circulation, and means that some Internet documents, such as annual reports that are publicly available, can be made of record by notice of reliance when paper versions of the annual reports are not acceptable as printed publications.

The probative value of Internet documents is limited. They can be used to demonstrate what the documents show on their face. However, documents obtained through the Internet may not be used to demonstrate the

truth of what has been printed. [Note 6.] A printout from a webpage may have more limitations on its probative value than traditional printed publications. A party may increase the weight the Board will give website evidence by submitting testimony and proof of the extent to which a particular website has been viewed. [Note 7.] Otherwise, the document may not be considered to have much probative value. [Note 8.]

The nonoffering party may verify the Internet document through the date and source information on the face of the document, and may rebut the probative value of the document by showing that there has been a significant change to the document as submitted by the offering party. Due to the transitory nature of the Internet, the party proffering information obtained from the Internet runs the risk that the website owner may change the information contained therein.

Internet search summaries are not admissible by notice of reliance. [Note 9.]

The Board strongly discourages the submission of cumulative evidence. *See*TBMP § 702.05. The Board has specifically stated that "It is not necessary for the parties to introduce every document obtained from an Internet search especially when it includes duplicative and irrelevant materials." [Note 10.] Internet documents may be objectionable under Fed. R. Evid. 403 on the ground that they are "needlessly presenting cumulative evidence."

Internet printouts that are otherwise properly authenticated are acceptable to show that the statements contained therein were made or that information was reported, but not to prove the truth of the statements contained therein. [Note 11.] Internet printouts, may have some relevance for what they show on their face, regardless of whether the statements are true or false. [Note 12.]

For Internet printouts from the Internet Archive Wayback Machine, the degree of authentication required depends on what the party offering the evidence seeks to establish. If a party seeks to rely on Wayback Machine printouts only to demonstrate what the webpages show on their face, they generally can be admissible under a notice of reliance as self-authenticating Internet evidence if the webpages display a URL and date. [Note 13.] If a party wishes to rely on the Wayback Machine evidence not just for what it shows on its face but to establish that the webpages submitted were displayed on various dates in the past, ("the truth of the capture of the archive date"), witness testimony must be offered to authenticate the printouts and lay the foundation that the webpage printouts are business records. [Note 14.] If a party wishes to go further and rely on the pages for the truth of the underlying webpage contents, which would constitute hearsay, competent witness testimony as to their accuracy may be required. [Note 15.] The authenticity and accuracy of the Wayback Machine captures can be further corroborated by witnesses familiar with the webpages themselves. [Note 16.]

The party who submits Internet materials must ensure that the evidence is legible, and that the evidence has been entered into the record. [Note 17.] The submitting party may submit only the relevant portions of a website so long as the portions are sufficient to show their context. [Note 18.]

NOTES:

1. *See, e.g., Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013) (objection to Internet printouts from petitioner's website showing the dates accessed and printed and URL information on the grounds that petitioner failed to authenticate the documents by testimony overruled), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1604 n.4 (TTAB 2010) (excerpts from websites promoting the sale of books and software admitted into evidence pursuant to notice of reliance), *aff'd-in-part, rev'd-in-part and remanded on other grounds*, 668 F.3d 1356, 101 USPQ2d 1713, 1718 (Fed. Cir. 2012); *Calypso Technology Inc. v. Calypso Capital*

Management LP, 100 USPQ2d 1213, 1216-19 (TTAB 2011) (detailed discussion of why certain documents, accompanied by adequate authentication, were admissible and why certain other documents, lacking in specifically-addressed authentication elements, were not admissible); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071 (TTAB 2011) (documents obtained from Internet admitted even though witness did not personally obtain or download documents).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016). *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010) overruled the Board's holding in *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998), that Internet materials are not self-authenticating and are treated differently from articles taken from the LexisNexis database with respect to whether they may be submitted as official records.

3. *See International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *7-8 (TTAB 2020) (nonconforming evidence consisting of Internet materials bearing web addresses without a copy of the corresponding web pages not considered by the Board), *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020); *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790 n.14 (TTAB 2018) (providing an Internet link to an article is insufficient to make the article of record because the information displayed at a link's Internet address is impermanent; article is of record only because it was submitted as an exhibit to a declaration. "The Board does not accept Internet links as a substitute for submission of a copy of the resulting page.").

4. 37 C.F.R. § 2.122(e)(2). *See STX Financing, LLC v. Terraza*, 2020 USPQ2d 10989, at *4 (TTAB 2020) (motion to strike exhibit consisting of Internet materials denied where date of access or publication of the Internet materials was not displayed on the face of the Internet materials themselves but was clearly provided in the notice of reliance); *United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1046-47 (TTAB 2014) (Internet printouts personal to applicant such as invoices and account information not admissible through notice of reliance even if show URLs and dates printed; press releases posted on Internet have become publicly available, thus admissible under notice of reliance); *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014) (notice of reliance failed to specify the relevance of the voluminous web pages submitted under two exhibits; defect is curable); *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013) (objection to Internet printouts from petitioner's website showing the dates accessed and printed and URL information on the grounds that petitioner failed to authenticate the documents by testimony overruled), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (web pages inadmissible for lack of URL and date accessed); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1216-19 (TTAB 2011) (detailed discussion of why certain documents, accompanied by adequate authentication, were admissible and why certain other documents, lacking in specifically-addressed authentication elements, including absent URL's or dates accessed printed, were not admissible); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1025 (TTAB 2011) (applicant did not indicate the general relevance of opposer's archival website and such relevance is not clear on the face of the submissions, but applicant may rely on copy of opposer's website made of record by opposer).

5. 37 C.F.R. § 2.122(g). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("The Office is adding new § 2.122(g) detailing the requirements for admission of evidence by notice of reliance. Section 2.122(g) provides that a notice must indicate generally the relevance of the evidence offered and associate it with one or more issues in the proceeding, but failure to do so with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order. The amendment codifies current case law and Office practice."). *See Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1164

(TTAB 2017) (Board applied Trademark Rule 2.122(g) in determining whether descriptions of relevance set forth in the notices of reliance were sufficient).

6. Fed. R. Civ. P. 802. *See, e.g.*, *Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *2 (TTAB 2020) (Internet printouts and other materials properly introduced under a notice of reliance without supporting testimony considered only for what they show on their face rather than for the truth of the matters asserted); *Milwaukee Electric Tool Corp. v. Freud America, Inc.*, 2019 USPQ2d 460354, at *4 (TTAB 2019) (same for website, Internet printouts and other materials), *complaint filed*, No. 20-cv-109 (M.D.N.C. Feb. 3, 2020); *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *2 (TTAB 2019) (unaccompanied by testimony, articles from the Internet may not be considered for the truth of the matters asserted but are admissible for what they show on their face); *Optimal Chemical Inc. v. Srills LLC*, 2019 USPQ2d 338409, at.*2 n.13 (TTAB 2019) (website printouts are hearsay and admissible under notice of reliance for what they show on their face but may not be relied upon for the truth of the matters asserted unless supported by testimony or other evidence); *Schiedmayer Celesta GmbH v. Piano Factory Group, Inc.*, 2019 USPQ2d 341894, at *3, *9 nn. 8, 15 (TTAB 2019) (Internet evidence relied on for "what these sources state, rather than the truth of what they state"; Internet reference works considered for what they show on their face, specifically that certain searches and materials point to Ms. Schiedmayer's family and its businesses and their musical instruments), *appeal filed*, No. 20-1196 (Fed. Cir. Dec. 3, 2019); *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790-91 (TTAB 2018) (newspaper articles and blog post submitted with no supporting testimony or other evidence are hearsay; "residual hearsay" exception of Fed. R. Evid. 807(a) does not apply); *WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1038 and 1040-41 (TTAB 2018) (printouts from websites downloaded from the Internet are admissible under notice of reliance for what they show on their face, but absent testimony from a competent witness, the matters asserted therein are hearsay and thus not probative of the truth of what has been printed); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1467 n.30 (TTAB 2014) (Internet webpage evidence admissible only to show what has been printed and not for the truth of what has been printed).

7. *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *3 (TTAB 2019) (no evidence introduced to show that United States consumers visited website) (citing *In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1424 (TTAB 2010)); *Baroness Small Estates, Inc. v. American Wine Trade, Inc.*, 104 USPQ2d 1224, 1228 (TTAB 2012) (noting that there was no evidence in the record as to the public exposure to the website pages submitted as evidence in genericness claim) (citing *In re Country Music Association Inc.*, 100 USPQ2d 1824, 1830 (TTAB 2011)).

8. *See, e.g.*, *International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *7 (TTAB 2020) ("Reference materials from foreign sources pertaining to cheese, even if in English, have limited probative value on the question of genericness because they do not reflect usage, or exposure to consumers, of the term GRUYERE in the United States."), *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020); *Optimal Chemical Inc. v. Srills LLC*, 2019 USPQ2d 338409, at *2 n.13 (TTAB 2019) (website printouts are hearsay and admissible under notice of reliance for what they show on their face but may not be relied upon for the truth of the matters asserted unless supported by testimony or other evidence); *WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1038 and 1040-41 (TTAB 2018) (same).

9. *See Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (search summary inadmissible because it merely offers links to information not otherwise of record); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1219 (TTAB 2011). *Cf. Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 124 USPQ2d 1184, 1193 (TTAB 2017) (Google results "are not very probative" because they "are very truncated and do not provide us with sufficient information upon

which to make a clear finding."), *appeal dismissed without prejudice sub nom. Snyder's-Lance, Inc. v. Frito-Lay North America, Inc.*, 414 F. Supp. 3d 822, 2019 USPQ2d 401574 (W.D.N.C. 2019), *reversed and remanded on other grounds*, 991 F.3d 512 (4th Cir. 2021); *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013) (results from search engine introduced by testimony admissible but of limited probative value because they lack sufficient context), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Miller v. Miller*, 105 USPQ2d 1615, 1617-18 (TTAB 2013) (search results summary introduced by testimony have probative weight to the extent the results include sufficient information surrounding the term searched to show context, that Miller is a surname, and have been supplemented by other testimony).

10. *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1040 n.19 (TTAB 2010). *See also Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013) (relevant, representative sample of articles obtained from Internet database sufficient and preferred; parties discouraged from submitting all results), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.).

11. *See, e.g., Schiedmayer Celesta GmbH v. Piano Factory Group, Inc.*, 2019 USPQ2d 341894, at *3, *9 nn. 8, 15 (TTAB 2019) (Internet evidence relied on for "what these sources state, rather than the truth of what they state"; Internet reference works considered for what they show on their face, specifically that certain searches and materials point to Ms. Schiedmayer's family and its businesses and their musical instruments), *appeal filed*, No. 20-1196 (Fed. Cir. Dec. 3, 2019); *Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1399 n.62 (TTAB 2016) (statements made on website constitute hearsay and cannot be used to establish prior use); *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013) (search engine results are only probative of what they show on their face, not for the truth of the matters contained therein), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1735 (TTAB 2012) (Internet printouts submitted as exhibits to testimony are not hearsay). *Cf. Optimal Chemical Inc. v. Srills LLC*, 2019 USPQ2d 338409, at *14 n.90 (TTAB 2019) (although respondent did not offer testimony in connection with certain Internet evidence, Board considered this evidence for the truth of the matters asserted where the petitioner did not object and opined on its accuracy in its rebuttal testimony and rebuttal brief); *WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1038 (TTAB 2018) (although printouts from Internet websites constitute hearsay, to the extent nonoffering party has accepted as fact any portion of this evidence, Board deems the evidence stipulated into the record for the truth of any matters asserted therein).

12. *Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *2, *11 (TTAB 2020) ("[S]uch materials are frequently competent to show, on their face, matters relevant to trademark claims (such as public perception), regardless of whether the statements are true or false"; third-party documentary evidence corroborates pervasive use by others in the industry) (*quotingHarry Winston S.A. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1428 (TTAB 2014)); *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *2 (TTAB 2019) ("sometimes what Internet printouts and printed publications show on their face is relevant to trademark cases, including likelihood of confusion cases"); *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *6, *7 (TTAB 2019) (third-party references are probative evidence that the relevant public perceives the terms "grabba" and "grabba leaf" to, at a minimum, immediately convey information about an ingredient or characteristic of tobacco, or tobacco products, including cigar wraps; urban dictionary definition probative when considered in context of third-party use), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019); *Ayoub, Inc. v. ACS Ayoub Carpet Service*, 118 USPQ2d 1392, 1399 n.62, 1403 (TTAB 2016) (although website printouts and printed materials could not be considered for their truth of the matter, multiple sources did corroborate third-party use).

13. *Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *3 (TTAB 2020).

14. *Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *3-4 (TTAB 2020) (witness testimony authenticated printouts and laid foundation to support intended evidentiary use).

15. *Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *4 (TTAB 2020) (testimony established that printouts qualify under the business records exception; webpages were not offered to prove the truth of the matter asserted).

16. *Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *4, *9, *11 (TTAB 2020) (other witnesses provided corroborating testimony to support authenticity and accuracy of webpage captures as of the date in question).

17. 37 C.F.R. § 2.126(a)(2); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("The Office is adding new § 2.126(a)(2) to require that exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible. The amendment codifies the use of electronic filing."). *See, e.g., RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1806 n.16 (TTAB 2018) ("Illegible evidence is given no consideration."), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013) (citing *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) ("It is reasonable to assume that it is opposer's responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible … .")), *aff'd mem.*, 565 F. App'x 900 (Fed. Cir. 2014); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351-52 (TTAB 2014) (duty of the party making submissions to the Board via ESTTA to ensure that they have been entered into the trial record), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014).

18. *See STX Financing, LLC v. Terraza*, 2020 USPQ2d 10989, at *4 (TTAB 2020) (motion to strike exhibits to notice of reliance on the ground that the offering party did not submit complete copies of the websites, but only screenshots of portions of the websites, denied).

704.08(c) Other Printed Materials

Certain printed publications qualify for submission by notice of reliance under 37 C.F.R. § 2.122(e) because they are considered essentially self-authenticating. [Note 1.] That is, permanent sources for the publications are identified and the nonoffering party is readily able to verify the authenticity of the documents. [Note 2.] The Board also deems a document obtained from the Internet that displays a date and its source as presumptively true and genuine. [Note 3.] Materials that do not fall within 37 C.F.R. § 2.122(e), that is, materials that are not admissible by notice of reliance, may nevertheless be introduced into evidence through the testimony of a person who can clearly and properly authenticate and identify the materials, including identifying the nature, source and date of the materials. [Note 4.] Trade inscriptions applied to a product or packaging or other materials affixed in the course of business may be self-authenticating. [Note 5.] Even if properly made of record, however, such materials are only probative of what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters. [Note 6.]

NOTES:

1. *See Swatch AG v. M. Z. Berger & Co.*, 108 USPQ2d 1463, 1466 (TTAB 2013) (applicant's objection to article from the magazine *Women's Wear Daily* overruled; periodicals are considered self-authenticating pursuant to Fed. R. Evid. 902(6) and may be admitted via notice of reliance), *aff'd*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1857 (TTAB 2007); *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1722 (TTAB 1999), *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).

2. *See Weyerhaeuser v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992).

3. 37 C.F.R. § 2.122(e). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963-64 (October 7, 2016) ("The Office is adding new § 2.122(e)(2) permitting admission of internet materials into evidence by notice of reliance and providing requirements for their identification. The amendment codifies current case law and Office practice."), and *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010).

4. *See Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741, 1748 (TTAB 2006) (excerpts taken from Internet websites sought to be introduced during testimony deposition not properly authenticated because witness was not aware of the parameters of the Internet search and was not able to name the individual who conducted the Internet search).

5. *See* Fed. R. Evid. 902(7); *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1167-68 (TTAB 2011) (although deponent failed to authenticate exhibits made up of product packaging, they were found to be self-authenticating).

6. *See ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 (TTAB 2012) (hangtag by itself, without any testimony describing how it was used, merely demonstrates that the hangtag existed at some point in time; not that the mark was actually placed on goods or that goods bearing the hangtag were offered for sale in commerce); *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1168 (TTAB 2011) (trade designations on materials of limited probative value because they do not establish they were actually used in commerce or the degree of consumer exposure); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1217, 1220-21 n.14 (TTAB 2011) (plaintiff's own printed publications and printouts from plaintiff's webpage are not evidence of statements made therein); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009) (articles and advertisements considered for whatever they may show on their face, but not for the truth of the matters asserted); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1884 n.8 (TTAB 2006) (publications only admissible for what they show on their face); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1931 n.26 (TTAB 2006) (Lexis/Nexis articles submitted by notice of reliance to demonstrate merchandising activities of applicant and other third parties is inadmissible as hearsay); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1813 (TTAB 2005) (printed publications and news reports hearsay if offered to prove the truth of the statements made therein, but acceptable to show that the stories have been circulated to the public), *rev'd on other grounds*, slip op. No. 05-2037 (D.D.C. Apr. 3, 2008); and *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2002) (not evidence of use but may have some probative value to show the meaning of a mark in the same way as third-party registrations).

704.09 Discovery Depositions

37 C.F.R. § 2.120(k) ***Use of discovery deposition, answer to interrogatory, admission or written disclosure.***

(1) *The discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party.*

(2) *Except as provided in paragraph (k)(1) of this section, the discovery deposition of a witness, whether or not a party, shall not be offered in evidence unless the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or there is a stipulation by the parties; or upon a showing that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The use of a discovery deposition by any party under this paragraph will be allowed only by stipulation of the parties approved by the Trademark Trial and Appeal Board, or by order of the Board on motion, which shall be filed when the party makes its pretrial disclosures, unless the motion is based upon a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, even though such deadline has passed, in which case the motion shall be filed promptly after the circumstances claimed to justify use of the deposition became known.*

(3)(i) *A discovery deposition, an answer to an interrogatory, or an admission to a request for admission, or a written initial disclosure, which may be offered in evidence under the provisions of paragraph (k) of this section, may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), or a copy of the written initial disclosure, together with a notice of reliance in accordance with § 2.122(g). The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party which files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.*

* * * *

(4) *If only part of a discovery deposition is submitted and made part of the record by a party, an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party. A notice of reliance filed by an adverse party must be supported by a written statement explaining why the adverse party needs to rely upon each additional part listed in the adverse party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts.*

* * * *

(6) *Paragraph (k) of this section will not be interpreted to preclude reading or use of written disclosures or documents, a discovery deposition, or answer to an interrogatory, or admission as part of the examination or cross-examination of any witness during the testimony period of any party.*

(7) *When a written disclosure, a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, or an authenticated produced document has been made of record by one party in accordance with the provisions of paragraph (k)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

(8) *Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board, except when submitted with a motion relating to disclosure or discovery, or in support of or in response to*

a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.

The discovery deposition *of a party* (or of anyone who, at the time of taking the deposition, was an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party) may be offered in evidence *by any adverse party*. [Note 1.]

Otherwise, the discovery deposition of a witness, whether or not a party, may not be offered in evidence except in the following situations:

(1) By stipulation of the parties, approved by the Board. [Note 2.]

(2) By order of the Board, on motion showing that the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The motion must be filed when the party makes its pretrial disclosures, unless the motion is based on a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, in which case the motion must be filed promptly after the circumstances claimed to justify use of the deposition became known. [Note 3.]

(3) If only part of a discovery deposition is submitted and made part of the record by a party entitled to offer the deposition in evidence, an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party. In such a case, the notice of reliance filed by the adverse party must be supported by a written statement explaining why the adverse party needs to rely on each additional part listed in the adverse party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts. [Note 4.]

A discovery deposition that may be offered in evidence under 37 C.F.R. § 2.120(k) may be made of record by filing, during the testimony period of the offering party, the deposition or any part thereof with any exhibit to the part that is filed, together with a notice of reliance. [Note 5.] The notice of reliance must indicate the general relevance of the discovery deposition or any part thereof and associate it with one or more issues in the case. [Note 6.] When only part of a deposition is relied on, the notice of reliance must specify the part or parts relied on. [Note 7.] In order to avoid creating an overly large record of irrelevant evidence, parties should, where appropriate, file only those portions of a discovery deposition transcript that are relevant to the pleaded claims, counterclaims, or affirmative defenses. [Note 8.] *See*TBMP § 702.05 (Overly Large Records).

When a discovery deposition has been made of record by one party in accordance with 37 C.F.R. § 2.120(k), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. [Note 9.] If only part of a discovery deposition has been made of record pursuant to 37 C.F.R. § 2.120(k), that part only may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. If one party has filed a notice of reliance on a discovery deposition or part thereof and an adverse party has based its presentation of evidence on the belief that the deposition or the part thereof is of record, the notice of reliance may not later be withdrawn. [Note 10.]

A discovery deposition not properly offered in evidence under 37 C.F.R. § 2.120(k) may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto, or treats the deposition as being of record, or improperly offers a discovery deposition in the same manner. [Note 11.] The failure

to disclose or supplement an initial disclosure to identify a witness does not necessarily preclude the introduction of a discovery deposition of that witness at trial. [Note 12.] *See*TBMP § 408.03.

Written disclosures, disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board except when submitted (1) with a motion relating to disclosure or discovery; or (2) in support of or response to a motion for summary judgment; or (3) under a notice of reliance during a party's testimony period; or (4) as exhibits to a testimony deposition; or (5) in support of an objection to proffered evidence on the ground that the evidence should have been, but was not, provided in response to a request for discovery. [Note 13.] *See*TBMP § 409.

Nothing in 37 C.F.R. § 2.120(k) will be interpreted to preclude the reading or the use of a discovery deposition as part of the examination or cross-examination of any witness during the testimony period of any party. [Note 14.]

For information concerning the taking of a discovery deposition, and the raising of objections thereto, see TBMP § 404, TBMP § 532, and TBMP § 707.02.

Please Note: Some of the cases cited in this section established principles later codified in former 37 C.F.R. § 2.120(j) which was amended and redesignated as 37 C.F.R. § 2.120(k) effective January 14, 2017, or were decided under rules that were the predecessors to such provisions.

NOTES:

1. 37 C.F.R. § 2.120(k)(1). *See Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1427 (TTAB 1993) (deponent was no longer an officer or director at time his deposition was taken); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1325 (TTAB 1992) (same); *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1630 n.5 (TTAB 1988) (only by adverse party); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987) (same); *Dynamark Corp. v. Weed Eaters, Inc.*, 207 USPQ 1026, 1028 n.2 (TTAB 1980) (same); *Fischer GmbH. v. Molnar & Co.*, 203 USPQ 861, 867 n.7 (TTAB 1979) (discovery deposition of non-party taken on written questions inadmissible); *Johnson Publishing Co. v. Cavin & Tubiana OHG*, 196 USPQ 383, 384 n.5 (TTAB 1977) (party who takes discovery deposition may place it into evidence).

2. 37 C.F.R. § 2.120(k)(2). *See, e.g., Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *1 n.5 (TTAB 2019) (parties stipulated to introduce the discovery depositions of certain witnesses taken in the Board proceeding as trial testimony in lieu of taking their testimonial depositions); *Southwestern Management, Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1013 n.6 (TTAB 2015) (parties stipulated to allow excerpts of discovery deposition of a non-party to be entered into evidence), *aff'd mem.*, 652 F. App'x 971 (Fed. Cir. 2016); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1425 n.21 (TTAB 2014) (discovery depositions of opposers' own officers submitted by parties' stipulation); *Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons Inc.*, 55 USPQ2d 1298, 1302 n.11 (TTAB 2000) (deposition of non-party properly in evidence by stipulation of parties). *Cf. Azalea Health Innovations, Inc. v. Rural Health Care, Inc.*, 125 USPQ2d 1236, 1240-41 (TTAB 2017) (granting opposer's motion to strike discovery deposition transcripts of non-party witnesses submitted by applicant under notice of reliance to impeach the witnesses' declaration trial testimony, where there was no stipulation to allow the non-party witnesses' discovery depositions, applicant did not elect oral cross-examination of the witnesses on their testimonial declarations, and applicant did not file a motion seeking Board approval to use the discovery depositions, or a motion claiming exceptional circumstances).

3. 37 C.F.R. § 2.120(k)(2). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("The Office is amending renumbered § 2.120(k)(2) to change the time for a motion to use a discovery deposition to when the offering party makes its pretrial disclosures and to clarify that the exceptional circumstances standard applies when this deadline has passed."). *See also Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009) (motion granted to use discovery deposition of foreign resident not willing to appear voluntarily and whose attendance could not be compelled); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426–27 (TTAB 1993); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987) (no special circumstances shown by applicant to admit discovery deposition of applicant's president); *Fischer GmbH. v. Molnar & Co.*, 203 USPQ 861, 867 (TTAB 1979) (mere speculation that non-party witness would be unavailable is insufficient); *National Fidelity Life Insurance v. National Insurance Trust*, 199 USPQ 691, 692 n.4 (TTAB 1978) (no special circumstances shown to admit discovery deposition of non-party). *Cf. Azalea Health Innovations, Inc. v. Rural Health Care, Inc.*, 125 USPQ2d 1236, 1240-41 (TTAB 2017) (granting opposer's motion to strike discovery deposition transcripts of non-party witnesses submitted by applicant under notice of reliance to impeach the witnesses' declaration trial testimony, where there was no stipulation to allow the non-party witnesses' discovery depositions, applicant did not elect oral cross-examination of the witnesses on their testimonial declarations, and applicant did not file a motion seeking Board approval to use the discovery depositions, or a motion claiming exceptional circumstances).

4. 37 C.F.R. § 2.120(k)(4). *See Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1352 n.13 (TTAB 2014) ("in the interests of fairness," Board considers additional excerpts of discovery deposition submitted by adverse party under notice of reliance), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014); *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1466 (TTAB 2013) (opposer's objections to applicant's offer in evidence of portions of the Fed. R. Civ. P. 30(b)(6) discovery depositions of applicant's own witnesses sustained as to those portions that constitute new testimony, overruled as to those portions that clarify witness' statements), *aff'd*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015); *City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1671 (TTAB 2013) (petitioner's objection to respondent's "counter-designations" of portions of respondent's Fed. R. Civ. P. 30(b)(6) discovery deposition overruled); *Rolex Watch U.S.A. Inc. v. AFP Imaging Corp.*, 101 USPQ2d 1188, 1190 (TTAB 2011) (adverse party provided the requisite written statement explaining why it needs to rely upon the additional excerpts), *judgment vacated based on action of defendant on appeal*, 107 USPQ2d 1626 (TTAB 2013); *Wear-Guard Corp. v. Van Dyne-Crotty Inc.*, 18 USPQ2d 1804, 1806 n.2 (TTAB 1990) (adverse party failed to show how portions submitted were misleading), *aff'd*, 17 USPQ2d 1866 (Fed. Cir. 1991); *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215 (TTAB 1988) (Board refused to consider pages of a deposition relied on by applicant in its brief since they were not relied on by opposer and not properly made of record by applicant and since opposer objected thereto); *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1631, n.5 (TTAB 1988) (where applicant submitted entire deposition of its president in response to opposer's partial submission, without identifying specific relevant testimony, Board refused to consider additional portions); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1447 n.6 (TTAB 1986) (pages of additional portions should be clearly marked); *Chesebrough-Pond's Inc. v. Soulful Days, Inc.*, 228 USPQ 954, 955 n.4 (TTAB 1985) (Board refused to consider additional exhibits since they did not serve to correct misimpression engendered by those of record); *Dynamark Corp. v. Weed Eaters, Inc.*, 207 USPQ 1026, 1028 n.2 (TTAB 1980) (distinguishing mandatory filing of trial deposition in its entirety from discovery deposition where only the portion or portions which are properly introduced are of record); *Johnson Publishing Co. v. Cavin & Tubiana OHG*, 196 USPQ 383, 384 n.5 (TTAB 1977).

5. 37 C.F.R. § 2.120(k)(3)(i). *See BASF Wyandotte Corp. v. Polychrome Corp.*, 586 F.2d 238, 200 USPQ 20, 21 (CCPA 1978) (mere presence of discovery responses in the file does not make them of record without

a notice of reliance); *Grote Industries, Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1201 (TTAB 2018) (discovery deposition transcript that is admissible under notice of reliance is untimely if submitted after party's testimony period has closed; Board considered untimely discovery deposition transcript because adverse party did not object), *complaint filed*, No. 18-CV-599-LJV-MJR (W.D.N.Y. May 4, 2018); *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009); *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215 (TTAB 1988); *Fischer GmbH. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979) (reliance upon the discovery deposition of a non-party witness not allowed); *Ethicon, Inc. v. American Cyanamid Co.*, 192 USPQ 647, 651 n.11 (TTAB 1976) (no consideration to discovery deposition not properly made of record); *Chemetron Corp. v. Self-Organizing Systems, Inc.*, 166 USPQ 495, 496 n.2 (TTAB 1970) (discovery depositions not in evidence since notice of reliance not filed); *American Skein & Foundry Co. v. Stein*, 165 USPQ 85, 85 (TTAB 1970) (discovery deposition inadmissible where it was timely filed but not accompanied by notice of reliance).

6. *See* 37 C.F.R. § 2.122(g). Effective January 14, 2017, the Board added new subsection (g) to 37 C.F.R. § 2.122 detailing the requirements for admission of evidence by notice of reliance. This amendment effectively overruled any prior case law stating that an offering party is not required to specify the general relevance of certain types of evidence submitted under notice of reliance such as discovery deposition excerpts and answers to interrogatories. *See also* 37 C.F.R. § 2.120(k)(3)(i).

7. *See Exxon Corp. v. Motorgas Oil & Refining Corp.*, 219 USPQ 440, 441 n.4 (TTAB 1983) (vague reference to reliance on "only those portions of the deposition pertaining to the descriptive nature of the opposed mark" insufficient).

8. *See Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2002) ("[E]ach party has submitted discovery deposition transcripts in toto, i.e., has made no apparent effort to identify and introduce only those portions that are relevant to our determination of the pleaded claims. While not improper, it is more effective to file only those portions that are relevant and explain their relevancy in the notice of reliance") (citing *Wear-Guard Corp. v. Van Dyne-Crotty Inc.*, 18 USPQ2d 1804, 1805 n.1 (TTAB 1990) and *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215, 1217 n.9 (TTAB 1988).

9. 37 C.F.R. § 2.120(k)(7). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.122(a), consistent with § 2.120(k)(7), to add that when evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. The amendments codify current Office practice."). *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 129 USPQ2d 1027, 1030 n.29 (TTAB 2018) (party may rely on testimony from a discovery deposition already made of record by adverse party-no need to resubmit), *reversed and remanded on other grounds*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), petition for rehearing en banc denied, 2020 USPQ2d 11438 (Fed. Cir. 2020). *See also American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1025 (TTAB 2011) (objection based on failure to indicate relevance to applicant's notice of reliance introducing opposer's archival websites sustained, but applicant may rely on copy of opposer's website made of record by opposer's deposition); *Chesebrough-Pond's Inc. v. Soulful Days, Inc.*, 228 USPQ 954, 955 n.4 (TTAB 1985) (notice of reliance on deposition already made of record by the other party is superfluous); *Andersen Corp. v. Therm-O-Shield International, Inc.*, 226 USPQ 431, 432 n.6 (TTAB 1985) (stipulation that deposition relied on by opposer may also be considered as part of applicant's case was unnecessary); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191, 1192 n.7 (TTAB 1984); *Miles Laboratories, Inc. v. SmithKline Corp.*, 189 USPQ 290, 291 n.4 (TTAB 1975).

10. *See Exxon Corp. v. Motorgas Oil & Refining Corp.*, 219 USPQ 440, 441 n.4 (TTAB 1983) (opposer's notice of reliance as to deposition designation indefinite and opposer given time to clarify; response severely narrowed original designation to applicant's prejudice and not permitted).

11. *See, e.g., Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 n.6 (TTAB 2008) (because the parties stipulated to the use of discovery depositions as evidence, because petitioner did not object to respondent's reliance on respondent's answers to petitioner's written discovery, and because the discovery responses were used as exhibits during depositions, Board considered the responses as having been properly made of record); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1737 n.11 (TTAB 1990) (no objection to applicant's introduction of discovery deposition of officer of opposer's parent corporation); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 747 n.4 (TTAB 1986) (deposition taken during discovery but treated by both parties as a testimonial deposition introduced by deposed party treated as trial deposition taken prior to testimony period pursuant to stipulation); *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354, 356 n.5 (TTAB 1984) (deposition of non-party treated as stipulated into the record since adverse party did not object and referred to it as being of record in its brief); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.7 (TTAB 1982) (discovery deposition of non-party treated by both parties as properly of record); *Pamex Foods, Inc. v. Clover Club Foods Co.*, 201 USPQ 308, 310 n.3 (TTAB 1978) (considered of record where although opposer did not file a notice of reliance on discovery depositions, both parties referred to the depositions in their briefs); *Plus Products v. Don Hall Laboratories*, 191 USPQ 584, 585 n.2 (TTAB 1976) (plaintiff's notice of reliance filed during rebuttal testimony period improper where defendant introduced no evidence; but since defendant filed improper notice of reliance in response thereto and because neither party objected to the untimely evidence of the other and moreover addressed each other's evidence, all material was considered); *Insta-Foam Products, Inc. v. Instapak Corp.*, 189 USPQ 793, 795 n.4 (TTAB 1976) (discovery deposition of non-party deemed stipulated into the record where there was no objection and both parties relied on the deposition).

12. *See Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009) (failure to disclose non-party witness in initial disclosures or to supplement initial disclosures did not preclude introduction of discovery deposition at trial when deposition was adequately noticed, at least one of party's principals attended deposition and attorney cross-examined witness).

13. 37 C.F.R. § 2.120(k)(8). *See Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 n.3 (TTAB 1999).

14. 37 C.F.R. § 2.120(k)(6). *Cf. West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.*, 2 USPQ2d 1306, 1308 n.3 (TTAB 1987) (party may testify as to veracity of information contained in interrogatory answers or use such answers to refresh memory of witness during testimony deposition).

704.10 Interrogatory Answers; Admissions

37 C.F.R. § 2.120(k) ***Use of discovery deposition, answer to interrogatory, admission or written disclosure.***

* * * *

(3)(i) *A discovery deposition, an answer to an interrogatory, or an admission to a request for admission, or a written initial disclosure, which may be offered in evidence under the provisions of paragraph (j) of this section, may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), or a copy of the written initial disclosure, together with a notice of reliance in accordance with § 2.122(g). The notice of reliance*

and the material submitted thereunder should be filed during the testimony period of the party which files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.

* * * *

(5) *Written disclosures, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record only by the receiving or inquiring party except that, if fewer than all of the written disclosures, answers to interrogatories, or fewer than all of the admissions, are offered in evidence by the receiving or inquiring party, the disclosing or responding party may introduce under a notice of reliance any other written disclosures, answers to interrogatories, or any other admissions, which should in fairness be considered so as to make not misleading what was offered by the receiving or inquiring party. The notice of reliance filed by the disclosing or responding party must be supported by a written statement explaining why the responding party needs to rely upon each of the additional written disclosures or discovery responses listed in the disclosing or responding party's notice, and absent such statement, the Board, in its discretion, may refuse to consider the additional written disclosures or responses.*

(6) *Paragraph (k) of this section will not be interpreted to preclude reading or use of written disclosures or documents, a discovery deposition, or answer to an interrogatory, or admission as part of the examination or cross-examination of any witness during the testimony period of any party.*

(7) *When a written disclosure, a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, or an authenticated produced document has been made of record by one party in accordance with the provisions of paragraph (k)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

(8) *Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board, except when submitted with a motion relating to disclosure or discovery, or in support of or in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.*

Ordinarily, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record by only the inquiring party. [Note 1.] See TBMP § 401 and TBMP § 704.14 for further information concerning disclosures.

However, if fewer than all of the answers to a set of interrogatories, or fewer than all of the admissions, are offered in evidence by the inquiring party, the responding party may introduce, under a notice of reliance, any other answers to interrogatories, or any other admissions that should be considered so as to avoid an unfair interpretation of the responses offered by the inquiring party. [Note 2.] The notice of reliance must be supported by a written statement explaining why the responding party needs to rely on each of the additional interrogatory answers, or admissions, listed in the responding party's notice, failing which the Board, in its discretion, may refuse to consider the additional responses. [Note 3.]

An interrogatory answer (including documents provided as all or part of an interrogatory answer under Fed. R. Civ. P. 33), or an admission to a request for admission, [Note 4], that may be offered in evidence under 37 C.F.R. § 2.120(k) may be made of record by notice of reliance during the testimony period of the offering party. The party should file a copy of the interrogatory and the answer thereto, with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), together with its notice of reliance thereon. [Note 5.]

The notice of reliance must indicate the general relevance of the interrogatory answer or admission (or any part thereof) and associate it with one or more issues in the case. [Note 6.] Interrogatory answers, or

admissions, may be admitted into evidence through the testimony of a witness as an alternative to the notice of reliance procedure. [Note 7.]

An interrogatory answer may also be made of record by stipulation of the parties, accompanied by a copy of the interrogatory and the answer thereto with any exhibit made part of the answer. Similarly, an admission may be made of record by stipulation of the parties, accompanied by a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto). [Note 8.]

When an interrogatory answer, or an admission, has been made of record by one party in accordance with 37 C.F.R. § 2.120(k), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. [Note 9.]

An interrogatory answer, or an admission, not properly offered in evidence under 37 C.F.R. § 2.120(k) may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto; and/or treats the answer, or admission, as being of record; and/or improperly offers an interrogatory answer, or an admission, in the same manner. [Note 10.]

Written disclosures, disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board except when submitted (1) with a motion relating to disclosure or discovery; or (2) in support of or response to a motion for summary judgment; or (3) under a notice of reliance during a party's testimony period; or (4) as exhibits to a testimony deposition; or (5) in support of an objection to proffered evidence on the ground that the evidence should have been, but was not, provided in response to a request for discovery. [Note 11.] **Please Note:** Unlike documents that are provided as all or part of an interrogatory answer under Fed. R. Civ. P. 33, documents that are produced in response to a document request cannot be made of record under a notice of reliance unless they are otherwise eligible for submission under a notice of reliance, e.g., because they are printed publications or were provided in connection with a response to an interrogatory or unless they have been authenticated by an admission or stipulation from the producing party. [Note 12.] *See*TBMP § 704.08 and TBMP § 704.11.

Nothing in 37 C.F.R. § 2.120(k) precludes reading or using an interrogatory answer, or an admission, as part of the examination or cross-examination of any witness during the testimony period of any party. [Note 13.]

Denials to admission requests cannot be submitted under notice of reliance. [Note 14.] "[U]nlike an admission (or a failure to respond which constitutes an admission), the denial of a request for admission establishes neither the truth nor the falsity of the assertion, but rather leaves the matter for proof at trial. *Cf.* Fed. R. Civ. P. 36(b)." [Note 15.]

Although parties are obliged to supplement their discovery responses under Fed. R. Civ. P. 26(e)(1), supplemental discovery materials served upon an adversary during trial cannot be made of record unless such materials fall under an exception in 37 C.F.R. § 2.120(k)(8). [Note 16.]

For information concerning the taking of discovery by way of interrogatories, see TBMP § 405. For information concerning the taking of discovery by way of requests for admission and for the effect of not responding to a request for admission, see TBMP § 407. For information concerning the raising of objections to notices of reliance and materials filed thereunder, see TBMP § 532 and TBMP § 707.02.

Please Note: Some of the cases cited in this section established principles later codified in the cited provisions in former 37 C.F.R. § 2.120(j), now 37 C.F.R. § 2.120(k), or were decided under rules which were the predecessors to such provisions.

NOTES:

1. 37 C.F.R. § 2.120(k)(5). *See Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1342-43 (TTAB 2017) (opposer's response to request for admission that two words have similar but not identical meanings considered admission properly introduced by applicant under notice of reliance); *Daniel J. Quirk Inc. v. Village Car Company*, 120 USPQ2d 1146, 1151 (TTAB 2016); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1217 (TTAB 2011) (defendant's responses to plaintiff's interrogatories and document requests, but not produced documents); *Triumph Machinery Co. v. Kentmaster Manufacturing Co.*, 1 USPQ2d 1826, 1827 n.3 (TTAB 1987); *Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.*, 222 USPQ 1012, 1015 n.7 (TTAB 1984); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.8 (TTAB 1982); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 950 (TTAB 1981).

See also Safeway Stores, Inc. v. Captn's Pick, Inc., 203 USPQ 1025, 1027 n.1 (TTAB 1979); *Jerrold Electronics Corp. v. Magnavox Co.*, 199 USPQ 751, 753 n.4 (TTAB 1978; *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493, 495 n.4 (TTAB 1978); *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n.6 (TTAB 1977) ; *Hovnanian Enterprises, Inc. v. Covered Bridge Estates, Inc.*, 195 USPQ 658, 660 n.2 (TTAB 1977); *A. H. Robins Co. v. Evsco Pharmaceutical Corp.*, 190 USPQ 340 (TTAB 1976); *W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308, 309 n.6 (TTAB 1976); *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647, 647 (TTAB 1976).

2. 37 C.F.R. § 2.120(k)(5). *See Turdin v. Trilobite, Ltd.* , 109 USPQ2d 1473, 1476-77 (TTAB 2014) (concurrent-use defendant's objection to plaintiff's submission of initial answer to interrogatory with notice of reliance, on ground that answer did not include defendant's supplemental response, is overruled, since 37 C.F.R. § 2.120(j)(5) provides in relevant part that inquiring party may make answer to interrogatory of record by notice of reliance, and that, if fewer than all answers to interrogatories are offered in evidence, responding party may introduce, under notice of reliance, any other answers to interrogatories which should in fairness be considered so as to render inquiring party's submission not misleading, and since defendant remedied any perceived unfairness by submitting supplemental answer and documents it produced under Fed. R. Civ. P. 33(d)); *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.5 (TTAB 1988). *Cf. Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1218 (TTAB 2011) (plaintiff introduced its responses to defendant's interrogatories by notice of reliance which were considered only to the extent that defendant submitted the non-confidential portions of plaintiff's responses through its own notice of reliance).

3. 37 C.F.R. § 2.120(k)(5). *See Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009) (additional interrogatory responses by answering party not considered because he did not include explanation as to why he needed to rely on each additional discovery response, and not obvious in what way they avoided any unfairness from what propounding party submitted); *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125, 1128 n.4 (TTAB 1995) (notice of reliance on responses stricken since responses did not clarify answers relied on by inquiring party); *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.5 (TTAB 1988) (TTAB 1988) (answering party is expected to select only the relevant answers and to inform the Board of the relationship of that answer to those offered by propounding party); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1719 n.4 (TTAB 1987) (other answers may be introduced to clarify, rebut or explain responses relied on by inquiring party; opposer failed to indicate the relevance of its interrogatory responses to rebut those relied on by applicant); *Board of Trustees of the University of*

Alabama v. BAMA-Werke Curt Baumann, 231 USPQ 408, 409 n.3 (TTAB 1986) (broad statement by answering party that without the additional responses the selected responses would be misleading is insufficient); *Packaging Industries Group, Inc. v. Great American Marketing, Inc.*, 227 USPQ 734, 734 n.3 (TTAB 1985) (applicant did not introduce the additional responses referred to in its brief by notice of reliance); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 950 (TTAB 1981) (answering party may not simply rely on all remaining answers and expect Board to determine which, if any, answers require explanation or clarification); *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647, 647 (TTAB 1976).

4. *See Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1342-43 (TTAB 2017) (opposer's response to request for admission that two words have similar but not identical meanings considered admission properly introduced by applicant under notice of reliance). *Cf. Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957 n.10 (TTAB 2008) (denials of requests for admission not admissible; the denial of a request for admission establishes neither the truth nor the falsity of the assertion, but rather leaves the matter for proof at trial).

5. 37 C.F.R. § 2.120(k)(3)(i). *See B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1503 (TTAB 2007) (catalog produced in lieu of interrogatory response can be made of record through notice of reliance on interrogatory response); *BASF Wyandotte Corp. v. Polychrome Corp.*, 586 F.2d 238, 200 USPQ 20, 21 (CCPA 1978); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (notice of reliance must specify and be accompanied by the interrogatory to which each document was provided in lieu of an answer); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1447 n.9 (TTAB 1986) (documents provided in lieu of interrogatory answer admissible by notice of reliance); *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (notice of reliance filed after close of testimony period untimely); *Bausch & Lomb Inc. v. Gentex Corp.*, 200 USPQ 117, 119 n.2 (TTAB 1978) (neither party filed notice of reliance on the other party's interrogatories and therefore not of record).

See also E. I. du Pont de Nemours & Co. v. G. C. Murphy Co., 199 USPQ 807, 808 n.2 (TTAB 1978); *Miss Nude Florida, Inc. v. Drost*, 193 USPQ 729, 731 (TTAB 1976), *pet. to Comm'r denied*, 198 USPQ 485 (Comm'r 1977); *Hollister Inc. v. Ident A Pet, Inc.*, 193 USPQ 439, 440 n.2 (TTAB 1976); *Plus Products v. Don Hall Laboratories*, 191 USPQ 584, 585 n.2 (TTAB 1976); *A. H. Robins Co. v. Evsco Pharmaceutical Corp.*, 190 USPQ 340, 341 n.3 (TTAB 1976).

Cf. Anheuser-Busch, Inc. v. Major Mud & Chemical Co., 221 USPQ 1191, 1192 n.7 (TTAB 1984) (applicant's notice of reliance on responses which were already made of record by opposer was superfluous).

6. *See* 37 C.F.R. § 2.120(g). *See, e.g.*, *STX Financing, LLC v.Terraza*, 2020 USPQ2d 10989, at *4 (TTAB 2020) (motion to strike opposer's responses to applicant's interrogatories for failure to indicate the general relevance of the interrogatory answers, instead asserting broadly that the interrogatories were relevant "to show no likelihood of confusion and/or dilution," granted with leave to cure).

On January 14, 2017, the Board added new subsection (g) to 37 C.F.R. § 2.122 detailing the requirements for admission of evidence under notice of reliance, effectively overruling *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.* , 201 USPQ 881, 883 (TTAB 1979) (not required to set forth the relevance of interrogatory answers). *See also* 37 C.F.R. § 2.120(k)(3)(i).

7. *See Lacoste Alligator S.A. v. Everlast World's Boxing Headquarters Corp.*, 204 USPQ 945, 947 (TTAB 1979).

8. *See Wilderness Group, Inc. v. Western Recreational Vehicles, Inc.*, 222 USPQ 1012, 1015 n.7 (TTAB 1984) (although parties stipulated that certain interrogatory answers were part of evidentiary record, because copies of the interrogatories and answers were never submitted to the Board, they could not be considered). *See also Jerrold Electronics Corp. v. Magnavox Co.*, 199 USPQ 751, 753 n.4 (TTAB 1978); *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n.5 (TTAB 1977). *Cf. Wella Corp. v. California Concept Corp.*, 192 USPQ 158, 160 n.4 (TTAB 1976) (supplemental answers to interrogatories were not covered by the stipulation), *rev'd on other grounds*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977).

9. 37 C.F.R. § 2.120(k)(7). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.122(a), consistent with § 2.120(k)(7), to add that when evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. The amendments codify current Office practice."). *See also Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191, 1192 n.7 (TTAB 1984) (applicant's notice of reliance on matter already made of record by opposer is superfluous); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1025 (TTAB 2011) (objection based on failure to indicate relevance to applicant's notice of reliance sustained, but applicant may rely on copy of record by opposer's deposition); *Henry Siegel Co. v. M & R International Manufacturing Co.*, 4 USPQ2d 1154, 1155 n.5 (TTAB 1987); *Beecham Inc. v. Helene Curtis Industries, Inc.*, 189 USPQ 647, 647 (TTAB 1976) (where party relies on all of adversary's answers to interrogatories, the adversary need not file its own notice of reliance thereon).

10. *See, e.g., Hanscomb Consulting, Inc. v. Hanscomb Ltd.*, 2020 USPQ2d 10085, at *2 (TTAB 2020) (each party introduced their own discovery responses propounded by the other party, but since neither party objected to the manner of introduction nor objected based on the general bar against a party introducing its own discovery responses, the Board considered these objections waived); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1435 n.3 (TTAB 2012) (opposer did not object to applicant's improper introduction of applicant's responses to interrogatories and requests for admission but instead treated the responses as being of record); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 n.6 (TTAB 2008) (because the parties stipulated to the use of discovery depositions as evidence, petitioner did not object to respondent's reliance on respondent's answers to petitioner's written discovery, and the discovery responses were used as exhibits during depositions, respondent's discovery responses considered as having been properly made of record); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 n.3 (TTAB 1993) (no objection to party's reliance on its own answers and moreover the responses set forth facts which were described in the parties' stipulation); *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.5 (TTAB 1988) (no objection to responding party's notice of reliance on remaining answers and such answers were deemed as explanatory or clarifying); *Triumph Machinery Co. v. Kentmaster Manufacturing Co.*, 1 USPQ2d 1826, 1827 n.3 (TTAB 1987) (no objection to party's reliance on its own answers); *Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 409 n.3 (TTAB 1986) (objection which was raised for first time in brief waived since defect of failing to explain why the additional responses were necessary could have been cured); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.4 (TTAB 1979) (no objection to untimely notice of reliance or to failure to submit copies of the discovery requests or responses thereto); *Safeway Stores, Inc. v. Captn's Pick, Inc.*, 203 USPQ 1025, 1027 n.1 (TTAB 1979) (no objection by either party to the other's improper reliance on its own answers; opposer did not object to interrogatories introduced by applicant and in fact referred to answers to other of opposer's interrogatories without benefit of notice of reliance); *Pamex Foods, Inc. v. Clover Club Foods Co.*, 201 USPQ 308, 310 n.3 (TTAB 1978) (discovery depositions filed without a notice of reliance were treated as being of record where both parties referred to the depositions in their briefs and in view of stipulations concerning marking of exhibits in the depositions); *Jerrold Electronics Corp. v. Magnavox Co.*, 199 USPQ 751, 753 n.4 (TTAB 1978) (both parties relied on answers given by

each to the other's interrogatories without objection); *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n.5 (TTAB 1977) (same); *Plus Products v. Don Hall Laboratories*, 191 USPQ 584, 585 n.2 (TTAB 1976) (neither party objected to improper notice of reliance by the other and each relied on the contents of the other's notice of reliance); *Plus Products v. Sterling Food Co.*, 188 USPQ 586, 587 n.2 (TTAB 1975) (applicant did not file required notice of reliance on opposer's answers but both parties referred to the answers in their briefs).

Cf. Hiraga v. Arena, 90 USPQ2d 1102, 1106 (TTAB 2009) (additional interrogatory answers not considered because non-offering party timely objected and never treated interrogatory answers as being of record).

11. 37 C.F.R. § 2.120(k)(8).

12. 37 C.F.R. § 2.120(k)(3)(ii). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("The Office is amending renumbered § 2.120(k)(3)(ii) to add that a party may make documents produced by another party of record by notice of reliance alone if the party has obtained an admission or stipulation from the producing party that authenticates the documents. This amendment is consistent with the amendment in renumbered § 2.120(i) permitting a party to make one comprehensive request for an admission authenticating specific documents produced by an adverse party."); *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1343 (TTAB 2017) (confidential settlement agreement produced by opposer proper subject matter for submission by applicant (under seal) under notice of reliance because in response to request for admission, opposer attested that documents produced were true and correct copies of authentic documents).

13. 37 C.F.R. § 2.120(k)(6). *See West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.*, 2 USPQ2d 1306, 1308 n.3 (TTAB 1987) (use of interrogatory answers to refresh memory of witness and testifying as to veracity of interrogatory answers permitted). *Cf. Steiger Tractor, Inc. v. Steiner Corp.*, 221 USPQ 165, 169-70 (TTAB 1984) (reading answers into record when witness was present at deposition inadmissible because no written copy given to refresh witness's memory), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984).

14. 37 C.F.R. § 2.120(k)(3)(i). *See, e.g., Tivo Brands, LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1101 n.14 (TTAB 2018); *Ayoub, Inc. v. ACS Ayoub Carpet Services*, 118 USPQ2d 1392, 1395 n.9 (TTAB 2016); *N.Y. Yankees Partnership v. IET Products & Services, Inc.*, 114 USPQ2d 1497, 1501 n.11 (TTAB 2015) (Board considered only opposer's admissions, not denials, in response to applicant's requests for admission); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1477 (TTAB 2014) (concurrent use defendant's objection to submission of denial to admission request sustained; "rule does not extend to denials"); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957 (TTAB 2008) (denials to requests for admission inadmissible).

15. *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *1 n.9 (TTAB 2020); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957 n.10 (TTAB 2008).

16. *Joel Gott Wines LLC v. Rehobeth Von Gott, Inc.*, 107 USPQ2d 1424, 1427-28 (TTAB 2013) ("It is true that Fed. R. Civ. P. 26(e)(1) charges parties with a duty to supplement their discovery responses. But this does not make whatever supplemental material is produced of record in the case.").

704.11 Produced Documents and Privilege Logs

37 C.F.R. § 2.122(e) ***Printed publications and official records.***

(1) *Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant in a particular proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered in accordance with paragraph (g) of this section. The notice of reliance shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.*

(2) *Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided.*

37 C.F.R. § 2.120(k)(3)(ii) *A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e) or the party has obtained an admission or stipulation from the producing party that authenticates the documents.*

Documents provided as all or part of an answer to an interrogatory under Fed. R. Civ. P. 33 may be made of record, as an interrogatory answer, by notice of reliance filed in accordance with 37 C.F.R. § 2.120(k)(3)(i) and 37 C.F.R. § 2.120(k)(5). [Note 1.] *See*TBMP § 704.10.

However, a party that has obtained documents from another party through disclosure or under Fed. R. Civ. P. 34 may not make the produced documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under 37 C.F.R. § 2.122(e) (as official records; or as printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in the proceeding; or Internet documents); or unless the documents have been authenticated by an admission or stipulation from the producing party. [Note 2.] *See*TBMP § 704.07 and TBMP § 704.08.

Listed below are a number of methods by which documents obtained through disclosure or produced in response to a request for production of documents may be made of record:

(1) A party that has obtained documents through disclosure or under Fed. R. Civ. P. 34 may serve on its adversary requests for admission of the authenticity of the documents, and then, during its testimony period, file a notice of reliance, under 37 C.F.R. § 2.120(k)(3)(i), on the requests for admission, the exhibits thereto, and its adversary's admissions (or a statement that its adversary failed to respond to the requests for admission). [Note 3.] However, if a party wishes to have an opportunity to serve requests for admission after obtaining documents under Fed. R. Civ. P. 34, it must serve its request for production of documents early in the discovery period, so that when it obtains the produced documents, it will have time to prepare and serve requests for admission, and the responding party will have time to prepare and serve its answers, prior to the expiration of the discovery period. [Note 4.] For information regarding the need for early initiation of discovery, see TBMP § 403.05(a) and TBMP § 403.05(b).

(2) A party that has obtained documents through disclosure or under Fed. R. Civ. P. 34 may offer them as exhibits in connection with the taking of its adversary's discovery deposition. With regard to Fed. R. Civ. P. 34 documents, however, the request for production of documents must be served early in the discovery

period, so that there will still be time remaining, after the requested documents have been produced, to notice and take a discovery deposition during the discovery period. *See*TBMP § 403.05.

(3) A party that has obtained documents through disclosure or under Fed. R. Civ. P. 34 may introduce them as exhibits during the cross-examination of its adversary's witness. [Note 5.] This method is available only if the adversary takes testimony and the documents pertain to matters within the scope of the direct examination of the witness.

(4) A party that has obtained documents through disclosure or under Fed. R. Civ. P. 34 may, during its own testimony period, take the testimony of its adversary as an adverse witness and introduce the obtained documents as exhibits during direct examination. [Note 6.]

(5) A party that has obtained documents through disclosure or under Fed. R. Civ. P. 34 may, during its own testimony period, make of record by notice of reliance, under 37 C.F.R. § 2.122(e), any of the documents that fall into the category of "printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue" and Internet materials. [Note 7.] *See also*TBMP § 704.07 and TBMP § 704.08.

(6) A party that wishes to obtain documents under Fed. R. Civ. P. 34 may combine its request for production of documents with a notice of taking discovery deposition, and ask that the requested documents be produced at the deposition. However, the combined request for production and notice of deposition must be served well before the date set for the deposition, because a discovery deposition must be both noticed and taken before the close of the discovery period, and because Fed. R. Civ. P. 34(b) allows a party 30 days in which to respond to a request for production of documents. *See*TBMP § 403.05.

(7) Documents obtained through disclosure or under Fed. R. Civ. P. 34 may be made of record by stipulation of the parties. [Note 8.]

(8) Documents obtained through disclosure or by request for production of documents under Fed. R. Civ. P. 34, and improperly offered in evidence, may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto; and/or treats the documents as being of record; and/or in the same manner improperly offers documents which it obtained under Fed. R. Civ. P. 34. [Note 9.]

For information on initial disclosures and on obtaining discovery by way of a request for production of documents, see TBMP § 401.02 and TBMP § 406.

If no documents exist which are responsive to a document request, a party's response that no documents exist may be made of record. [Note 10.]

A privilege log produced by a party during discovery cannot be introduced into evidence through a notice of reliance. [Note 11.]

NOTES:

1. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476-77 (TTAB 2014) (Board considered documents responsive to interrogatory under Fed. R. Civ. P. 33(d) submitted under notice of reliance); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103-1104 (TTAB 2007) (because respondent produced documents in responding to petitioner's interrogatories and admitted in responses to requests for admissions that the documents it produced were true and correct copies of authentic documents, documents are admissible by way of a notice of reliance); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (notice of reliance failed to indicate that documents were being introduced under 37 C.F.R. § 2.120(j)(3)(i) by specifying and making of record a copy of the particular interrogatories to which each document was

provided in lieu of an interrogatory answer); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1447-48 (TTAB 1986).

2. 37 C.F.R. § 2.120(k)(3)(ii). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("The Office is amending renumbered § 2.120(k)(3)(ii) to add that a party may make documents of record by notice of reliance alone if the party has obtained an admission or stipulation from the producing party that authenticates the documents. This amendment is consistent with the amendment in renumbered § 2.120(i) permitting a party to make one comprehensive request for an admission authenticating specific documents produced by an adverse party."). *See, e.g., Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 71345, at *2 n.10 (TTAB 2020) (respondent authenticated document production by referring to the document production in his interrogatory responses but since petitioner did not submit the produced documents, there was nothing for the Board to review); *Schiedmayer Celesta GmbH v. Piano Factory Group, Inc.*, 2019 USPQ2d 341894, at *1 nn. 4 & 5 (TTAB 2019) (unauthenticated documents produced in response to document requests not considered); *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1343 (TTAB 2017) (confidential settlement agreement produced by opposer proper subject matter for submission by applicant (under seal) under notice of reliance because in response to request for admission, opposer attested that documents produced were true and correct copies of authentic documents); *Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1032 n.5 (TTAB 2016) (documents produced in response to document production requests made of record by stipulation); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1477 (TTAB 2014) (evidence submitted concurrently with concurrent use applicant's rebuttal disclosures not considered); *Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1932 n.7 (TTAB 2013) (documents produced in response to a request for production of documents may not be introduced under notice of reliance); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 at n.8 (TTAB 2012) (produced documents cannot be introduced by notice of reliance alone); *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1020-21 n.2 (TTAB 2011) (produced documents not considered because not admissible under notice of reliance); *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886 n.5 (TTAB 2008); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1447 n.9 (TTAB 1986); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.5 (TTAB 1985) (documents were neither official records nor printed publications); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n.4 (TTAB 1984) (documents were not printed publications).

3. 37 C.F.R. § 2.120(k)(3)(i). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("The Office is amending renumbered § 2.120(k)(3)(ii) to add that a party may make documents produced by another party of record by notice of reliance alone if the party has obtained an admission or stipulation from the producing party that authenticates the documents. This amendment is consistent with the amendment in renumbered § 2.120(i) permitting a party to make one comprehensive request for an admission authenticating specific documents produced by an adverse party."); *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1343 (TTAB 2017) (confidential settlement agreement produced by opposer proper subject matter for submission by applicant (under seal) under notice of reliance because in response to request for admission, opposer attested that documents produced were true and correct copies of authentic documents).

4. 37 C.F.R. § 2.120(a)(3). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69951 (October 7, 2016) ("Under the amended rules, discovery must be served early enough in the discovery period that responses will be provided and all discovery will be complete by the close of discovery. This includes production of documents, which have to be produced or inspected by the close of discovery."); *Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268, 1270

(TTAB 2017) (discovery must be served early enough in the discovery period so that responses are due no later than the close of discovery).

5. *See Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, 191 USPQ 119, 121 n.1 (TTAB 1976).

6. *See Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, 191 USPQ 119, 121 n.1 (TTAB 1976).

7. 37 C.F.R. § 2.122(e); 37 C.F.R. § 2.120(k)(3)(ii); *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010).

8. 37 C.F.R. § 2.120(k)(3)(ii). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("The Office is amending renumbered § 2.120(k)(3)(ii) to add that a party may make documents of record by notice of reliance alone if the party has obtained an admission or stipulation from the producing party that authenticates the documents. This amendment is consistent with the amendment in renumbered § 2.120(i) permitting a party to make one comprehensive request for an admission authenticating specific documents produced by an adverse party.").

9. *See, e.g., Executive Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1179 n.9 (TTAB 2017) (responses to document requests submitted by notice alone treated as being stipulated into record where both parties submitted them in this manner and neither objected); *Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1901-02 (TTAB 2006); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 n.4 (TTAB 1984) (improper subject of notice of reliance but no objection raised); *Autac Inc. v. Viking Industries, Inc.*, 199 USPQ 367, 369 n.2 (TTAB 1978) (neither party objected to other's offering of Fed. R. Civ. P. 34 documents by notice alone); *Southwire Co. v. Kaiser Aluminum & Chemical Corp.*, 196 USPQ 566, 569 n.1 (TTAB 1977) (applicant did not object to documents produced and introduced by notice alone and referred to those documents in its brief); *Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, 191 USPQ 119, 121 n.1 (TTAB 1976) (no objection to notice of reliance). *Cf. Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 906 n.8 (TTAB 1985).

Cf. 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) (Board did not consider at final decision evidence stricken by the Board in an earlier order as improperly filed, such evidence consisting of petitioner's interrogatory responses and labels produced by petitioner, even though petitioner did not object to submission of this evidence by respondent).

10. *See City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013) (responses to document production requests are admissible solely for purposes of showing that a party has stated that there are no responsive documents); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 n.7 (TTAB 2012) (written responses to document requests indicating that no documents exist may be submitted by notice of reliance); *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1217 n.8 (TTAB 2011); *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1020-21 n.2 (TTAB 2011); *Spirits International B.V. v. S. S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi*, 99 USPQ2d 1545, 1547-48 n.5 (TTAB 2011); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883 n.5 (TTAB 2008).

See also Lebanon Seaboard Corp. v. R&R Turf Supply Inc., 101 USPQ2d 1826, 1829 (TTAB 2012) (document responses consisting of objections and/or representations that the documents would be produced treated as of record).

11. *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1806 n.21 (TTAB 2018) (Board did not consider privilege log submitted under notice of reliance), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021).

704.12 Judicial Notice

37 C.F.R. § 2.122(a) ***Applicable rules.*** *Unless the parties otherwise stipulate, the rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part. When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

Fed. R. Evid. 201. Judicial Notice of Adjudicative Facts.

(a) ***Scope.*** *This rule governs judicial notice of an adjudicative fact only, not a legislative fact.*

(b) ***Kinds of Facts That May Be Judicially Noticed.*** *The court may judicially notice a fact that is not subject to reasonable dispute because it:*

(1) *is generally known within the trial court's territorial jurisdiction; or*

(2) *can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.*

(c) ***Taking Notice.*** *The court:*

(1) *may take judicial notice on its own; or*

(2) *must take judicial notice if a party requests it and the court is supplied with the necessary information.*

(d) ***Timing.*** *The court may take judicial notice at any stage of the proceeding.*

(e) ***Opportunity to Be Heard.*** *On timely request, a party is entitled to be heard on the propriety of taking judicial notice and the nature of the fact to be noticed. If the court takes judicial notice before notifying a party, the party, on request, is still entitled to be heard.*

(f) ***Instructing the Jury.*** *In a civil case, the court must instruct the jury to accept the noticed fact as conclusive. In a criminal case, the court must instruct the jury that it may or may not accept the noticed fact as conclusive.*

In appropriate instances, the Board may take judicial notice of adjudicative facts. *See* 37 C.F.R. § 2.122(a) and Fed. R. Evid. 201.

704.12(a) Kind of Fact That May be Judicially Noticed

The only kind of fact that may be judicially noticed by the Board is a fact that is "not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned." [Note 1.]

For examples of decisions concerning whether particular facts are appropriate subject matter for judicial notice by the Board, see cases cited in the note below. [Note 2.] *See also*TBMP § 1208.04 for additional cases.

NOTES:

1. Fed. R. Evid. 201(b). *See Omaha Steaks International, Inc. v. Greater Omaha Packing Co., Inc.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (per Fed. R. Evid. 201(b) and 201(c), providing case captions including case names and docket numbers of trademark infringement actions "likely was sufficient" for the Board to take judicial notice that a party had filed various infringement actions, but not sufficient to take judicial notice of the contents of the complaints, that the cases related to the mark at issue in the Board proceeding, or that others were actively infringing the party's asserted mark); *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 n.5 (TTAB 1999). *See, e.g., Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1603 (TTAB 1999); *Omega SA v. Compucorp*, 229 USPQ 191, 194 (TTAB 1985); *United States National Bank of Oregon v. Midwest Savings and Loan Association*, 194 USPQ 232, 235 (TTAB 1977).

Please Note: The Federal Circuit, in *In re Chippendales USA, Inc.* , 622 F.3d 1346, 96 USPQ2d 1681 (Fed. Cir. 2010), exercised its discretion to take judicial notice of a third party's registrations. Although the court took judicial notice of a third-party registration in that case, the Board does not take judicial notice of either third-party registrations or a party's own registration[s] insofar as the Trademark Rules of Practice specify how to make such registrations of record in an inter partes proceeding. *See* 37 C.F.R. § 2.122(d) and 37 C.F.R. § 2.122(e). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69955 (October 7, 2016) (Board considered but rejected suggestion of taking judicial notice of USPTO records, explaining various reasons introduction of information contained in USPTO trademark file records is most appropriately borne by the party seeking to introduce the evidence).

2. *Omaha Steaks International, Inc. v. Greater Omaha Packing Co., Inc.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (filing of various infringement actions when party provided case captions - yes; contents of the complaints, that the cases related to the mark at issue in the Board proceeding, or that others were actively infringing the party's asserted mark - no: "The Board is not required to scour, not just the dockets, but the multiple pleadings referenced in those dockets to determine the substance of the litigations referenced.").

Cases issued in 2000 and after: *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *7 n.9 (TTAB 2019) (Board took judicial notice of census bureau data although not made of record by either party); *M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd.*, 2019 USPQ2d 149090, at *1 n.7 (TTAB 2019) (Board took judicial notice of British spelling of word "gutka" and official United States publication (NCI Cancer Dictionary), although not made of record by either party); *In re Morinaga Nyuguo Kabushiki Kaisha*, 120 USPQ2d 1738, 1744 n.4 (TTAB 2016) (locations of Puyallup, Washington and Mount Rainer - yes); *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767-68 (TTAB 2016) (patent excerpt, and definitions from Wikipedia, definitions from commercial websites that do not constitute dictionary definitions, and excerpts for which the source of the materials was not identified - no); *Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1029 (TTAB 2015) (applicant's photographs of a person from which its marks were allegedly derived - no); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1098 n.114 (TTAB 2014) (census data - yes), *aff'd*, 112 F. Supp. 3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *vacated and remanded, Pro Football, Inc. v. Blackhorse*, 709 F. App'x 183 (per curiam) (4th Cir. 2018) (mem.); *UMG Recordings Inc. v. Matte, Inc.*, 100 USPQ2d 1868, 1874, 1879 n.12 (TTAB 2011) (dictionary definition - yes; web pages from websites - no); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011) (information from encyclopedias - yes), *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); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1075 n.17 (TTAB 2011) (dictionary definitions - yes); *Enbridge Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1542 n.9 (TTAB 2009) (phrase with a

possible industry specific-meaning and where the parties have not set forth and addressed a single, definable meaning - no); *UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1046 (TTAB 2009) (registration issuing from pleaded application after applicant's trial brief had been filed, although copy of application was of record - no); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 (TTAB 2009) (definitions from an online source which does not indicate it is the electronic version of a printed reference work but are consistent with definitions in "a more traditional reference source" - yes); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590 n.8 (TTAB 2008) (online reference works which exist in printed format or have regular fixed editions - yes); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1723 (TTAB 2008) (items of outerwear and undergarments are related - no); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1889 (TTAB 2008) (the licensing of commercial trademarks on "collateral products" has become a part of everyday life - yes); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007) (third-party registrations mentioned in trial brief - no); *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1192 n.9 (TTAB 2007) (current status of registration owned by party properly made of record, when status of registration changed between time made of record and time case decided - yes; Office assignment records reflecting current ownership - yes); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1485 (TTAB 2007) (number of applications and registrations in applicant's name - no); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378, 1379 n.7 (TTAB 2006) (dictionary definitions - yes; "scholarly reviews" of an essay at several websites - no); *Motion Picture Association of America Inc. v. Respect Sportswear Inc.*, 83 USPQ2d 1555, 1558 (TTAB 2007) (results from Internet search engines and from eBay website - no); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1931 n.26 (TTAB 2006) (third-party website materials - no); *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988) (dictionary definition of term as trademark - yes, indicates mark is reasonably famous; also, encyclopedias may be consulted); *Wella Corp. v. California Concept Corp.*, 192 USPQ 158 (TTAB 1976), *rev'd on other grounds*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977) (home cold permanent wave kits have for many years been sold directly to nonprofessional consumers through retail outlets - yes); *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1605 (TTAB 1999) (statements regarding race relations pleaded in the complaint - no); *In re Wada*, 48 USPQ2d 1689, 1689 n.2 (TTAB 1998) (there are thousands of registered marks incorporating the term NEW YORK for goods and services that do not originate there - no), *aff'd*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982) (dictionary definitions - yes), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002) (online dictionary definition where resource was also available in book form - yes); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001) (dictionary entries and other standard reference works - yes); *In re 3Com Corp.*, 56 USPQ2d 1060, 1061 n.3 (TTAB 2000) (dictionary definitions and technical reference works, e.g., computer dictionary - yes).

Cases issued before 2000: *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 (TTAB 1999) (dictionary definitions judicially noticed although not made of record by either party); *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999) (online dictionaries which otherwise do not exist in printed format - no); *In re Astra Merck Inc.*, 50 USPQ2d 1216, 1219 (TTAB 1998) ("Physicians' Desk Reference" - yes); *In re U.S. Cargo Inc.*, 49 USPQ2d 1702, 1704 (TTAB 1998) ("U.S." means the United States, which is a geographic area with defined boundaries - yes); *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998) (third-party registrations - no); *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1229 n.6 (TTAB 1989) (Catonsville, Maryland is located between Baltimore, Maryland and Washington, DC - yes); *Los Angeles Bonaventure Co. v. Bonaventure Associates*, 4 USPQ2d 1882, 1884 (TTAB 1987) (whether other companies have expanded from restaurant services to hotel services under a single mark, and, if so, when - no); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1293 (TTAB 1986) (files of applications and/or registrations, where no copies thereof are filed, and where they are not the subject of the proceeding - no); *Omega SA v. Compucorp*, 229 USPQ 191, 192 n.6 (TTAB 1985)

(presumptions concerning the significance in trade of certain terms - no); *Hertz System, Inc. v. A-Drive Corp.*, 222 USPQ 625, 630 n.14 (TTAB 1984) (the numeral "1" is widely used to indicate superiority - yes); *Hamilton Burr Publishing Co. v. E.W. Communications, Inc.*, 216 USPQ 802, 804 n.5 (TTAB 1982) (probation report - no); *Abbott Laboratories v. Tac Industries, Inc.*, 217 USPQ 819, 823 (TTAB 1981) (use of antimicrobial agents in the floor covering industry - no); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n.7 (TTAB 1981) (dictionary definitions - yes); *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88, 95 n.3 (TTAB 1980) (standard reference works - yes); *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493, 495 (TTAB 1978) (third-party registrations and listings in trade directories, where no copies thereof are submitted - no); *Plus Products v. Sterling Food Co.*, 188 USPQ 586, 589 (TTAB 1975) (food supplements and fortifiers are commonly used in producing bakery products - yes); *Bristol-Myers Co. v. Texize Chemicals, Inc.*, 168 USPQ 670, 671 (TTAB 1971) (operations of opposer and applicant - no).

704.12(b) When Taken

The Board will take judicial notice of a relevant fact not subject to reasonable dispute, as defined in Fed. R. Evid. 201(b), if a party (1) requests that the Board do so, and (2) supplies the necessary information. [Note 1.] The request should be made during the requesting party's testimony period, by notice of reliance accompanied by the necessary information. [Note 2.] The Board, in its discretion, may take judicial notice of a fact not subject to reasonable dispute, as defined in Fed. R. Evid. 201(b), whether or not it is requested to do so. [Note 3.]

NOTES:

1. Fed. R. Evid. 201(c). *See International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *17 n.115 (TTAB 2020) (request to take judicial notice of the definition of "gruyere" from Encyclopedia Britannica denied for failure to submit a copy of the webpage containing the entry where instead only web address provided), appeal filed, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020); *Omaha Steaks International, Inc. v. Greater Omaha Packing Co., Inc.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (party requesting judicial notice be taken must provide the necessary information); *United States National Bank of Oregon v. Midwest Savings and Loan Association*, 194 USPQ 232, 235 (TTAB 1977); *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431, 433 (TTAB 1976).

2. *See Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431, 434 (TTAB 1976). *See also Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769, 770 n.5 (TTAB 1985); *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88, 95 n.3 (TTAB 1980).

3. Fed. R. Evid. 201(c). *See Performance Open Wheel Racing, Inc. v. United States Auto Club Inc.*, 2019 USPQ2d 208901, at *4 n.34 (TTAB 2019) (Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1037 n.14 (TTAB 2010) (same); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) (Board takes judicial notice of dictionary definitions); *Boswell v. Mavety Media Group Ltd*,, 52 USPQ2d 1600, 1603 (TTAB 1999) (declined to take judicial notice of slang dictionary definition when submitted as part of rebuttal testimony when could have been submitted with case in chief); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982) (Board takes judicial notice of dictionary definitions), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *United States National Bank of Oregon v. Midwest Savings and Loan Association*, 194 USPQ 232, 235 (TTAB 1977); *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431, 433 (TTAB 1976).

704.12(c) Opportunity to be Heard

A party to a proceeding before the Board is entitled, on timely request, "to be heard on the propriety of taking judicial notice and the nature of the fact to be noticed. If the court takes judicial notice before notifying a party, the party, on request, is still entitled to be heard." [Note 1.] This does not mean, however, that when judicial notice is taken without prior notification, a party is automatically entitled to a hearing on request, even if it makes no offer to show that the taking of judicial notice was improper. [Note 2.]

NOTES:

1. Fed. R. Evid. 201(e). *See Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 431, 433-34 (TTAB 1976).

2. *See In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 n.6 (Fed. Cir. 1983). *See also Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (party can waive right to contest judicial notice if it does not request to be heard at the time), *aff'g* 204 USPQ 396, 401 n.5 (TTAB 1979) (where the Board took judicial notice of certain facts outside the record).

704.12(d) Time of Taking Notice

Judicial notice may be taken at any stage of a Board proceeding, even on review of the Board's decision on appeal. [Note 1.] However, the Federal Circuit may decline to consider a request for judicial notice made at the late stage of oral argument on appeal. [Note 2.]

NOTES:

1. *See, e.g.*, Fed. R. Evid. 201(d); *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (request for judicial notice as to fame of mark made in the briefs on appeal); *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988) (judicial notice of banking business on appeal); *American Security Bank v. American Security and Trust Co.*, 571 F.2d 564, 197 USPQ 65, 67 n.1 (CCPA 1978) (judicial notice of absence of listing in local telephone directories); *Wella Corp. v. California Concept Corp.*, 192 USPQ 158 (TTAB 1976), *rev'd* on other grounds, 558 F.2d 1019, 194 USPQ 419, 422 n.5 (CCPA 1977) (fact of common knowledge, e.g., of purchasers and channels of trade for home permanent wave kits, appropriate for judicial notice); *Food Specialty Co. v. Kal Kan Foods, Inc.*, 487 F.2d 1389, 180 USPQ 136, 139 n.3 (CCPA 1973) (judicial notice on appeal of general sentiment towards kittens which differs from that toward other small animal pets); *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 n.5 (TTAB 1999) (judicial notice may be taken at any time).

2. *See Packard Press Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000) (Court declined to consider whether to take judicial notice of fame where request for judicial notice was made for first time at oral argument on appeal).

704.13 Testimony From Another Proceeding

37 C.F.R. § 2.122(f) ***Testimony from other proceedings.*** *By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject,*

however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.

On motion granted by the Board, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or their privies, may be used in a pending Board inter partes proceeding, to the extent that the testimony is relevant and material, subject "to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony." [Note 1.]

The Board has construed the term "testimony," as used in 37 C.F.R. § 2.122(f), as meaning only trial testimony [Note 2], or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding. The purpose of the rule is to offer a party a means for introducing testimony from a prior proceeding without having to call a witness to authenticate the testimony, thereby allowing a party a relatively quick and simple means by which to introduce testimony from another proceeding into evidence. It is not intended as specifying the only means by which oral or written statements from another proceeding can be introduced at trial in a Board proceeding. [Note 3.]

Testimony from another proceeding between the parties or their privies may be used, on motion granted by the Board, as evidence in connection with a motion for summary judgment, or as evidence at trial. [Note 4.] However, when the Board allows testimony of this nature to be used in connection with a motion for summary judgment, the testimony (and any testimony taken on recall of the same witness for examination or cross-examination, or in rebuttal thereof) is of record only for purposes of the motion; it will not be considered at final hearing if the case goes to trial, unless it is reintroduced, on motion granted by the Board, during the appropriate trial period. *See*TBMP § 528.05(a) and TBMP § 528.05(f).

For information on filing a motion for leave to use testimony from another proceeding, see TBMP § 530.

Testimony from another proceeding may also be made of record in a Board proceeding by stipulation of the parties approved by the Board. The same is true of a discovery deposition.

NOTES:

1. 37 C.F.R. § 2.122(f). *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1317 (TTAB 1992) (stating that there is no prerequisite that the Board must have considered the testimony or determined the relevancy in the prior opposition, or that the adverse party actually attended the deposition when originally taken); *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 9 USPQ2d 1061, 1063 n.2 (TTAB 1988) (motion to use testimony from prior district court proceeding granted as uncontested and right to recall the witness waived since no request to do so was made), *rev'd on other grounds*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989); *Oxy Metal Industries Corp. v. Technic, Inc.*, 189 USPQ 57, 58 (TTAB 1975) (motion to rely on testimony from prior cancellation proceeding between the parties granted, subject to applicant's right to recall witnesses), *summary judgment granted*, 191 USPQ 50 (TTAB 1976); *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440 (TTAB 1973).

2. *See Threshold.TV Inc. v. Metronome Enterprises Inc.*, 96 USPQ2d 1031, 1035 n.8 (TTAB 2010) (the term "testimony," as used in Trademark Rule 2.122(f), has been construed to mean only trial testimony, or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding); *Marcon Ltd. v. Avon Products Inc.*, 4 USPQ2d 1474, 1475 n.3 (TTAB 1987) (discovery deposition from previous proceeding to which applicant was not a party would not be admissible under this rule, but in this case, it was made of record by another means); *Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*,

230 USPQ 172, 182 (TTAB 1986) (*cf.* dissent at 182 n.13 contending that discovery deposition should have been admitted as admission against interest).

3. *Threshold.TV Inc. v. Metronome Enterprises Inc.*, 96 USPQ2d 1031, 1035 (TTAB 2010).

4. *See, e.g., Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1467 n.4 (TTAB 2016) (motions for leave to use testimony and evidence introduced in a civil action granted as uncontested); *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 9 USPQ2d 1061, 1063 n.2 (TTAB 1988) (evidence on the case); *Oxy Metal Industries Corp. v. Technic, Inc.*, 189 USPQ 57, 58 (TTAB 1975) (summary judgment evidence).

704.14 Initial Disclosures and Disclosed Documents

37 C.F.R. § 2.120(k) ***Use of discovery deposition, answer to interrogatory, admission or written disclosure.***

(3)(i) *A discovery deposition, an answer to an interrogatory, an admission to a request for admission, or a written initial disclosure, which may be offered in evidence under the provisions of paragraph (k) of this section, may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), or a copy of the written initial disclosure, together with a notice of reliance in accordance with § 2.122(g). The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party that files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.*

(ii) *A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e), or the party has obtained an admission or stipulation from the producing party that authenticates the documents.*

* * * *

(5) *Written disclosures, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record only by the receiving or inquiring party except that, if fewer than all of the written disclosures, answers to interrogatories, or fewer than all of the admissions, are offered in evidence by the receiving or inquiring party, the disclosing or responding party may introduce under a notice of reliance any other written disclosures, answers to interrogatories, or any other admissions, which should in fairness be considered so as to make not misleading what was offered by the receiving or inquiring party. The notice of reliance filed by the disclosing or responding party must be supported by a written statement explaining why the disclosing or responding party needs to rely upon each of the additional written disclosures or discovery responses listed in the disclosing or responding party's notice, and absent such statement, the Board, in its discretion, may refuse to consider the additional written disclosures or responses.*

(6) *Paragraph (k) of this section will not be interpreted to preclude reading or use of written disclosures or documents, a discovery deposition, or answer to an interrogatory, or admission as part of the examination or cross-examination of any witness during the testimony period of any party.*

(7) *When a written disclosure, a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, or an authenticated and produced document has been made of record by one party in accordance with the provisions of paragraph (k)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

(8) *Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board,*

except when submitted with a motion relating to disclosure or discovery, or in support of or in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.

A written initial disclosure which may be offered in evidence under 37 C.F.R. § 2.120(k)(3)(i) may be made of record by filing a copy of the written disclosure with a notice of reliance. [Note 1.] The notice of reliance and the material submitted should be filed during the testimony period of the party that files the notice of reliance. [Note 2.]

Disclosed documents, if provided in lieu of descriptions of documents, may be introduced at trial by a notice of reliance but only if otherwise appropriate for such filing pursuant to 37 C.F.R. § 2.122(e), or the party has obtained an admission or stipulation from the producing party that authenticates the documents. [Note 3.] *See*TBMP § 704.07 and TBMP § 704.08. In essence, initial written disclosures and initial disclosures of documents will be treated like responses to written discovery requests. [Note 4.]

Written disclosures may be submitted and made part of the record only by the receiving or inquiring party except that, if fewer than all of the written disclosures are offered in evidence by the receiving or inquiring party, the disclosing or responding party may introduce under a notice of reliance any other written disclosures which should in fairness be considered so as to make not misleading what was offered by the receiving or inquiring party. The notice of reliance filed by the disclosing or responding party must comply with the requirements set forth in 37 C.F.R. § 2.122(g) and also be supported by a written statement explaining why the disclosing or responding party needs to rely upon each of the additional written disclosures or discovery responses listed in the disclosing or responding party's notice, and absent such statement the Board, in its discretion, may refuse to consider the additional written disclosures or responses. [Note 5.]

The Board will not interpret 37 C.F.R. § 2.120(k) to preclude the reading or use of written disclosures or documents as part of the examination or cross-examination of any witness during the testimony period of any party. [Note 6.]

When a written disclosure or a part thereof has been made of record by one party in accordance with the provisions of 37 C.F.R. § 2.120(k)(3), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. [Note 7.]

Written disclosures or disclosed documents should not be filed with the Board, except when submitted with a motion relating to disclosure or discovery, or in support of or in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period. [Note 8.]

Please Note: Effective January 14, 2017, former subsection (j) of 37 C.F.R. § 2.120 was amended and redesignated as 37 C.F.R. § 2.120(k).

NOTES:

1. 37 C.F.R. § 2.120(k)(3)(i). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("The Office is amending renumbered § 2.120(k)(3)(i) to clarify that the disclosures referenced are initial disclosures, to remove the exclusion of disclosed documents, and to incorporate a reference to new § 2.122(g)."); *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1788 n.5 (TTAB 2018) (initial disclosures not admissible evidence unless submitted at trial under notice of reliance, where appropriate, or through testimony); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1956 (TTAB 2008); *Syngenta Crop Protection, Inc. v. Bio-Chek*, LLC, 90 USPQ2d 1112, 1117 (TTAB 2005).

2. 37 C.F.R. § 2.120(k)(3)(i).

3. 37 C.F.R. § 2.120(k)(3)(ii). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69962 (October 7, 2016) ("The Office is amending renumbered § 2.120(k)(3)(ii) to add that a party may make documents of record by notice of reliance alone if the party has obtained an admission or stipulation from the producing party that authenticates the documents. This amendment is consistent with the amendment in renumbered § 2.120(i) permitting a party to make one comprehensive request for an admission authenticating specific documents produced by an adverse party.").

4. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008).

5. 37 C.F.R. § 2.120(k)(5). *See* 37 C.F.R. § 2.122(g) and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) ("The Office is adding new § 2.122(g) detailing the requirement for admission of evidence by notice of reliance. Section 2.122(g) provides that a notice must indicate generally the relevance of the evidence offered and associate it with one or more issues in the proceeding, but failure to do so with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order. The amendment codifies current case law and Office practice."),

6. 37 C.F.R. § 2.120(k)(6).

7. 37 C.F.R. § 2.120(k)(7). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.122(a), consistent with § 2.120(k)(7), to add that when evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. The amendments codify current Office practice."). *Cf. Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 129 USPQ2d 1027, 1030 n.29 (TTAB 2018) (party may rely on testimony from a discovery deposition already made of record by adverse party-no need to resubmit), *reversed and remanded on other grounds*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020) , *petition for rehearing en banc denied*, 2020 USPQ2d 11438 (Fed. Cir. 2020); *Anheuser-Busch, Inc. v. Major Mud & Chemical Co.*, 221 USPQ 1191, 1192 n.7 (TTAB 1984) (once filed, testimony depositions are of record for both parties for all relevant purposes; adversary's discovery responses, once filed, are considered to be in evidence for both parties for all purposes permitted by the Federal Rules of Evidence).

8. 37 C.F.R. § 2.120(k)(8). *See TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1788 n.5 (TTAB 2018) (initial disclosures should not be filed as a matter of course; initial disclosures are not admissible evidence unless they are submitted at trial under notice of reliance, where appropriate, or through testimony); *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1542 n.3 (TTAB 2008).

705 Stipulated Evidence and Accelerated Case Resolution (ACR)

37 C.F.R. § 2.127(e)(2). *If any motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion be considered at trial as trial evidence, which may be supplemented by additional evidence during trial.*

Subject to the approval of the Board, parties may enter into a wide variety of stipulations concerning the admission of specified matter into evidence. The parties may even stipulate to the entire trial record. [Note

1.] The use of stipulated evidence normally results in savings of time and expense for all concerned. Notwithstanding such a stipulation, a party may reserve the right to object to stipulated evidence on the grounds of competency, relevance, and materiality. [Note 2.] However, if a party has not reserved the right to object, the party may not later raise objections to that evidence once it has stipulated to the admissibility of that evidence. [Note 3.]

For example, parties may stipulate that a party may rely on specified responses to requests for discovery, or on other specified documents or exhibits; or what a particular witness would testify to if called; or to the facts in the case of any party; or that a discovery deposition may be used as testimony; or that evidence from another proceeding may be used as evidence in the proceeding in which the stipulation is filed. [Note 4.] Parties may also stipulate that materials submitted with summary judgment briefs be considered at trial as evidence which may be supplemented as additional evidence during trial. [Note 5.] See TBMP § 704.07, TBMP § 704.08, TBMP § 704.09, TBMP § 704.10, and TBMP § 704.11 for a discussion of various types of evidence, and TBMP § 703.01(b) regarding the testimony of witnesses.

In certain cases where the parties have entered into certain stipulations, the Board may allow the parties to participate in Accelerated Case Resolution (ACR). *See*TBMP § 528.05(a)(2) and TBMP § 702.04. Generally, parties will stipulate to ACR during the pleading or discovery phase of a Board inter partes proceeding to obtain a pretrial final disposition on the merits in lieu of summary judgment or to have an abbreviated trial on the merits. However, parties may stipulate to ACR-type efficiencies at any stage of a proceeding in order to expedite the remainder of the trial schedule. Parties seeking to avail themselves of such efficiencies may stipulate to, for example, abbreviating the length of the testimony period; limiting the subject matter for testimony; agreeing to limit the number of witnesses; or agreeing to streamline the method of introduction of evidence, for example, by stipulating to facts. [Note 6.] While many of the changes to the Board's rules in 2017 were adopted with an eye towards smoother and more efficient inter partes proceedings, parties are encouraged to continue to explore whether ACR is useful to them, and to craft stipulations that work for them and accelerate the timing of the Board's final decision. [Note 7.]

This section is intended to provide a brief overview of stipulated evidence and ACR. For more detailed information and recent cases, see TBMP § 528.05(a)(2) and TBMP § 702.04.

NOTES:

1. *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties stipulated to the entire record in the case including business records, public records, government documents, marketing materials, materials obtained from the Internet, and 13 paragraphs of facts involving such issues as applicant's dates of first use and the extent and manner in which a designation is used and advertised, the channels of trade for such use, and recognition by third parties of such use; and the dates, nature and extent of descriptive uses of designation by opposer's parent company).

2. *See Blackhorse v. Pro-Football Inc.*, 111 USPQ2d 1080, 1084-85 (TTAB 2014) (parties stipulated that the record of a prior proceeding may be submitted into evidence under notice of reliance, reserving the right to object based on relevance), *aff'd*, 112 F. Supp. 3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *vacated and remanded*, 709 F. App'x 183 (4th Cir. 2018) (mem.); *UMG Recordings Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1875 (TTAB 2011) (stipulated evidence subject to objection); *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007).

3. *See Blackhorse v. Pro-Football Inc.*, 111 USPQ2d 1080, 1088 (TTAB 2014) (petitioner estopped from objection to certain evidence on any basis except relevance because it falls within the parties' stipulation), *aff'd*, 112 F. Supp. 3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *vacated and remanded*, *Pro Football, Inc.*

v. Blackhorse, 709 F. App'x 183 (per curiam) (4th Cir. 2018) (mem.); *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2009) (by stipulating affidavit and exhibits thereto into evidence, applicant waived its right to object to the admissibility of exhibits attached to affidavit), *aff'd on other grounds*, *Creative Arts by Calloway, LLC v. Brooks*, No. 09-cv-10488 (S.D.N.Y. Dec. 27, 2012), *dismissed*, slip op. No. 13-147 (2d Cir. March 7, 2013). *Cf. UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1875 (TTAB 2011) (counterproductive for applicant to object to the submission of evidence to which it already provided a stipulation for introduction).

4. *See* 37 C.F.R. § 2.123(b). *See, e.g.*, *Hanscomb Consulting, Inc. v. Hanscomb Ltd.*, 2020 USPQ2d 10085, at *2 (TTAB 2020) (parties stipulated to treat discovery responses and documents produced in earlier Board proceeding as discovery responses and documents produced in response to discovery requests in present Board proceeding); *Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *1 n.5 (TTAB 2019) (parties stipulated to treat discovery responses provided in prior federal civil action as responses to discovery propounded in Board proceeding, and to introduce the discovery depositions of certain witnesses taken in the Board proceeding as trial testimony in lieu of taking their testimonial depositions); *N.Y. Yankees Partnership v. IET Products & Services, Inc.*, 114 USPQ2d 1497, 1500 (TTAB 2015) (parties stipulated that witness testimony would be submitted solely by declaration and without cross-examination); *Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913, 1916 (TTAB 2015) (parties filed ACR stipulation, agreed to forego discovery, waived disclosures, stipulated to facts and attached documents, filed briefs with additional evidence, and allowed option to opt out); *Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1304 (TTAB 2014) (ACR on cross-motions for summary judgment stipulated to likelihood of confusion limited issue to priority); *Inter IKEA Systems B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1738 (2014) (parties filed joint stipulation that all documents produced in response to a request for production of documents were deemed authentic business records and were admissible subject to any objections other than authenticity); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1950 (TTAB 2014) (after suggestion by Board in order denying motion for summary judgment, parties stipulated to forego trial and rely on evidence submitted in support of the motions for summary judgment, supplemented by expert declarations, trial briefs and an oral hearing), *vacated and remanded on other grounds*, *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015), *original decision aff'd*, *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 124 USPQ2d 1184 (TTAB 2017), *appeal dismissed without prejudice sub nom. Snyder's-Lance, Inc. v. Frito-Lay North America, Inc.*, 414 F. Supp. 3d 822, 2019 USPQ2d 401574 (W.D.N.C. 2019), *reversed and remanded on other grounds*, 991 F.3d 512 (4th Cir. 2021); *Miller v. Miller*, 105 USPQ2d 1615, 1617 n.6 (TTAB 2013) (parties stipulated to testimony by affidavit and provided a stipulation of undisputed facts); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1435 n.2 (TTAB 2012) (parties stipulated to testimony by declaration); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1873 (TTAB 2011) (parties stipulated to submission of testimony via declaration, submission by notice of reliance of evidence from another case, and submission of information and documents provided by either party during discovery); *Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (with specified exceptions, parties stipulated that all evidence submitted in a previous case by notice of reliance shall be admissible in instant proceeding by a notice of reliance); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1563 (TTAB 2011) (parties stipulated to authenticity of produced documents and to the introduction of testimony in affidavit or declaration form, with certain guidelines), *rev'd on other grounds*, slip op, No. 11-3684 (D.N.J. August 29, 2017); *Kistner Concrete Products Inc. v. Contech Arch Technologies Inc.*, 97 USPQ2d 1912, 1915 (TTAB 2011) (parties stipulated to authenticity of produced documents).

5. 37 C.F.R. § 2.127(e)(2). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69967 (October 7, 2016) ("The Office is amending § 2.127(e)(2) to add that if a motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion be considered at trial as trial evidence, which may be supplemented by additional

evidence during trial. The revision codifies an approach used by parties in proceedings incorporating ACR-type efficiencies at trial."); *Milwaukee Electric Tool Corp. v. Freud America, Inc.*, 2019 USPQ2d 460354, at *2 (TTAB 2019) (parties stipulated to admissibility of certain declarations and exhibits submitted by each party on summary judgment), *complaint filed*, No. 20-cv-109 (M.D.N.C. Feb. 3, 2020); *Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial).

6. *See Gemological Institute of America, Inc. v. Gemology Headquarters International, LLC*, 111 USPQ2d 1559, 1561 (TTAB 2014) (parties' stipulation provided for the admission into evidence of specific dated expert reports and accompanying exhibits and an expert discovery deposition transcript); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1426 (TTAB 2014) (stipulation to submission of witness declarations and discovery depositions, the authenticity of certain documents, retail prices of opposers' goods, the fact that advertisements and news articles refer to opposers, and press clippings are representative of the media in which opposers advertise); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1653 (TTAB 2014) (parties' stipulation under ACR provided limitations on discovery, excluded the filing of motions for summary judgment and the use of expert testimony, streamlined the methods for introduction of evidence during trial, stipulated to fact regarding no actual confusion), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016); *Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1186 (TTAB 2014) (stipulation to the admission and use of certain produced documents and waiver of objections based on authenticity or hearsay as to those documents); *Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775 (TTAB 2013) (parties' ACR agreement included stipulation of undisputed facts); *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1547 (TTAB 2012) (parties filed a joint stipulation of undisputed facts); *Brooks v. Creative Arts by Calloway, LLC*, 93 USPQ2d 1823, 1824 (TTAB 2009) (parties stipulated to 14 paragraphs of facts, submission of testimony of certain witnesses in declaration form, and that sole issue to be decided at final hearing was priority), *aff'd on other grounds*, *Creative Arts by Calloway, LLC v. Brooks*, No. 09-cv-10488 (S.D.N.Y. Dec. 27, 2012), *dismissed*, slip op. No. 13-147 (2d Cir. March 7, 2013); *Eveready Battery Co. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties stipulated that evidence submitted in connection with summary judgment motion be deemed of record for trial pursuant to Accelerated Case Resolution (ACR)); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676 (TTAB 2007) (parties stipulated to 13 paragraphs of facts); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (parties stipulated that evidence submitted in connection with summary judgment motion be deemed of record for trial). *Cf. UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1873 (TTAB 2011) (efficiencies realized by stipulations defeated by submission of excessive records).

7. *See TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1412 (TTAB 2018) (highlighting continued utility of ACR following 2017 rules changes).

706 Noncomplying Evidence

37 C.F.R. § 2.123(k) ***Evidence not considered.*** *Evidence not obtained and filed in compliance with these sections will not be considered.*

Evidence not obtained and filed in compliance with the rules of practice governing inter partes proceedings before the Board will not be considered by the Board. [Note 1.]

Please Note: Effective January 14, 2017, former subsection (l) of 37 C.F.R. § 2.123 was amended and redesignated as 37 C.F.R. § 2.123(k).

NOTES:

1. 37 C.F.R. § 2.123(k). *See International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *7-8 (TTAB 2020) (nonconforming evidence consisting of documents in whole or in part in a foreign language without an English translation and materials bearing web addresses without a copy of the corresponding web pages not considered by the Board), *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020); *Grote Industries, Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1200 (TTAB 2019) (Board requires all submissions to be on paper or filed through ESTTA; materials submitted on two compact discs during testimony period not considered), complaint filed, No. 18-CV-599-LJV-MJR (W.D.N.Y. May 4, 2018); *Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1654 (TTAB 2014) (evidence submitted on flash drive stricken from record, parties may not by agreement override 37 C.F.R. § 2.126 provisions prescribing form of submission), *appeal dismissed per stipulation*, No. 14-CV-4463 (D. Minn. Jan. 20, 2016); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1846 n.8 (TTAB 2004) (materials submitted outside of applicant's assigned testimony period and which failed to comply with the Board's evidentiary rules given no consideration); *The Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 748 (TTAB 1986) (collection of twenty-nine registrations listed in appendix to brief not considered because not in compliance with rules of practice); *Original Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) (stating that a party may not reasonably presume evidence is of record when that evidence is not offered in accordance with the rules); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1009 n.18 (TTAB 1984) (copy of decision by Canadian Opposition Board attached to main brief and not otherwise properly made of record was not considered); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 391 n.10 (TTAB 1976) (evidence submitted for first time with brief not considered); *Plus Products v. General Mills, Inc.*, 188 USPQ 520, 521 n.1 (TTAB 1975) (evidence submitted after filing of reply brief not considered); *American Skein & Foundry Co. v. Stein*, 165 USPQ 85, 85 (TTAB 1970) (discovery deposition timely filed but not accompanied by notice of reliance not considered).

707 Objections to Evidence

707.01 In General

37 C.F.R. § 2.122(a) ***Applicable rules.*** *Unless the parties otherwise stipulate, the rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this part. When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.*

The introduction of evidence in inter partes proceedings before the Board is governed by the Federal Rules of Evidence, the relevant portions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the rules of practice in trademark cases (i.e., the provisions of Part 2 of Title 37 of the Code of Federal Regulations). [Note 1.] A party to a Board inter partes proceeding that believes that proffered evidence should, under these rules, be excluded from consideration, may raise an objection. The procedure for raising an objection to proffered evidence depends on the nature of the evidence and the ground for objection. [Note 2.]

As a general proposition, where ordinarily inadmissible hearsay evidence is admitted into evidence without objection, it may be considered for whatever probative value the finder of fact chooses to give it. [Note 3.] When parties specifically agree to waive hearsay objections, the Board may rely on the evidence for the truth of the matter asserted. [Note 4.]

The Board is entitled to weigh the evidence [Note 5], and has the discretion on how it considers evidentiary objections, especially in cases where numerous objections have been lodged or the objections are not outcome determinative. [Note 6.]

An objection that is first raised in a reply brief is untimely. [Note 7.]

See TBMP § 801.02(c) for information about reply briefs.

NOTES:

1. 37 C.F.R. § 2.122(a).

2. *See generally Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *3-9 (TTAB 2020); *see also Societe Des Produits Nestle S.A. v. Taboada*, 2020 USPQ2d 10893, at *7 (TTAB 2020) (objection that evidence was not adequately disclosed in pretrial disclosures overruled as untimely and waived when first raised in trial brief; objection is curable and should have been made via motion to strike promptly after testimony declaration and exhibits were filed), *appeal filed*, No. 3:20-cv-00400-MHL (E.D. Va. June 5, 2020).

3. *See, e.g., Daniel J. Quirk Inc. v. Village Car Company*, 120 USPQ2d 1146 (TTAB 2016); *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1746 n.9 (TTAB 1987); *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1582 n.4 (TTAB 1987).

4. *Daniel J. Quirk Inc. v. Village Car Company*, 120 USPQ2d 1146 (TTAB 2016); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1086 (TTAB 2014), *aff'd*, 112 F. Supp. 3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *vacated and remanded*, *Pro Football, Inc. v. Blackhorse*, 709 F. App'x 183 (per curiam) (4th Cir. 2018) (mem.). *Cf. Optimal Chemical Inc. v. Srills LLC*, 2019 USPQ2d 338409, at *14 n.90 (TTAB 2019) (Board considered Internet evidence for the truth of the matters asserted where the petitioner did not object and opined on its accuracy in its rebuttal testimony and rebuttal brief).

5. *See Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1378 (Fed. Cir. 2018) ("The TTAB is entitled to weigh the evidence …") (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 856, 214 USPQ 1, 7 (1982) ("Determining the weight and credibility of the evidence is the special province of the trier of fact.")).

6. *See International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *3, *7 (TTAB 2020) (Board declined to rule on applicant's 150 individual evidentiary objections; instead ruling on only a selected few), *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020); *Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *2 (TTAB 2020) ("Board proceedings are heard by Administrative Trademark Judges, not lay jurors who might easily be misled, confused, or prejudiced by irrelevant evidence"); *Hanscomb Consulting, Inc. v. Hanscomb Ltd.*, 2020 USPQ2d 10085, at *3 (TTAB 2020) (Board is "capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence, including any inherent limitations"); *AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at *4 (TTAB 2020) (same); *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *3 (TTAB 2019) (same); *M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd.*, 2019 USPQ2d 149090, at *3 (TTAB 2019) (same); *Norris v. PAVE: Promoting Awareness, Victim Empowerment*, 2019 USPQ2d 370880 at *1-2 (TTAB 2019) (same); *Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, at *4 (TTAB 2019) (Board is capable of assessing the proper evidentiary weight to be accorded the testimony and evidence,

including its imperfections and admissibility, and according it whatever probative value it may have); *Pierce-Arrow Society v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at *3 (TTAB 2019) (Board saw no compelling reason to individually address the objections of hearsay, lack of personal knowledge, lack of authentication, irrelevance, and lack of foundation but kept the objections in mind when considering the testimony and evidence, and according appropriate value to the testimony and evidence according to its merits); *Milwaukee Electric Tool Corp. v. Freud America, Inc.*, 2019 USPQ2d 460354, at *4 (TTAB 2019) (declining to individually address numerous objections that go to weight rather than admissibility, noting that the Board is capable of weighing the relevance or the strength or weakness of the evidence and according it appropriate probative value), *complaint filed*, No. 20-cv-109 (M.D.N.C. Feb. 3, 2020); *Grote Industries, Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1200 (TTAB 2018) ("[O]ur proceedings are tried before judges not likely to be easily confused or prejudiced. Objections to trial testimony on bases more relevant to jury trials are particularly unnecessary in this forum."), *complaint filed*, No. 18-CV-599-LJV-MJR (W.D.N.Y. May 4, 2018); *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1804 (TTAB 2018) ("the Board is capable of weighing the relevance and strength or weakness of the objected to testimony and evidence, including any inherent limitations"), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1478 (TTAB 2017) (where parties devoted more than 30 pages of their briefing at final hearing to numerous detailed evidentiary objections, Board exercised discretion to rule explicitly only on major objections); *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1510 (TTAB 2017) ("we choose not to make specific rulings on each and every objection"); *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017), *appeal dismissed per stipulation*, No. 17-00345 (E.D. Va. August 24, 2017); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1737 (TTAB 2014); *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1755 (TTAB 2013), *aff'd* , 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007); *Hunt Control Systems Inc. v. Koninkijke Philips Elecs. N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011) ("Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations, and this precludes the need to strike the testimony and evidence."); *U.S. Playing Card Co. v. Harbro LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006) ("[B]ecause an opposition is akin to a bench trial, the Board is capable of assessing the proper evidentiary weight to be accorded the testimony and evidence, taking into account the imperfections surrounding the admissibility of such testimony and evidence."). *Cf. Harris v. Rivera*, 454 U.S. 339, 346 (1981) ("In bench trials, judges routinely hear inadmissible evidence that they are presumed to ignore when making decisions.").

7. *See Grote Industries, Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1199 (TTAB 2018) ("Objections raised for the first time in a reply brief are untimely because they effectively foreclose the adverse party from responding to the objections."), *complaint filed*, No. 18-CV-599-LJV-MJR (W.D.N.Y. May 4, 2018). *Cf. Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1927 (TTAB 2011) (objection on the basis that the witness had not been previously disclosed waived where not renewed in main brief and raised for first time in rebuttal brief), *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) (objection raised at trial waived when petitioner waited until its reply brief to renew objections).

707.02 Objections to Notices of Reliance

707.02(a) In General

During its testimony period, a party may make certain specified types of evidence of record by filing a notice of reliance thereon, accompanied by the evidence being offered. *See generally* TBMP § 702 and TBMP §

704. 37 C.F.R. § 2.120(k)(3)(i) provides for the introduction, by notice of reliance, of a discovery deposition, an answer to an interrogatory, an admission to a request for admission, or written initial disclosure; but 37 C.F.R. § 2.120(k)(3)(ii) specifically states that documents obtained through disclosure or by production under Fed. R. Civ. P. 34 may not be made of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of 37 C.F.R. § 2.122(e), or the party has obtained an admission or stipulation from the producing party that authenticates the documents. 37 C.F.R. § 2.122(d)(2) provides for the introduction, by notice of reliance, of a registration owned by a party to a proceeding. 37 C.F.R. § 2.122(e) provides for the introduction, by notice of reliance, of certain specified types of printed publications and official records. *Cf.*TBMP § 101.01 and TBMP § 101.02. *See also*TBMP § 704.03(b), TBMP § 704.07, TBMP § 704.08, TBMP § 704.09, TBMP § 704.10, and TBMP § 704.11 discussing introduction of other types of evidence by notice of reliance.

Some grounds for objection to a notice of reliance are waived unless promptly made (generally errors of any kind which might be obviated or cured if promptly presented) while other grounds that cannot be cured may be raised at any time. The various grounds for objection to a notice of reliance, and the time and procedure for raising them, are discussed in the sections that follow. *See also*TBMP § 707.04.

707.02(b) On Procedural Grounds

Ordinarily, a procedural objection to a notice of reliance should be raised promptly, preferably by motion to strike if the defect is one that can be cured. [Note 1.] However, if the ground for the objection is one that could not be cured even if raised promptly, the adverse party may wait and raise the procedural objection in or with its brief on the case or in an appendix or separate statement of objections attached to the brief. [Note 2.] If the objection is one that could have been cured promptly, and was not timely raised, the objection is deemed to be waived. [Note 3.]

For information concerning motions to strike notices of reliance, see TBMP § 532.

NOTES:

1. *See, e.g.,* 37 C.F.R. § 2.122(g) and MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69964 (October 7, 2016) ("The Office is adding new § 2.122(g) detailing the requirement for admission of evidence by notice of reliance. Section 2.122(g) provides that a notice must indicate generally the relevance of the evidence offered and associate it with one or more issues in the proceeding, but failure to do so with sufficient specificity is a procedural defect that can be cured by the offering party within the time set by Board order. The amendment codifies current case law and Office practice."); *Grote Industries, Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1199 (TTAB 2018) (objections deemed waived when raised for the first time in a reply brief because adverse party is effectively prevented from responding to them), *complaint filed*, No. 18-CV-599-LJV-MJR (W.D.N.Y. May 4, 2018); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1163 (TTAB 2017) ("Objections to testimony or to a notice of reliance grounded in asserted procedural defects are waived unless raised promptly, when there is an opportunity to cure."); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (objection waived where respondent received notice of reliance without referenced publications appended thereto but did not raise the issue until briefing); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (objection that notice of reliance did not set forth relevance of appended documents raised for first time in brief waived).

2. Effective January 14, 2017, 37 C.F.R. § 2.128(b) was amended to clarify and codify current practice that evidentiary objections may be set out in a separate appendix that does not count against the page limit for a brief. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81

Fed. Reg. 69950, 69967 (October 7, 2016). *See Harjo v. Pro Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (motion to strike trial brief as exceeding page limitation denied where evidentiary objections which were not required to be raised immediately were raised in appendices to the brief rather than in text of brief); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) (objections to testimony on grounds including relevance and bias of witness, raised a year after depositions were taken and set out in a separate paper from brief, were not untimely and paper did not result in violation of page limitation for final briefs).

3. *See City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1672 (TTAB 2013) (petitioner's objection to respondent's submission via notice of reliance of a business brochure prepared by a third party overruled; "[a]ny shortcomings in respondent's original submission … under notice of reliance, such as its failure to identify the URL and when the document was actually accessed (either printed out or downloaded), are procedural deficiencies that were not timely raised by petitioner and thus have been waived); *Corporacion Habanos SA v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1093 (TTAB 2012) (objection that relevance of evidence not identified waived where raised for first time with brief because procedural deficiency could have been cured if objection had been raised seasonably); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291-92 (TTAB 1986) (defect of failing to append copy of printed publication identified in notice of reliance could have been cured); *Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 409 n.3 (TTAB 1986) (petitioner's objection that respondent's justification for reliance on its own discovery responses was insufficient raised for first time in petitioner's brief was untimely since defect is one which could have been cured if raised promptly); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983) (objection that items submitted by notice of reliance were neither official records nor printed publications raised in brief sustained); *Quaker Oats Co. v. Acme Feed Mills, Inc.*, 192 USPQ 653, 655 n.9 (TTAB 1976) (objection to notice of reliance as to statement of relevance of third-party registrations untimely); *Manpower, Inc. v. Manpower Information Inc.*, 190 USPQ 18, 21 (TTAB 1976) (objection that notice of reliance failed to indicate relevance of materials was curable and should have been raised when notice was filed).

707.02(b)(1) On Ground of Untimeliness

When a notice of reliance under any of the aforementioned rules is filed after the close of the offering party's testimony period, an adverse party may file a motion to strike the notice of reliance (and, thus, the evidence submitted thereunder), in its entirety, as untimely. [Note 1.] Alternatively, an adverse party may raise this ground for objection in its brief on the case or in an appendix or separate statement of objections attached to the brief. [Note 2.]

NOTES:

1. *See, e.g., Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1902 (TTAB 2006) (motion to strike supplemental notice of reliance as having been filed outside testimony period granted); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (motion to strike untimely supplemental notice of reliance to admit current status and title copy of registration in place of timely but older status and title copy granted); *May Department Stores Co. v. Prince*, 200 USPQ 803, 805 n.1 (TTAB 1978) (motion to strike untimely notice of reliance on interrogatory answers and certified copies of corporate records filed with the state granted). *Cf. Optimal Chemical Inc. v. Srills LLC*, 2019 USPQ2d 338409, at *3 n.28 (TTAB 2019) (any objection to the timeliness of petitioner's exhibits to the notice of reliance filed after the close of the rebuttal period were deemed waived).

2. *See, e.g., Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 361 n.3 (TTAB 1978), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); *Miss Nude Florida, Inc. v. Drost*, 193 USPQ 729, 731 (TTAB 1976) (respondent's objection to untimely notice of reliance raised for the first time in its brief was not waived), *pet. to Comm'r denied*, 198 USPQ 485 (Comm'r 1977). *Cf. International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *3 n.12 (TTAB 2020) (declarations signed prior to testimony period and submitted by opposers as trial testimony considered to have been properly submitted because applicants did not object to them as untimely, and, in fact, treated them as part of the record by raising substantive objections against them), *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020); *Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to opening of opposer's testimony period, and applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected on seasonable objection).

707.02(b)(2) On Other Procedural Grounds

An adverse party may object to a notice of reliance, in whole or in part, on the ground that the notice does not comply with the procedural requirements of the particular rule under which it was submitted, as, for example, that a 37 C.F.R. § 2.122(e) notice of reliance on a printed publication does not include a copy of the printed publication, or does not indicate the general relevance and associate the proffered materials with one or more issues in the case in accordance with 37 C.F.R. § 2.122(g) [Note 1], or the proffered materials are not appropriate for introduction by notice of reliance. [Note 2.]

When, on a motion to strike a notice of reliance on the ground that it does not meet the procedural requirements of the rule under which it was filed, the Board finds that the notice is defective, but that the defect is curable, the Board may allow the relying party time to cure the defect, failing which the notice will stand stricken. [Note 3.]

If a motion to strike a notice of reliance raises objections that cannot be resolved simply by reviewing the face of the notice of reliance (and attached documents), the Board will defer determination of the motion until final hearing. [Note 4.] When determination of a motion to strike a notice of reliance is deferred until final hearing, the parties should argue the matter alternatively in their briefs on the case.

Please Note: Some of the cases cited in this section involve former subsection (j) of 37 C.F.R. § 2.120 which was amended and redesignated as 37 C.F.R. § 2.120(k) effective January 14, 2017.

NOTES:

1. *See, e.g., STX Financing, LLC v. Terraza*, 2020 USPQ2d 10989, at *4 (TTAB 2020) (motion to strike opposer's responses to applicant's interrogatories for failure to indicate the general relevance of the interrogatory answers, instead asserting broadly that the interrogatories were relevant "to show no likelihood of confusion and/or dilution," granted with leave to cure); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1163 (TTAB 2017) (granting motion to strike notices of reliance under Trademark Rule 2.122(g), with leave to cure, where relevancy description "so general as to be meaningless," and for insufficiently explaining association of documents with particular facts relevant to particular claims and defenses); *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014) (notice of reliance failed to sufficiently indicate the relevance of the material being offered by not specifying the relevance of the voluminous web pages submitted under two exhibits); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (motion to strike granted where notice of reliance was filed under inapplicable provision of rules in that items did not constitute discovery materials admissible under 37 C.F.R.

§ 2.120(j)(3) and opposer failed to explain relevance of appended copy of notice of opposition from a different case); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (notice of reliance failed to indicate that documents were being introduced under 37 C.F.R. § 2.120(j)(3)(i) by specifying and making of record a copy of the particular interrogatories to which each document was provided in lieu of an interrogatory answer); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1719 n.4 (TTAB 1987) (motion to strike notice of reliance granted where opposer failed to indicate how its own answers clarified, rebutted or explained those relied on by applicant); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 951 (TTAB 1981) (motion to strike notice of reliance granted in part where applicant failed to identify specific answers sought to be introduced by answering party or indicate how they explained, clarified or rebutted answers relied on by inquiring party); *Johnson & Johnson v. American Hospital Supply Corp.*, 187 USPQ 478, 479 (TTAB 1975) (applicant's objection to opposer's notice of reliance on letters between applicant and attorneys for third party well taken because such documents were not printed publications or official records and were not properly identified during deposition so as to lay foundation for introduction into evidence); *Rogers Corp. v. Fields Plastics & Chemicals, Inc.*, 172 USPQ 377, 378-79 (TTAB 1972) (motion to strike notice of reliance on entire remainder of deposition granted); *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123, 124 (TTAB 1971) (motion to strike items in applicant's notice of reliance stricken as they were either duplicative of evidence already made of record, not deemed to be printed publications in general circulation, or, in view of the purpose stated by applicant in the notice of reliance, hearsay).

2. *See, e.g., WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037 (TTAB 2018) (under circumstances of the case, Board denied opposer's motion to strike testimony declarations that had been filed and served as exhibits to applicant's notice of reliance, as doing otherwise would elevate form over substance. "Although the better practice would have been for Applicant to file and serve separately copies of the [witnesses'] testimony declarations, instead of attaching them as exhibits to its notice of reliance, Applicant's failure to do so is of no consequence."); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009) (printed publications that include advertisements for party's goods and services are not disqualified as proper subject matter for notice of reliance because they contain advertisements); *Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2019-20 (TTAB 2003) (whether plaintiff's price sheets and catalogs constitute proper subject matter for a notice of reliance is not a substantive issue and may be determined from the face of the notice of reliance). *See also United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1046-47 (TTAB 2014) (evaluation of various documents submitted under notice of reliance).

3. 37 C.F.R. § 2.122(g). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("To alleviate any uncertainty, this final rule adds a paragraph to the requirements for a notice of reliance, specifically, to require that the notice indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. In an effort to curtail motion practice on this point, the rule explicitly states any failure of a notice of reliance to meet this requirement will be considered a curable procedural defect. This codifies the holding of *FUJIFILM SonoSite, Inc. v. Sonoscape Co.*, 111 USPQ2d 1234, 1237 (TTAB 2014)."). *See e.g., STX Financing, LLC v. Terraza*, 2020 USPQ2d 10989, at *4 (TTAB 2020) (motion to strike granted with leave to cure where general relevancy description was insufficient); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1163 (TTAB 2017) (granting motion to strike notices of reliance under Trademark Rule 2.122(g), with leave to cure, where relevancy description "so general as to be meaningless," and for insufficiently explaining association of documents with particular facts relevant to particular claims and defenses; description in other notices of reliance acceptable because "sufficiently narrow or focused"). *See also FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014) (motion to strike exhibits under notice of reliance granted with leave to cure); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (allowed 20 days to submit substitute notice of reliance remedying defects including

submission of proper official record); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (allowed time to clarify that the documents submitted by notice of reliance were in fact produced in response to interrogatories rather than in response to document requests); *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.6 (TTAB 1988) (documents remained stricken where party did not correct deficiencies).

4. *See FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (motion to strike unpleaded registration deferred as admissibility depends on purpose for which it was submitted); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (under the circumstances, whether documents were properly admissible under 37 C.F.R. § 2.120(j)(3)(i) and/or 2.120(j)(3)(ii) deferred).

707.02(c) On Substantive Grounds

An adverse party may object to a notice of reliance on substantive grounds, such as that evidence offered under the notice constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial. Objections of this nature normally should be raised in or with the objecting party's brief on the case or in an appendix or separate statement of objections attached to the brief [Note 1], rather than by motion to strike, unless the ground for objection is one that could be cured if raised promptly by motion to strike. [Note 2.] *Cf.*TBMP § 707.02(b)(2) and TBMP § 707.03(c). This is because it is the policy of the Board not to read trial testimony or examine other trial evidence prior to final deliberations in the proceeding. *See*TBMP § 502.01. If a motion to strike a notice of reliance raises objections that cannot be resolved simply by reviewing the face of the notice of reliance (and attached documents), determination of the motion will be deferred by the Board until final hearing. [Note 3.]

Evidence timely and properly introduced by notice of reliance under the applicable trademark rules generally will not be stricken, but the Board will consider any outstanding objections thereto in its evaluation of the probative value of the evidence at final hearing. [Note 4.] *Cf.*TBMP § 707.03(c).

Because the parties to an inter partes Board proceeding generally will not know until final decision whether a substantive objection to a notice of reliance has been sustained, they should argue the matter alternatively in their briefs on the case.

NOTES:

1. Effective January 14, 2017, 37 C.F.R. § 2.128(b) was amended to clarify and codify current practice that evidentiary objections may be set out in a separate appendix that does not count against the page limit for a brief. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69967 (October 7, 2016). *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 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. 2013) (mem.); *Harjo v. Pro Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (motion to strike trial brief as exceeding page limitation denied where evidentiary objections which were not required to be raised immediately were raised in appendices to the brief rather than in text of brief); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) (objections to testimony on grounds including relevance and bias of witness, raised a year after depositions were taken and set out in a separate paper from brief, were not untimely and paper did not result in violation of page limitation for final briefs).

2. *See* 37 C.F.R. § 2.123(j) and 37 C.F.R. § 2.128(b); Fed. R. Civ. P. 32(d)(3)(A).

3. *See FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1236 (TTAB 2014) (motion to strike unpleaded registration deferred as admissibility depends on purpose for which it was submitted); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (whether notice of reliance sought to introduce improper rebuttal evidence deferred); *M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (whether documents submitted by notice of reliance were properly authenticated and whether they constituted hearsay deferred).

4. *See, e.g., Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990) (timely notice of reliance on four-year-old status and title copy of pleaded registration was not stricken); *Jetzon Tire & Rubber Corp. v. General Motors Corp.*, 177 USPQ 467, 468 n.3 (TTAB 1973) (copies of USPTO drawings are official records and therefore not stricken; however, their probative value is limited); *American Optical Corp. v. American Olean Tile Co.*, 169 USPQ 123, 125 (TTAB 1971) ("Certificate of Good Standing" from a U.S. district court is admissible as an official record and therefore not stricken; however its probative value determined at final hearing). *See also McDonald's Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1274 (TTAB 2014) (where parties moved to strike evidence Board noted objections and took them into consideration allocating the appropriate weight to the evidence).

707.03 Objections to Trial Testimony

707.03(a) In General

As in the case of an objection to a notice of reliance, an objection to trial testimony must be raised promptly if the defect is one that can be obviated or removed, failing which it is deemed waived. [Note 1.] Parties are discouraged from filing objections that are not outcome-determinative or that do not have an effect on either their own or their adversary's position. [Note 2.] The objections, which are waived unless promptly raised, are basically procedural in nature. Objections to trial testimony are not waived for failure to make them during or before the taking of a deposition, or after receipt of a testimony declaration or affidavit, provided that the ground for objection is not one that might have been obviated or removed if presented at that time. These objections are basically substantive in nature. [Note 3.] The grounds for objection to trial testimony and the procedures for raising them are discussed below.

NOTES:

1. *See, e.g., Societe Des Produits Nestle S.A. v. Taboada*, 2020 USPQ2d 10893, at *7 (TTAB 2020) (objection to inadequate pretrial disclosure overruled as untimely when first raised in trial brief because objection is curable and should have been made by the prompt filing of a motion to strike upon submission of testimony declaration and exhibits); *Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *5 (TTAB 2020) (objection to foundation raised for the first time in trial brief is untimely because it is curable), *appeal filed*, No. 3:20-cv-00400-MHL (E.D. Va. June 5, 2020); *Nahshin v. Product Source International LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013) ("As a general rule, objections that are curable must be seasonably raised, or they will be deemed waived"; objections to portions of depositions on written questions deemed waived), *aff'd*, 112 F. Supp. 3d 383 (E.D. Va. 2015).

2. *See, e.g., International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *3 (TTAB 2020) (Board declined to consider applicants' 150 individual objections), *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1875-77 (TTAB 2011) (despite stipulations, opposer filed 25 pages of objections and applicant filed 100 pages of objections, essentially subverting the steps taken to streamline the process and burdening the Board; Board further set out specific objections as

examples of what it overruled); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1501 (TTAB 2005) ("At the oral hearing, pursuant to the Board's inquiry, counsel indicated that none of the objected-to evidence is outcome determinative. Several of the parties' objections merely reiterate what was raised in their motions to strike, and, thus, these evidentiary issues have already been handled above in deciding the various motions. … The parties spent an inordinate amount of effort on evidentiary disputes. The gamesmanship during discovery, which then carried over into certain aspects of the trial phase, is breathtaking, and both sides are guilty of participating in this wasteful behavior."). *Cf. Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *3 (TTAB 2020) (Board is "well equipped to assess the testimony and the degree of accuracy of any subsequent characterization of it without resorting to striking testimony or questions," denying opposer's objection and motion to strike a question of counsel, asked during a Rule 30(b)(6) discovery deposition, that had been submitted as trial evidence).

3. *See generally Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *3-9 (TTAB 2020) (discussing curable vs. noncurable objections), *appeal filed*, No. 3:20-cv-00400-MHL (E.D. Va. June 5, 2020). *See also International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *3-7 (TTAB 2020) (objections based on lack of personal knowledge, hearsay and relevance raised for first time in main brief are timely) *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020).

707.03(b) On Procedural Grounds

707.03(b)(1) On Ground of Untimeliness

A party may not take a testimony deposition, or execute or submit a testimony affidavit or declaration, outside of its assigned testimony period, except 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 § 701.

When there is no such approved stipulation, granted motion or Board order, and a testimony deposition is taken or a testimony declaration or affidavit is executed or submitted after the close of the deposing or offering party's testimony period, an adverse party may file a motion to strike the testimony, in its entirety, as untimely. *See*TBMP § 533.01. Alternatively, an adverse party may raise this ground for objection in its brief on the case or in an appendix or separate statement of objections attached to the brief. [Note 2.] See TBMP § 801.03. *Cf.*TBMP § 707.02(b)(1).

On the other hand, when a testimony deposition is noticed for a date prior to the opening of the deposing party's testimony period, or affidavit or declaration testimony is executed or submitted prior to the opening of the submitting party's testimony period, an adverse party that fails to promptly object to the testimony on the ground of untimeliness may be found to have waived this ground for objection, because the premature scheduling or submission of testimony is an error which can be corrected on seasonable objection. [Note 3.]

NOTES:

1. 37 C.F.R. § 2.121(a). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is amending § 2.121(a) to clarify that evidence must be presented during a party's testimony period. … These amendments codify current Office practice."); *Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 71345, at *2 (TTAB 2020) ("a party may introduce testimony and evidence only during its assigned testimony period"); *Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086, at *2 n.3 (TTAB 2020) (parties stipulated that any declaration

or affidavit shall be admissible even though executed before and not during the testimony period of a party). *See also M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd.*, 2019 USPQ2d 149090, at *2 n.11 (TTAB 2019) (substitute testimony declaration was untimely filed outside of opposer's testimony period); *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *4 (TTAB 2019) (three year old declaration from application file was not of record as trial testimony as it was not executed (taken) during petitioner's testimony period), *cancellation order vacated on default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019). *Cf. International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *3 n.12 (TTAB 2020) (declarations signed prior to testimony period considered because applicants did not object to them as untimely and treated them as part of the record), *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020).

2. 37 C.F.R. § 2.128(b). Effective January 14, 2017, 37 C.F.R. § 2.128(b) was amended to clarify and codify current practice that evidentiary objections may be set out in a separate appendix that does not count against the page limit for a brief. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69967 (October 7, 2016).

3. *See International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *3 n.12 (TTAB 2020) (declarations signed prior to testimony period and submitted by opposers as trial testimony considered because applicants did not object to them as untimely and treated them as part of the record by raising substantive objections against them); *Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (objection to timeliness of testimony deposition taken two days before period opened, but raised for the first time in brief, waived).

707.03(b)(2) On Ground of Improper or Inadequate Notice

37 C.F.R. § 2.123(c) ***Notice of examination of witnesses.*** *Before the oral depositions of witnesses shall be taken by a party, due notice in writing shall be given to the adverse party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available. When a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election. Upon motion for good cause by any party, or upon its own initiative, the Board may extend the periods for electing and taking oral cross-examination. When such election has been made but cannot be completed within that testimony period, the Board, after the close of that testimony period, shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the oral cross-examination(s).*

37 C.F.R. § 2.123(e) ***Examination of witnesses.***

* * * *

(3) *If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.*

(i) *A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e).*

(ii) *A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

Before testimony depositions on oral examination may be taken by a party, the party must give every adverse party due notice in writing of the time when and place where the depositions will be taken, the cause or matter in which they are to be used, and the name and address of each witness to be deposed. [Note 1.] *See*TBMP § 703.01(e).

When a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election. [Note 2.] The Board may extend the periods for electing and taking oral cross-examination and, when necessary, will suspend or reschedule the proceeding to allow the parties to orderly complete oral cross-examination(s) that cannot be completed within a testimony period. [Note 3.] *See*TBMP § 703.01(e).

If the notice of examination of witnesses served by a party is improper or inadequate with respect to any witness, such as it does not give due (i.e., reasonable) notice, or does not identify a witness whose deposition is taken, an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence. However, promptly after the deposition is completed, the adverse party, if it wishes to preserve the objection, must move to strike the testimony from the record. [Note 4.] *See*TBMP § 533.02.

A motion to strike testimony for improper or inadequate notice must request the exclusion of the entire deposition, not just a part thereof. The motion will be decided on the basis of all the relevant circumstances. [Note 5.]

For further information concerning motions to strike testimony for improper or inadequate notice, see TBMP § 533.02.

NOTES:

1. 37 C.F.R. § 2.123(c). *Cf.* Fed. R. Civ. P. 30(b)(1).

2. 37 C.F.R. § 2.123(c). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is further amending § 2.123(c) to add that, when a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election.")

3. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is further amending § 2.123(c) to add that the Board may extend the periods for electing and taking oral cross-examination and, when necessary, shall suspend or reschedule proceedings in the matter to allow for the orderly completion of oral cross-examination(s) that cannot be completed within a testimony period.").

4. 37 C.F.R. § 2.123(e)(3). *See Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (while respondent's objection to notice was raised at the deposition, respondent failed to preserve the objection by moving to strike testimony promptly thereafter). *Cf. Empresa Cubana Del Tabaco v. General Cigar Co.*, 2019 USPQ2d 227680, at *2 n.9 (TTAB 2019) (in view of denial of motion to take oral cross-examination of foreign declarants, notice of election of oral cross-examination of no effect).

5. 37 C.F.R. § 2.123(e)(3).

707.03(b)(3) On Ground of Failure to Disclose

37 C.F.R. § 2.121(e) *A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. However, no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. … If a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure. … When a party fails to make required pretrial disclosures, any adverse party or parties may have remedy by way of a motion to the Board to delay or reset any subsequent pretrial disclosure deadlines and/or testimony periods. A party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. When testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion to strike …*

37 C.F.R. § 2.123(e) ***Examination of witnesses.***

* * * *

(3) *If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.*

(i) *A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e). …*

A party may object to improper or inadequate pretrial or rebuttal disclosures and may move to strike the testimony of a witness for lack of proper pretrial or rebuttal disclosure. [Note 1.]

If pretrial disclosures or the notice of examination of witnesses served pursuant to 37 C.F.R. § 2.123(c) are improper or inadequate with respect to any witness, an adverse party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. [Note 2.] The adverse party may also cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, must move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. [Note 3.] A motion to strike the testimony of a witness

for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with 37 C.F.R. § 2.121(e). [Note 4.]

When testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial or rebuttal disclosure, the remedy for any adverse party is the prompt filing of a motion to strike. [Note 5.]

Failure to assert an objection in a timely manner may result in the objection being waived. [Note 6.]

NOTES:

1. 37 C.F.R. § 2.121(e) and 37 C.F.R. § 2.123(e)(3). *See also* 37 C.F.R. § 2.118; *Bayer Consumer Care AG v. Belmora LLC*, 110 USPQ2d 1623, 1628 (TTAB 2014) (expert witness testimony stricken after party failed to timely identify and disclose the witness), *rev'd on other grounds*, 84 F. Supp. 3d 490 (E.D. Va. 2015), *vacated and remanded*, 819 F.3d 697 (4th Cir. 2016), *cert denied*, 137 S. Ct. 1202 (2017), *aff'd on remand*, 338 F. Supp. 3d 1477 (E.D. Va. 2018), *district court decision vacated and remanded*, 2021 USPQ2d 126 (4th Cir. 2021) (Board decision upheld by 4th Circuit), *petition for rehearing en banc filed*, No. 18-2183, 18-2232 (4th Cir. March 2 , 2021); *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009) (testimony stricken because identity of witness not disclosed prior to trial). *Cf. Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *2-3 (TTAB 2020) (respondent's motion to strike rebuttal witness for failure to disclose denied where petitioner substituted its legal assistant for its previously disclosed attorney for same authentication purpose); *Societe Des Produits Nestle S.A. v. Taboada*, 2020 USPQ2d 10893, at *7 (TTAB 2020) (objection that evidence was not adequately disclosed in pretrial disclosures overruled as untimely and waived when first raised in trial brief; objection is curable and should have been made via motion to strike promptly after testimony declaration and exhibits were filed); *WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037 (TTAB 2018) (opposer's objection to applicant's testimony declarations submitted as exhibits to notice of reliance overruled where applicant provided notice to opposer via pretrial disclosures about witnesses and the subject matter of their anticipated testimony, testimony declarations were timely served, and opposer had opportunity but chose not to cross-examine the witnesses); *Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1099-1104 (TTAB 2018) (denying opposer's motion to strike pretrial disclosure of the identity of three witnesses where one witness had been identified in initial and supplemental initial disclosures and failure to disclose earlier the identities of the other two found substantially justified and harmless).

2.37 C.F.R. § 2.121(e). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.121(e) to add that a party may move to quash a noticed testimony deposition of a witness not identified or improperly identified in pretrial disclosures before the deposition. The amendment codifies current Office practice.").

3. 37 C.F.R. § 2.123(e)(3).

4. 37 C.F.R. § 2.121(e) and 37 C.F.R. § 2.123(e)(3)(i). *See Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1299 (TTAB 2015) (motion to strike the entirety of respondent's testimony deposition on the basis that pretrial disclosures were untimely because sent to an incorrect address and attention of attorney no longer employed at the law firm granted in part and denied in part); *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009) (failure to disclose testimony witness in initial disclosures considered as a relevant circumstance in determining whether to strike testimony deposition.). *Cf. Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *2-3 (TTAB 2020) (respondent's motion to strike rebuttal witness for failure to disclose denied where petitioner substituted its legal assistant for its previously disclosed attorney for same authentication purpose); *Entravision Communications Corp. v. Liberman Television LLC*, 113

USPQ2d 1526 (TTAB 2015) (motion to substitute expert witness and report granted, where prior disclosed witness unavailable).

5. 37 C.F.R. § 2.121(e). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69963 (October 7, 2016) ("The Office is further amending § 2.121(e) to add that when testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the prompt filing of a motion to strike…"). *See WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037 (TTAB 2018) (opposer's objection to applicant's testimony declarations overruled where applicant provided notice to opposer via pretrial disclosures about witnesses and the subject matter of their anticipated testimony, testimony declarations were timely served, and opposer had opportunity but chose not to cross-examine the witnesses); *Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1099-1104 (TTAB 2018) (opposer's motion to strike pretrial disclosure of the identity of three witnesses denied--no surprise where one witness had been identified in initial and supplemental initial disclosures, and failure to disclose in supplemental initial disclosures the identities of the other two found substantially justified and harmless when applicant ascertained the identities shortly before serving pretrial disclosures, but applicant had listed the subject matter of their testimony in initial disclosures, and the record showed that opposer was aware of the witnesses and the pertinent information covered in their testimony declarations).

6. *See Societe Des Produits Nestle S.A. v. Taboada*, 2020 USPQ2d 10893, at *7 (TTAB 2020) (objection that evidence was not adequately disclosed in pretrial disclosures overruled as untimely and waived when first raised in trial brief; objection is curable and should have been made via motion to strike promptly after testimony declaration and exhibits were filed); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1927 (TTAB 2011) (objection on the basis that the witness had not been previously disclosed waived where not renewed in main brief and raised for first time in rebuttal brief), *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).

707.03(c) On Other Procedural Grounds and on Substantive Grounds

37 C.F.R. § 2.123(e)(3) *If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.*

(i) *A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with § 2.121(e).*

(ii) *A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.*

37 C.F.R. § 2.123(e)(4) *All objections made at the time of an oral examination to the qualifications of the officer taking the deposition, or to the manner of taking it, or to the evidence presented, or to the conduct of any party, and any other objection to the proceedings, shall be noted by the officer upon the deposition. Evidence objected to shall be taken subject to the objections.*

37 C.F.R. § 2.123(i) ***Effect of errors and irregularities in depositions.*** *Rule 32(d)(1), (2), and (3)(A) and (B) of the Federal Rules of Civil Procedure shall apply to errors and irregularities in depositions. Notice will not be taken of merely formal or technical objections which shall not appear to have wrought a substantial*

injury to the party raising them; and in case of such injury it must be made to appear that the objection was raised at the time specified in said rule.

37 C.F.R. § 2.123(j) ***Objections to admissibility.*** *Subject to the provisions of paragraph (i) of this section, objection may be made to receiving in evidence any declaration, affidavit, or deposition, or part thereof, or any other evidence, for any reason which would require the exclusion of the evidence from consideration. Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony must be raised at the time specified in Rule 32(d)(3)(A) of the Federal Rules of Civil Procedure. Such objections may not be considered until final hearing.*

Fed. R. Civ. P. 32(d) Waiver of Objections.

(1) ***To the Notice.*** *An objection to an error or irregularity in a deposition notice is waived unless promptly served in writing on the party giving the notice.*

(2) ***To the Officer's Qualification.*** *An objection based on disqualification of the officer before whom a deposition is to be taken is waived if not made:*

(A) *before the deposition begins; or*

(B) *promptly after the basis for disqualification becomes known or, with reasonable diligence, could have been known.*

(3) **To the Taking of the Deposition.**

(A) ***Objection to Competence, Relevance, or Materiality.*** *An objection to a deponent's competence — or to the competence, relevance, or materiality of testimony — is not waived by a failure to make the objection before or during the deposition, unless the ground for it might have been corrected at that time.*

(B) ***Objection to an Error or Irregularity.*** *An objection to an error or irregularity at an oral examination is waived if:*

(i) *it relates to the manner of taking the deposition, the form of a question or answer, the oath or affirmation, a party's conduct, or other matters that might have been corrected at that time; and*

(ii) *it is not timely made during the deposition.*

(C) ***Objection to a Written Question.*** *An objection to the form of a written question under Rule 31 is waived if not served in writing on the party submitting the question within the time for serving responsive questions or, if the question is a recross question, within 7 days after being served with it.*

(4) ***To Completing and Returning the Deposition.*** *An objection to how the officer transcribed the testimony — or prepared, signed, certified, sealed, endorsed, sent, or otherwise dealt with the deposition — is waived unless a motion to suppress is made promptly after the error or irregularity becomes known or, with reasonable diligence, could have been known.*

An adverse party may object to any form of testimony not only on the grounds of untimeliness, *see* TBMP § 707.03(b)(1), but also on the ground that the party taking the testimony has not complied with one or more of the procedural requirements specified in the rules governing the particular type of testimony in Board inter partes proceedings. In the case of testimony depositions, a party may also object on the grounds of improper or inadequate notice. *See* TBMP § 707.03(b)(2). In addition, objection may be made to any form of testimony on one or more substantive grounds, such as that the witness is incompetent to testify, or that the testimony is irrelevant or constitutes hearsay or improper rebuttal. The time and procedure for raising these objections is described below.

Because parties that have raised objections to trial testimony generally will not know the disposition thereof until final decision, they should argue the matters alternatively in their briefs on the case.

Please Note: Some of the cases cited in this section established principles later codified in the cited provisions in former 37 C.F.R. § 2.123(i), now 37 C.F.R. § 2.123(j), or were decided under rules which were the predecessors to such provisions.

707.03(c)(1) Oral Testimony Depositions

As noted in TBMP § 707.03(a), some objections to testimony depositions must be raised promptly, or they are waived. The objections, which are waived unless raised promptly, are basically procedural in nature. They include:

(1) Objections to errors and irregularities in the notice for taking a deposition (waived unless written objection is promptly served on the party giving the notice, in the case of an objection based on improper or inadequate notice, waived unless the provisions of 37 C.F.R. § 2.123(e)(3) are followed), *see* TBMP § 707.03(b)(2);

(2) Objections to taking a deposition because of disqualification of the officer before whom the deposition is to be taken (waived unless made before the taking of the deposition begins or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence);

(3) Objections based on errors and irregularities occurring at the oral examination in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of parties;

(4) Objections regarding the signing of testimonial deposition transcripts [Note 1]; and

(5) Errors of any kind that might be obviated, removed, or cured if promptly presented (waived unless seasonable objection thereto is made at the taking of the deposition). [Note 2.] Moreover, notice will not be taken of merely formal or technical objections, unless they were timely raised, and appear to have caused substantial injury to the party raising them. [Note 3.] This applies not only to errors and irregularities in the taking of a deposition, but also in the form of a deposition transcript (such as, improperly numbered pages or questions, improperly marked exhibits, etc.). [Note 4.]

Other objections to testimony depositions are not waived for failure to make them during or before the taking of the deposition, provided that the ground for objection is not one that might have been obviated or removed if presented at that time. These objections, which are basically substantive in nature [Note 5], include objections:

(1) to the competency of a witness, or

(2) to the competency, relevance, or materiality of testimony, or

(3) that the testimony constitutes hearsay or improper rebuttal.

When an objection of this type could not have been obviated or removed if presented at the deposition, the Board will consider it even if the objection is raised for the first time in or with [Note 6] a party's brief on the case. [Note 7.]

Substantive objections to testimony, that is, objections going to such matters as the competency of a witness, or the competency, relevance, or materiality of testimony, or the asserted hearsay or improper rebuttal nature of the testimony, are not considered by the Board prior to final hearing. [Note 8.] *Cf.* TBMP § 707.02(c). This is because testimony is taken out of the presence of the Board, and it is the policy of the Board not to read trial testimony, or examine other trial evidence offered by the parties, prior to deliberations on the final decision. *See* TBMP § 502.01. Further, testimony regularly taken in accordance with the applicable rules ordinarily will not be stricken on the basis of a substantive objection; rather, any such objection (unless

waived) will be considered by the Board in its evaluation of the probative value of the testimony at final hearing. [Note 9.] *Cf.*TBMP § 707.02(c).

Similarly, if the propriety of a procedural objection to a testimony deposition (such as an objection to the form of a question) cannot be determined without reading the deposition, or examining other trial evidence, it generally will not be considered by the Board until final hearing. [Note 10.] *Cf.*TBMP § 707.02(b)(2).

For the foregoing reasons, the objections described in this section (as opposed to the objection to testimony as late-taken, which may be raised by motion to strike – *see* TBMP § 533.01 and TBMP § 707.03(b)(1) – and the objection based on improper or inadequate notice of the taking of an oral deposition, which is the subject of the motion to strike procedure described in 37 C.F.R. § 2.123(e)(3), and TBMP § 533.02 and TBMP § 707.03(b)(2)), generally should not be raised by motion to strike. Rather, objections should simply be made in writing at the time specified in the rules cited above, or orally "on the record" at the taking of the deposition, as appropriate. These objections, if properly asserted and not waived or rendered moot, normally will be considered by the Board in its determination of the case at final hearing. [Note 11.] *Cf.*TBMP § 707.02(c).

Additionally, in order to preserve an objection that was seasonably raised during the taking of a testimony deposition, a party should maintain the objection in its brief on the case, as an appendix to its brief on the case or in a separate statement of objections filed with its brief on the case. [Note 12.] *See*TBMP § 707.04. However, parties are discouraged from filing objections that are not outcome-determinative or that are duplicative of issues previously raised via a motion to strike. [Note 13.] If a party advances numerous objections during each testimonial deposition and then renews the objections in a general manner in its brief, the Board may find the general objections insufficient to preserve the individual objections originally made during the testimonial depositions. [Note 14.]

NOTES:

1. *See Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116 (TTAB 2009) (objection that deposition transcripts were not signed waived by failing to timely raise objection – basis for objection could have been cured if objection was raised when the evidence was offered).

2. *See* 37 C.F.R. § 2.123(e)(3) and 37 C.F.R. § 2.123(i); Fed. R. Civ. P. 32(d)(1), Fed. R. Civ. P. 32(d)(2), Fed. R. Civ. P. 32(d)(3)(A), and Fed. R. Civ. P. 32(d)(3)(B). *See also Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070-71 (TTAB 2011) (objection concerning authentication made in brief but not in testimonial deposition procedural in nature and not timely raised; but same exhibits from Internet submitted under notice of reliance authenticated, and even if not submitted under notice of reliance, are admissible as long as witness testifies to general relevance and it is possible to determine the source and date of retrieval); *Hornby v. TJX Cos.*, 87 USPQ2d 1411, 1417 (TTAB 2008) (objection regarding authentication of testimonial deposition exhibits made in brief but not in testimonial deposition itself overruled); *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1271 n.4 (TTAB 1999) (objection raised for the first time in brief to manner in which testimonial depositions were filed, waived since purported defect could have been cured if promptly raised); *Chase Manhattan Bank, N.A. v. Life Care Services Corp.*, 227 USPQ 389, 391 (TTAB 1985) (foundation objections to a survey submitted by opposer raised for the first time in brief waived); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (objection on grounds of improper identification or authentication of exhibits waived since defects could have been cured if made during the deposition).

Cf. Miss Nude Florida, Inc. v. Drost, 193 USPQ 729, 731 (TTAB 1976), *pet. denied*, 198 USPQ 485 (Comm'r 1977) (objection to untimeliness of notice of reliance raised for first time in brief was not waived since defect could not have been cured or remedied).

3. *See* 37 C.F.R. § 2.123(i). *See also, e.g., Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (regarding technical deficiencies in marking exhibits). *See also* Fed. R. Civ. P. 61 and, with respect to notices of reliance, *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1292 n.1 (TTAB 1986) (noting precept of Fed. R. Civ. P. 61, Board stated that plaintiff's failure to serve notice of reliance was not fatal per se to the notice of reliance).

4. *See* Fed. R. Civ. P. 61; 37 C.F.R. § 2.123(g). *See, e.g., Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (Board will consider objection regarding improper authentication of documents in deposition, but ruling depends on facts of the case); *Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPQ2d 1382, 1384 (TTAB 2000) (improperly marked exhibits considered); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (Board has discretion to consider improperly marked exhibits).

5. *See* 37 C.F.R. § 2.123(j); Fed. R. Civ. P. 32(d)(3)(A); *Genesco Inc. v. Martz*, 66 USPQ2d 1260 (TTAB 2003) (objection to the failure of opposer to provide applicant with the notes to which the witness was referring during his testimony was considered substantive, not procedural in nature); *Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769, 769 n.4 (TTAB 1985) (objection that testimony is immaterial because it is outside scope of pleading is not waived).

6. 37 C.F.R. § 2.128(b). Effective January 14, 2017, 37 C.F.R. § 2.128(b) was amended to clarify and codify current practice that evidentiary objections may be set out in a separate appendix that does not count against the page limit for a brief. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69967 (October 7, 2016). *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 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. 2013) (mem.) *See Harjo v. Pro Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (motion to strike trial brief as exceeding page limitation denied where evidentiary objections which were not required to be raised immediately were raised in appendices to the brief rather than in text of brief); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992) (objections to testimony on grounds including relevance and bias of witness, raised a year after depositions were taken and set out in a separate paper from brief, were not untimely and paper did not result in violation of page limitation for final briefs).

7. *See Ava Ruha Corp. v. Mother's Nutritional Center, Inc.*, 113 USPQ2d 1575, 1579 (TTAB 2015) (based on the witness' status as CFO and personal knowledge of the records, objection based on lack of personal knowledge under Fed. R. Evid. 602 overruled; Board need not exclude evidence for danger of unfair prejudice under Fed. R. Evid. 403); *City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674-75 (TTAB 2013) (objection sustained to testimony prior to witness' employment with respondent pursuant to Federal Rule of Evidence 602); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1735 (TTAB 2012) (objection sustained because deponents statements regarding information they received from third parties during telephone conversations was inadmissible hearsay); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011) (objection sustained because purported statements made by employees of retail websites to deponent, and handwritten notes taken by deponent of such statements, are hearsay).

Cf. Pass & Seymour, Inc. v. Syrelec, 224 USPQ 845, 847 (TTAB 1984) (objection on ground of hearsay with no foundation for establishing an exception waived since defect could have been cured if objection was raised during the deposition).

8. *See, e.g., Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990) (objections based on relevancy and materiality deferred); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 307 n.1 (TTAB 1979) (objections to relevance and materiality of exhibits offered at a deposition deferred); *Primal Feeling Center of New England, Inc. v. Janov*, 201 USPQ 44, 47-48 (TTAB 1978) (objection on hearsay grounds or that witness offered opinion testimony without adequate foundation deferred); *Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469, 471 n.5 (TTAB 1973) (objection to testimony as lacking foundation deferred).

9. *See RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1804 (TTAB 2018) ("the Board is capable of weighing the relevance and strength or weakness of the objected to testimony and evidence, including any inherent limitations"), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1194 n.19 (TTAB 2014) ("the Board generally does not strike testimony taken in accordance with the applicable rules on the basis of substantive objections; rather, the Board considers such objections when evaluating the probative value of the testimony at final hearing."); *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005) (Board considers substantive objections in evaluating probative value of testimony at final hearing). *See also Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1325 (TTAB 1992); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305 (TTAB 1979); *Primal Feeling Center of New England, Inc. v. Janov*, 201 USPQ 44 (TTAB 1978); *Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469 (TTAB 1973).

10. *See, e.g., Globe-Union Inc. v. Raven Laboratories Inc.*, 180 USPQ 469, 471 n.5 (TTAB 1973) (objection to testimony as based on leading questions deferred).

11. *See* 37 C.F.R. § 2.123(j).

12. *See Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1928 (TTAB 2011) (objection on the basis that the witness had not been previously disclosed waived where not renewed in main brief and raised for first time in rebuttal brief), *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); *Anthony's Pizza & Pasta International, Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1273 n.4 (TTAB 2009) (objection to testimony raised in deposition may be maintained in appendix to brief or by separate statement of objections), *aff'd*, 415 F. App'x 222 (Fed. Cir. 2010); *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1718 n.25 (TTAB 2007) (objection to deposition exhibit waived because not renewed in trial brief); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (objection to testimony waived when not renewed in brief); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007) (objection raised at trial waived when petitioner waited until its reply brief to renew objections); *Duramax Marine LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1785 (TTAB 2006) (objection that witness was not a trademark expert not maintained in brief and thus waived); *First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 77 USPQ2d 1334, 1340 n.14 (TTAB 2005), (objection made in deposition but not renewed in brief deemed waived), *rev'd on other grounds*, 476 F.3d 867, 81 USPQ2d 1375 (Fed. Cir. 2007); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.4 (TTAB 1990) (objections to testimony and exhibits made during depositions deemed waived where neither party raised any objection to specific evidence in its brief); *United Rum Merchants Ltd. v. Fregal, Inc.*, 216 USPQ 217, 218 n.4 (TTAB 1982) (party failed to pursue objection to certain insufficiently identified exhibits introduced at trial in its brief); *Donut Shops Management Corp. v. Mace*, 209 USPQ 615 (TTAB 1981); *Medtronic, Inc. v. Medical Devices, Inc.*, 204 USPQ 317, 320 n.1 (TTAB 1979) (applicant's objections to opposer's main testimony and rebuttal testimony on grounds of hearsay and competency deemed waived where applicant did not repeat the objections in its brief and in fact attempted

to use the rebuttal to support its own case); *Volkswagenwerk AG v. Clement Wheel Co.*, 204 USPQ 76, 83 (TTAB 1979) (objections made during depositions but not argued in the briefs were considered to have been dropped); *Fischer GmbH. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585, 587 n.3 (TTAB 1977).

13. *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495 (TTAB 2005) ("At the oral hearing, pursuant to the Board's inquiry, counsel indicated that none of the objected-to evidence is outcome determinative. Several of the parties' objections merely reiterate what was raised in their motions to strike, and, thus, these evidentiary issues have already been handled above in deciding the various motions. … The parties spent an inordinate amount of effort on evidentiary disputes. The gamesmanship during discovery, which then carried over into certain aspects of the trial phase, is breathtaking, and both sides are guilty of participating in this wasteful behavior."). *Cf. Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *3 (TTAB 2020) (Board is "well equipped to assess the testimony and the degree of accuracy of any subsequent characterization of it without resorting to striking testimony or questions," denying opposer's objection and motion to strike a question of counsel, asked during a Rule 30(b)(6) discovery deposition, that had been submitted as trial evidence).

14. *See Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741, 1747 (TTAB 2006) (sweeping allegations in brief insufficient to preserve individual objections originally made in testimonial deposition).

707.03(c)(2) Testimony By Affidavit or Declaration

Objections may be made to testimony presented by affidavit or declarations for any reason which would require the exclusion of the evidence from consideration. [Note 1.] As with testimony depositions, objections to the competency of a witness or to the competency, relevancy, or materiality of affidavit or declaration testimony must be raised at the time specified in Rule 32(d)(3)(A) of the Federal Rules of Civil Procedure. [Note 2.] A party need not elect oral cross-examination in order to lodge a substantive objection to testimony by declaration or affidavit; such an objection may be raised by a motion to strike and maintained in the brief, or raised in the brief for the first time. [Note 3.] Such objections may not be considered until final hearing. [Note 4.] Further, the Board ordinarily will not strike declaration or affidavit testimony on the basis of a substantive objection if the testimony was taken in accordance with the applicable rules; rather, the Board usually considers the objection upon evaluation of the probative value of the testimony at final hearing. [Note 5.] *Cf.* TBMP § 707.02(c).

NOTES:

1. 37 C.F.R. § 2.123(j). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending renumbered § 2.123(j) to add that objection may be made to receiving in evidence any declaration or affidavit."). *See, e.g., TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790-91 (TTAB 2018) (newspaper articles and blog post submitted with no supporting testimony or other evidence are hearsay; "residual hearsay" exception of Fed. R. Evid. 807(a) does not apply); *WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037 (TTAB 2018) (under circumstances of the case, Board denied opposer's motion to strike testimony declarations that had been filed and served as exhibits to applicant's notice of reliance, as doing otherwise would elevate form over substance. "Although the better practice would have been for Applicant to file and serve separately copies of the [witnesses'] testimony declarations, instead of attaching them as exhibits to its notice of reliance, Applicant's failure to do so is of no consequence."). *See generally Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *3-9 (TTAB 2020) (discussing curable vs. noncurable objections to testimony and exhibits (including hearsay, lack of

personal knowledge and lack of foundation), waiver of objections and timeliness of objections), *appeal filed*, No. 3:20-cv-00400-MHL (E.D. Va. June 5, 2020).

2. 37 C.F.R. § 2.123(j). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending renumbered § 2.123(j) to add that objection may be made to receiving in evidence any declaration or affidavit. The Office is further amending renumbered § 2.123(j) to provide that objections may not be considered until final hearing."). *See Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1047 (TTAB 2017) (following well-established Board policy of generally not striking testimony taken in accordance with applicable rules on the basis of substantive objections, and instead considering the objections when evaluating the probative value of the testimony at final hearing, Board overruled objections to declaration testimony based on hearsay, lack of personal knowledge, and irrelevance, and that it is opinion testimony from a nonexpert); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1167 (TTAB 2017) (substantive objection to declaration testimony deferred; such an objection "may be raised by a motion to strike and maintained in the brief, or raised in the brief for the first time.").

3. *Barclays Capital Inc. v. Tiger Lily Ventures Ltd*., 124 USPQ2d 1160, 1167 (TTAB 2017). *See, e.g., Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, at.*3 (TTAB 2019) (sustaining objections to declaration testimony based on lack of personal knowledge, insufficient foundation, or impermissible lay opinion testimony; overruling Fed. R. Evid. 1005 objections of both parties); Norris v. PAVE: Promoting Awareness, Victim Empowerment, 2019 USPQ2d 370880, at *2 (TTAB 2019) (considering opposer's objection to declaration testimony regarding witness' lack of personal knowledge and disregarding testimony not based thereon); Pierce-Arrow Society v. Spintek Filtration, Inc., 2019 USPQ2d 471774, at *2 (TTAB 2019) (sustaining objection to portion of declaration opinion testimony beyond witness' area of expertise and where witness opined on the ultimate disposition of the claim; objection to testimony overruled where the specific statements objected to not identified); Andrusiek v. Cosmic Crusaders LLC, 2019 USPQ2d 222984, at *3 n.8 (TTAB 2019) (failure to seek cross-examination of respondent's declarant does not preclude petitioner from arguing in his brief that the declarations merit little evidentiary weight).

4. 37 C.F.R. § 2.123(j). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending renumbered § 2.123(j) to add that objection may be made to receiving in evidence any declaration or affidavit. The Office is further amending renumbered § 2.123(j) to provide that objections may not be considered until final hearing."). *See Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *4 (TTAB 2020) (Board considers substantive objections in evaluating probative value of testimony at final hearing); *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1047 (TTAB 2017) (same); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1167 (TTAB 2017) (substantive objection to declaration testimony deferred; such an objection "may be raised by a motion to strike and maintained in the brief, or raised in the brief for the first time.").

5. *Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *4 (TTAB 2020) (the Board generally does not strike testimony taken in accordance with the applicable rules on the basis of substantive objections but considers its probative value at final hearing); *Milwaukee Electric Tool Corp. v. Freud America, Inc.*, 2019 USPQ2d 460354, at *2-3 (TTAB 2019) (overruling objections based on relevance, unfair prejudice, or misleading nature, noting that Board is capable of weighing the relevance and strength or weakness of testimony and evidence, including any inherent limitations), *complaint filed*, No. 20-cv-109 (M.D.N.C. Feb. 3, 2020); *M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd.*, 2019 USPQ2d 149090, at *3 (TTAB 2019) (whether testimony is supported by other evidence can be considered in determining its weight, but any lack of support does not render it inadmissible; Board is capable of weighing the strength or weakness of objected-to testimony, including any inherent limitations); *Tao Licensing, LLC v. Bender*

Consulting Ltd., 125 USPQ2d 1043, 1047 (TTAB 2017) (objections on grounds of hearsay, lack of personal knowledge, irrelevance, and that it constitutes opinion testimony from a non-expert overruled, but Board will weigh the relevance and strength or weakness of the objected-to testimony, including any inherent limitations).

707.03(c)(3) Testimony Depositions on Written Depositions

When a deposition is taken on written questions pursuant to 37 C.F.R. § 2.124, written objections to questions (that is, the direct questions, cross questions, redirect questions, and recross questions) may be served on the party propounding the subject questions. A party that serves written objections on a propounding party must also serve a copy of the objections on every other adverse party. [Note 1.] *See*TBMP § 703.02(g). Objections to questions and answers in depositions on written questions generally are considered by the Board (unless waived) at final hearing. [Note 2.] *See*TBMP § 703.02(k).

NOTES:

1. *See* 37 C.F.R. § 2.124(d)(1).

2. *See, e.g., Nahshin v. Product Source International LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013) (objections to portions of depositions on written questions deemed waived), *aff'd*, 112 F. Supp.3d 383 (E.D. Va. 2015).

707.03(d) Refusal to Answer Deposition Question

When an objection is made to a question propounded during a testimony deposition, the question ordinarily should be answered subject to the objection. However, a witness may properly refuse to answer a question asking for information that is, for example, privileged, trade secret or otherwise protected from disclosure by the protective order in place for the case. *See*TBMP § 404.09.

If a deposition is being taken pursuant to a subpoena, issued pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45, and a witness not only objects to, but also refuses to answer, a particular question, the propounding party may obtain an immediate ruling on the propriety of the objection only by the unwieldy process of adjourning the deposition and applying, under 35 U.S.C. § 24, to the federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer. *See*TBMP § 404.09.

There is no mechanism for obtaining from the Board, prior to final hearing, a ruling on the propriety of an objection to a question propounded during a testimony deposition. *See*TBMP § 404.08 and TBMP § 707.03(c). Accordingly, where the witness in a testimony deposition refuses to answer a particular question, no court action is sought, and the Board finds at final hearing that the objection was not well taken, the Board may presume that the answer would have been unfavorable to the position of the party whose witness refused to answer, or may find that the refusal to answer reduces the probative value of the witness's testimony. [Note 1.]

For information concerning a refusal to answer a discovery deposition question, see TBMP § 404.03(a)(2) regarding deposition of non-party residing in the United States, TBMP § 404.08(c) (Objections During Deposition), TBMP § 404.09 (Discovery Depositions Compared to Testimony Depositions), TBMP § 411 (Remedy for Failure to Provide Disclosures or Discovery), and TBMP § 523 (Motion to Compel Disclosures or Discovery).

NOTES:

1. *See Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505, 510 (Fed. Cir. 1983) (no error in drawing adverse inference where witnesses inappropriately refused to answer relevant questions), *aff'g*, 213 USPQ 594 (TTAB 1982); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993) (where opposer's objections were found to be not well taken, Board presumed that the answers would have been adverse to opposer's position); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990); *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720, 723 (TTAB 1984); *Ferro Corp. v. SCM Corp.*, 219 USPQ 346, 351 (TTAB 1983); *Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116 (TTAB 1982); *Data Packaging Corp. v. Morning Star, Inc.*, 212 USPQ 109, 114 n.5 (TTAB 1981); *Donut Shops Management Corp. v. Mace*, 209 USPQ 615, 622 n.7 (TTAB 1981); *S. Rudofker's Sons, Inc. v. "42" Products, Ltd.*, 161 USPQ 499, 499 (TTAB 1969); *Bordenkircher v. Solis Entrialgo y Cia., S. A.*, 100 USPQ 268, 276-278 (Comm'r 1953). *Cf. Land v. Regan*, 342 F.2d 92, 144 USPQ 661, 668-69 (CCPA 1965).

707.04 Waiver of Objection

A party may waive an objection to evidence by failing to raise the objection at the appropriate time. [Note 1.] *See*TBMP § 707.02 and TBMP § 707.03.

For example, an objection to a notice of reliance on the ground that the notice does not comply with the procedural requirements of the particular rule under which it was submitted generally should be raised promptly. If a party fails to raise an objection of this nature promptly, the objection may be deemed waived, unless the ground for objection is one that could not have been cured even if raised promptly. *See*TBMP § 707.02(b)(1) and TBMP § 707.02(b)(2).

Similarly, an objection to a testimony deposition on the ground that it does not comply with the applicable procedural rules generally is waived if not raised promptly, unless the ground for objection is one which could not have been cured even if raised promptly. *See*TBMP § 707.03(b)(1) and TBMP § 707.03(c).

On the other hand, objections to a notice of reliance, or to testimony, on substantive grounds, such as, that the proffered evidence constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial, generally are not waived for failure to raise them promptly, unless the ground for objection is one which could have been cured if raised promptly. [Note 2.] *See*TBMP § 707.02(c) and TBMP § 707.03(c).

Objections may be made to testimony presented by affidavit or declaration for any reason which would require the exclusion of the evidence from consideration. [Note 3.] As with testimony depositions, objections to the competency of a witness or to the competency, relevancy, or materiality of affidavit or declaration testimony must be raised at the time specified in Rule 32(d)(3)(A) of the Federal Rules of Civil Procedure. [Note 4.] Such objections may not be considered until final hearing. [Note 5.] Further, the Board ordinarily will not strike affidavit or declaration testimony on the basis of a substantive objection if the testimony was taken in accordance with the applicable rules; rather, the Board usually will consider the objection upon evaluation of the probative value of the testimony at final hearing unless the objection has been waived. [Note 6.] *Cf.*TBMP § 707.02(c).

If a party fails to attend a testimony deposition, any objection, which is waived if not made at the deposition, is waived. [Note 7.]

Additionally, by failing to preserve the objection in its brief on the case, or in an appendix to the brief on the case or in a separate statement of objections filed with the brief on the case, a party may waive an objection that was seasonably raised at trial. [Note 8.] *See*TBMP § 707.03(c). However, parties are discouraged from filing objections that are not outcome-determinative or that are duplicative of issues previously raised via a motion to strike. [Note 9.]

NOTES:

1. *See* 37 C.F.R. § 2.123(e)(3), 37 C.F.R. § 2.123(i), and 37 C.F.R. § 2.123(j); and Fed. R. Civ. P. 32(d)(1), Fed. R. Civ. P. 32(d)(2), Fed. R. Civ. P. 32(d)(3)(A), and Fed. R. Civ. P. 32(d)(3)(B). *See generally Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *3-9 (TTAB 2020) (discussing curable vs. noncurable objections to testimony affidavits and exhibits, waiver of objections and timeliness of objections), *appeal filed*, No. 3:20-cv-00400-MHL (E.D. Va. June 5, 2020). *See, e.g.*, *Societe Des Produits Nestle S.A. v. Taboada*, 2020 USPQ2d 10893, at *7 (TTAB 2020) (objection that evidence was not adequately disclosed in pretrial disclosures overruled as untimely and waived when first raised in trial brief); *International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *3-7 (TTAB 2020) (when raised for the first time with main brief, objection on the basis of lack of foundation was untimely and waived), *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020); *Grote Industries, Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1199-1200, 1207 n.28 (TTAB 2018) (objections deemed waived when first raised in a reply brief ; party estopped from raising procedural objections at final hearing when it failed to timely assert them during the testimony depositions; testimony objections waived when not asserted in or with opening brief; Board considered discovery deposition transcripts that had been untimely filed because adverse party did not object), *complaint filed*, No. 18-CV-599-LJV-MJR (W.D.N.Y. May 4, 2018); *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1603 n.3 (TTAB 2010), *aff'd-in-part, rev'd-in-part and remanded on other grounds*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012).

2. *See generally Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *3-9 (TTAB 2020) (discussing curable vs. noncurable objections to testimony and exhibits (including hearsay, lack of personal knowledge and lack of foundation, waiver of objections and timeliness of objections). *See also Societe Des Produits Nestle S.A. v. Taboada*, 2020 USPQ2d 10893, at *7 (TTAB 2020) (curable objection to pretrial disclosures deemed waived; should have been made via motion to strike promptly after testimony declaration and exhibits were filed); *International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *3-7 (TTAB 2020) (objections based on lack of personal knowledge, hearsay and relevance raised for first time in trial brief considered timely and not waived), *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020); *Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *5 (TTAB 2020) (objection to foundation raised for first time in trial brief is untimely because there is no opportunity to cure the alleged defect whether the testimony is by deposition, affidavit or declaration); *Hornby v. TJX Companies*, 87 USPQ2d 1411, 1417 (TTAB 2008) (objection regarding authentication of testimonial deposition exhibits made in brief but not in testimonial deposition itself overruled – offering party did not have opportunity to provide authenticated testimony in testimonial deposition).

3. 37 C.F.R. § 2.123(j). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending renumbered § 2.123(j) to add that objection may be made to receiving in evidence any declaration or affidavit. The Office is further amending renumbered § 2.123(j) to provide that objections may not be considered until final hearing."). *See generally Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *3-9 (TTAB 2020) (discussing curable vs. noncurable objections to testimony affidavits and exhibits (including

hearsay, lack of personal knowledge and lack of foundation), waiver of objections and timeliness of objections).

4. 37 C.F.R. § 2.123(j). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending renumbered § 2.123(j) to add that objection may be made to receiving in evidence any declaration or affidavit. The Office is further amending renumbered § 2.123(j) to provide that objections may not be considered until final hearing."); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1167 (TTAB 2017) (substantive objection to declaration testimony deferred; such an objection "may be raised by a motion to strike and maintained in the brief, or raised in the brief for the first time."). *See, e.g., Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409, at *3 (TTAB 2019) (sustaining objections to declaration testimony based on lack of personal knowledge, insufficient foundation, or impermissible lay opinion testimony; overruling Fed. R. Evid. 1005 objections of both parties); *Norris v. PAVE: Promoting Awareness, Victim Empowerment*, 2019 USPQ2d 370880, at *2 (TTAB 2019) (considering opposer's objection to declaration testimony regarding witness' lack of personal knowledge and disregarding testimony not based thereon); *Pierce-Arrow Society v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at *2 (TTAB 2019) (sustaining objection to portion of declaration opinion testimony beyond witness' area of expertise and where witness opined on the ultimate disposition of the claim; objection to declaration testimony overruled where the specific statements objected to not identified); *Andrusiek v. Cosmic Crusaders LLC*, 2019 USPQ2d 222984, at *3 n.8 (TTAB 2019) (failure to seek cross-examination of respondent's declarant does not preclude petitioner from arguing in his brief that the declarations merit little evidentiary weight).

5. 37 C.F.R. § 2.123(j). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69965 (October 7, 2016) ("The Office is amending renumbered § 2.123(j) to add that objection may be made to receiving in evidence any declaration or affidavit. The Office is further amending renumbered § 2.123(j) to provide that objections may not be considered until final hearing."); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1167 (TTAB 2017) (substantive objection to declaration testimony deferred; such an objection "may be raised by a motion to strike and maintained in the brief, or raised in the brief for the first time."). With respect to depositions, *see also Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *4 (TTAB 2020) (Board considers substantive objections in evaluating probative value of testimony at final hearing). *Cf. Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005) (same for depositions).

6. *See Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *4 (TTAB 2020) (the Board generally does not strike testimony taken in accordance with the applicable rules on the basis of substantive objections but considers its probative value at final hearing); *Milwaukee Electric Tool Corp. v. Freud America, Inc.*, 2019 USPQ2d 460354, at *2-3 (TTAB 2019) (overruling objections based on relevance, unfair prejudice, or misleading nature, noting that Board is capable of weighing the relevance and strength or weakness of testimony and evidence, including any inherent limitations), *complaint filed*, No. 20-cv-109 (M.D.N.C. Feb. 3, 2020); *M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd.*, 2019 USPQ2d 149090, at *3 (TTAB 2019) (whether testimony is supported by other evidence can be considered in determining its weight, but any lack of support does not render it inadmissible; Board is capable of weighing the strength or weakness of objected-to testimony, including any inherent limitations); *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1047 (TTAB 2017) (objections on grounds of hearsay, lack of personal knowledge, irrelevance, and that it constitutes opinion testimony from a non-expert overruled, but Board will weigh the relevance and strength or weakness of the objected-to testimony, including any inherent limitations).

7. *See* NOTICE OF FINAL RULEMAKING, 48 Fed. Reg. 23122, 23132 (May 23, 1983); *Wright Line Inc. v. Data Safe Services Corp.*, 229 USPQ 769, 770 (TTAB 1985); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984).

8. *See Grote Industries, Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1207 n.28 (TTAB 2018) (testimony objections waived when not asserted in or with opening brief), *complaint filed*, No. 18-CV-599-LJV-MJR (W.D.N.Y. May 4, 2018); *UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1244 n.3 (TTAB 2015) (various objections asserted during testimony, including that certain documents introduced at trial were not produced during discovery, which were not maintained in brief were deemed waived); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1592 n.7 (TTAB 2011) (objection to testimony deemed waived because it was not maintained in brief) *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *Anthony's Pizza & Pasta International, Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1273 n.4 (TTAB 2009) (objection to testimony raised in deposition may be maintained in appendix to brief or by separate statement of objections), *aff'd*, 415 F. App'x 222 (Fed. Cir. 2010); *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1718 n.25 (TTAB 2007) (objection to deposition exhibit waived because not renewed in trial brief); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (objection to testimony waived when not renewed in brief); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007) (objections raised at trial waived when petitioner waited until its reply brief to renew objections); *Duramax Marine LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1785 (TTAB 2006) (objection that witness was not a trademark expert not maintained in brief and thus waived); *First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 77 USPQ2d 1334, 1340 n.14 (TTAB 2005) (objection made in deposition but not renewed in brief deemed waived), rev'd on other grounds, 476 F.3d 867, 81 USPQ2d 1375 (Fed. Cir. 2007); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.4 (TTAB 1990) (objections to testimony and exhibits made during depositions deemed waived where neither party raised any objection to specific evidence in its brief); *United Rum Merchants Ltd. v. Fregal, Inc.*, 216 USPQ 217, 218 n.4 (TTAB 1982) (party failed to pursue objection to certain insufficiently identified exhibits introduced at trial in its brief); *Medtronic, Inc. v. Medical Devices, Inc.*, 204 USPQ 317, 320 n.1 (TTAB 1979) (applicant's objections to opposer's main testimony and rebuttal testimony on grounds of hearsay and competency deemed waived where applicant did not repeat the objections and in fact attempted to use the rebuttal to support its own case); *Volkswagenwerk AG v. Clement Wheel Co.*, 204 USPQ 76, 83 (TTAB 1979) (objections made during depositions but not argued in the briefs were considered to have been dropped); *Fischer GmbH v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585, 587 n.3 (TTAB 1977).

9. *International Dairy Foods Association v. Interprofession du Gruyère, & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *3 (TTAB 2020) (Board declined to consider applicants' over 150 objections), *appeal filed*, No. 1:20-cv-01174-TSE-TCB (E.D. Va. Oct. 6, 2020); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495 (TTAB 2005) ("At the oral hearing, pursuant to the Board's inquiry, counsel indicated that none of the objected-to evidence is outcome determinative. Several of the parties' objections merely reiterate what was raised in their motions to strike, and, thus, these evidentiary issues have already been handled above in deciding the various motions. … The parties spent an inordinate amount of effort on evidentiary disputes. The gamesmanship during discovery, which then carried over into certain aspects of the trial phase, is breathtaking, and both sides are guilty of participating in this wasteful behavior."). *Cf. Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *3 (TTAB 2020) (Board is "well equipped to assess the testimony and the degree of accuracy of any subsequent characterization of it without resorting to striking testimony or questions," denying opposer's objection and motion to strike a question of counsel, asked during a Rule 30(b)(6) discovery deposition, that had been submitted as trial evidence).

Chapter 800 BRIEFS ON CASE, ORAL HEARING, FINAL DECISION

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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. *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *1 n.3 (TTAB 2020) (various affirmative defenses deemed waived because no evidence or argument presented at trial); *Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *1 n.5 (TTAB 2020) (affirmative defenses deemed waived because applicant did not discuss them in its trial brief); *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 Chateauneuf 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); *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, and should not be used as an opportunity to argue plaintiff's case in chief.

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 handing 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. Haggar 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, with the requisite fee. [Note 2.] 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, a complex record, highly technical goods and/or services, 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. The record and brief, therefore, are of paramount importance.

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 3.] 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 4.]

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.

Parties and judges may attend oral hearings in person or, at the discretion of the Board, remotely through video conference. [Note 5.]

NOTES:

1. 37 C.F.R. § 2.116(f).

2. 37 C.F.R § 2.6(a)(24).

3. *See* 37 C.F.R. § 2.123(k).

4. *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.").

5. 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.] The request for oral hearing must be accompanied by the requisite filing fee. [Note 2.] Under certain limited circumstances, a party may file a request for oral hearing via paper submission. [Note 3.] 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 § 2.6(a)(24).

3. 37 C.F.R. § 2.126(b).

802.03 Time and Place of Hearing

When a timely request for an oral hearing, with the requisite fee, 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.

PLEASE NOTE: For the foreseeable future, the Board will only be conducting oral hearings by video. For more information, please visit our website atwww.uspto.gov/ttab.

NOTES:

1. 37 C.F.R § 2.6(a)(24) and 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 Decisions Program 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 Conference

For hearings held at the offices of the Board, a party may request attendance via video conference 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 VTCOPSDISTLIST@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.

It is recommended that a party who wishes to present a visual aid at the hearing email a copy to TTABHearings@uspto.gov and to opposing counsel at least three days before the hearing for distribution to the panel. 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. It is recommended that a party that introduced an audio or video recording as an exhibit at trial which wishes to play the recording at the oral hearing notify the Board at least three days in advance so that the Board can be prepared with the appropriate platform. 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, it is recommended that they should have been provided to the Board and opposing counsel at least three days before the hearing. *See*TBMP § 802.07. 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).

Generally, 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 TTAB Reading Room (formerly the USPTO e-FOIA) webpage, both of which may be accessed by proceeding number or other criteria. A link to the TTAB Reading Room is available on the Board's webpage under "Board receipts & issued decisions" or may be accessed directly at **https://ttab-reading-room.uspto.gov/efoia/efoia-ui/#/search/decisions** . 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) When the opposition status is updated to "Terminated" in TTABVUE, the status of the subject application is updated to "Opposition Terminated – See TTAB Records," and the application is released to the Trademark Examining Operation, which may then take additional appropriate action (and make further appropriate updates to the status of the application), such as:

- (a) issue 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;
- (b) issue a registration pursuant to 37 C.F.R. § 2.81(a);
- (c) republish the subject application if necessary.

(4) 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.

(5) 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 – After Inter-Partes Decision" 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:

(6) 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.

(7) When a decision of the Board dismissing the petition for cancellation becomes final, the cancellation proceeding is terminated in TTABVUE and the status of the subject registration ultimately reverts to the earlier and otherwise appropriate status.

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 notice of allowance may be issued or an application may be abandoned prematurely, or 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 to indicate that the proceeding is "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 from the date of termination. 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, 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).

Chapter 900 REVIEW OF DECISION OF BOARD

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901 Appeals--In General

Trademark Act § 21, 15 U.S.C. § 1071 ***Review of Director's or Trademark Trial and Appeal Board's Decision.***

(a) ***Persons entitled to appeal; United States Court of Appeals for the Federal Circuit; waiver of civil action; election of civil action by adverse party; procedure.***

(1) *An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 1058 or section 71 of this title, or an applicant for renewal, who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: Provided, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Director, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Director that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b), of this section, in default of which the decision appealed from shall govern the further proceedings in the case.*

(2) *When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.*

(b) ***Civil action; persons entitled to; jurisdiction of court; status of Director; procedure.***

(1) *Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be cancelled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Director to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1051(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c).*

(2) *The Director shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.*

(3) *In any case where there is no adverse party, a copy of the complaint shall be served on the Director, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the United States Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the United States Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.*

(4) *Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the United States Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there are adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the Eastern District of Virginia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.*

37 C.F.R. § 2.145 ***Appeal to court and civil action.***

(a) ***For an Appeal to the United States Court of Appeals for the Federal Circuit under section 21(a) of the Act.***

(1) *An applicant for registration, or any party to an interference, opposition, or cancellation proceeding or any party to an application to register as a concurrent user, hereinafter referred to as inter partes proceedings, who is dissatisfied with the decision of the Trademark Trial and Appeal Board, and any registrant who has filed an affidavit or declaration under section 8 or section 71 of the Act or who has filed an application for renewal and is dissatisfied with the decision of the Director (§§ 2.165, 2.184), may appeal to the United States Court of Appeals for the Federal Circuit. It is unnecessary to request reconsideration by the Board before filing any such appeal; however, a party requesting reconsideration must do so before filing a notice of appeal.*

(2) *In all appeals under section 21(a), the appellant must take the following steps:*

(i) *File the notice of appeal with the Director, addressed to the Office of the General Counsel, as provided in § 104.2 of this chapter;*

(ii) *File a copy of the notice of appeal with the Trademark Trial and Appeal Board via ESTTA; and*

(iii) *Comply with the requirements of the Federal Rules of Appellate Procedure and Rules for the United States Court of Appeals for the Federal Circuit, including serving the requisite number of copies on the Court and paying the requisite fee for the appeal.*

(3) ***Additional requirements.***

(i) *The notice of appeal shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.*

(ii) *In inter partes proceedings, the notice of appeal must be served as provided in § 2.119.*

* * * *

(b) ***For a notice of election under section 21(a)(1) to proceed under section 21(b) of the Act.***

(1) *Any applicant or registrant in an ex parte case who takes an appeal to the United States Court of Appeals for the Federal Circuit waives any right to proceed under section 21(b) of the Act.*

(2) *If an adverse party to an appeal taken to the United States Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding elects to have all further review proceedings conducted under section 21(b) of the Act, that party must take the following steps:*

(i) *File a notice of election with the Director, addressed to the Office of the General Counsel, as provided in § 104.2 of this chapter;*

(ii) *File a copy of the notice of election with the Trademark Trial and Appeal Board via ESTTA; and*

(iii) *Serve the notice of election as provided in § 2.119.*

(c) ***For a civil action under section 21(b) of the Act.***

(1) *Any person who may appeal to the United States Court of Appeals for the Federal Circuit (paragraph (a) of this section), may have remedy by civil action under section 21(b) of the Act. It is unnecessary to request reconsideration by the Board before filing any such civil action; however, a party requesting reconsideration must do so before filing a civil action.*

(2) *Any applicant or registrant in an ex parte case who seeks remedy by civil action under section 21(b) of the Act must serve the summons and complaint pursuant to Rule 4(i) of the Federal Rules of Civil Procedure with the copy to the Director addressed to the Office of the General Counsel as provided in § 104.2 of this chapter. A copy of the complaint must also be filed with the Trademark Trial and Appeal Board via ESTTA.*

(3) *The party initiating an action for review of a Board decision in an inter partes case under section 21(b) of the Act must file notice thereof with the Trademark Trial and Appeal Board via ESTTA no later than five business days after filing the complaint in the district court. The notice must identify the civil action with particularity by providing the case name, case number, and court in which it was filed. A copy of the complaint may be filed with the notice. Failure to file the required notice can result in termination of the Board proceeding and further action within the United States Patent and Trademark Office consistent with the final Board decision.*

* * * *

(d) ***Time for appeal or civil action.***

(1) ***For an appeal under section 21(a).*** *The notice of appeal filed pursuant to section 21(a) of the Act must be filed with the Director no later than sixty-three (63) days from the date of the final decision of the Trademark Trial and Appeal Board or the Director. In inter partes cases, the time for filing a notice of cross-appeal expires 14 days after service of the notice of appeal or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

(2) ***For a notice of election under 21(a)(1) and a civil action pursuant to such notice of election.*** *The times for filing a notice of election under section 21(a)(1) and for commencing a civil action pursuant to a notice of election are governed by section 21(a)(1) of the Act.*

(3) ***For a civil action under section 21(b).*** *A civil action must be commenced no later than sixty-three (63) days after the date of the final decision of the Trademark Trial and Appeal Board or Director. In inter partes cases, the time for filing a cross-action expires 14 days after service of the summons and complaint or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

(4) ***Time computation.***

(i) *If a request for rehearing or reconsideration or modification of the Board decision is filed within the time specified in § 2.127(b), § 2.129(c), or § 2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire no later than sixty-three (63) days after action on the request.*

(ii) ***Holidays.*** *The times specified in this section in days are calendar days. If the last day of time specified for an appeal, notice of election, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday in the District of Columbia pursuant to § 2.196.*

* * * *

Please Note: Effective January 14, 2017, 37 C.F.R. § 2.145 was reorganized and reworded to improve the clarity and structure of the rule and to align the provisions with the analogous rules governing judicial review of Patent Trial and Appeal Board decisions in 37 C.F.R. part 90. For a detailed summary of the amendments, see MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69969-70 (Oct. 7, 2016).

901.01 Avenues Of Appeal

A party to a Board proceeding who is dissatisfied with the decision of the Board is provided, under the Act, with two possible (mutually exclusive) remedies. [Note 1.] The dissatisfied party may either:

(1) Appeal to the United States Court of Appeals for the Federal Circuit ("Federal Circuit"), which will review the decision from which the appeal is taken on the record before the USPTO, or

(2) Have remedy by civil action (in a United States District Court), in which the court "may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be cancelled, or such other matter as the issues in the proceeding require, as the facts in the case may appear." [Note 2.]

In an inter partes proceeding, if a dissatisfied party chooses to file an appeal to the Federal Circuit, any adverse party may, within 20 days after the filing of the notice of appeal, file notice that it elects to have the appeal dismissed, and to have further proceedings conducted instead by way of civil action. [Note 3.] Within 30 days after the filing of a notice of election by an adverse party, the appellant must commence a civil action for review of the Board's decision, failing which the Board's decision will govern further proceedings in the case. [Note 4.]

The Federal Circuit is often referred to in Board decisions as "our primary reviewing court." [Note 5.]

NOTES:

1. *Compare Princeton Vanguard, LLC and Snyder's-Lance , Inc., v. Frito-Lay North America*, 414 F. Supp. 3d 822, 2019 USPQ2d 401574, at *4, *7 (W.D.N.C. 2019) ("the plain language of the statute does not allow a dissatisfied party who has taken an appeal to the Federal Circuit under §1071(a) to later exercise the option to file a civil action under §1071(b)"; plaintiffs waived their right to appeal to the district court the Board's decision on remand from the Federal Circuit), *reversed and remanded on other grounds*, 991 F.3d 512 (4th Cir. 2021); *with Gillette Co. v. "42" Products Ltd.*, 435 F.2d 1114, 168 USPQ 197, 199-200 (9th Cir. 1970) (where dissatisfied party seeking appeal of unfavorable decision of Board on remand was not the dissatisfied party who filed the earlier appeal to the Court of Patent Appeals, party was not foreclosed from appealing to the district court by way of civil action).

2. Trademark Act § 21, 15 U.S.C. § 1071; 37 C.F.R. § 2.145. *See Shammas v. Focarino*, 784 F.3d 219, 114 USPQ2d 1489, 1490 (4th Cir. 2015) (dissatisfied trademark applicant may seek review of an adverse ruling on his trademark application either by appealing the ruling to the Court of Appeals for the Federal Circuit or by commencing an action in a federal district court), *cert. denied sub nom. Shammas v. Hirschfeld*, 136 S. Ct. 1376, (2016); *Jean Alexander Cosmetics, Inc. v. L'Oreal USA, Inc.*, 458 F.3d 244, 80 USPQ2d 1470, 1479 (3d Cir. 2006) (discussing prevailing party's ability to appeal Board decision); *CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1458 (7th Cir. 2001) (choice of appealing TTAB decision in inter partes case to Federal Circuit on closed record of Board proceedings or a federal district court with the option of presenting additional evidence); *Spraying Systems Co. v. Delavan Inc.*, 975 F.2d 387, 24 USPQ2d 1181, 1183 (7th Cir. 1992) (appeal to district court is in part an appeal and in part a new action); *Alltrade Inc. v. Uniweld Products Inc.*, 946 F.2d 622, 20 USPQ2d 1698, 1703 (9th Cir. 1991) (where winning and losing party each appealed to different district court; discussion of appealability of those aspects of a ruling with which "winning" party is dissatisfied, and dismissal, stay or transfer of second-filed appeal); *Princeton Vanguard, LLC and Snyder's Lance, Inc., v. Frito-Lay North America*, 414 F. Supp. 3d 822, 2019 USPQ2d 401574, at *3 (W.D.N.C. 2019) ("Under Section 1071 a dissatisfied party has two options for appeal. It may appeal to the Federal Circuit under 15 U.S.C § 1071(a) or it may appeal by filing a civil action in a District Court under 15 U.S.C § 1071(b)."), *reversed and remanded on other grounds*, 991 F.3d 512 (4th Cir. 2021); *RxD Media, LLC v. IP Application Development LLC*, 377 F. Supp. 3d 588, 591 (E.D. Va. 2019) (a party to an opposition proceeding dissatisfied with the result of a TTAB decision may either appeal that decision to the Federal Circuit or commence a de novo civil action in a federal district court where it is permitted to conduct discovery and submit new evidence and testimony), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Combe Inc. v. Dr. August Wolff GmbH & Co.*, 382 F. Supp. 3d 429, 443 (E.D. Va. 2019) (in a § 1071(b) action, "the parties to the action have the right to admit the PTO record as well as any new evidence not presented to the PTO that is admissible under the Federal Rules of Evidence and Civil Procedure"), *appeal filed*, No. 19-1674 (4th Cir. June 24, 2019); *Product Source International, LLC v. Nahshin*, 112 F. Supp. 3d 383 (E.D. Va. 2015) (applicant who is dissatisfied with final decision of TTAB has choice of appealing the decision to the Court of Appeals for the Federal Circuit or a remedy by civil action in district court).

3. Trademark Act § 21(a)(1), 15 U.S.C. § 1071(a)(1); 37 C.F.R. § 2.145(b)(2).

4. Trademark Act § 21(a)(1), 15 U.S.C. § 1071(a)(1); 37 C.F.R. § 2.145(d)(3).

5. *See, e.g., Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *5 (TTAB 2019) ("Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit …"), *cancellation order vacated by default judgment*, No. 0:19-cv-61614-DPG (S.D. Fla. Dec. 17, 2019); *In re Ocean Technology, Inc.*, 2019

USPQ2d 450686, *5 (TTAB 2019) ("The Board and our primary reviewing court (the Federal Circuit and its predecessor the Court of Customs and Patent Appeals)..."); *In re Thor Tech*, 90 USPQ2d 1634, 1637 (TTAB 2009); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1024 (TTAB 2009); *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, n.2 (TTAB 2008); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1514 (TTAB 2005), *aff'd*, 479 F.3d 825, 81 USPQ2d 1919 (Fed. Cir. 2007).

901.02 What May Be Appealed

901.02(a) Final Decision Versus Interlocutory Decision

The only type of Board decision that may be appealed, whether to the United States Court of Appeals for the Federal Circuit ("Federal Circuit") or by way of civil action, is a final decision, i.e., a final dispositive ruling that ends litigation on the merits before the Board. [Note 1.]

Interlocutory decisions or orders, i.e., decisions or orders that do not put an end to the litigation before the Board, are not appealable. [Note 2.]

Appealability is not limited to decisions issued by the Board after final hearing. Other types of Board decisions are also appealable, in those cases where they put an end to the litigation before the Board. [Note 3.]

On the other hand, if the Board resolves a merits issue prior to final hearing, but other merits issues remain, that is, the litigation is still before the Board as a whole, the Board's decision on the merits issue is interlocutory, rather than final, for purposes of judicial review. For example, in a case in which there is a counterclaim, if the Board grants summary judgment only as to the counterclaim, the case is not ripe for appeal until there has been a final decision with respect to the original claim; similarly, if the Board grants summary judgment only as to the original claim, the case is not ripe for appeal until there has been a final decision with respect to the counterclaim. [Note 4.] When the Board, prior to final hearing, issues a decision resolving one or more, but not all, of the merits issues in a case before it, the Board may include in its decision the following statement: "This decision is interlocutory in nature. Appeal may be taken within two months after the entry of a final decision in the case." [Note 5.]

When an appeal is taken from a decision of the Board, it is the court to which an appeal is taken, not the Board, that determines whether the involved decision is appealable, that is, whether the court has jurisdiction to entertain the appeal. [Note 6.]

When a final decision of the Board is reviewed on appeal, interlocutory orders or decisions issued during the course of the proceeding before the Board may also be reviewed if they are "logically related" to the basic substantive issues in the case. [Note 7.]

A party may obtain review of an order or decision of the Board which concerns matters of procedure (rather than the central issue or issues before the Board), and does not put an end to the litigation before the Board, by timely filing a petition to the Director. [Note 8.] *See* TBMP § 905. A party may also file a request with the Board for reconsideration of such an order or decision. *See* TBMP § 518.

The mandamus procedure set forth in Fed. R. App. P. 21 and Fed. Cir. R. 21 may not be used as a substitute for the appeal procedure specified in Trademark Act § 21, 15 U.S.C. § 1071. [Note 9.]

Issues not presented to or passed on by the Board, and raised for the first time on appeal to the Federal Circuit, are generally, absent exceptional circumstances, considered waived . [Note 10.]

NOTES:

1. *See Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1564-65 (Fed. Cir. 1989) (en banc) (Federal Circuit may review only final decisions of TTAB); *R.G. Barry Corp. v. Mushroom Makers, Inc.*, 609 F.2d 1002, 1005, 204 USPQ 195, 197 (CCPA 1979) (the word "decision" in the statute means "final decision"); *Prospector Capital Partners, Inc. v. DTTM Operations LLC*, 123 USPQ2d 1832, 1834-35 (TTAB 2017) (Petitioner's request seeking judicial review of the Board's interlocutory order is premature); *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, 1 USPQ2d 1424, 1427 (Comm'r 1986) (term "decision" has repeatedly been held to mean "final decision").

2. *See Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1565 (Fed. Cir. 1989) (en banc) (where Board granted partial summary judgment dismissing allegation of misuse of registration symbol but denied summary judgment on other potentially dispositive ownership and consent issues, appeal was premature since appealed issues did not result in disposition of case); *AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at *12 n.70 (TTAB 2020) (finding that opposer had standing to oppose was jurisdictional, not a final adjudication of the merits, and not appealable); *Prospector Capital Partners, Inc. v. DTTM Operations LLC*, 123 USPQ2d 1832, 1834-35 (TTAB 2017) (Board's dismissal of petition to cancel allowing petitioner to file amended petition to remedy identified defects is interlocutory in nature and non-final; Board does not have the authority to order a "transfer" of the proceeding to district court for judicial review); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USQP2d 1106, 1115 n.12 (TTAB 2011) (order denying motion for summary judgment as to one of three cancellation proceedings is interlocutory in nature and not yet appealable); *Hewlett Packard v. Vudu, Inc.*, 92 USPQ2d 1630, 1633 n.5 (TTAB 2009) (Board granted partial summary judgment on only one class of goods and pointed out that order was interlocutory, citing *Copeland's Enterprises*).

See also Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 853 F.2d 888, 7 USPQ2d 1628, 1630 n.2 (Fed. Cir. 1988) (ordinarily denial of summary judgment is interlocutory and not appealable except where, as in this case, decision was a final decision of dismissal [i.e., the Board, in effect, entered judgment in favor of nonmoving party]); *Parker Brothers v. Tuxedo Monopoly, Inc.*, 225 USPQ 1222 (TTAB 1984), appeal dismissed, 757 F.2d 254, 226 USPQ 11, 11 (Fed. Cir. 1985) (order denying summary judgment was interlocutory and thus non-final and non-appealable); *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, 1 USPQ2d 1424, 1427 (Comm'r 1986) (Director is without jurisdiction to certify an order to the Federal Circuit and Court is without jurisdiction to hear it).

3. *See, e.g., Fred Beverages, Inc. v. Fred's Capital Management Co.*, 605 F.3d 963, 94 USPQ2d 1958, 1959 (Fed. Cir. 2010) (after judgment entered granting petition to cancel sought against single class of multi-class registration, decision denying motion for leave to amend to seek cancellation against additional classes was reviewable); *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1711 (Fed. Cir. 1991) (decision denying reconsideration of Board's order dismissing opposition for failure to prosecute was reviewable); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1477 (Fed. Cir. 1990) (decision granting summary judgment was reviewable); *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, 1630 n.2 (Fed. Cir. 1988) (denial of motion for summary judgment where it resulted in judgment against moving party was reviewable); *Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420, 422 (CCPA 1976) (decision granting motion to dismiss for failure to state a claim is reviewable); *3PMC, LLC v. Huggins*, 115 USPQ2d 1488, 1489 (TTAB 2015) (judgment entered under Trademark Rule 2.135 for abandoning application after commencement

of opposition was reviewable); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USQP2d 1106, 1115 n.11 (TTAB 2011) (order granting summary judgment as to two of three cancellation proceedings is a final decision of the Board which may be appealed); *Williams v. Five Platters, Inc.*, 181 USPQ 409 (TTAB 1970), *aff'd*, 510 F.2d 963, 184 USPQ 744, 745 (CCPA 1975) (reviewing decision denying petitioner's Fed. R. Civ. P. 60(b) motion to vacate earlier decision granting respondent's motion for summary judgment).

4. *See AT&T Mobility LLC v. Thomann*, 2020 USPQ2d 53785, at *12 n.70 (TTAB 2020) (finding that opposer had standing to oppose was jurisdictional, not a final adjudication of the merits, and not appealable); *Procter & Gamble Co. v. Sentry Chemical Co.*, 22 USPQ2d 1589, 1594 n.4 (TTAB 1992) (decision granting opposer's motion for summary judgment on counterclaim and denying opposer's motion for partial summary judgment in the opposition was not appealable). *See also Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1565 (Fed. Cir. 1989) (en banc) (appeal of order granting partial summary judgment was premature).

5. *See, e.g., Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 n.17 (TTAB 1998); *Procter & Gamble Co. v. Sentry Chemical Co.*, 22 USPQ2d 1589, 1594 n.4 (TTAB 1992).

6. *See R.G. Barry Corp. v. Mushroom Makers, Inc.*, 609 F.2d 1002, 204 USPQ 195, 197 n.3 (CCPA 1979) (following Board's denial of motion for summary judgment on issue of res judicata, Board's attempt to "certify" an interlocutory decision as appealable given no effect in court's determination of whether it had jurisdiction over the appeal); *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, 1 USPQ2d 1424, 1427 (Comm'r 1986) (Director has no statutory authority to "certify" interlocutory orders of the Board for appeal). See also, with respect to jurisdiction to entertain an appeal, *Snyder's-Lance, Inc., v. Frito-Lay North America*, 414 F. Supp. 3d 822, 2019 USPQ2d 401574, at *3, *7 (W.D.N.C. 2019) (court sua sponte considered and found it had no subject matter jurisdiction to hear the appeal because dissatisfied party had earlier appealed to the Court of Appeals for the Federal Circuit), *appeal filed*, No. 19-2316 (4th Cir. Nov. 20, 2019); *Truck-Lite Co., LLC v. Grote Industries, Inc.*, 2019 USPQ2d 119235, at *9 (W.D.N.Y. 2019) (for judicial economy, court exercised its discretion and applied pendent personal jurisdiction where the anchor claims are a combination of federal and state law claims and the pendent claim is a federal claim seeking de novo review of a TTAB decision, since all of the claims derive from a common nucleus of operative facts); *Alltrade Inc. v. Uniweld Products Inc.*, 946 F.2d 622, 20 USPQ2d 1698, 1701 (9th Cir. 1991).

7. *See Questor Corp. v. Dan Robbins & Associates, Inc.*, 599 F.2d 1009, 202 USPQ 100, 104 (CCPA 1979) (denial of motion to strike deposition as untimely filed was a purely procedural issue, not a decision sufficiently related to the merits of the appealable issues); *Palisades Pageants, Inc. v. Miss America Pageant*, 442 F.2d 1385, 169 USPQ 790, 792 (CCPA 1971), *cert. denied*, 404 U.S. 938, 171 USPQ 641 (1971) (Board's decision to deny applicant's motion to amend description of services not logically related to the "jurisdiction-giving issues" in the case, i.e., the issues of likelihood of confusion and laches, and not reviewable).

8. *See Palisades Pageants, Inc. v. Miss America Pageant*, 442 F.2d 1385, 169 USPQ 790, 792 (CCPA 1971), *cert. denied*, 404 U.S. 938, 171 USPQ 641 (1971).

9. *See Formica Corp. v. Lefkowitz*, 590 F.2d 915, 200 USPQ 641, 646 (CCPA 1979) (stating that this is particularly true where the issue involves jurisdictional questions that Board is competent to decide and that are reviewable in the regular course of appeal). *See also In re Tam*, slip op. 16-121 unpublished (Fed. Cir. March 30, 2016) (applicant's petition for writ of mandamus to instruct Director to publish his application

denied, no clear abuse of discretion in Director's suspension of the matter pending possible further proceedings).

10. *Hylete LLC v. Hybrid Athletics, LLC*, 931 F.3d 1170, 2019 USPQ2d 285253, at *3-4 (Fed. Cir. 2019) (party waived issue by not raising it in the Board proceeding; "[g]enerally, federal appellate courts do not consider issues 'not passed upon below' or entertain arguments not presented to the lower tribunal").

901.02(b) Judgment Subject To Establishment Of Constructive Use

In an inter partes proceeding before the Board, no final judgment will be entered in favor of an applicant under Trademark Act § 1(b), 15 U.S.C. § 1051(b), before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to Trademark Act § 7(c), 15 U.S.C. § 1057(c). [Note 1.] Rather, in those cases where the Board finds that a § 1(b) applicant is entitled to prevail only if it establishes constructive use, the Board will enter judgment in favor of that applicant, subject to the applicant's establishment of constructive use. [Note 2.] If, after entry of that judgment, the § 1(b) applicant files an acceptable statement of use, and obtains a registration, thus establishing its constructive use, final judgment will be entered in behalf of the § 1(b) applicant. If, on the other hand, the § 1(b) applicant fails to establish constructive use, that is, fails to file an acceptable statement of use and obtain a registration, judgment will instead be entered in favor of the adverse party.

When the Board enters judgment in favor of a § 1(b) applicant subject to that party's establishment of constructive use, the time for filing an appeal or commencing a civil action for review of the Board's decision runs from the date of the entry of judgment subject to establishment of constructive use. [Note 3.]

NOTES:

1. Trademark Act § 21(a)(4) and Trademark Act § 21(b)(1), 15 U.S.C. § 1071(a)(4) and 15 U.S.C. § 1071(b)(1).

2. 37 C.F.R. § 2.129(d). *See also RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1809 n.50, 1816 (TTAB 2018) (judgment entered in favor of applicant subject to establishment of constructive use; Board decision contingent on registration, if and when registration is issued appropriate action is taken to terminate the proceeding), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Kraft Group LLC v. William A. Harpole*, 90 USPQ2d 1837, 1842 (TTAB 2009) (judgment in favor of applicant subject to establishment of constructive use); *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840, 1844 (TTAB 1995) (constructive use provision of § 7(c) interpreted differently in Board cases involving right to register and civil actions, such as infringement action, involving a party's right to use a mark); *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544-45 (TTAB 1991) (judgment entered in favor of applicant subject to applicant's establishment of constructive use).

3. *See* 37 C.F.R. § 2.129(d); *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1816 (TTAB 2018), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544-45 (TTAB 1991).

901.03 Motions For Relief From Final Judgment During Appeal

When a party files a Fed. R. Civ. P. 60(b) motion for relief from final judgment contemporaneously with, or during the pendency of an appeal, the Board has jurisdiction to entertain the motion. If the Board determines that the motion is to be denied, the Board will enter the order denying the motion. Any appeal of the denial may be consolidated with the appeal of the underlying order. If the Board is inclined to grant the Fed. R. Civ. P. 60(b) motion, it will issue a short memorandum so stating. The movant may then request a limited remand from the appellate court so that the Board can rule on the motion. [Note 1.]

NOTES:

1. *See Home Products International v. U.S.*, 633 F.3d 1369, 1378 n.9 (Fed. Cir. 2011); *3PMC, LLC v. Huggins*, 115 USPQ2d 1488, 1489 (TTAB 2015); *Pramil S.R.L. v. Farah*, 93 USPQ2d 1093, 1095 (TTAB 2009).

902 Appeal To Court Of Appeals For The Federal Circuit

902.01 Notice Of Appeal

Trademark Act § 21(a)(2), 15 U.S.C. § 1071(a)(2) *When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the United States Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.*

37 C.F.R. § 2.145 ***Appeal to court and civil action.***

(a) ***For an Appeal to the United States Court of Appeals for the Federal Circuit under section 21(a) of the Act.***

(1) *An applicant for registration, or any party to an interference, opposition, or cancellation proceeding or any party to an application to register as a concurrent user, hereinafter referred to as inter partes proceedings, who is dissatisfied with the decision of the Trademark Trial and Appeal Board, and any registrant who has filed an affidavit or declaration under section 8 or section 71 of the Act or who has filed an application for renewal and is dissatisfied with the decision of the Director (§§ 2.165, 2.184), may appeal to the United States Court of Appeals for the Federal Circuit. It is unnecessary to request reconsideration by the Board before filing any such appeal; however, a party requesting reconsideration must do so before filing a notice of appeal.*

(2) *In all appeals under section 21(a), the appellant must take the following steps:*

(i) *File the notice of appeal with the Director, addressed to the Office of the General Counsel, as provided in § 104.2 of this chapter;*

(ii) *File a copy of the notice of appeal with the Trademark Trial and Appeal Board via ESTTA; and*

(iii) *Comply with the requirements of the Federal Rules of Appellate Procedure and Rules for the United States Court of Appeals for the Federal Circuit, including serving the requisite number of copies on the Court and paying the requisite fee for the appeal.*

(3) ***Additional requirements.***

(i) *The notice of appeal shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.*

(ii) *In inter partes proceedings, the notice of appeal must be served as provided in § 2.119.*

37 C.F.R. § 104.2 Address for mail and service; telephone number.

(a) *Mail under this part should be addressed to the*

Office of the General Counsel
United States Patent and Trademark Office
P.O. Box 1450
Alexandria,Virginia 22313-1450

(b) *Service by hand should be made during business hours to the*

Office of the General Counsel,
10B20, Madison Building East
600 Dulany Street
Alexandria, Virginia 22313-1450

(c) *The Office of the General Counsel may be reached by telephone at 571-272-7000 during business hours.*

A party taking an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board must give written notice thereof both to the Director and to the Court of Appeals for the Federal Circuit, and pay to the Court the fee required by the Court's rules. [Note 1.]

Specifically, the original notice of appeal must be filed in the USPTO, within the time required by 37 C.F.R. § 2.145(d). [Note 2.] *See* TBMP § 902.02. The certificate of mailing procedure described in 37 C.F.R. § 2.197, and the Priority Mail Express® procedure described in 37 C.F.R. § 2.198, are available for filing a notice of appeal with the Director. However, the notice of appeal filed with the Board must be through ESTTA. The notice must specify the party or parties taking the appeal and designate the decision or part thereof appealed from. However, reasons for appeal need not be given. [Note 3.] A copy of the decision or order being appealed, and a copy of any decision on reconsideration thereof, should be attached to the notice of appeal. [Note 4.] If the appeal is taken from a decision of the Board in an inter partes proceeding, a copy of the notice must be served on every other party to the proceeding, in the manner prescribed in 37 C.F.R. § 2.119. [Note 5.] *See*TBMP § 113. The written notice, if mailed to the USPTO (rather than hand-delivered to the Office of the General Counsel), must be addressed to Office of the General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. [Note 6.]

Notices of appeal must be filed with the Board through ESTTA. For appeals of ex parte decisions, the applicant should select the ESTTA button “Appeal to CAFC”; for appeals of inter partes decisions, the appellant should select the button “Review of Order or Decision of the Board.” For information on ESTTA filing of notices of appeal in civil actions see TBMP § 903.01.

For information concerning the ways (i.e., by hand delivery, first-class mail, electronic filing, etc.) in which a notice of appeal may be filed with the Director, the filing date of a notice of appeal, and the address to be used on a notice of appeal mailed to the Director, *see* 37 C.F.R. § 104.2, 37 C.F.R. § 2.190, 37 C.F.R. § 2.195, 37 C.F.R. § 2.197, and 37 C.F.R. § 2.198.

For further information concerning how to file a notice of appeal, contact the Office of the Solicitor in the USPTO at (571) 272-9035.

For filing notices of appeal in the Court of Appeals for the Federal Circuit, appellants must comply with the Federal Rules of Appellate Procedure and Rules for the United States Court of Appeals for the Federal Circuit. [Note 7.] A copy of the decision being appealed, and a copy of any decision on reconsideration thereof, should be attached to the copy of the notice. [Note 8.]

The Federal Circuit Rules and Forms can be found on the Court's website at: **www.cafc.uscourts.gov**.

Note that effective July 1, 2020, the Federal Circuit has adopted amendments to Federal Circuit Rules of Practice and the Federal Circuit Attorney Discipline Rules. These amendments apply to all cases and documents filed or pending on or after July 1, 2020 unless otherwise ordered.

NOTES:

1. 37 C.F.R. § 2.145(a); Fed. Cir. R. 15.

2. Trademark Act § 21(a)(2), 15 U.S.C. § 1071(a)(2); 37 C.F.R. § 2.145(d).

3. 37 C.F.R. § 2.145(a)(3).

4. 37 C.F.R. § 2.145(a)(3).

5. *See* 37 C.F.R. § 2.145(a)(3)(ii).

6. *See* 37 C.F.R. § 104.2.

7. *See* 37 C.F.R. § 2.145(a)(2)(iii).

8. *See* the website for the Court of Appeals for the Federal Circuit at: **www.cafc.uscourts.gov**.

902.02 Time For Filing Notice Of Appeal, Cross-Appeal

Trademark Act § 21(a)(2), 15 U.S.C. § 1071(a)(2) *When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the United States Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.*

37 C.F.R. § 2.145(d) ***Time for appeal or civil action.***

(1) ***For an appeal under section 21(a).*** *The notice of appeal filed pursuant to section 21(a) of the Act must be filed with the Director no later than sixty-three (63) days from the date of the final decision of the Trademark Trial and Appeal Board or the Director. In inter partes cases, the time for filing a notice of cross-appeal expires 14 days after service of the notice of appeal or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

(2) ***For a notice of election under 21(a)(1) and a civil action pursuant to such notice of election.*** *The times for filing a notice of election under section 21(a)(1) and for commencing a civil action pursuant to a notice of election are governed by section 21(a)(1) of the Act.*

(3) ***For a civil action under section 21(b).*** *A civil action must be commenced no later than sixty-three (63) days after the date of the final decision of the Trademark Trial and Appeal Board or Director. In inter partes cases, the time for filing a cross-action expires 14 days after service of the summons and complaint*

or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.

(4) ***Time computation.***

(i) *If a request for rehearing or reconsideration or modification of the Board decision is filed within the time specified in § 2.127(b), § 2.129(c), or § 2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire no later than sixty-three (63) days after action on the request.*

(ii) ***Holidays.*** *The times specified in this section in days are calendar days. If the last day of time specified for an appeal, notice of election, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday in the District of Columbia pursuant to § 2.196.*

37 C.F.R. § 2.145(e) ***Extension of time.***

(1) *The Director, or the Director's designee, may extend the time for filing an appeal, or commencing a civil action, upon written request if:*

(i) *Requested before the expiration of the period for filing an appeal or commencing a civil action, and upon a showing of good cause; or*

(ii) *Requested after the expiration of the period for filing an appeal or commencing a civil action, and upon a showing that the failure to act was the result of excusable neglect.*

(2) *The request must be filed as provided in § 104.2 of this chapter and addressed to the attention of the Office of the Solicitor. A copy of the request should also be filed with the Trademark Trial and Appeal Board via ESTTA.*

The time for filing a notice of appeal to the United States Court of Appeals for the Federal Circuit ("Federal Circuit") is sixty-three (63) days from the date of the Board decision which is the subject of the appeal. [Note 1.] If the last day for filing an appeal falls on a Saturday, Sunday or Federal holiday in the District of Columbia, then the time is extended to the next day which is not a Saturday, Sunday or Federal holiday. [Note 2.] When the Board enters judgment in favor of a Trademark Act §1(b), 15 U.S.C. § 1051(b) applicant subject to that party's establishment of constructive use (*see*TBMP § 901.02(b)), the time for filing an appeal runs from the date of the entry of judgment subject to establishment of constructive use. [Note 3.]

If a request for rehearing, reconsideration, or modification of the Board's decision is filed within the time specified in 37 C.F.R. § 2.127(b), 37 C.F.R. § 2.129(c), or 37 C.F.R. § 2.144, or within any extension of time granted thereunder, the time for filing an appeal expires sixty-three (63) days after action on the request. [Note 4.] If the last day for filing an appeal falls on a Saturday, Sunday or Federal holiday in the District of Columbia, then the time is extended to the next day which is not a Saturday, Sunday or Federal holiday. [Note 5.] Because the Board's rules do not permit a second or subsequent request for reconsideration, only a timely first request for reconsideration or modification will toll the time for filing an appeal.

In an inter partes case, the time for filing a notice of cross-appeal expires (1) 14 days after service of the notice of appeal, or (2) 63 days from the date of the Board decision which is the subject of the appeal, whichever is later. [Note 6.]

The certificate of mailing procedure described in 37 C.F.R. § 2.197, and the Priority Mail Express® procedure described in 37 C.F.R. § 2.198, are available for filing a notice of appeal or a notice of cross-appeal with the Director. However, the notice of appeal filed with the Board must be through ESTTA.

If a written request to extend the time for appeal is filed before the expiration of the appeal period, the Director may grant the request on a showing of good cause. If the request is not filed until after the expiration of the appeal period, the Director may grant the request only on a showing that the failure to act was the result of excusable neglect. [Note 7.] A request for an extension of time to file an appeal should be addressed to the attention of the Office of the General Counsel, as provided in 37 C.F.R. § 104.2, and directed to the attention of the Solicitor. *See* 37 C.F.R. § 2.146(e)(2).

It is the Director, through the Office of the Solicitor in the Office of the General Counsel, not the Board, who determines whether a notice of appeal has been timely filed. If the Director determines that a notice of appeal was not timely, the Director notifies the clerk of the Federal Circuit thereof. The clerk in turn issues an order to the appellant to show cause why the appeal should not be dismissed, and refers appellant's response to the Court. [Note 8.]

An appellant that has received an order to show cause from the clerk of the Federal Circuit may file a request under 37 C.F.R. § 2.145(e) for an extension of time to file an appeal, accompanied by a showing that the late filing of the notice of appeal was the result of excusable neglect. The request should be filed in the Office of the General Counsel and directed to the attention of the Solicitor, which will notify the clerk of the Court of the Director's decision on the request.

NOTES:

1. Trademark Act § 21(a)(2), 15 U.S.C. § 1071(a)(2); 37 C.F.R. § 2.145(d)(1). *See, e.g.*, *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1816 (TTAB 2018) ("The time for filing an appeal or for commencing a civil action will run from the date of this decision."), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021).

2. 37 C.F.R. § 2.145(d)(4)(ii).

3. 37 C.F.R. § 2.129(d); *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1816 (TTAB 2018), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021). *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544-45 (TTAB 1991) (judgment entered in favor of applicant subject to applicant's establishment of constructive use).

4. 37 C.F.R. § 2.145(d)(4).

5. 37 C.F.R. § 2.145(d)(4)(ii).

6. 37 C.F.R. § 2.145(d)(1).

7. 37 C.F.R. § 2.145(e).

8. *See* Fed. Cir. R. 15(b)(2).

902.03 Appeal To Federal Circuit Waives Appeal By Civil Action

A party which takes an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board thereby waives its right to have remedy by way of civil action under Trademark Act § 21(b), 15 U.S.C. § 1071(b). [Note 1.] *See* TBMP § 903.05.

However, in an inter partes case, if an adverse party, in response to the notice of appeal to the Federal Circuit, files a notice electing to have further proceedings conducted instead by way of civil action, the appeal to the Federal Circuit will be dismissed, and the party that filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case. [Note 2.] *See* TBMP § 901.01 and TBMP § 902.04.

NOTES:

1. Trademark Act § 21(a)(1), 15 U.S.C. § 1071(a)(1) (party which appeals to the Federal Circuit thereby waives its right to proceed under Trademark Act § 21(b)); 37 C.F.R. § 2.145(b)(1) (applicant in ex parte case which takes an appeal to the Federal Circuit waives any right to proceed under Trademark Act § 21(b)). *Cf.* Trademark Act § 21(b)(1), 15 U.S.C. § 1071 (b)(1) (party dissatisfied with decision of Board may, unless appeal has been taken to the Federal Circuit, have remedy by civil action). *See Princeton Vanguard, LLC and Snyder's-Lance, Inc., v. Frito-Lay North America*, 414 F. Supp. 3d 822, 2019 USPQ2d 401574, at *4, *7 (W.D.N.C. 2019) ("the plain language of the statute does not allow a dissatisfied party who has taken an appeal to the Federal Circuit under §1071(a) to later exercise the option to file a civil action under §1071(b)"; plaintiffs waived their right to appeal to the district court the Board's decision on remand from the Federal Circuit), *reversed and remanded on other grounds*, 991 F.3d 512 (4th Cir. 2021).

2. 37 C.F.R. § 2.145(b)(2),37 C.F.R. § 2.145(d)(2).

902.04 Notice Of Election To Have Review By Civil Action

Trademark Act Section 21(a)(1), 15 U.S.C. § 1071(a)(1) *An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 1058 or section 71 of this title, or an applicant for renewal, who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: Provided, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Director, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Director that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b), of this section, in default of which the decision appealed from shall govern the further proceedings in the case.*

37 C.F.R. § 2.145(b)(2) *If an adverse party to an appeal taken to the United States Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding elects to have all further review proceedings conducted under section 21(b) of the Act, that party must take the following steps:*

(i) *File a notice of election with the Director, addressed to the Office of the General Counsel, as provided in § 104.2 of this chapter;*

(ii) *File a copy of the notice of election with the Trademark Trial and Appeal Board via ESTTA; and*

(iii) *Serve the notice of election as provided in § 2.119.*

* * * *

(d)(2) ***For a notice of election under 21(a)(1) and a civil action pursuant to such notice of election.*** *The times for filing a notice of election under section 21(a)(1) and for commencing a civil action pursuant to a notice of election are governed by section 21(a)(1) of the Act.*

* * * *

When a defeated party in an inter partes proceeding before the Board takes an appeal to the United States Court of Appeals for the Federal Circuit, any adverse party may, within 20 days after the filing of the notice of appeal, file a notice with the Director as provided in 37 C.F.R. § 104.2 electing to have all further proceedings conducted by way of civil action, under Trademark Act § 21(b), 15 U.S.C. § 1071 (b) seeking review of the decision that was the subject of the appeal. [Note 1.] As with a notice of appeal, the notice of election, if delivered by mail to the Director, must be addressed to Office of the General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. The certificate of mailing procedure described in 37 C.F.R. § 2.197, and the Priority Mail Express® procedure described in 37 C.F.R. § 2.198, are available for filing a notice of election. A copy of the notice must be filed with the Board through ESTTA and be served on every other party to the proceeding, in the manner prescribed in 37 C.F.R. § 2.119. [Note 2.] *See*TBMP § 113. A copy of the notice must also be filed with the Federal Circuit. [Note 3.]

If an adverse party files a notice electing to have further proceedings conducted by way of civil action under Trademark Act § 21(b), the appeal to the Federal Circuit will be dismissed, (Fed. Cir. R. 15(e)) and the party that filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case. [Note 4.] Any cross-action must be filed within 14 days after service of the summons and complaint in the civil action. [Note 5.]

NOTES:

1. Trademark Act § 21(a)(1), 15 U.S.C. § 1071(a)(1); 37 C.F.R. § 2.145(b)(2).

2. 37 C.F.R. § 2.145(b)(2)(ii) and 37 C.F.R. § 2.145(b)(2)(iii).

3. Fed. Cir. R. 15(e).

4. Trademark Act § 21(a)(1), 15 U.S.C. § 1071(a)(1); 37 C.F.R. § 2.145(d)(2).

5. 37 C.F.R. § 2.145(d)(3).

902.05 Information Concerning Times Specified In 37 C.F.R. § 2.145

37 C.F.R. § 2.145(d)(4)(ii) ***Holidays.*** *The times specified in this section in days are calendar days. If the last day of time specified for an appeal, notice of election, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday in the District of Columbia pursuant to § 2.196.*

In 37 C.F.R. § 2.145 (which concerns appeals and civil actions seeking review of Board decisions), the times specified in days are calendar days. If the last day of the time allowed for filing an appeal falls on a Saturday, Sunday, or Federal holiday in the District of Columbia, the time for filing an appeal is extended to the next day which is not a Saturday, Sunday, or Federal holiday. [Note 1.]

NOTES:

1. 37 C.F.R. § 2.145(d)(2)(ii).

902.06 Certified List

Trademark Act § 21(a)(3), 15 U.S.C. § 1071(a)(3) *The Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the United States Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Director shall submit to that court a brief explaining the grounds for the decision of the United States Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.*

When notice is filed in the USPTO of an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board, the Director, via the Office of the Solicitor, sends to the Federal Circuit a statement indicating whether the notice of appeal was considered timely filed, and a certified list of the documents comprising the record in the USPTO, i.e., a certified copy of the list of docket entries containing the USPTO record of the proceeding. [Note 1.] The Office of the Solicitor sends a copy of the certified list to every party to the proceeding. [Note 2.]

When the Federal Circuit receives the notice of appeal, the Court dockets the appeal, and gives notice to all parties of the date of docketing, assigned appeal number, and the short case name. [Note 3.] The appellant's time in which to file its initial brief runs from the date of service of the certified list or index pursuant to Federal Circuit Rule 17(c). [Note 4.]

NOTES:

1. Trademark Act § 21(a)(3), 15 U.S.C. § 1071(a)(3); Fed. Cir. R. 15(b)(1) and 17(b)(1).

2. Fed. Cir. R. 17(c).

3. Fed. Cir. R. 15(b)(3).

4. Fed. Cir. R. 31(a)(1)(B). For information concerning briefing schedules in consolidated cases in which more than one set of parties has appealed, see Fed. Cir. R. 31(a)(1)(D).

902.07 Appeal Briefs, Appendix, Etc.

For information concerning other matters of practice and procedure during an appeal to the United States Court of Appeals for the Federal Circuit from a Board decision, including information concerning motions, briefs, the appendix to the briefs, oral argument, etc., see the Federal Circuit Rules on the Court's website at **www.cafc.uscourts.gov**.

For information concerning the appendix to the briefs, in particular, see Fed. Cir. R. 30 and 32.

902.08 Special Provisions for Ex Parte Cases

Trademark Act § 21(a)(3), 15 U.S.C. § 1071(a)(3) *In an ex parte case, the Director shall submit to that court a brief explaining the grounds for the decision of the United States Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.*

37 C.F.R. § 2.145(b)(1) *Any applicant or registrant in an ex parte case who takes an appeal to the United States Court of Appeals for the Federal Circuit waives any right to proceed under Section 21(b) of the Act.*

If an applicant in an ex parte case takes an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board, the applicant thereby waives its right to proceed by way of civil action under Trademark Act § 21(b), 15 U.S.C. § 1071(b). [Note 1.]

On appeal to the Federal Circuit in an ex parte case, the Director, via the Office of the Solicitor, files a brief in support of the Board's decision. [Note 2.]

Questions regarding the determination of the contents of the appendix pursuant to Fed. Cir. R. 30(b) should be directed to the Office of the Solicitor.

In situations where the original appellee in an appeal of an inter partes case does not appear, the USPTO may move and the Federal Circuit may grant leave for the Director to participate to defend the Board's decision. In such cases, the Court may substitute the Director as appellee and revise the caption of the appeal to reflect its ex parte nature. [Note 3.]

NOTES:

1. Trademark Act § 21(a)(1), 15 U.S.C. § 1071(a)(1); 37 C.F.R. § 2.145(b)(1).

2. Trademark Act § 21(a)(3), 15 U.S.C. § 1071(a)(3).

3. *In re Bose Corp.*, 580 F.3d. 1240, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009) (upon motion by Director, USPTO was substituted by Court for appellee that did not appear).

903 Review By Civil Action

903.01 Notice Of Civil Action

37 C.F.R. § 2.145(c)(3) *The party initiating an action for review of a Board decision in an inter partes case under section 21(b) of the Act must file notice thereof with the Trademark Trial and Appeal Board via ESTTA no later than five business days after filing the complaint in the district court. The notice must identify the civil action with particularity by providing the case name, case number, and court in which it was filed. A copy of the complaint may be filed with the notice. Failure to file the required notice can result in termination of the Board proceeding and further action within the United States Patent and Trademark Office consistent with the final Board decision.*

A party which commences a civil action, under Trademark Act § 21(b), 15 U.S.C. § 1071(b) seeking review of a decision of the Board should file written notice thereof with the Board no later than five business days after filing the complaint in the district court. The notice to the Board must be filed through ESTTA. Failure to notify the Board of the commencement of the civil action may result in premature termination of the proceeding. [Note 1.] That is, if the Board is unaware of the commencement of the civil action, the Board will treat its own decision as final, and will take steps, based on such judgment, to close out the proceeding file and give effect to its judgment. *See* TBMP § 806. When review of a decision in ex parte appeal is sought by way of a civil action in district court, the applicant should select the ESTTA button "Appeal to District Court." For review of an inter partes decision, the party should select the ESTTA button "Review of Order or Decision of the Board."

NOTES:

1. *See* 37 C.F.R. § 2.145(c)(3).

903.02 Parties To And Service Of Civil Action

Trademark Act § 21(b), 15 U.S.C. § 1071(b) ***Civil action; persons entitled to; jurisdiction of court; status of Director; procedure.***

* * * *

(2) *The Director shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.*

(3) *In any case where there is no adverse party, a copy of the complaint shall be served on the Director, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. . . .*

(4) *Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the United States Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action....*

When a party to a Board inter partes proceeding appeals a decision of the Board by commencing a civil action seeking review of the decision, the Director shall not be made a party to the civil action. However, the clerk of the court in which the civil action is filed must notify the Director of the filing of the complaint, and the Director has the right to intervene in the action. [Note 1.]

The suit may be instituted against the party in interest as shown by the records of the USPTO at the time of the decision of which review is sought, but any party in interest may become a party to the action. [Note 2.]

When an applicant in an ex parte proceeding appeals a decision of the Board by commencing a civil action seeking review of the decision, a copy of the complaint must be served on the USPTO Director (who is a party to the proceeding) and a copy must be filed with the Board through ESTTA. [Note 3.] When review is sought for an ex parte decision, the party should select the ESTTA button "Appeal to District Court." Service of a complaint on the Director is governed by Fed. R. Civ. P. 4(i), "Serving the United States, Its Agencies, Corporations, Officers, or Employees." Under Fed. R. Civ. P. 4(i), copies of the complaint and summons must be served in a timely manner on the USPTO Director, the U.S. Attorney for the district where the action is brought, and the Attorney General of the United States. Service of the summons and complaint on the USPTO Director must be made to the Office of General Counsel. [Note 4.]

NOTES:

1. Trademark Act § 21(b)(2), 15 U.S.C. § 1071(b)(2).

2. Trademark Act § 21(b)(4), 15 U.S.C. § 1071(b)(4).

3. Trademark Act § 21(b)(3), 15 U.S.C. § 1071(b)(3), 37 C.F.R. § 2.145(c)(2).

4. *See* 37 C.F.R. § 104.2; Fed. R. Civ. P. 4(i).

903.03 Place Of Civil Action

Trademark Act § 21(b)(4), 15 U.S.C. § 1071(b)(4) *Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the United States Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there are adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the Eastern District of Virginia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.*

Generally, a civil action under Trademark Act § 21(b), 15 U.S.C. § 1071(b), may be brought in any Federal district court which has jurisdiction over the person. However, if there are adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the Eastern District of Virginia has jurisdiction. [Note 1.]

In ex parte cases, for purposes of venue under 28 U.S.C. § 1391(e), the USPTO resides in the Eastern District of Virginia. [Note 2.]

NOTES:

1. Trademark Act § 21(b)(4), 15 U.S.C. § 1071(b)(4). *See, e.g., Pro-Football Inc. v. Harjo*, 284 F. Supp. 2d 96, 68 USPQ2d 1225, 1228 (D.D.C. 2003) (U.S. District Court of the District of Columbia has jurisdiction where defendants reside in plurality of districts not within the same state), *aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009); *Del-Viking Productions Inc. v. Estate of Johnson*, 31 USPQ2d 1063, 1064 (W.D. Pa. 1994) (civil action improperly brought in Pennsylvania was transferred to U.S. District Court for the District of Columbia in view of existence of multiple adverse parties residing in different states). **Please Note:** At the time these cases were decided, 15 U.S.C. § 1071(b)(4) expressly provided for jurisdiction in the United States District Court for the District of Columbia. The statute was subsequently amended to provide jurisdiction in the United States District Court for the Eastern District of Virginia.

Compare regarding application of "first to file" rule, *Alltrade Inc. v. Uniweld Products Inc.*, 946 F.2d 622, 20 USPQ2d 1698, 1703 (9th Cir. 1991) (district court erred in dismissing rather than staying second-filed suit); and, regarding the transfer of an action to a different forum, *Chocoladefabriken Lindt & Sprungli Aktiengesellschaft v. Rykoff-Sexton Inc.*, 24 USPQ2d 1236, 1238 (S.D.N.Y. 1992) (civil action filed in New York transferred to California where defendant's witnesses and relevant documents and records were located).

2. *See* 35 U.S.C. § 1(b) ("The United States Patent and Trademark Office shall be deemed, for purposes of venue in civil actions, to be a resident of the district in which its principal office is located, except where jurisdiction is otherwise provided by law."). The USPTO's headquarters are located in Alexandria, Virginia, which is in the Eastern District of Virginia.

903.04 Time For Filing Civil Action, Cross-Action

Trademark Act § 21(b)(1), 15 U.S.C. § 1071(b)(1) *Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced*

within such time after such decision, not less than sixty days, as the Director appoints or as provided in subsection (a) of this section. . . .

37 C.F.R. § 2.145

(d) ***Time for appeal or civil action.***

(1) ***For an appeal under section 21(a).*** *The notice of appeal filed pursuant to section 21(a) of the Act must be filed with the Director no later than sixty-three (63) days from the date of the final decision of the Trademark Trial and Appeal Board or the Director. In inter partes cases, the time for filing a notice of cross-appeal expires 14 days after service of the notice of appeal or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

(2) ***For a notice of election under 21(a)(1) and a civil action pursuant to such notice of election.*** *The times for filing a notice of election under section 21(a)(1) and for commencing a civil action pursuant to a notice of election are governed by section 21(a)(1) of the Act.*

(3) ***For a civil action under section 21(b).*** *A civil action must be commenced no later than sixty-three (63) days after the date of the final decision of the Trademark Trial and Appeal Board or Director. In inter partes cases, the time for filing a cross-action expires 14 days after service of the summons and complaint or 63 days from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

(4) ***Time computation.***

(i) *If a request for rehearing or reconsideration or modification of the Board decision is filed within the time specified in § 2.127(b), § 2.129(c), or § 2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire no later than sixty-three (63) days after action on the request.*

(ii) ***Holidays.*** *The times specified in this section in days are calendar days. If the last day of time specified for an appeal, notice of election, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday in the District of Columbia pursuant to § 2.196.*

(e) ***Extensions of time.***

(1) *The Director, or the Director's designee, may extend the time for filing an appeal, or commencing a civil action, upon written request if:*

(i) *Requested before the expiration of the period for filing an appeal or commencing a civil action, and upon a showing of good cause; or*

(ii) *Requested after the expiration of the period for filing an appeal or commencing a civil action, and upon a showing that the failure to act was the result of excusable neglect.*

(2) *The request must be filed as provided in § 104.2 of this chapter and addressed to the attention of the Office of the Solicitor. A copy of the request should also be filed with the Trademark Trial and Appeal Board via ESTTA.*

The time for commencing a civil action under Trademark Act § 21(b), 15 U.S.C. § 1071(b), is sixty-three (63) days from the date of the Board decision of which review is sought. [Note 1.] If the last day for filing an appeal falls on a Saturday, Sunday or Federal holiday in the District of Columbia, then the time is extended to the next day which is not a Saturday, Sunday or Federal holiday. [Note 2.] A civil action is commenced by the filing of a complaint with the court. [Note 3.] When the Board enters judgment in favor of a Trademark Act § 1(b), 15 U.S.C. § 1051(b), applicant subject to that party's establishment of constructive use (*see* TBMP § 901.02(b)), the time for commencing a civil action for review of the Board's decision runs from the date of the entry of judgment subject to establishment of constructive use. [Note 4.]

If a request for rehearing, reconsideration, or modification of the Board's decision is filed within the time specified in 37 C.F.R. § 2.127(b), 37 C.F.R. § 2.129(c), or 37 C.F.R. § 2.144, or within any extension of time granted thereunder, the time for commencing a civil action expires sixty-three (63) days after action on the request. [Note 5.] If the last day for filing an appeal falls on a Saturday, Sunday or Federal holiday in the District of Columbia, then the time is extended to the next day which is not a Saturday, Sunday or Federal holiday. [Note 6.] Because the Board's rules do not permit a second or subsequent request for reconsideration, only a timely first request for reconsideration or modification will toll the time for commencing a civil action. In an inter partes case, the time for filing a cross-action expires (1) 14 days after service of the summons and complaint, or (2) sixty-three (63) from the date of the Board decision which is the subject of the civil action, whichever is later. [Note 7.]

If a written request to extend the time for commencing a civil action is filed before the expiration of the period for commencing a civil action, the USPTO may grant the request on a showing of good cause. If the request is not filed until after the expiration of the period for commencing a civil action, the USPTO may grant the request only on a showing that the failure to act was the result of excusable neglect. [Note 8.] A request for an extension of time to file an appeal should be addressed to the Office of the General Counsel, as provided in 37 C.F.R. § 104.2, and directed to the attention of the Solicitor. *See* 37 C.F.R. § 2.142(e)(2).

NOTES:

1. Trademark Act § 21(b)(1), 15 U.S.C. § 1071(b)(1) (not less than 60 days); 37 C.F.R. § 2.145(d)(3) (63 days). *See, e.g., RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1816 (TTAB 2018) ("The time for filing an appeal or for commencing a civil action will run from the date of this decision."), *aff'd*, 377 F. Supp. 3d 588, (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021).

2. 37 C.F.R. § 2.145(d)(4)(ii).

3. Fed. R. Civ. P. 3.

4. 37 C.F.R. § 2.129(d). *See, e.g., RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1816 (TTAB 2018) (judgment entered in favor of applicant subject to applicant's establishment of constructive use), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021). *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544-45 (TTAB 1991) (same).

5. 37 C.F.R. § 2.145(d)(4).

6. 37 C.F.R. § 2.145(d)(4)(ii).

7. 37 C.F.R. § 2.145(d)(3).

8. 37 C.F.R. § 2.145(e).

903.05 Information Concerning Times Specified In 37 C.F.R. § 2.145

37 C.F.R. § 2.145(d)(4)(ii) ***Holidays.*** *The times specified in this section in days are calendar days. If the last day of time specified for an appeal, notice of election, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday in the District of Columbia pursuant to § 2.196.*

In 37 C.F.R. § 2.145 (which concerns appeals and civil actions seeking review of Board decisions), the times specified in days are calendar days. If the last day of the time allowed for commencing a civil action falls on a Saturday, Sunday, or Federal holiday in the District of Columbia, the time for commencing a civil action is extended to the next day which is not a Saturday, Sunday, or Federal holiday. [Note 1.]

NOTES:

1. 37 C.F.R. § 2.145(d)(4)(ii).

903.06 Civil Action Precluded By Appeal To Federal Circuit

In a proceeding before the Board, a party that is dissatisfied with the decision of the Board may have remedy by way of civil action, unless an appeal to the United States Court of Appeals for the Federal Circuit has been taken. [Note 1.] *See* TBMP § 902.03.

However, in an inter partes case, if an appeal has been taken to the Federal Circuit, and a party adverse to the appellant files a notice electing to have further proceedings conducted instead by way of civil action, the appeal to the Federal Circuit will be dismissed, and the party which filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case. *See*TBMP § 901.01 and TBMP § 902.04. [Note 2.]

NOTES:

1. Trademark Act § 21(b)(1), 15 U.S.C. § 1071(b)(1). *Cf.* Trademark Act § 21(a)(1), 15 U.S.C. § 1071(a)(1) (party which appeals to the Federal Circuit thereby waives its right to proceed under Trademark Act § 21(b)); 37 C.F.R. § 2.145(b)(1) (applicant in ex parte case which takes an appeal to the Federal Circuit waives any right to proceed under Trademark Act § 21(b)). *See Princeton Vanguard, LLC and Snyder's-Lance, Inc. v. Frito-Lay North America*, 414 F. Supp. 3d 822, 2019 USPQ2d 401574, at *4, *7 (W.D.N.C. 2019) ("the plain language of the statute does not allow a dissatisfied party who has taken an appeal to the Federal Circuit under § 1071(a) to later exercise the option to file a civil action under §1071(b)"; plaintiffs waived their right to appeal to the district court the Board's decision on remand from the Federal Circuit), a *reversed and remanded on other grounds*, 991 F.3d 512 (4th Cir. 2021).

2. *See Belmora LLC v. Bayer Consumer Care AG*, 84 F. Supp. 3d 490, 115 USPQ2d 1032, 1036 (E.D. Va. 2015) (Belmora filed notice of appeal of Board's decision to Federal Circuit; Bayer then filed a notice of election to have review by civil action), *vacated and remanded*, 819 F.3d 617 (4th Cir. 2016), *cert denied*, 137 S. Ct. 1202 (2017), *aff'd on remand*, 338 F. Supp. 3d 1477 (E.D. Va. 2018), *vacated and remanded on other grounds*, 2021 USPQ2d 126 (4th Cir. 2021).

903.07 Special Provisions For Ex Parte Civil Actions

Trademark Act § 21(b)(3), 15 U.S.C. § 1071(b)(3) *In any case where there is no adverse party, a copy of the complaint shall be served on the Director, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the United States Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the United States*

Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.

When an applicant in an ex parte case seeks review of a decision of the Board by way of civil action under Trademark Act § 21(b), 15 U.S.C. § 1071(b), it must effect service on the USPTO Director pursuant to Fed. R. Civ. P. 4(i) ("Serving the United States and its Agencies, Corporations, Officers, or Employees."). "All the expenses of the proceeding," including but not limited to expert witness fees, copying, and travel, must be paid by the applicant which brought the suit, whether the final decision is in favor of the applicant or not, unless the court finds the expenses to be unreasonable. [Note 1.] Under Fed. R. Civ. P. 4(i), copies of the complaint and summons must be served in a timely manner on the USPTO Director, the U.S. Attorney for the district where the action is brought, and the Attorney General of the United States. Service of the summons and complaint on the USPTO Director must be made to the Office of General Counsel as indicated in 37 C.F.R. § 104.2 and a copy of the notice of appeal must be filed with the Board through ESTTA as indicated in 37 C.F.R. § 2.145(a)(2)(ii).

NOTES:

1. Trademark Act § 21(b)(3), 15 U.S.C. § 1071(b)(3). *See, e.g.*, *Sandvik Aktiebolag v. Samuels*, No. 89-3127-LFO, 1991 WL 25774 (D.D.C. Feb. 7, 1991) (USPTO's expert witness fees must be reimbursed); *Realvirt, LLC v. Lee*, 226 F. Supp. 3d 695 (E.D. Va. 2016), *vacated as to attorneys' fees*, 734 F. App'x 754 (Fed. Cir. Aug. 14, 2018).

Please Note: The U.S. Supreme Court in *Peter v. NantKwest, Inc.*, ___U.S.___, 140 S. Ct. 365, 2019 USPQ2d 474054, at *7 (2019), *aff'g NantKwest, Inc. v. Iancu*, 898 F.3d 1177, 127 USPQ2d 1497 (Fed. Cir. 2018) (en banc), held that the USPTO, in a civil action under the similar expense payment provisions of 35 U.S.C. § 145, cannot recover the salaries of its legal personnel, and in effect, implicitly rejected the Fourth Circuit's holding in *Shammas v. Focarino*, 784 F.3d 219, 224 (4th Cir. 2015), *cert. denied sub nom, Shammas v. Hirschfeld*, 136 S. Ct. 1376 (2016), that awarded legal fees under the expense payment provision of 15 U.S.C. § 1071(b)(3).

904 Access To Record During Appeal

904.01 Access During Appeal To Federal Circuit

Board file records are maintained electronically and may be accessed, even during an appeal, through TTABVUE. When it deems necessary, the Federal Circuit may, on motion or sua sponte, order transmission (via the Office of the Solicitor) of certified copies of the record, or portions thereof, or the physical exhibits, at any time during the pendency of the appeal. [Note 1.]

Application and registration file records are maintained electronically by the USPTO and may be accessed, even during an appeal, through TSDR.

Nonconfidential submissions filed with the Board may be viewed online at any time through the publicly available TTABVUE system, accessible at **www.ttabvue.uspto.gov/ttabvue**. The TTABVUE database contains most Board proceedings since 2001. To inspect or copy one of the paper files, contact the National Archives and Records Administration, www.archives.gov/research. For further information regarding the inspection and copying of older paper files, see TBMP § 120.01.

Any portions of the record that are subject to a protective order may be inspected and copied only in accordance with the terms of the protective order, unless the Federal Circuit amends, modifies, or annuls the protective order, in which case access by a party, or its attorney or other authorized representative, to the record will be governed by the Court's order. [Note 2.]

NOTES:

1. Trademark Act § 21(a)(3), 15 U.S.C. § 1071(a)(3); Fed. Cir. R. 17(a).

2. Fed. Cir. R. 17(d) and 17(e).

904.02 Access During Review By Civil Action

Board file records are maintained electronically and may be accessed through TTABVUE. To the extent a certified copy is required, it will be transmitted (via the Office of the Solicitor) to the court in which the civil action is pending only upon order of the court. [Note 1.]

During a civil action seeking review of a decision of the Board in an ex parte case, the subject application file is retained by the USPTO. The USPTO files a certified copy of the administrative record with the court.

Nonconfidential submissions filed with the Board may be viewed online at any time through the publicly available TTABVUE system, accessible at **www.ttabvue.uspto.gov/ttabvue**. The TTABVUE database contains most Board proceedings since 2001. To inspect or copy one of the paper files contact the National Archives and Records Administration, **www.archives.gov/research**. For further information regarding the inspection and copying of older paper files, see TBMP § 120.01.

Any portions of the record which are subject to a protective order may be inspected and copied only in accordance with the terms of the protective order, unless the district court amends, modifies, or annuls the protective order, in which case access by a party, or its attorney or other authorized representative, to the record will be governed by the court's order.

NOTES:

1. *See* 15 U.S.C. § 1071(b)(3). ("[T]he record in the Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses ... as the court imposes. ...").

905 Petition To The Director

37 C.F.R. § 2.146 ***Petitions to the Director.***

(a) *Petition may be taken to the Director in a trademark case:*

(1) *From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by § 2.63(a) and (b);*

(2) *In any case for which the Act of 1946, or Title 35 of the United States Code, or parts 2, 3, 6, and 7 of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Director;*

(3) *To invoke the supervisory authority of the Director in appropriate circumstances;*

(4) *In any case not specifically defined and provided for by parts 2, 3, 6, and 7 of Title 37 of the Code of Federal Regulations; or*

(5) *In an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.*

(b) *Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Director.*

(c) *Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by § 2.6. Any brief in support of the petition shall be embodied in or accompany the petition. The petition must be signed by the petitioner, someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(5). When facts are to be proved on petition, the petitioner must submit proof in the form of verified statements signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.*

(d) *Unless a different deadline is specified elsewhere in this chapter, a petition under this section must be filed by not later than:*

(1) *Two months after the issue date of the action, or date of receipt of the filing, from which relief is requested; or*

(2) *Where the applicant or registrant declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the action, or where no action was issued, the petition must be filed by not later than:*

(i) *Two months of actual knowledge of the abandonment of an application and not later than six months after the date the trademark electronic records system indicates that the application is abandoned in full or in part;*

(ii) *Where the registrant has timely filed an affidavit of use or excusable non-use under Section 8 or 71 of the Act, or a renewal application under Section 9 of the Act, two months after the date of actual knowledge of the cancellation/expiration of a registration and not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired; or*

(iii) *Two months after the date of actual knowledge of the denial of certification of an international application under § 7.13(b) and not later than six months after the trademark electronic records system indicates that certification is denied.*

(e)(1) *A petition from the grant or denial of a request for an extension of time to file a notice of opposition must be filed no later than fifteen days after the issue date of the grant or denial of the request. A petition from the grant of a request must be served on the attorney or other authorized representative of the potential opposer, if any, or on the potential opposer. A petition from the denial of a request must be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition shall be made as provided by § 2.119. The potential opposer or the applicant, as the case may be, may file a response by not later than fifteen days after the date of service of the petition and shall serve a copy of the response on the petitioner, with proof of service as provided by § 2.119. No further document relating to the petition may be filed.*

(2) *A petition from an interlocutory order of the Trademark Trial and Appeal Board must be filed by not later than thirty days after the issue date of the order from which relief is requested. Any brief in response to the petition must be filed, with any supporting exhibits, not later than fifteen days after the date of service of the petition. Petitions and responses to petitions, and any papers accompanying a petition or response, under this subsection must be served on every adverse party pursuant to § 2.119.*

(f) *An oral hearing will not be held on a petition except when considered necessary by the Director.*

(g) *The mere filing of a petition to the Director will not act as a stay in any appeal or inter partes proceeding that is pending before the Trademark Trial and Appeal Board nor stay the period for replying to an Office action in an application except when a stay is specifically requested and is granted or when §§ 2.63(b) and 2.65 are applicable to an ex parte application.*

(h) *Authority to act on petitions, or on any petition, may be delegated by the Director.*

(i) *If the Director denies a petition, the petitioner may request reconsideration, if:*

(1) *The petitioner files the request by not later than:*

(i) *Two months after the issue date of the decision denying the petition; or*

(ii) *Two months after the date of actual knowledge of the decision denying the petition and not later than six months after the issue date of the decision where the petitioner declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the decision; and*

(2) *The petitioner pays a second petition fee under § 2.6.*

37 C.F.R. § 2.147 ***Petition to the Director to accept a paper submission.***

* * * *

(b) ***Certain paper submissions timely filed before the date of a filing deadline***.

(1) *An applicant, registrant, or petitioner for cancellation may file a petition to the Director under this section, requesting acceptance of any of the following submissions that was timely submitted on paper and otherwise met the minimum filing requirements, but not processed or examined by the Office because it was not submitted electronically pursuant to § 2.21(a), § 2.23(a), or § 2.111(c)(1), and the applicant, registrant, or petitioner for cancellation is unable to timely resubmit the document electronically by the deadline*: • * * * *

The only type of Board decision that may be appealed, whether to the United States Court of Appeals for the Federal Circuit or by way of civil action, is a final decision, i.e., a "final dispositive ruling that ends litigation on the merits" before the Board. Interlocutory decisions or orders, i.e., decisions or orders that do not put an end to the litigation before the Board, are not appealable. Appealability is not limited to decisions issued by the Board after final hearing. Other types of Board decisions are also appealable, in those cases where they put an end to the litigation before the Board. *See* TBMP § 901.02(a).

When a final decision of the Board is reviewed on appeal, interlocutory orders or decisions issued during the course of the proceeding before the Board may also be reviewed if they are "logically related" to the basic substantive issues in the case. *See* TBMP § 901.02(a) (What May Be Appealed).

In an inter partes proceeding, a party may obtain review of an order or decision of the Board which concerns matters of procedure (rather than the central issue or issues before the Board), and does not put an end to the litigation before the Board, by timely Petition to the Director. [Note 1.]

A Petition to the Director from an interlocutory order or decision of the Board, in a Board inter partes proceeding, must be filed no later than 30 days after the issue date of the order or decision from which relief is requested. Any brief in response to the petition must be filed, with any supporting exhibits, no later than 15 days from the date of service of the petition. Petitions from an interlocutory order or decision of the Board, responses to such petitions, and any materials accompanying a petition or response, must be served on every adverse party in the manner prescribed in 37 C.F.R. § 2.119(a). [Note 2.] *See* TBMP § 113.

For information concerning a Petition to the Director from the denial, or from the granting, of a request for an extension of time to file a notice of opposition, see 37 C.F.R. § 2.146(e)(1), and TBMP § 211.03.

A petition on any matter not otherwise specifically provided for must be filed no later than two months after the issue date of the action from which relief is requested. [Note 3.]

The mere filing of a Petition to the Director will not act as a stay in any ex parte appeal or inter partes proceeding pending before the Board. [Note 4.] However, the Board may in its discretion suspend proceedings in an inter partes case pending determination of a Petition to the Director.

A Petition to the Director must include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by 37 C.F.R. § 2.6. Any brief in support of the Petition must be embodied in or accompany the Petition. When facts are to be proved in ex parte cases, the proof, in the form of a verified statement, and any exhibits, must accompany the Petition. [Note 5.]

An oral hearing will not be held on a Petition to the Director except when considered necessary by the Director. [Note 6.]

For further information on Petitions to the Director, see 37 C.F.R. § 2.146. *Cf.* TMEP Chapter 1700 . For information on filing a Petition to the Director to file on paper a petition to cancel on the fifth year anniversary date of the registration see 37 C.F.R. § 2.147(b)(1).

NOTES:

1. *See* 37 C.F.R. § 2.146; *Chesebrough-Pond's Inc. v. Faberge, Inc.* , 618 F.2d 776, 205 USPQ 888, 891 (CCPA 1980) (grant of summary judgment motion although essentially a procedural decision is appealable not petitionable in view of its substantial substantive effect); *Palisades Pageants, Inc. v. Miss America Pageant* , 442 F.2d 1385, 169 USPQ 790, 792 (CCPA 1971) (whether Board abused discretion in denying motion to amend description of services was a matter to be determined by Commissioner, not the Court since not part of the central issue); *Jack Lenor Larsen Inc. v. Chas. O. Larsen Co.* , 44 USPQ2d 1950, 1952 n.2 (TTAB 1997) (petition to Director seeking reopening of cancellation proceeding is inappropriate as petition because it seeks review of final decision of Board); *Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent Inc.* , 60 USPQ2d 1703 (Comm'r 2000) (petition from Board's finding that registration issued inadvertently and to direct Board to dismiss opposition granted in view of defect in request for extension of time to oppose); *Kimberly Clark Corp. v. Paper Converting Industry Inc.* , 21 USPQ2d 1875 (Comm'r 1991) (decision denying motion to dismiss opposition as untimely filed reviewed by petition); *Miss Nude Florida, Inc. v. Drost* , 193 USPQ 729 (TTAB 1976), *pet. to Comm'r denied,* 198 USPQ 485, 486 (Comm'r 1977) (Board's decision not to consider untimely evidence was critical factor leading to Board's final decision and to that extent was "logically related" to the central issue and therefore appropriate for appeal rather than petition); *Johnson & Johnson v. Cenco Medical/Health Supply Corp.* , 177 USPQ 586 (Comm'r 1973) (Board's decision granting motion to amend pleading to add new claim reviewable by petition). *Cf.* 37 C.F.R. § 2.146(b) (questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under Trademark Act §§ 2, 3, 4, 5, 6, and 23, 15 U.S.C. §§ 1052, 1053, 1054, 1055, 1056, and 1091, are not considered to be appropriate subject matter for Petition to the Director).

2. 37 C.F.R. § 2.146(e)(2).

3. 37 C.F.R. § 2.146(d).

4. 37 C.F.R. § 2.146(g). *See In re Docrite Inc.*, 40 USPQ2d 1636, 1637 n.1 (Comm'r 1996) (citing Trademark Rule 2.146(g) and stating that filing petition to review denial of request to extend time to oppose does not stay time to file opposition or further extensions of time to oppose).

5. 37 C.F.R. § 2.146(c). *See, e.g., Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952 n.2 (TTAB 1997) (respondent's petition did not specify which subsection of 2.146(a) provided basis for Director's review).

6. 37 C.F.R. § 2.146(f).

906 Standards Of Review Of Board Decisions

As stated at the outset of this chapter, after the Board determines and decides "the respective rights of registration" under Trademark Act § 17, 15 U.S.C. § 1067, any party dissatisfied with the Board's decision may seek review of the decision either by appealing to the United States Court of Appeals for the Federal Circuit or by filing a civil action in a federal district court. [Note 1.]

NOTES:

1. Trademark Act § 21, 15 U.S.C. § 1071.

906.01 Appeal To Federal Circuit Or Review By Civil Action

In an appeal to the Federal Circuit, the case proceeds on the closed administrative record and no new evidence is permitted. [Note 1.] In contrast, an appeal to the district court is both an appeal and a new action, which allows the parties to submit new evidence and, in inter partes cases, to raise additional claims. [Note 2.]

Questions of fact. In a district court civil action under Trademark Act § 21(b), 15 U.S.C. § 1071(b), the district court's standard of review for agency fact finding depends on whether new evidence is introduced on a disputed issue of fact. If new evidence is introduced on a disputed question of fact, the district court "must make de novo factual findings that take account of both the new evidence and the administrative record before the PTO" on the issue about which the new evidence is offered. [Note 3.] In cases where no new evidence is adduced on a disputed factual issue, the district court applies the same deferential APA substantial evidence standard in reviewing the TTAB fact findings on that issue as would the Federal Circuit reviewing the same issue. [Note 4.] In inter partes cases where additional legal causes of action have been pled, the district court will make its own factual findings as to those additional claims. [Note 5.]

The degree of deference that the reviewing courts must afford Board's findings of fact was decided by the U.S. Supreme Court in *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999). In that decision, the Supreme Court held that the proper standard of judicial review of findings of fact made by the USPTO is not the traditional "clearly erroneous" standard of review, but rather the "slightly more" deferential standard of the Administrative Procedure Act (APA), 5 U.S.C. § 706(2). [Note 6.] Thus, whether a party elects direct review by the Federal Circuit or initiates a new action in the district court, the APA standard of review should be applied to the Board's fact-finding. [Note 7.]

The Supreme Court did not decide which of the two standards of review under APA § 706(2), 5 U.S.C. §§ 706(2)(A) and (E), the "arbitrary, capricious" test under APA §§ 706(2) and 706(2)(A) or the "substantial evidence" test under § 706(2)(E), should be applied. [Note 8.] Of the two tests, the Federal Circuit has determined that the "substantial evidence" standard is the appropriate standard of review for USPTO findings

of fact. [Note 9.] A number of circuit courts of appeals have also indicated that "substantial evidence" review is appropriate. [Note 10.]

The substantial evidence standard requires the reviewing court to ask whether a reasonable person might accept that the evidentiary record supports the agency's conclusion. [Note 11.] Considered to be less deferential than the "arbitrary, capricious" standard of the APA, "substantial evidence" requires a stricter judicial review of agency fact-finding. [Note 12.] A review for substantial evidence "involves examination of the record as a whole, taking into account evidence that both justifies and detracts from an agency's decision." [Note 13.] Moreover, "the possibility of drawing two inconsistent conclusions from the evidence does not prevent an administrative agency's finding from being supported by substantial evidence." [Note 14.] "Where two different conclusions may be warranted based on the evidence of record, the Board's decision to favor one conclusion over the other is the type of decision that must be sustained by this court as supported by substantial evidence." [Note 15.] Substantial evidence is "'more than a mere scintilla' and 'such relevant evidence as a reasonable mind would accept as adequate' to support a conclusion." [Note 16.]

Examples of findings of fact include abandonment [Note 17]; functionality [Note 18]; descriptiveness [Note 19]; whether trade dress is product design [Note 20.]; whether an asserted mark is generic [Note 21]; whether the later version of a mark creates the same continuing commercial impression [Note 22]; whether applicant had a bona fide intent to use the mark in commerce [Note 23]; whether a mark is merely descriptive or generic [Note 24]; priority/ownership. [Note 25.]; and factual findings on each relevant *DuPont* factor in the likelihood of confusion analysis. [Note 26.]

Conclusions of law. While the Board's findings of fact are reviewed for substantial evidence, conclusions of law are reviewed de novo. [Note 27.]

Examples of legal conclusions that receive de novo review include whether a multi-color mark as applied to product packaging can never be inherently distinctive [Note 28], whether the Board properly granted summary judgment or a motion to dismiss, whether it was proper for the Board to consider certain types of evidence, whether the correct legal standard was used in a genericness analysis, and whether preclusion applies to bar a particular action. [Note 29.] With regard to the likelihood of confusion analysis under a Section 2(d) claim, the U.S. Court of Appeals for the Federal Circuit reviews the factual findings on each relevant *DuPont* factor for substantial evidence, but reviews the Board's weighing of the *DuPont* factors de novo as a legal determination. [Note 30.]

The Board's interpretations of the Trademark Act are legal determinations, but under general principles of administrative law, courts have given deference to the Board's reasonable interpretations of the statute the agency is charged with administering. [Note 31.] "Deference" is generally given to the USPTO's interpretation of its own regulations. [Note 32.]

Collateral Estoppel effect. In *B & B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045, 2048 (2015), the Supreme Court held that issue preclusion can be based on a decision by the Trademark Trial and Appeal Board in an inter partes case in which the ordinary elements of issue preclusion are met. [Note 33.] Courts, citing *B&B Hardware*, have given preclusive effect to TTAB decisions that found fraud. [Note 34.] Similarly, courts have given preclusive effect to TTAB decisions concerning priority and likelihood of confusion. [Note 35.]

Application of Board's Trial Rules: The Board's interpretation of its own rules and practice set forth in the TBMP is reviewed under the arbitrary, capricious, and abuse of discretion standard. [Note 36.] Examples

include whether it was procedurally improper for the Board to grant a post-trial, unconsented motion to disclaim a term and whether evidence was properly of record. [Note 37.]

NOTES:

1. Trademark Act § 21(a)(4), 15 U.S.C. § 1071(a)(4).

2. *See Belmora LLC v. Bayer Consumer Care AG*, 338 F.Supp. 3d 477, 484 (E.D. Va. 2015) ("any new evidence submitted to the court on a disputed factual question is considered de novo"; in addition to appeal of Board decision, state and federal claims added), *vacated and remanded on other grounds*, 2021 USPQ2d 126 (4th Cir. 2021); *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 109 USPQ2d 1291, 1295 (4th Cir. 2014) (when an inter partes Board decision is challenged by filing a civil action in district court, the parties have the right to submit further evidence and additional claims); *CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1458 (7th Cir. 2001) (appeal from district court's review of Board's finding of no likelihood of confusion, and from district court's decision on added claims of infringement, unfair competition and dilution); *RxD Media, LLC v. IP Application Development LLC*, 377 F. Supp. 3d 588, 591 (E.D. Va. 2019) (a party to an opposition proceeding dissatisfied with the result of a Board decision may commence a de novo civil action in a federal district court where it is permitted to conduct discovery and submit new evidence and testimony; additional claims included trademark infringement, unfair competition and false designation of origin), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Combe Inc. v. Dr. August Wolff GmbH & Co.*, 382 F. Supp. 3d 429, 443 (E.D. Va. 2019) (in a § 1071(b) action, "the parties to the action have the right to admit the PTO record as well as any new evidence not presented to the PTO that is admissible under the Federal Rules of Evidence and Civil Procedure") *appeal filed*, No. 19-1674 (4th Cir. June 24, 2019); *Truck-Lite Co., LLC v. Grote Industries, Inc.*, 2019 USPQ2d 119235, at *1-2 (W.D.N.Y. 2019) (in addition to seeking review of Board decision, nine additional claims added); *Autodesk, Inc. v. Lee*, 113 USPQ2d 1161, 1162 (E.D. Va. 2014) (where new evidence is submitted in civil action under § 1071(b), court "reviews the record de novo and acts as the finder of fact based on the entire record"), appeal withdrawn (4th Cir. Jan. 28, 2015).

3. *See RxD Media, LLC v. IP Application Development LLC*, 377 F. Supp. 3d 588, 591-92 (E.D. Va. 2019) (discussing de novo and substantial evidence standards of review in § 1071(b) proceedings), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Belmora LLC v. Bayer Consumer Care AG*, 338 F. Supp. 3d 477, 484 (E.D. Va. 2018) ("any new evidence submitted to the court on a disputed factual question is considered de novo"), *vacated and remanded on other grounds*, 2021 USPQ2d 126 (4th Cir. 2021); *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 109 USPQ2d 1291, 1295 (4th Cir. 2014) ("[W]here new evidence is presented to the district court on a disputed fact question, a de novo finding will be necessary to take such evidence into account together with the evidence before the board") (internal citations omitted).

See also Kappos v. Hyatt, 132 S. Ct. 1690, 1701, 102 USPQ2d 1337 (2012) (interpreting 35 U.S.C. § 145). Although *Kappos v. Hyatt* concerned a district court civil action under 35 U.S.C. § 145 challenging the USPTO's rejection of a patent application, the Court's holding on this point applies to district court civil actions challenging refusals to register trademarks because of the relationship and similarities between 35 U.S.C. § 145 and 15 U.S.C. § 1071 (b). Prior to 1962, the Lanham Act incorporated the patent review procedures in 35 U.S.C. § 145. In 1962, Congress revised 15 U.S.C. § 1071 (b), to incorporate "with necessary changes in language, the various provisions of title 35 relating to such appeals and review." *See* S. Rep. No. 87-2107 (1962), 1962 U.S.C.C.A.N. 2844, 2850.

4. *See RxD Media, LLC v. IP Application Development LLC*, 377 F. Supp. 3d 588, 591-92 (E.D. Va. 2019) (discussing substantial evidence standard of review in § 1071(b) proceedings), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Belmora LLC v. Bayer Consumer Care AG*, 338 F. Supp. 3d 477, 484 (E.D.

Va. 2018) ("factual findings made by the Board which are untouched by new evidence presented to the court are reviewed under the substantial evidence standard mandated by the Administrative Procedure Act"), *vacated and remanded on other grounds*, 2021 USPQ2d 126 (4th Cir. 2021); *CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1458 (7th Cir. 2001).

5. *See RxD Media, LLC v. IP Application Development LLC*, 377 F. Supp. 3d 588, 595 (E.D. Va. 2019) (granting summary judgment for defendant on additional claims and affirming Board decision), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021) *Belmora LLC v. Bayer Consumer Care AG*, 338 F. Supp. 3d 477, 488 (E.D. Va. 2018) (dismissing parties additional claims on summary judgment and affirming Board decision), *vacated and remanded on other grounds*, 2021 USPQ2d 126 (4th Cir. 2021); *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 109 USPQ2d 1291, 1295 (4th Cir. 2014) ("The district court has authority independent of the PTO to . . . decide any related matters such as infringement and unfair competition claims."); *CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1458 (7th Cir. 2001).

6. *See CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1458 (7th Cir. 2001) (quoting *Dickinson v. Zurko*, 527 U.S. 150, 165, 50 USPQ2d 1930 (1999)).

7. *Dickinson v. Zurko*, 527 U.S. 150, 119 S.Ct. 1816, 50 USPQ2d 1930, 1936 (1999) (rejecting the argument that the "two paths" for review would create "an anomaly" in the standard of review). *See RxD Media, LLC v. IP Application Development LLC*, 377 F. Supp. 3d 588, 592 (E.D. Va. 2019) ("If no new evidence is admitted that relates to a disputed fact question, the reviewing court must apply the APA substantial evidence standard to the PTO's findings of fact on that issue."), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Belmora LLC v. Bayer Consumer Care AG*, 338 F. Supp. 3d 477, 483-84 (E.D. Va. 2018) ("[F]actual findings made by the Board which are untouched by new evidence presented to the court are reviewed under the substantial evidence standard mandated by the Administrative Procedure Act."), *vacated and remanded on other grounds*, 2021 USPQ2d 126 (4th Cir. 2021); *Pro-Football Inc. v. Harjo*, 284 F. Supp. 2d 96, 68 USPQ2d 1225, 1239 (D.D.C. 2003) (district court review of Board decision is "commensurate with the 'substantial evidence' standard of review articulated in the APA."), *remanded*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), *aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009).

8. 5 U.S.C. §§ 706(2)(A) and (E). *See In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1773 (Fed. Cir. 2000).

9. *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1372 (Fed. Cir. 2018) (court reviews legal conclusions de novo and finding of fact for substantial evidence); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1044 (Fed. Cir. 2018) (court reviews factual findings for substantial evidence); *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1576 (Fed. Cir. 2015) (same); *In re Louisiana Fish Fry Products, Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (Board's factual determinations are reviewed for substantial evidence); *Couture v. Playdom, Inc.*, 778 F.3d 1379, 113 USPQ2d 2042, 2043 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 88 (2015); *Coach Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1716 (Fed. Cir. 2012); *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000). *But see Fred Beverages, Inc. v. Fred's Capital Management Co.*, 605 F.3d 963, 94 USPQ2d 1958, 1960 (Fed. Cir. 2010) ("Where an agency departs from established precedent without a reasoned explanation, its decision will be vacated as arbitrary and capricious.").

10. *See CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1459 (7th Cir. 2001). *See also In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000).

11. *Dickinson v. Zurko*, 527 U.S. 150, 165, 50 USPQ2d 1930, 1937 (1999); *Hylete LLC v. Hybrid Athletics, LLC*, 931 F.3d 1170, 2019 USPQ2d 285253, at *3 (Fed. Cir. 2019) ("Substantial evidence is "such relevant evidence [that] a reasonable mind would accept as adequate to support a conclusion.") (quoting *In re i.am.symbolic LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017)); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1044 (Fed. Cir. 2018) (Board's factual findings reviewed for substantial evidence, which requires 'such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.') (quoting *Consolidated Edison Co. v. N.L.R.B.*, 305 U.S. 197, 229-30 (1938); *Jack Wolfskin Ausrustung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1133 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 982 (2016); *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000), (quoting *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229-30 (1938) ("substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.... Mere uncorroborated hearsay or rumor does not constitute substantial evidence.").

See also Aycock Engineering Inc. v. Airflite Inc., 560 F.3d 1350, 90 USPQ2d 1301, 1304 (Fed. Cir. 2009) ("Substantial evidence is 'more than a mere scintilla' and 'such relevant evidence as a reasonable mind would accept as adequate to support a conclusion.' [internal cites omitted]"); *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000) ("The substantial evidence standard requires the reviewing court to ask whether a reasonable person might find that the evidentiary record supports the agency's conclusion.").

12. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000) (the "arbitrary, capricious" standard of review is the most deferential of the APA standards of review).

13. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000).

14. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000) (quoting *Consolo v. Federal Maritime Commission*, 383 U.S. 607, 620 (1966)).

15. *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1372 (Fed. Cir. 2018) ("The [TTAB's] finding[s] may be supported by substantial evidence even if two inconsistent conclusions can be drawn from the evidence.") (citing *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) (citation omitted)."); *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1836 (Fed. Cir. 2007) (citing *In re Jolley*, 308 F.3d 1317, 64 USPQ2d 1901, 1904 (Fed. Cir. 2002)).

16. *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1372 (Fed. Cir. 2018) (*citing Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015) (internal quotation marks, citation, and subsequent history omitted)); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1044 (Fed. Cir. 2018) (quoting *Consolidated Edison Co. v. N.L.R.B.*, 305 U.S. 197, 229-30 (1938)); *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Consolidated Edison v. NLRB*, 305 U.S. 197, 229 (1938)); *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017); *Coach Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1716 (Fed. Cir. 2012) (quoting *Consolidated Edison v. NLRB*, 305 U.S. 197, 229 (1938)); *Juice Generation, Inc. v. GS Enterprises, LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015); *In re Mouttet*, 686 F.3d 1322, 1331 (Fed. Cir. 2012) ("Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence.") (citation omitted).

17. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000) (abandonment is a question of fact).

18. *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002) (functionality is a question of fact).

19. *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1372 (Fed. Cir. 2018) ("Placement of a term on the fanciful-suggestive-descriptive-generic continuum is a question of fact.") (quoting *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 102 USPQ2d 1753 (Fed. Cir. 2012)); *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) ("The Board's determination that a mark is merely descriptive is a factual finding that is reviewed for support by substantial evidence."); *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1040 (Fed. Cir. 1990) (descriptiveness is a question of fact). *See also In re Chippendales USA*, 622 F.3d 1346, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010) ("The issue of inherent distinctiveness is a factual determination made by the Board.") (quoting *Hoover Co. v. Royal Appliances Mfg. Co.*, 238 F.3d 1357, 1359, 57 USPQ2d 1720 (Fed. Cir. 2001)); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) ("The Board's placement of a mark on the fanciful-suggestive-descriptive-generic continuum is a question of fact, which this court reviews for substantial evidence."); *In re Compagnie Generale Maritime*, 993 F.2d 841, 845, 26 USPQ2d 1652, 1654 (Fed. Cir. 1993) ("Whether a mark is primarily geographically descriptive or deceptively misdescriptive is a question of fact.").

20. *In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395, 1397 (Fed. Cir. 2006) (similar to question of descriptiveness, issue of whether trade dress is product design is question of fact, as is inquiry into whether mark is unitary).

21. *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1372 (Fed. Cir. 2018) ("Placement of a term on the fanciful-suggestive-descriptive-generic continuum is a question of fact.") (citing *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 102 USPQ2d 1753 (Fed. Cir. 2012); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1044 (Fed. Cir. 2018) (whether the Board applied the correct legal standard in assessing a mark for genericness is a question of law to be reviewed de novo) (citing *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015) (internal citation and subsequent history omitted) and *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002)); *In re Louisiana Fish Fry Products, Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (review of Board's legal conclusions de novo and its factual determinations for substantial evidence).

22. *Jack Wolfskin Ausrustung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1133 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 982 (2016) (noting Supreme Court's holding in *Hana Financial, Inc. v. Hana Bank*, 135 S. Ct. 907 (2015), in connection with a priority dispute, that "same continuing commercial impression" is a question of fact," Federal Circuit no longer treats this question as a question of law subject to de novo review; therefore substantial evidence standard applies to continuing commercial impression in determining both priority and abandonment).

23. *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1893 (Fed. Cir. 2015).

24. *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1372 (Fed. Cir. 2018) ("Placement of a term on the fanciful-suggestive-descriptive-generic continuum is a question of fact.") (citing *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 102 USPQ2d 1753 (Fed. Cir. 2012)); *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017) (same).

25. *Lyons v. American College of Veterinary Sports Medicine & Rehabilitation*, 859 F.3d 1023, 123 USPQ2d 1024, 1030 (Fed. Cir. 2017) (Board's findings regarding disputed ownership of mark were supported by substantial evidence).

26. *Quiktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 USPQ2d 35, at *2 (Fed. Cir. 2021) ("We review the Board's factual findings on each relevant DuPont factor for substantial evidence, but we review the Board's … weighing of the DuPont factors de novo.").

27. *Hylete LLC v. Hybrid Athletics, LLC*, 931 F.3d 1170, 2019 USPQ2d 285253, at *3 (Fed. Cir. 2019) (Federal Circuit reviews the Board's legal conclusions de novo and its factual findings for substantial evidence) (citing *In re i.am.symbolic LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017)); *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1372 (Fed. Cir. 2018) (Federal Circuit reviews legal conclusions de novo and finding of fact for substantial evidence); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1044 (Fed. Cir. 2018) (whether the correct legal standard was applied in assessing a mark for genericness is a question of law to be reviewed de novo) (citing *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015) (internal citation and subsequent history omitted) and *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002)); *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (Federal Circuit reviews conclusions of law de novo); *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (Board's findings of fact are reviewed for substantial evidence; conclusions of law are reviewed de novo); *Lyons v. American College of Veterinary Sports Medicine & Rehabilitation*, 859 F.3d 1023, 123 USPQ2d 1024, 1026-27 (Fed. Cir. 2017) (same); *In re Louisiana Fish Fry Products, Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (Federal Circuit reviews Board's legal conclusions de novo); *Couture v. Playdom, Inc.*, 778 F.3d 1379, 113 USPQ2d 2042, 2043 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 88 (2015); *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1716 (Fed. Cir. 2012) ("We review the Board's legal conclusions de novo …) (citing *In re Pacer Tech.*, 338 F.3d 1348, 1349, 67 USPQ2d 1629 (Fed. Cir. 2003)); *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Glendale International Corp. v. USPTO*, 374 F. Supp. 2d 479, 75 USPQ2d 1139, 1143 (E.D. Va. 2005).

28. *See In re Forney Indus., Inc.*, 955 F.3d 940, 2020 USPQ2d 10310, at *3 (Fed. Cir. 2020) ("The correct standard to apply in determining inherent distinctiveness, however, is a legal question, which we review de novo").

29. *See Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1049 (Fed. Cir. 2018) (case remanded after de novo review because Board applied incorrect legal standard in assessing whether proposed marks are generic and by failing to assess the level of the proposed marks' distinctiveness, both of which are legal determinations); *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (Board did not err as matter of law by considering explanatory text of specimens in concluding that applicant's "First Tuesday" mark in connection with lottery services and games is merely descriptive of applicant's goods and services); *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1171 (Fed. Cir. 2013) ("Whether preclusion applies to bar a particular action is an issue of law, which this court decides de novo."); *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002) (conclusions of law are reviewed without deference, and on grant of summary judgment, court must decide for itself whether moving party has shown that it is entitled to judgment as a matter of law); *Sunrise Jewelry Mfg. Corp. v. Fred, S.A.*, 175 F.3d 1322, 50 USPQ2d 1532, 1534 (Fed. Cir. 1999) (whether Board properly granted defendant's motion to dismiss is a question of law that is reviewed "independently"); *Spraying Systems Co. v. Delavan Inc.*, 975 F.2d 387, 24 USPQ2d 1181, 1184 (7th Cir. 1992) (Board's grant of summary judgment is reviewed de novo).

30. *See Quiktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 USPQ2d 35, at *2 (Fed. Cir. 2021) ("We review the Board's factual findings on each relevant DuPont factor for substantial evidence, but we review the Board's … weighing of the DuPont factors de novo."); *Hylete LLC v. Hybrid Athletics, LLC*, 931 F.3d 1170, 2019 USPQ2d 285253, at *3 (Fed. Cir. 2019) ("Likelihood of confusion is a question of law based on underlying findings of facts. … The Board's underlying findings of fact as to each *DuPont* factor are reviewed for substantial evidence.") (citing *In re Chatam International Inc.*, 380 F.3d 1340, 1342 (Fed. Cir. 2004)); *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) ("Likelihood of confusion is a question of law based on underlying findings of fact.") (citing *In re Chatam International, Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004)); *Juice Generation, Inc. v. GS Enterprises, LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (conclusion regarding a likelihood of confusion is a question of law that the Federal Circuit reviews de novo, although underlying factual findings are reviewed for substantial evidence); *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) ("The Board's legal conclusion receives plenary review, while the factors relevant to likelihood of confusion are reviewed for support by substantial evidence, in accordance with the criteria of the Administrative Procedure Act."); *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

31. *See ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 159, 82 USPQ2d 1414, 1429 (2nd Cir. 2007) (under general principles of administrative law deference is due to the Board's interpretation of the statute the agency is charged with administering); *Star Industries Inc. v. Bacardi & Co. Ltd.*, 412 F.3d 373, 75 USPQ2d 1098, 1102 n.2 (2nd Cir. 2005); *International Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco*, 329 F.3d 359, 66 USPQ2d 1705, 1719-20 (4th Cir. 2003); *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997) ("[T]his court defers to the agency's reasonable statutory interpretation."); *Eastman Kodak Co. v. Bell & Howell Document Management Prods., Co.*, 994 F.2d 1569, 26 USPQ2d 1912, 1915-16 (Fed. Cir. 1993) (applying *Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837 (1984) to a decision of the Board, which is treated as if it were the "agency," and holding the Board's interpretation of an ambiguous provision of the trademark statute reasonable, rather than undertaking a de novo interpretation of law); *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 634, 29 USPQ2d 1231, 1243 (7th Cir. 1993) (affording *Chevron* deference to the Board's interpretation of the Lanham Act). *But see In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1781 (Fed. Cir. 2001) (validity of the Board's adaptation of the related goods test to geographic marks is a question of law that is reviewed de novo); *In re International Flavors & Fragrances, Inc.*, 183 F.3d 1361, 51 USPQ2d 1513, 1515 (Fed. Cir. 1999).

32. Compare *Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (Board did not abuse its discretion in excluding appellant's evidence, where Board's evidentiary determination was based on the TBMP, citing cases where "we have affirmed the TTAB's determinations, specifically with regard to evidence admission, where they are clearly in line with the language of the TBMP.") *with Custom Computer Services Inc. v. Paychex Properties Inc.*, 337 F.3d 1334, 67 USPQ2d 1638, 1639 (Fed. Cir. 2003) (substantial deference to USPTO's interpretation of its own regulation).

33. *Accord MaxLinear, Inc. v. CF Crespe LLC*, 880 F.3d 1373, 125 USPQ2d 1577, 1579 (Fed. Cir. 2018) (" *B & B Hardware* is particularly relevant here, as the Court held that 'issue preclusion should apply' to the final written decision of the Trademark Trial and Appeal Board ("TTAB"). … The TTAB, at issue in *B & B Hardware*, and [PTAB] in this case, are indistinguishable for preclusion purposes."); *V.V.V. & Sons Edible Oils Limited v. Meenakshi Overseas, LLC*, 946 F.3d 542, 2019 USPQ2d 494448, at *3-4 (9th Cir. 2019) (reversing district court's finding of claim preclusion based on Board opposition proceeding, but noting the applicability of *B & B Hardware* to issues decided in Board proceedings and leaving it to the district court to consider whether plaintiff "should be precluded from litigating certain issues because of the

TTAB judgment"); *Cesari S.r.L. v. Peju Province Winery L.P.*, No. 17-873, 2017 WL 6509004 (S.D.N.Y. Dec. 11, 2017) (court discusses issue and claim preclusion, and applies *B & B Hardware* to grant partial summary judgment on likelihood of confusion in infringement case). *Cf. In re FCA US LLC*, 126 USPQ2d 1214, 1215-19 (TTAB 2018) (Board affirms likelihood of confusion refusal despite district court's previous finding of no infringement; issue preclusion principles of *B & B Hardware* not applicable because USPTO was not a party to the infringement action and issues presented to district court in infringement action differ from issues in ex parte appeal. "As the Supreme Court said of the trademark registration process as compared to infringement litigation, 'it is a separate proceeding to decide separate rights.' *B & B Hardware*, 113 USPQ2d at 2056."); *appeal filed*, No. 18-2069 (Fed. Cir. June 13, 2018); *CSL Silicones Inc. v. Midsun Group Inc.*, 170 F. Supp. 3d 304, 318-19 & n.12, (D. Conn. 2016) (issue preclusion not applicable under *B & B Hardware* because no issues were decided in the 2005 Board cancellation proceeding which was dismissed with prejudice following petitioner's withdrawal of its cancellation petition; finding no claim preclusion due to change in transactional facts).

34. *Nationstar Mortgage, LLC v. Ahmad*, 155 F. Supp. 3d 585, 592-93 (E.D. Va. 2015) (citing *Nationstar Mortgage, LLC v. Ahmad*, 112 UPQ2d 1361 (TTAB 2014)), *appeal dismissed*, No. 16-1422 (4th Cir. July 13, 2016). *But see Beasley v. Howard*, 2020 USPQ2d 7300, at *5 (D.N.J. 2020) (claim preclusion applied in civil action seeking cancellation of registration based on "priority of use and fraud" where the parties had been involved in two separate Board cancellation proceedings and final judgments had been entered on plaintiff's fraud and likelihood of confusion claims in the Board proceedings and not appealed).

35. *Ashe v. The PNC Financial Services Group, Inc.*, 165 F.Supp.3d 357 (D. Md. 2015). *See also Jean Alexander Cosmetics, Inc. v. L'Oreal USA, Inc.*, 458 F.3d 244, 80 USPQ2d 1470, 1479 (3d Cir. 2006) (finding issue preclusion as to independently sufficient alternative holding of no likelihood of confusion which was raised and litigated in Board proceeding); *Treadwell Original Drifters, LLC v. Original Drifters, Inc.*, No. 1:15-cv-580, 2016 WL 5899289, at *6-7 (E.D. Va. Jan. 28, 2016) (issue preclusion found for party in privity on the issue of priority based on 2004 Board decision, but not based on 2009 or 2015 Board decisions), *aff'd*, 678 F. App'x 90 (4th Cir. 2017).

36. *Royal Crown Co. v. Coca-Cola Co.*, 823 F. App'x 960, 2020 USPQ2d 10881, at *2 (Fed. Cir. 2020) ("The Board's application of its own trial rules is reviewed for a determination of whether it is "arbitrary, capricious, [or] an abuse of discretion."); *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (Board did not abuse its discretion in excluding appellant's evidence, where Board's evidentiary determination was based on the TBMP, citing cases where "we have affirmed the TTAB's determinations, specifically with regard to evidence admission, where they are clearly in line with the language of the TBMP.").

37. *Royal Crown Co. v. Coca-Cola Co.*, 823 F. App'x 960, 2020 USPQ2d 10881, at *3 (Fed. Cir. 2020) (Board's granting Coca-Cola's post-trial, unconsented-to motion was not arbitrary, capricious, and an abuse of discretion; "… the Board exercises its discretion to grant motions—for all kinds of amendments—in the appropriate circumstances, which usually align with general principles of administrative economy and vary depending on the case."); *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (Board did not abuse its discretion in excluding appellant's evidence, where Board's evidentiary determination was based on the TBMP, citing cases where "we have affirmed the TTAB's determinations, specifically with regard to evidence admission, where they are clearly in line with the language of the TBMP.").

906.02 Petition To Director

In reviewing non-final rulings of the Board, the Director will exercise supervisory authority under 37 C.F.R. § 2.146(a)(3) and reverse the Board's ruling only where there is a clear error or abuse of discretion. [Note 1.]

NOTES:

1. *See In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1511 (Comm'r 1995); *Huffy Corp. v. Geoffrey Inc.*, 18 USPQ2d 1240, 1242 (Comm'r 1990); *Paolo's Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899, 1902 (Comm'r 1990).

Chapter 1000 INTERFERENCES

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1002	**Declaration of Interference**
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1004	**Issues in Interference**
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1001 In General

Trademark Act § 16,15 U.S.C. § 1066 *Upon petition showing extraordinary circumstances, the Director may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive. No interference shall be declared between an application and the registration of a mark the right to the use of which has become incontestable.*

37 C.F.R. § 2.83 ***Conflicting marks.***

(a) *Whenever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the Official Gazette for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register.*

(b) *In situations in which conflicting applications have the same effective filing date, the application with the earliest date of execution will be published in the Official Gazette for opposition or issued on the Supplemental Register.*

(c) *Action on the conflicting application which is not published in the Official Gazette for opposition or not issued on the Supplemental Register will be suspended by the Examiner of Trademarks until the published or issued application is registered or abandoned.*

37 C.F.R. § 2.146 ***Petitions to the Director.***

(a) *Petition may be taken to the Director in a trademark case: ...*

(4) *In any case not specifically defined and provided for by parts 2, 3, 6, and 7 of Title 37 of the Code of Federal Regulations; …*

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 1.] A “conflict” exists, for interference purposes, whenever “application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive.” [Note 2.]

Ordinarily, when conflicting applications are pending, the application with the earliest effective filing date is approved for publication in the Official Gazette for opposition (if the mark is eligible for registration on the Principal Register), or is registered on the Supplemental Register (if the mark is eligible for registration on the Supplemental Register). Action on any later-filed conflicting application is suspended until the earlier-filed application is registered or abandoned. [Note 3.]

If the owner of an application which conflicts with one or more pending applications wishes to have the Office set up an interference proceeding between the conflicting applications, rather than have the Office follow the procedure described in 37 C.F.R. § 2.83, that applicant must file a petition to the Director to declare an interference. [Note 4.] TBMP § 1002.

Please Note: Although the Director is authorized by Trademark Act § 16, 15 U.S.C. § 1066 to declare an interference between an application and a registration (except for registrations issued on the Supplemental Register, registrations issued under the Trademark Act of 1920, and registrations of marks the right to use of which has become incontestable), it is not the Director's practice to do so, *see*TBMP § 1002.

NOTES:

1. *See* Trademark Act § 16, 15 U.S.C. § 1066 and Trademark Act § 18, 15 U.S.C. § 1068.

2. Trademark Act § 16, 15 U.S.C. § 1066. *See also* Trademark Act § 2(d), 15 U.S.C. § 1052(d); 37 C.F.R. § 2.83; TMEP § 1208.03 *et seq.*; TMEP § 1507.

3. 37 C.F.R. § 2.83; TMEP § 1208.02(c).

4. *See* Trademark Act § 16, 15 U.S.C. § 1066; 37 C.F.R. § 2.146(a)(4) and 37 C.F.R. § 2.146(c).

1002 Declaration of Interference

Trademark Act § 16,15 U.S.C. § 1066 *Upon petition showing extraordinary circumstances, the Director may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive. No interference shall be declared between an application and the registration of a mark the right to use of which has become incontestable.*

37 C.F.R. § 2.146 ***Petitions to the Director.***

(a) *Petition may be taken to the Director in a trademark case: ...*

(4) *In any case not specifically defined and provided for by parts 2, 3, 6, and 7 of Title 37 of the Code of Federal Regulations; …*

(c) *Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by § 2.6. Any brief in support of the petition shall be embodied in or accompany the petition. The petition must be signed by the petitioner, someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(5). When facts are to be proved on petition, the petitioner must submit proof in the form of verified statements signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.*

Under Trademark Act § 16, 15 U.S.C. § 1066, the Director, upon petition showing extraordinary circumstances, may declare that an interference exists when an application conflicts with a registration issued to another, or with an application previously filed by another, that is, "when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration

of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive."

A petition for declaration of an interference will be granted by the Director only if the petition shows "extraordinary circumstances which would result in a party being unduly prejudiced without an interference." [Note 1.] Ordinarily, the availability of an opposition or cancellation proceeding is deemed to prevent any undue prejudice from the unavailability of an interference proceeding. [Note 2.] One such petition was granted where, without the ability to invoke an interference proceeding, multiple oppositions which would have both complicated and substantially delayed resolution of the dispute would have been necessary. [Note 3.]

Although the Director is authorized by Trademark Act § 16, 15 U.S.C. § 1066 to declare an interference between an application and a registration (except for registrations issued on the Supplemental Register, registrations issued under the Trademark Act of 1920, and registrations of marks the right to use of which has become incontestable) [Note 4], it is not the Director's practice to do so. [Note 5.] This is because a registration will not be cancelled as a result of a decision in an interference proceeding. A formal petition for cancellation must still be filed and granted, and the registration must be cancelled, before any registration will be issued to the applicant. [Note 6.] The interference proceeding is superfluous, since the cancellation proceeding by itself will accomplish the same purpose as the two proceedings together.

A petition to the Director to declare an interference should be made by filing a separate "PETITION TO THE DIRECTOR," through TEAS, and be accompanied by the fee specified in 37 C.F.R. § 2.6. For further information concerning the form for a petition to the Director, see 37 C.F.R. § 2.146(c), TMEP § 1208.03 and TBMP § 905.

A petition to declare an interference should not be filed in an application until the examining attorney has examined the application, and the mark has been found registrable but for the existence of one or more pending conflicting applications. When such a petition is filed, the Office of the Commissioner for Trademarks will make a determination of the petition. A request for interference does not alter the normal course of examination. [Note 7.]

Please note: In connection with Executive Order 13777, ''Enforcing the Regulatory Reform Agenda,'' the USPTO issued a final rule removing as unnecessary the regulations concerning trademark interferences codified at 37 C.F.R. § 2.91, 37 C.F.R. § 2.92, 37 C.F.R. § 2.93, 37 C.F.R. § 2.96, and 37 C.F.R. § 2.98. [Note 8.] These rules are now marked "Reserved." Parties still retain an avenue for seeking a declaration of interference by filing a petition to the Director under 37 C.F.R. § 2.146(a)(4), which provides that a petitioner may seek relief in any case not specifically defined and provided for by Part 2 of Title 37. [Note 9.]

NOTES:

1. TMEP § 1208.03(b) and TMEP § 1507. *See also In re Ratny*, 24 USPQ2d 1713, 1715 (Comm'r 1992) (extraordinary circumstances required for interference); *In re Kimbell Foods, Inc.*, 184 USPQ 172, 173 (Comm'r 1974) (same); *In re Family Inns of America, Inc.*, 180 USPQ 332, 332 (Comm'r 1974) (same).

2. TMEP § 1208.03(b) and TMEP § 1507. *See also In re Kimbell Foods, Inc.*, 184 USPQ 172, 173 (Comm'r 1974).

3. *See In re Family Inns of America, Inc.*, 180 USPQ 332, 332 (Comm'r 1974). *See also*TMEP § 1208.03; TMEP § 1208.03(b).

4. *See* Trademark Act § 16, Trademark Act § 26, and Trademark Act § 46(b), 15 U.S.C. § 1066, 15 U.S.C. § 1094, 15 U.S.C. § 1051; TMEP § 1507.

5. *See In re Kimbell Foods, Inc.*, 184 USPQ 172, 173 (Comm'r 1974); *Ex parte H. Wittur & Co.*, 153 USPQ 362, 363 (Comm'r 1966).

6. *See In re Kimbell Foods, Inc.*, 184 USPQ 172, 173 (Comm'r 1974); *Ex parte H. Wittur & Co.*, 153 USPQ 362, 363 (Comm'r 1966). *Cf. Hy-Pure Laboratories, Inc. v. Foley & Co.*, 98 USPQ 280, 281 (Chief Examiner 1953) (present practice is not to cancel the registration of the losing registrant in an interference when the cases were not copending, unless the winning party files a formal petition to cancel the registration); *Cudahy Packing Co. v. York Pharmacal Co.*, 93 USPQ 227, 228 (Comm'r 1952) (same).

7. *See*TMEP § 1208.03.

8. REMOVAL OF RULES GOVERNING TRADEMARK INTERFERENCES, 83 Federal Register 33129, 33130 (July 17, 2018). The final rule also revised the authority citation for part 2, and the undesignated center heading "INTERFERENCES AND CONCURRENT USE PROCEEDINGS" to read "CONCURRENT USE PROCEEDINGS."

9. REMOVAL OF RULES GOVERNING TRADEMARK INTERFERENCES, 83 Federal Register 33129, 33130 (July 17, 2018).

1003 Institution of Interference

An interference proceeding does not commence with the granting of a petition to the Director to declare an interference. Rather, the interference proceeding will not be instituted unless and until the examining attorney has determined that the marks which are to be included in the interference are registrable, but for the interfering marks; and all of the marks have been published (preferably together) in the Official Gazette for opposition, subject to the interference. [Note 1.]

If an application published subject to interference is opposed by an entity which is not to be a party to the interference, the opposition may be determined first, following which the interference, if still necessary and appropriate, will be instituted. [Note 2.] Alternatively, depending upon the circumstances, the opposition and interference may go forward contemporaneously. If an opposition is filed by an entity that is to be a party to the interference, and the interference is to involve three or more parties, the opposition will be dismissed without prejudice in favor of the interference proceeding, wherein the rights of all parties can be determined in a single proceeding. If an opposition is filed by an entity that is to be a party to the interference, and the interference is to involve only two parties, the rights of the parties will be determined in the opposition, and the interference will not be instituted.

If the marks which are to be included in an interference (1) are found by the examining attorney to be registrable, (2) are published for opposition, and (3) survive the opposition period (as indicated in the preceding paragraph), the interference proceeding will be instituted by the Board.

The Board prepares a "Notice of Interference" notifying the parties that the interference proceeding is thereby instituted, and setting conferencing, disclosure, discovery, trial and briefing dates in the case, as may be deemed appropriate by the Board. The notice specifies the name and address of each party to the proceeding and of each party's attorney or other authorized representative, if any; the mark of each party; and the serial number, filing date, and publication date of each involved application. [Note 3.]

An interference proceeding commences when the Board mails or emails the notice of interference to the parties. *See*TBMP § 302. The notice is mailed or emailed to the attorney or other authorized representative of each involved applicant, or, if the applicant does not have an attorney or other authorized representative, to the applicant. [Note 4.]

It is not the Director's practice to declare an interference with a registration. *See*TBMP § 1002. However, should the Director elect to declare an interference with one or more registrations, the notice of interference would specify the registration number and issuance date of each involved registration, and would be mailed or emailed to the registrant or its assignee of record.

There are no pleadings in an interference proceeding. *Cf.*TBMP § 1003 (Institution of Interference), TBMP § 1106 (Commencement of Concurrent Use Proceeding), and TBMP § 1107 (Answer; Default in Concurrent Use Proceeding). The notice of interference takes the place of pleadings, to the extent that it serves to provide each party with information concerning the involved application (or registration, if an interference should be declared with one or more registrations) of every adverse party.

There is no fee for an interference proceeding, beyond the fee required for a petition to the Director to declare an interference. [Note 5.]

NOTES:

1. *See*TMEP § 1208.03(c).

2. *Cf.* 37 C.F.R. § 2.99(c).

3. *Cf.* 37 C.F.R. § 2.99(c).

4. *Cf.* 37 C.F.R. § 2.99(c).

5. *See* 37 C.F.R. § 2.6.

1004 Issues in Interference

Normally, the issue to be determined in an interference proceeding is priority of use. However, such additional issues as the registrability of each mark, and whether there is, in fact, a conflict between the marks involved in the proceeding (i.e., whether the marks do so resemble one another as to be likely, when used in connection with the respective goods and/or services of the parties, to cause confusion, mistake, or deception), are always before the Board in an interference, and may also be determined. There is no requirement that a party file an affirmative pleading of such matters in order to be heard thereon. [Note 1.]

NOTES:

1. *See, e.g.*, Trademark Act § 17 and Trademark Act § 18, 15 U.S.C. § 1067 and 15 U.S.C. § 1068; *Giant Food Inc. v. Malone & Hyde, Inc.*, 522 F.2d 1386, 187 USPQ 374, 380 (CCPA 1975); *Dynamet Technology, Inc. v. Dynamet Inc.*, 197 USPQ 702, 711-12 (TTAB 1977), *aff'd*, 593 F.2d 1007, 201 USPQ 129 (CCPA 1979); *Jos. Schlitz Brewing Co. v. United Vintners, Inc.*, 166 USPQ 493, 494 (TTAB 1970); *Clairol Inc. v. Holland Hall Products, Inc.*, 165 USPQ 214, 217-18 (TTAB 1970); *Tudor Square Sportswear, Inc. v. Pop-Op Corp.*, 160 USPQ 50, 53-54 (TTAB 1968); *La Jolla Sportswear Co. v. Maskuline Underwear Co.*, 114 USPQ 130, 131 (Comm'r 1957); Rules of Practice in Trademark Cases, 48 Fed. Reg. 23122 (May 23,

1983), (deleting former 37 C.F.R. § 2.97, which contained a requirement for an affirmative pleading of registrability issues).

1005 Burden of Proof

37 C.F.R. § 2.116(b) *... A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.*

In an interference proceeding, the party whose involved application has the latest filing date is the junior party. When there are three or more parties to an interference, a party is a junior party to every other party whose involved application has an earlier filing date. If the involved applications of any parties have the same filing date, the application with the latest date of execution is deemed to have the latest filing date, and that applicant is the junior party. [Note 1.] *Cf* . TBMP § 1108.

A junior party in an interference proceeding is in the position of plaintiff, and has the burden of proof, as against every party that is senior, that is, as against every party whose involved application has an earlier filing date. Conversely, a senior party is in the position of defendant as against every party that is junior, that is, as against every party whose involved application has a later filing date. [Note 2.] For information concerning joining or substituting a transferee when there has been an assignment of a mark which is involved in an interference proceeding, see TBMP § 512.01.

NOTES:

1. *Cf.* 37 C.F.R. § 2.99(e).

2. 37 C.F.R. § 2.116(b). *See also Jim Dandy Co. v. Martha White Foods, Inc.*, 458 F.2d 1397, 173 USPQ 673, 674 (CCPA 1972); *McNeil v. Mini Mansions, Inc.*, 178 USPQ 312, 314 (TTAB 1973).

1006 Addition of Party

A party may be added to an interference only upon petition to the Director filed, pursuant to 37 C.F.R. § 2.146(a)(4), by the party to be added.

1007 Conduct of Proceeding

Once commenced, an interference proceeding is conducted in the same general manner as an opposition or cancellation proceeding, except that there are no pleadings, and therefore no motions relating to pleadings. [Note 1.] The issues of priority of use, likelihood of confusion, and registrability are always before the Board. A party's burden of proof as against another party to the proceeding depends upon the filing date of its involved application, and additional parties may be added to the proceeding upon petition to the Director filed by the party to be added. *See*TBMP § 1002 (Declaration); TBMP § 1003 (Institution); TBMP § 1004 (Issues in Interference); TBMP § 1005 (Burden of Proof); and TBMP § 1006 (Addition of Party).

In addition, the trial and briefing schedule in an interference involving three or more parties differs, because of the multiplicity of parties, from that in an opposition or cancellation. In the notice of interference that commences an interference proceeding, the Board sets trial and briefing dates in the case, including dates for a discovery conference, initial and expert disclosures, an opening and closing date for discovery, and

pretrial disclosures and rebuttal disclosures, as may be deemed appropriate by the Board. *See* TBMP § 1003. In particular, the Board schedules testimony periods so that each party in the position of plaintiff, *see*TBMP § 1005, will have a period for presenting its case in chief against each party in the position of defendant, each party in the position of defendant will have a period for presenting its case and meeting the case of each plaintiff, and each party in the position of plaintiff will have a period for presenting evidence in rebuttal. The scheduling order will also set the time for pretrial disclosures of witnesses. [Note 2.] Similarly, the Board schedules briefing periods so that each party, beginning with the junior-most party and ending with the senior-most party, will have a time for filing its main brief on the case, and each junior party will have a time for filing a reply brief. *See*TBMP § 801.02(e). As in all inter partes proceedings before the Board, the parties may stipulate to pretrial disposition on the merits or abbreviated trial on the merits by means of Accelerated Case Resolution (ACR), and may otherwise stipulate to a variety of matters to expedite the proceeding. [Note 3.] For information on ACR, see TBMP § 528.05(a)(2) and TBMP § 702.04.

With the exceptions noted above, the practices and procedures for conferencing, making disclosures, taking discovery, filing motions, introducing evidence, briefing the case, presenting oral arguments at final hearing, and seeking review of a decision of the Board, are essentially the same in an interference as in an opposition or cancellation.

NOTES:

1. *Compare, e.g.,* 37 C.F.R. § 2.107 with 37 C.F.R. § 2.115.

2. *See, e.g.,* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244-42245 (August 1, 2007).

3. 37 C.F.R. § 2.121(e).

Chapter 1100 CONCURRENT USE PROCEEDINGS

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1101 In General

Trademark Act § 2, 15 U.S.C. § 1052 *No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it*

* * * *

(d) *Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause*

mistake, or to deceive: Provided, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to

(1) *the earliest of the filing dates of the applications pending or of any registration issued under this chapter;*

(2) *July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or*

(3) *July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.*

Trademark Act § 17, 15 U.S.C. § 1067(a) *In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Director shall give notice to all parties and shall direct the Trademark Trial and Appeal Board to determine and decide the respective rights of registration.…*

Trademark Act § 18, 15 U.S.C. § 1068 *In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties under this chapter may be established in the proceedings: Provided, That in the case of the registration of any mark based on concurrent use, the Director shall determine and fix the conditions and limitations provided for in subsection (d) of section 1052 of this title.…*

1101.01 Nature of Proceeding

A concurrent use registration proceeding (hereafter referred to as a "concurrent use proceeding") is an inter partes proceeding in which the Board determines whether one or more applicants is entitled to a concurrent registration, that is, a restricted registration, with conditions and limitations fixed by the Board, as to the mode or place of use of the applicant's mark or the goods and/or services on or in connection with which the mark is used. [Note 1.] Restrictions are generally to claimed geographic areas of use.

Trademark Act § 2(d), 15 U.S.C. § 1052(d), governs the Board's determination of registrability in a concurrent use proceeding. That section provides, in part, that if the Director (acting through the Board):

... determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to …

a certain specified date (normally, prior to the earliest application filing date of the application(s), or 1946 Act registration(s) (if any), involved in the proceeding, or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905.) [Note 2.] *See*TBMP § 1103.01(b).

The proviso of Trademark Act § 2(d), 15 U.S.C. § 1052(d), sets out two requirements for issuance of a concurrent use registration in a proceeding before the Board. [Note 3.] A concurrent use applicant needs to meet the jurisdictional requirement of use in commerce prior to the applicable date specified in Trademark Act § 2(d). For information concerning the dates specified in Trademark Act § 2(d) and a discussion of the jurisdictional requirement, see TBMP § 1103.01(b). A concurrent use applicant also must show that use of the mark for which it seeks a concurrent registration will not result in a likelihood of confusion. [Note 4.] There is no provision in the Lanham Act to allow for concurrent use registrations in the dilution context. [Note 5.]

For information regarding disclosures and discovery conferences in the context of a concurrent use proceeding, see TBMP § 401. [Note 6.]

NOTES:

1. *See, e.g.,* Trademark Act § 2(d), Trademark Act § 17, and Trademark Act § 18, 15 U.S.C. § 1052(d), 15 U.S.C. § 1067, and 15 U.S.C. § 1068; 37 C.F.R. § 2.133(c); *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 831 (CCPA 1980) (the conditions and limitations imposed by Trademark Act § 2(d) are for the purpose of preventing consumer confusion); *Southwestern Management, Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1020 (TTAB 2015), *aff'd mem.*, 652 F. App'x 971 (Fed. Cir. 2016) (referencing the language of Trademark Act § 2(d)); *Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2d 1925, 1928 (TTAB 2015) (same); *Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300, 1307 (TTAB 2003) ("A concurrent use registration, by its very nature, contemplates that the registered mark can and does function to identify more than one source … because each source's use of the mark is subject to conditions and limitations which eliminate likelihood of confusion . . . ."); *Terrific Promotions Inc. v. Vantex Inc.*, 36 USPQ2d 1349, 1353 (TTAB 1995); *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1229 (TTAB 1989); *Women's World Shops Inc. v. Lane Bryant Inc.*, 5 USPQ2d 1985, 1988 (TTAB 1988); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 916 (TTAB 1984).

2. *See* Trademark Act § 17, 15 U.S.C. § 1067.

3. *See In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431, 436 (CCPA 1970); *Southwestern Management, Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1020 (TTAB 2015), *aff'd mem.*, 652 F. App'x 971 (Fed. Cir. 2016); *Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2d 1925 (TTAB 2015); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879, 882 (TTAB 1985).

4. *See Southwestern Management, Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1020 (TTAB 2015), *aff'd mem.*, 652 F. App'x 971 (Fed. Cir. 2016); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1478 (TTAB 2014); *America's Best Franchising Inc. v. Abbott*, 106 USPQ2d 1540, 1547-48 (TTAB 2013); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 (TTAB 1990); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879, 882 n.4 (TTAB 1985). *Cf. Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300, 1307 (TTAB 2003) (petitioner asserting that concurrent use registration should be deemed abandoned because mark is used by multiple parties "must do more than merely show that the registered mark is being used concurrently by the concurrent use registrants in accordance with the conditions and limitations set forth in their concurrent use registrations.").

5. *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 330 F.3d 1333, 66 USPQ2d 1811, 1819 (Fed. Cir. 2003) ("Section 1063 does not provide for concurrent use registrations, an omission that must be seen as a deliberate choice made by Congress."). *See also* Trademark Act § 2(f), 15 U.S.C. § 1052(f) ("A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c), may be refused registration only pursuant to a proceeding brought under section 13.").

6. 37 C.F.R. § 2.120(a)(1). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244-47 (August 1, 2007).

1101.02 Context for USPTO Determination of Concurrent Rights

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

Within the USPTO, the Board determines the right to a concurrent registration. [Note 1.] Concurrent registration rights are considered and determined by the Board only in the context of a concurrent use proceeding. [Note 2.]

A registration cannot be restricted territorially by amendment under Trademark Act § 7(e), 15 U.S.C. § 1057(e), and 37 C.F.R. § 2.173(a). [Note 3.] Thus, a cancellation proceeding may not be settled by amending the involved registration to include territorial restrictions. [Note 4.] However, the registrant may agree to entry of judgment against it in the cancellation proceeding or voluntarily surrender its registration for cancellation and thereafter apply for a registration as a lawful concurrent user. [Note 5.] *See also*TBMP § 1114. The cancellation proceeding may be suspended to allow registrant time to file a concurrent use application, and terminated when registrant's concurrent use application has been published for opposition purposes and no opposition is filed, or all oppositions filed are dismissed or withdrawn. *See*TBMP § 1113.02.

Moreover, a Trademark Act § 7(e) amendment may generally not be used to remove a concurrent use restriction from a registration. However, removal of a concurrent use restriction by amendment under Trademark Act § 7(e) may be permitted where an entity which was the only exception to registrant's right to exclusive use of its registered mark assigns its rights in its mark to registrant, so that all rights in the mark are merged in registrant. [Note 6.]

NOTES:

1. *See* Trademark Act § 2(d), Trademark Act § 17, and Trademark Act § 18, 15 U.S.C. § 1052(d), 15 U.S.C. § 1067 and 15 U.S.C. § 1068.

2. *See* Trademark Act § 2(d), Trademark Act § 17, and Trademark Act § 18, 15 U.S.C. § 1052(d), 15 U.S.C. § 1067, and 15 U.S.C. § 1068. *See also* 37 C.F.R. § 2.99(h) and 37 C.F.R. § 2.133(c); *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 330 F.3d 1333, 66 USPQ2d 1811, 1815 (Fed. Cir. 2003); *Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665, 669 (Fed. Cir. 1984) (attempt to interject concurrent use proceeding into cancellation unavailing), *aff'g*, 220 USPQ 52 (TTAB 1983); *Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394, 400 (Fed. Cir. 1983) (concurrent use not available in cancellation by way of counterclaim); *Rosso & Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 219 USPQ 1050, 1053 (Fed. Cir. 1983); *Selfway, Inc. v. Travelers Petroleum, Inc.*, 579 F.2d

75, 198 USPQ 271, 277 (CCPA 1978) (concurrent rights can only be adjudicated in concurrent use proceeding); *Holmes Oil Co. v Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1149 (TTAB 2011) (in concurrent use proceedings, the Board determines entitlement to a registration, generally with a geographic restriction); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1106 n.3 (TTAB 2007) (no consideration given in cancellation proceeding to proposed counterclaim to partially cancel petitioner's pleaded registrations by further limiting the geographic scope thereof).

3. *See In re Forbo*, 4 USPQ2d 1415, 1415 (Comm'r 1984) ("Registrations are territorially restricted pursuant to concurrent use or court proceedings in which territorial rights are judicially determined; a registrant may not make this determination itself or request it in the same way that a registration is restricted as to goods.").

4. *See, e.g., Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831, 832 (Comm'r 1984) (a decision in the cancellation proceeding adverse to respondent would not preclude respondent from filing a new application seeking concurrent registration with petitioner). *See also Boi Na Braza, LLC v. Terra Sul Corp.*, 110 USPQ2d 1386, 1388 (TTAB 2014) (after its registration was cancelled, respondent filed a new application seeking a concurrent use registration with petitioner named as concurrent user).

5. *See Chichi's, Inc. v. Chi-Chi's*, Inc., 222 USPQ 831, 832 (Comm'r 1984).

6. *See In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383, 1384 (Comm'r 1987) (geographic restriction removed by amendment when excepted rights assigned to registrant).

1102 Generation of Proceeding

1102.01 Means of Generation

A concurrent use proceeding before the Board may be generated only by filing an application with the Office under Trademark Act § 1(a), 15 U.S.C. § 1051(a), for registration as a lawful concurrent user (hereafter referred to as a "concurrent use application"). [Note 1.] The Board determines and decides the applicant's right to a concurrent use registration under Trademark Act § 17, 15 U.S.C. § 1067. A concurrent use application is an application in which applicant concedes that its use of the mark is not exclusive and provides the USPTO with all the information applicant has regarding others who are using the same or similar mark. [Note 2.] Specifically, Trademark Act § 1(a)(3)(D), 15 U.S.C. § 1051(a)(3)(D) provides:

… in the case of every application claiming concurrent use, the applicant shall—

(i) state exceptions to the claim of exclusive use; and

(ii) shall specify, to the extent of the verifier's knowledge—

(I) any concurrent use by others;

(II) the goods on or in connection with which and the areas in which each concurrent use exists;

(III) the periods of each use; and

(IV) the goods and area for which the applicant desires registration.

In addition to the above statutory requirements, the applicant shall state in the application the geographic area, the goods or services, and the mode of use for which applicant seeks registration; and also shall state, to the extent of the applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; registrations issued to or applications filed by such others, if any; the geographic

areas of such use; the goods or services on or in connection with which such use is made; the mode of such use; and the time periods of such use. [Note 3.]

For further information concerning the requirements for a concurrent use application, see TBMP § 1103.

NOTES:

1. *See Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831, 832 (Comm'r 1984) (Commissioner has no power to order the commencement of a concurrent use proceeding absent a concurrent use application; respondent in cancellation proceeding may agree to entry of judgment against it or voluntarily surrender its registration for cancellation and then apply for a registration as a lawful concurrent user, and may also request that the district court determine the respective concurrent rights of the parties). *Cf. J&D Home Improvement Inc. v. Basement Doctor Inc.*, 65 USPQ2d 1958 (D. Del. 2003) (federal district courts lack original jurisdiction over matters regarding concurrent use of trademark). *See also In re Forbo*, 4 USPQ2d 1415, 1416 (Comm'r 1984) (registrant may not request geographic restriction by amendment under Trademark Act § 7(d)); *Inland Oil & Transport Co. v. IOT Corp.*, 197 USPQ 562, 563 (TTAB 1977); *Hollowform, Inc. v. Delma Aeh*, 180 USPQ 284, 286 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975).

2. *See* Trademark Act § 1(a)(1)(A), Trademark Act § 1(a)(3)(D)(i), and Trademark Act § 1(a)(3)(D)(ii)(I-IV), 15 U.S.C. § 1051(a)(1)(A), 15 U.S.C. § 1051(a)(3)(D)(i) and 15 U.S.C. § 1051(a)(3)(D)(ii)(I-IV). *See also* Trademark Act § 2(d), 15 U.S.C. § 1052(d); 37 C.F.R. § 2.42; TMEP § 1207.04.

3. *See* 37 C.F.R. § 2.42(b).

1102.02 Bases for Concurrent Registration – Board Determination; Court Determination

There are two bases upon which a concurrent registration may be issued.

First, a concurrent registration may be issued when the Board determines, in a concurrent use proceeding, that an applicant is entitled to a concurrent registration. Such determination may have been made in a prior concurrent use proceeding or will be made in the to-be-instituted concurrent use proceeding. *See*TBMP § 1101.01 and TBMP § 1103.01.

Second, a concurrent use registration may be issued "when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce." [Note 1.]

These two types of concurrent use registrations are the only means by which a geographically restricted registration may be obtained. *See*TBMP § 1101.02. Thus, for example, an applicant may not, by including a geographical restriction in its identification of goods and/or services, obtain a geographically restricted registration without a concurrent use proceeding. [Note 2.]

If an application seeking concurrent registration on the basis of the Board's decision in a prior concurrent use proceeding meets certain requirements, in addition to those necessary for all concurrent use applications [Note 3], the registration sought, if otherwise appropriate, will be issued based on the Board's prior decision. *See* TBMP § 1103. A new concurrent use proceeding before the Board will not be necessary, because of the legal principles of res judicata and stare decisis. [Note 4.] For information concerning the requirements for an application seeking a concurrent registration on the basis of the Board's decision in a prior concurrent use proceeding, see TBMP § 1103.02.

Similarly, if an application seeking concurrent registration on the basis of a prior court determination of concurrent rights meets certain requirements, in addition to those necessary for all concurrent use applications [Note 5], the registration sought, if otherwise appropriate, will be issued based on the court determination, without any concurrent use proceeding before the Board. [Note 6.] For information concerning the requirements for an application seeking a concurrent registration on the basis of a prior court determination of concurrent rights, see TBMP § 1103.03.

NOTES:

1. *See* Trademark Act § 2(d), 15 U.S.C. § 1052(d). *See also* 37 C.F.R. § 2.99(f); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 (CCPA 1976) (district court found applicant entitled to restricted registration); *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412, 419-20 (CCPA 1961) (court ordered restricted registration); *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383, 1384 (Comm'r 1987) (concurrent use rights must be made by a court or by the TTAB).

2. *See In re Home Federal Savings & Loan Association*, 213 USPQ 68, 69 (TTAB 1982) (applicant may not amend to seek geographical limitations outside a concurrent use proceeding). *See also In re Forbo*, 4 USPQ2d 1415, 1416 (Comm'r 1984) (registrant may not request geographic restriction by amendment under Trademark Act § 7(d)).

3. *See* 37 C.F.R. § 2.42.

4. *Cf.* 37 C.F.R. § 2.99(f).

5. *See* 37 C.F.R. § 2.42.

6. *See* 37 C.F.R. § 2.99(f).

1103 Requirements for Concurrent Use Application

Trademark Act § 1, 15 U.S.C. § 1051(a)(1) *The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director, and such number of specimens or facsimiles of the mark as used as may be required by the Director.*

(3)(D) *... except that, in the case of every application claiming concurrent use, the applicant shall –*

(i) *state exceptions to the claim of exclusive use; and*

(ii) *shall specify, to the extent of the verifier's knowledge --*

(I) *any concurrent use by others;*

(II) *the goods on or in connection with which and the areas in which each concurrent use exists;*

(III) *the periods of each use; and*

(IV) *the goods and area for which the applicant desires registration.*

* * * *

Trademark Act § 2, 15 U.S.C. § 1052 *No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it -*

* * * *

(d) *Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to*

(1) *the earliest of the filing dates of the applications pending or of any registration issued under this chapter;*

(2) *July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or*

(3) *July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.*

37 C.F.R. § 2.42 ***Concurrent use.***

(a) *Prior to seeking concurrent use, an application for registration on the Principal Register under the Act must assert use in commerce and include all the application elements required by the preceding sections, in addition to § 2.44 or § 2.45, if applicable.*

(b) *The applicant must also include a verified statement that indicates the following, to the extent of the applicant's knowledge:*

(1) *For a trademark or service mark, the geographic area in which the applicant is using the mark in commerce; for a collective mark or certification mark, the geographic area in which the applicant's members or authorized users are using the mark in commerce;*

(2) *For a trademark or service mark, the applicant's goods or services; for a collective trademark, collective service mark, or certification mark, the applicant's members' or authorized users' goods or services; for a collective membership mark, the nature of the applicant's collective membership organization;*

(3) *The mode of use for which the applicant seeks registration;*

(4) *The concurrent users' names and addresses;*

(5) *The registrations issued to or applications filed by such concurrent users, if any;*

(6) *For a trademark or service mark, the geographic areas in which the concurrent user is using the mark in commerce; for a collective mark or certification mark, the geographic areas in which the concurrent user's members or authorized users are using the mark in commerce;*

(7) *For a trademark or service mark, the concurrent user's goods or services; for a collective trademark, collective service mark, or certification mark, the concurrent user's members' or authorized users' goods or services; for a collective membership mark, the nature of the concurrent user's collective membership organization;*

(8) *The mode of use by the concurrent users or the concurrent users' members or authorized users; and*

(9) *The time periods of such use by the concurrent users or the concurrent users' members or authorized users.*

37 C.F.R. § 2.73 ***Amendment to recite concurrent use.*** *An application that includes section 1(a) of the Trademark Act as a filing basis, or for which an acceptable allegation of use under § 2.76 or § 2.88 has been filed, may be amended to an application for concurrent use registration, provided that the application as amended meets the requirements of § 2.42. The trademark examining attorney will determine whether the application, as amended, is acceptable.*

37 C.F.R. § 2.99 ***Application to register as concurrent user.***

(a) *An application for registration as a lawful concurrent user will be examined in the same manner as other applications for registration.*

(b) *If it appears that the applicant is entitled to have the mark registered, subject to a concurrent use proceeding, the mark will be published in the Official Gazette as provided by § 2.80.*

(c) *If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Trademark Trial and Appeal Board will send a notice of institution to the applicant for concurrent use registration (plaintiff) and to each applicant, registrant or user specified as a concurrent user in the application (defendants). The notice for each defendant shall state the name and address of the plaintiff and of the plaintiff's attorney or other authorized representative, if any, together with the serial number and filing date of the application. If a party has provided the Office with an e-mail address, the notice may be transmitted via e-mail.*

(d)(1) *The Board's notice of institution will include a web link or web address to access the concurrent use application proceeding contained in the Office records.*

(2) *An answer to the notice is not required in the case of an applicant or registrant whose application or registration is acknowledged by the concurrent use applicant in the concurrent use application, but a statement, if desired, may be filed within forty days after the issuance of the notice; in the case of any other party specified as a concurrent user in the application, an answer must be filed within forty days after the issuance of the notice.*

(3) *If an answer, when required, is not filed, judgment will be entered precluding the defaulting user from claiming any right more extensive than that acknowledged in the application(s) for concurrent use registration, but the burden of proving entitlement to registration(s) will remain with the concurrent use applicant(s).*

(e) *The applicant for a concurrent use registration has the burden of proving entitlement thereto. If there are two or more applications for concurrent use registration involved in a proceeding, the party whose application has the latest filing date is the junior party. A party whose application has a filing date between the filing dates of the earliest involved application and the latest involved application is a junior party to every party whose involved application has an earlier filing date. If any applications have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. A person specified as an excepted user in a concurrent use application but who has not filed an application shall be considered a party senior to every party that has an application involved in the proceeding.*

(f) *When a concurrent use registration is sought on the basis that a court of competent jurisdiction has finally determined that the parties are entitled to use the same or similar marks in commerce, a concurrent use registration proceeding will not be instituted if all of the following conditions are fulfilled:*

(1) *The applicant is entitled to registration subject only to the concurrent lawful use of a party to the court proceeding; and*

(2) *The court decree specifies the rights of the parties; and*

(3) *A true copy of the court decree is submitted to the examining attorney; and*

(4) *The concurrent use application complies fully and exactly with the court decree; and*

(5) *The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted by the Director in accordance with the court decree. If any of the conditions specified in this paragraph is not satisfied, a concurrent use registration proceeding shall be prepared and instituted as provided in paragraphs (a) through (e) of this section.*

(g) *Registrations and applications to register on the Supplemental Register and registrations under the Act of 1920 are not subject to concurrent use registration proceedings. Applications under section 1(b) of the Act of 1946 are subject to concurrent use registration proceedings only after the applicant files an acceptable amendment to allege use under § 2.76 or § 2.88. Applications based solely on section 44 or section 66(a) of the Act are not subject to concurrent use registration proceedings.*

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

1103.01 Application Based on Board Determination

An application for concurrent registration based on a Board determination must:

(1) assert use in commerce of the mark sought to be registered [Note 1], *see also* TBMP § 1103.01(a);

(2) meet jurisdictional requirements [Note 2], *see also* TBMP § 1103.01(b);

(3) include a verified statement indicating to the extent of applicant's knowledge the geographic area in which the applicant is using a trademark or service mark in commerce; for a trademark or service mark, the goods and/or services used in commerce; for a collective trademark, collective service mark, or certification mark, the geographic area in which the applicant's members' or authorized users' are using the marks in commerce; and for a collective membership mark, the nature of the concurrent user's collective membership organization; and (if applicable) the mode of use for which applicant seeks registration of the mark [Note 3];

(4) include a verified statement indicating, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; their geographic areas of use for a trademark or service mark, and the goods and/or services on or in connection with which their use is made; for a collective trademark, collective service mark, or certification mark, the concurrent user's members' or authorized users' geographic area of use and the goods or services on or in connection with which their use is made; the time periods of their use; and the registrations issued to or applications filed by them, if any; for a collective membership mark, the nature of the concurrent user's collective membership organization; [Note 4]; and

(5) specify and contain all the elements required by the rules of practice in trademark cases for a non-restricted application. [Note 5.] *See also* TBMP § 1103.01(c).

When it is determined that applicant is entitled to have its mark registered, subject to a concurrent use proceeding, the mark will be published for opposition. If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Board will send notification to the applicant and to each entity that

has been named as an excepted user by the applicant of the institution of the concurrent use proceeding. [Note 6.] The Board's notice of institution will include a web link or web address to access the concurrent use application proceeding contained in Office records. [Note 7.]

For information concerning applicant's obligation to assert use in commerce, see TBMP § 1103.01(a).

For information concerning applicant's obligation to meet certain jurisdictional requirements, see TBMP § 1103.01(b).

NOTES:

1. Trademark Act § 2(d), 15 U.S.C. § 1052(d). *See* 37 C.F.R. § 2.99(g).

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

3. *See* 37 C.F.R. § 2.42(b)(1)-(3). *See also* Trademark Act § 1(a)(3)(D), 15 U.S.C. § 1051(a)(3)(D).

4. *See* 37 C.F.R. § 2.42(b)(4)-(9).

5. *See* 37 C.F.R. § 2.32 - 37 C.F.R. § 2.41.

6. *See* 37 C.F.R § 2.99(c).

7. *See* 37 C.F.R. § 2.99(d). Concurrent use applicants no longer need to serve a copy of their application on the excepted applicants, registrants and users. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69956 (Oct. 7, 2016).

1103.01(a) Application Must Assert Use in Commerce

A basic requirement for any concurrent use application (whether it is to be based on a Board determination or on a prior court determination of applicant's concurrent use rights) is that it must assert use in commerce of the mark sought to be registered.

Trademark Act § 2(d), 15 U.S.C. § 1052(d), provides, in pertinent part:

[I]f the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons ***when they have become entitled to use such marks as a result of their concurrent lawful use in commerce*** *prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act; ...Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks* ***in commerce***. [Note 1.] (Emphasis added.)

In an application based on use in commerce under Trademark Act § 1(a), 15 U.S.C. § 1051 (a), the applicant may seek concurrent use registration at the time the application is filed or in a subsequent amendment. [Note 2.]

If a concurrent use application is filed as an intent-to-use application under Trademark Act § 1(b), 15 U.S.C. § 1051(b), rather than as a use application under Trademark Act § 1(a), 15 U.S.C. § 1051(a), the applicant may not amend the application to seek concurrent use until use is effected. [Note 3.] Thus, an intent-to-use application for an unrestricted registration may be amended to seek concurrent registration only after an acceptable allegation of use under 37 C.F.R. § 2.76 or 37 C.F.R. § 2.88 has been filed in the application. [Note 4.]

Applications based solely on Trademark Act § 44, 15 U.S.C. § 1126 or based on Trademark Act § 66(a), 15 U.S.C. § 1141f(a), are not subject to concurrent use registration proceedings. [Note 5.] Thus, an application for registration under the provisions of Trademark Act § 44 may not seek concurrent registration unless the application also includes, as a second basis for registration, an allegation of use in commerce pursuant to Trademark Act § 1(a), 15 U.S.C. § 1051(a), or, in the case of an application based also on Trademark Act § 1(b), 15 U.S.C. § 1051(b), an allegation of use under 37 C.F.R. § 2.76 or 37 C.F.R. § 2.88. [Note 6.] Where the second basis for registration is Trademark Act § 1(b), the allegation of use must be filed prior to amendment of the application to seek concurrent use registration. [Note 7.] In a § 66(a) application, the applicant may not claim more than one basis. [Note 8]. Thus, a § 66(a) application is never subject to concurrent use proceedings.

NOTES:

1. Trademark Act § 2(d), 15 U.S.C. § 1052(d). *See* 37 C.F.R. § 2.99(g); *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (concurrent use applicant's use of mark during pendency of registrant's federal registration is not lawful, but use of mark following cancellation of federal registration is lawful as it is not subject to former constructive notice effects of that registration; "constructive notice … exists, and lasts, only as long as the federal registration giving rise to that constructive notice remains in effect."); *Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2d 1925, 1927 (TTAB 2015) (during ex parte prosecution examining attorney advised intent-to-use applicant that it could not seek concurrent use registration until it filed an acceptable allegation of use); *Fleming Companies v. Thriftway Inc.*, 809 F. Supp. 38, 26 USPQ2d 1551, 1553 (S.D. Ohio 1992) (use must be lawful), *aff'g* 21 USPQ2d 1451 (TTAB 1991).

2. TMEP § 1207.04(b).

3. *See* 37 C.F.R. § 2.99(g); TMEP § 1207.04(b).

4. *See* 37 C.F.R. § 2.73.

5. 37 C.F.R. § 2.99(g). *See* TMEP § 1207.04(b); Miscellaneous Changes to Trademark Rules of Practice, 73 Fed. Reg. 67759 (November 17, 2008).

6. *See*TMEP § 1207.04(b).

7. *See* 37 C.F.R. § 2.73.

8. 37 C.F.R. § 2.34(b). *See also*TMEP § 806.02(a).

1103.01(b) Jurisdictional Requirement

An application seeking concurrent registration through a concurrent use proceeding before the Board must allege use in commerce "prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under [the Trademark Act of 1946]; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947." [Note 1.] As a practical matter, this means that an application seeking concurrent registration through a concurrent use proceeding normally must assert a date of first use in commerce prior to the earliest application filing date of the application(s) or 1946 Act registration(s) involved in the proceeding, (or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905).

This requirement is jurisdictional in nature. [Note 2.] If it is not met, i.e., if the asserted date of first use is not prior to the cut-off date as described in the preceding paragraph, applicant normally is not entitled to a concurrent registration, and the trademark examining attorney in charge of the application should refuse registration.

However, an application for concurrent registration need not meet the jurisdictional requirement, that is, need not assert use in commerce prior to the earliest application filing date of the application(s), or registration(s) (if any), involved in the proceeding (or prior to July 5, 1947 if relevant) under two circumstances. The first circumstance exists where the owner of such application(s) or registration(s) consents to the grant of a concurrent registration to the concurrent use applicant. [Note 3.] The second circumstance exists where there is an application seeking concurrent registration based on a final determination, by a court of competent jurisdiction, that applicant is entitled to concurrently use its mark. [Note 4.] *See*TBMP § 1103.03.

NOTES:

1. *See* Trademark Act § 2(d), 15 U.S.C. § 1052(d).

2. *See Stawski v. Lawson*, 129 USPQ2d 1036 (TTAB 2018) (concurrent use denied because concurrent use applicant failed to establish jurisdictional requirement of prior lawful use in commerce), *on appeal*, No. 19-1617 (Fed. Cir. March 4, 2019); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987) (a valid application cannot be filed at all without lawful use in commerce and for purposes of concurrent use proceeding, such lawful use must have begun prior to the filing date of any application with which concurrent use is sought); *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431, 436 (CCPA 1970) (applicant's lawful use outside of conflicting claimant's area is jurisdictional in nature and must begin prior to filing date by conflicting claimant; extent of such actual use in commerce is irrelevant so long as it is more than a token use); *Fleming Companies v. Thriftway Inc.*, 809 F. Supp. 38, 26 USPQ2d 1551, 1553 (S.D. Ohio 1992) (plaintiff did not use mark in expanded territory prior to defendant's registration and therefore could not be "lawful" user), *aff'g* 21 USPQ 1451 (TTAB 1991); *Boi Na Braza, LLC v. Terra Sul Corp.*, 110 USPQ2d 1386, 1392 (TTAB 2014) (applicant's claim of first use prior to the earliest filing dates of the involved applications and registration met the jurisdictional requirement); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1478 (TTAB 2014) (applicant's evidence that he used his mark prior to the earliest filing date of the involved applications met the jurisdictional requirement); *America's Best Franchising Inc. v. Abbott*, 106 USPQ2d 1540, 1548 (TTAB 2013) (applicant's use of its mark prior to the filing date of defendant's geographically unrestricted registration meets the jurisdictional requirement); *CDS Inc. v. I.C.E.D. Management, Inc.*, 80 USPQ2d 1572, 1580 n.12 (TTAB 2006) (priority is not normally an issue in concurrent use proceedings; question is whether concurrent use applicant has met the jurisdictional requirement of establishing use in commerce prior to the filing date of the defendant's application); *Ole'*

Taco Inc. v. Tacos Ole, Inc., 221 USPQ 912, 915 (TTAB 1984) (applicant's "innocent use without notice of registrant's use and activity" prior to registrant's filing date meets the jurisdictional requirement); *The Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133, 1136 (TTAB 1982) (jurisdictional requirement met); *Morgan Services Inc. v. Morgan Linen Services Inc.*, 12 USPQ2d 1841, 1842 (TTAB 1989) (assignees (excepted users) stand in the shoes of the assignor (concurrent use applicant) for purposes of determining jurisdictional requirement and therefore assignee's acquisition of rights through territorial assignment meets jurisdictional requirement); *My Aching Back Inc. v. Klugman*, 6 USPQ2d 1892, 1894 (TTAB 1988) (jurisdictional requirement not met where applicant was not a lawful concurrent user since applicant used mark after filing date of excepted user's registration and therefore had constructive notice of use of same mark for same goods by another party); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879, 882 (TTAB 1985) (jurisdictional requirement met where excepted users had no registration or application). *Cf. The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (where Board declined to institute concurrent use proceeding).

3. *See* Trademark Act § 2(d), 15 U.S.C. § 1052(d).

4. *See In re Home Federal Savings and Loan Association*, 213 USPQ 68, 69 (TTAB 1982).

1103.01(c) Application Must Meet Requirements Applicable to Non-Restricted Application

A concurrent use application must specify and contain all the elements required by the rules of practice in trademark cases for a non-restricted application. [Note 1.]

NOTES:

1. *See* 37 C.F.R. § 2.32 - 37 C.F.R. § 2.41. *See also DataNational Corp. v. BellSouth Corp.*, 60 F.3d 1565, 35 USPQ2d 1554, 1558-59 (Fed. Cir. 1995) (before an applicant may obtain a concurrent use registration, it must first satisfy requirements which apply to any application whether restricted or unrestricted; applicant may not obtain concurrent use registration where designation is generic in non-territory), *aff'g* 18 USPQ2d 1862, 1866 (TTAB 1991); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987) (a valid application cannot be filed at all without lawful use in commerce and for purposes of concurrent use proceeding, such lawful use must begin prior to the filing date of any application with which concurrent use is sought); *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431, 436 (CCPA 1970) (extent of such use in commerce is irrelevant so long as it is more than a token use); *Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2d 1925, 1933 (TTAB 2015) (motion for summary judgment granted where there is no genuine dispute of material fact that applicant did not use the mark shown in the drawing in commerce prior to the filing date of the application underlying defendant's registration).

1103.01(d) Application Must Identify Nature and Extent of Restriction Sought

1103.01(d)(1) In General

Trademark Act § 1, 15 U.S.C. § 1051(a)(3)(D) *… in the case of every application claiming concurrent use, the applicant shall –*

(i) *state exceptions to the claim of exclusive use; and*

(ii) *shall specify, to the extent of the verifier's knowledge—*

(I) *any concurrent use by others;*

(II) *the goods on or in connection with which and the areas in which each concurrent use exists;*

(III) *the periods of each use; and*

(IV) *the goods and area for which the applicant desires registration.*

37 C.F.R. § 2.42 ***Concurrent use.***

(a) *Prior to seeking concurrent use, an application for registration on the Principal Register under the Act must assert use in commerce and include all the application elements required by the preceding sections, in addition to § 2.44 or § 2.45, if applicable.*

(b) *The applicant must also include a verified statement that indicates the following, to the extent of the applicant's knowledge:*

(1) *For a trademark or service mark, the geographic area in which the applicant is using the mark in commerce; for a collective mark or certification mark, the geographic area in which the applicant's members or authorized users are using the mark in commerce;*

(2) *For a trademark or service mark, the applicant's goods or services; for a collective trademark, collective service mark, or certification mark, the applicant's members' or authorized users' goods or services; for a collective membership mark, the nature of the applicant's collective membership organization;*

(3) *The mode of use for which the applicant seeks registration;*

(4) *The concurrent users' names and addresses;*

(5) *The registrations issued to or applications filed by such concurrent users, if any;*

(6) *For a trademark or service mark, the geographic areas in which the concurrent user is using the mark in commerce; for a collective mark or certification mark, the geographic areas in which the concurrent user's members or authorized users are using the mark in commerce;*

(7) *For a trademark or service mark, the concurrent user's goods or services; for a collective trademark, collective service mark, or certification mark, the concurrent user's members' or authorized users' goods or services; for a collective membership mark, the nature of the concurrent user's collective membership organization;*

(8) *The mode of use by the concurrent users or the concurrent users' members or authorized users; and*

(9) *The time periods of such use by the concurrent users or the concurrent users' members or authorized users.*

The applicant must include a verified statement stating, to the extent of applicant's knowledge, the geographic area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration of the mark. [Note 1.] The application must also state to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; their geographic areas of use; the goods and/or services on or in connection with which their use is made; the mode of their use; the periods of their use; and the registrations issued to, or applications filed by them, if any. For information concerning statements by the concurrent use applicant regarding use of the mark by others, see TBMP § 1103.01(e).

The statement in the application of the area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration serves to give notice, both when the mark is published for opposition (assuming it is approved for publication) and when a concurrent use proceeding is thereafter instituted (if no opposition is filed, or if all oppositions filed are dismissed or withdrawn), of the scope of the registration sought by applicant. The statement setting forth the concurrent lawful use of the mark by others serves to give notice of the extent of applicant's acknowledgment of the concurrent rights of others. [Note 2.]

NOTES:

1. *See* 37 C.F.R. § 2.42(b). *See also* Trademark Act § 1(a), 15 U.S.C. § 1051(a)(3)(D).

2. *See* 37 C.F.R. § 2.99(d)(1) and 37 C.F.R. § 2.99(d)(3); *In re Wells Fargo & Co.*, 231 USPQ 95, 105-06 (TTAB 1986); *In re El Chico Corp.*, 159 USPQ 740, 741 (TTAB 1968). *See also Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1230 (TTAB 1993) (at late stage in contested concurrent use proceeding, Board will generally not permit concurrent use applicant to enlarge territory for which it seeks registration).

1103.01(d)(2) Geographic Restrictions

Generally, concurrent rights arise when a party, in good faith, and without knowledge of a prior party's use in another geographic area, adopts and uses the same or similar mark for the same or similar goods or services within its own geographic area. [Note 1.] The vast majority of concurrent use applications seek a registration that is restricted geographically.

The area for which registration is sought is usually more extensive than the area in which the applicant is actually using its mark. If an applicant for concurrent registration believes that it is the prior user as against the other party or parties to the proceeding, applicant may, as the prior user, seek registration for all of the United States except for the subsequent user's area of actual use and (possibly) natural expansion. [Note 2.] If applicant is not the prior user, but believes that the prior user, through its failure to expand over a long period of time, has abandoned its right as a prior user to expand into all of the United States except for the applicant's area of actual use and natural expansion, applicant may seek registration for all of the United States except for the prior user's area of actual use. [Note 3.] If the concurrent use applicant is a subsequent user not seeking registration for the entire United States because it does not believe that the prior user has abandoned its rights, the concurrent use applicant normally will seek registration not only for its area of actual use but also for its area of natural expansion. In any case, even where the concurrent use applicant is the prior user, if another party to the proceeding owns a registration of its mark, the right to use of which has become incontestable, any registration issued to the concurrent use applicant will be limited to the concurrent use applicant's area of actual use prior to actual or constructive notice of registrant's rights, unless the parties stipulate otherwise. [Note 4.]

The description of the geographic area sought by the concurrent use applicant should be sufficiently definite. If the excepted area is less than an entire state, it should be described in terms of counties or in other specific and definite terms. [Note 5.]

NOTES:

1. *See Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1307 (Fed. Cir. 1987) (issue of likelihood of confusion was properly resolved by looking at the concurrent use applicant's area of actual use, not merely the area claimed in its application); *Southwestern Management, Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007 (TTAB 2015) ("…even if Applicant had knowledge of Defendant's prior common law uses, such knowledge would not necessarily obviate good faith on the part of Applicant, as Applicant could have believed that its adoption was sufficiently remote so as to make confusion unlikely."), *aff'd mem.*, 652 F. App'x 971 (Fed. Cir. 2016); *Boi Na Braza, LLC v. Terra Sul Corp.*, 110 USPQ2d 1386, 1392 (TTAB 2014) (applicant adopted its mark in good faith and without knowledge of defendant's prior use); *America's Best Franchising Inc. v. Abbott*, 106 USPQ2d 1540, 1548 (TTAB 2013) (applicant adopted use of its marks in good faith, in its own geographic area, and without knowledge of defendant's prior use of its marks); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1726 (TTAB 1990) (actual use in a territory

is not necessary to establish rights in that territory and depends on a number of factors). *See also Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 829 (CCPA 1980) (mere knowledge of the existence of the prior user should not, in itself, constitute bad faith); *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431, 436 (CCPA 1970) (concurrent use jurisdictional requirements met); *Fleming Companies v. Thriftway Inc.*, 809 F. Supp. 38, 26 USPQ2d 1551, 1553 (S.D. Ohio 1992) (plaintiff did not use mark in expanded territory prior to defendant's registration and therefore could not be "lawful" user), *aff'g* 21 USPQ 1451 (TTAB 1991); *DataNational Corp. v. BellSouth Corp.*, 18 USPQ2d 1862, 1866 (TTAB 1991), *aff'd*, 60 F.3d 1565, 35 USPQ2d 1554 (Fed. Cir. 1995) (concurrent use application for mark that is generic in concurrent use applicant's unclaimed territory fails to meet jurisdictional requirements even if mark is associated with applicant in its claimed territory); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879, 884 (TTAB 1985) (primary concern in concurrent use proceeding is the avoidance of likelihood of confusion; here, confusion inevitable; applicant unable to establish its entitlement to registration in area claimed, where senior user was national franchise).

2. *See Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1229 (TTAB 1989) (as a general rule prior user is entitled to registration covering entire United States except for geographic area in which subsequent user has actually used the mark plus an area shown to be within the natural expansion of its business, but rule is not absolute); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 916 (TTAB 1984) (subsequent user may obtain registration for area of actual use as well as area of natural expansion and subsequent user who adopts in good faith is not necessarily precluded from further expansion after learning of prior user); *Zimmerman v. Holiday Inns of America, Inc.*, 123 USPQ 86, 87 (TTAB 1959) (acknowledged the right of the subsequent user to operate in areas into which it had expanded after notice of the existence of the prior user). *Cf. Terrific Promotions Inc. v. Vantex Inc.*, 36 USPQ2d 1349, 1353 (TTAB 1995) (where good faith subsequent user that had vigorously expanded under mark was given most of U.S.).

3. *See, e.g., Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 832 (CCPA 1980); *Boi Na Braza, LLC v. Terra Sul Corp.*, 110 USPQ2d 1386, 1394-95 (TTAB 2014) (applicant entitled to registration for all of the United States except for prior users' area of actual use due to defendant's inaction and except for "buffer area" ceded by applicant); *America's Best Franchising Inc. v. Abbott*, 106 USPQ2d 1540, 1554 (TTAB 2013) (applicant entitled to registration for all of the United States except prior user's area of actual use due to defendant's inaction and because applicant was the first to seek federal registration); *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1228 (TTAB 1989). *Cf. Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307-08 (TTAB 1984) (applicant not entitled to concurrent use registration where user abandoned application for mark but not its right to continue using mark).

4. *See* Trademark Act § 15 and Trademark Act § 33(b)(5), 15 U.S.C. § 1065 and 15 U.S.C. § 1115(b)(5); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 633 (CCPA 1976) (court determination of rights); *Thriftimart, Inc. v. Scot Lad Foods, Inc.*, 207 USPQ 330, 334 (TTAB 1980) (agreement by parties found to obviate likelihood of confusion).

5. *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1230 (TTAB 1993) (description excepting "the San Francisco Bay area" indefinite); *In re El Chico Corp.*, 159 USPQ 740, 741 (TTAB 1968) (merely stating that there are various users in various states for similar services is insufficient).

1103.01(d)(3) Mode of Use Restrictions

In very rare instances, a concurrent use applicant may seek concurrent registration based only on conditions or limitations as to the mode of use of its mark [Note 1] or as to the goods and/or services on or in connection with which the mark is used, i.e., a restriction as to the form in which it may use its mark; a limitation as to the trade channels in which its goods are sold; a requirement that the mark always be used in conjunction

with a particular trade dress or house mark, or a specified disclaimer of affiliation. [Note 2.] Usually, "mode of use" cases arise before the federal district courts, which, for equitable reasons, may permit a continuation of concurrent use even if there is some resulting confusion. Notwithstanding the likelihood of confusion, a party to the court proceeding may obtain concurrent registration on the basis of such a court determination, if its application is otherwise acceptable for registration. [Note 3.] In contrast, when concurrent registration is sought by way of a concurrent use proceeding before the Board, the Board cannot allow registration if it finds that there would be a likelihood of confusion from the continued concurrent use of the marks. [Note 4.]

An applicant seeking registration on the basis of "mode of use" conditions or limitations should request concurrent registration only if its application includes a condition or limitation not capable of being incorporated into the applicant's drawing of its mark and/or identification of goods or services, and into the drawing and/or identification of any conflicting application or registration which may be owned by another. [Note 5.]

Where an applicant seeks registration on the basis of "mode of use" conditions or limitations which are incorporated, or are capable of being incorporated, into the applicant's drawing of its mark and/or identification of goods or services, and into the drawing and/or identification of any conflicting application or registration which may be owned by another, a concurrent use proceeding is unnecessary and will not be instituted by the Board. The application should be presented as a regular application, not as a concurrent use application. [Note 6.] If an applicant that has incorporated mode of use conditions or limitations into its drawing and/or identification is unable to obtain a registration in the absence of corresponding conditions or limitations in a conflicting application or registration, and the owner thereof is not willing to amend its application or registration to include the conditions or limitations, applicant's remedy lies in an opposition or a petition for cancellation, respectively, to restrict the application or registration appropriately. [Note 7.]

For information concerning a claim for partial opposition or partial cancellation, i.e., a request to restrict, see TBMP § 309.03(d).

NOTES:

1. *See The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1589 n.4 (TTAB 1995) (mode of use refers to "the manner of displaying the mark, e.g., where the mark is displayed only in a certain stylization, or only in conjunction with a particular trade dress or house mark, or only in conjunction with a disclaimer of affiliation.").

2. *See, e.g., Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 632 (CCPA 1976) (restrictions, *inter alia*, to form of mark and geographic area of use); *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412, 419-20 (CCPA 1961) (restrictions, *inter alia*, to form of mark and types of goods). *Cf. The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (request for concurrent use registration based on asserted dissimilarity of trade channels denied); *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986) (court imposed geographic restriction and mode of use requirements involving, *inter alia*, trade dress and advertising).

3. *See, e.g.*, Trademark Act § 2(d), 15 U.S.C. § 1052 (d); *Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300, 1302 n.4 (TTAB 2003) (mode of use restrictions in nine concurrent use registrations issued in accord with opinions and orders entered by federal district court in antitrust litigation); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 (CCPA 1976) (application presenting mark in plain typed capital letters did not violate judgment but accompanying specimen showing

mark in prohibited script did); *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412, 416 (CCPA 1961).

4. *See* Trademark Act § 2(d), 15 U.S.C. § 1052(d); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 (CCPA 1976) ("[T]he sentence referring to court determinations is independent of the opening words of the proviso referring to the Commissioner's determination that confusion, etc., is 'not likely.' We do not consider those words to be a limitation on the provision for granting concurrent registrations on the basis of determinations of right to use by courts of competent jurisdiction.").

5. *See The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1591 (TTAB 1995) (refusing to institute concurrent use proceeding where sole basis for applicant's request for institution thereof is the asserted dissimilarity in the trade channels in which the parties' services are offered; "Concurrent use proceedings shall be reserved for those situations where the proposed conditions and limitations cannot be incorporated into the drawing of the mark or the identification of goods, and cannot be considered under the main clause of Section 2(d)."). *See also Ex parte Crossett Lumber Co.*, 89 USPQ 29, 30 (USPTO 1951) (no concurrent use proceeding instituted where only proposed restriction was to have parties use same mark with different additional wording by each).

6. *See The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1590-91 (TTAB 1995) ("Any 'conditions and limitations' as to the parties' marks and/or goods which are incorporated into the parties' respective drawings and identifications of goods and/or services can and must be considered as part of the basic likelihood of confusion analysis under the main clause of Section 2(d).").

7. *See The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1591 n.7 (TTAB 1995) ("If the mark and/or goods conditions or limitations which might avoid a finding of likelihood of confusion are not already present in a conflicting registration, and the owner of the registration is not willing to amend its registration to incorporate the conditions or limitations, applicant's remedy lies in a petition for partial cancellation to restrict the registration;" concurrent use proceeding not instituted where only limitation was trade channels that could be adequately dealt with under main clause of Trademark Act § 2(d) in ordinary ex parte or inter partes proceeding).

1103.01(e) Application Must Identify Excepted Users and Their Asserted Rights

In addition to the requirement that the applicant must provide certain information about its own mark, *see* TBMP § 1103.01(d)(1)-(3), the applicant must state in the application, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; their areas of use; the goods and/or services on or in connection with which their use is made; the mode of their use; the periods of their use; and the registrations issued to or applications filed by them, if any. [Note 1.]

In specifying a concurrent use applicant's extent of its knowledge of the concurrent rights of others, [Note 2] it is not necessary that it list, as exceptions to its claim of exclusive use, every entity known to it to be using the same or similar mark for the same or similar goods or services. Rather, applicant's duty is to list any entity known to it to be a senior user of a clearly conflicting mark, as well as any junior user known to it to have clearly conflicting rights which are clearly established, as, for example, by court decree, by settlement agreement, or by a registration. [Note 3.]

NOTES:

1. *See* 37 C.F.R. § 2.42(b).

2. *See* 37 C.F.R. § 2.42(b). *See also* Trademark Act § 1(a), 15 U.S.C. § 1051(a); *Gallagher's Restaurants Inc., v. Gallagher's Farms Inc.*, 3 USPQ2d 1864, 1866 (TTAB 1986) (motion to amend concurrent use application to add additional users denied where it was filed late in proceeding, existence of the users were known to applicant years earlier, and applicant failed to specify the marks or the goods/services allegedly used by those parties); *In re Wells Fargo & Co.*, 231 USPQ 106, 116 (TTAB 1986) (concurrent use registration denied where, inter alia, applicant failed to specify areas of use and services of excepted user); *In re El Chico Corp.*, 159 USPQ 740, 741 (TTAB 1968) (merely stating that there are various users in various states for similar services is insufficient).

3. *See Rosso & Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 219 USPQ 1050, 1053 (Fed. Cir. 1983) (no requirement to investigate and report all possible users; senior user ordinarily need not identify junior users in the oath unless rights of a junior user have been "clearly established"); *Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133, 1137 (TTAB 1982) (duty to investigate only known prior users; existence of other users came to applicant's attention after applicant began use and then only as result of computer-generated search report). *See also In re Sun Refining & Marketing Co.*, 23 USPQ2d 1072, 1073 (TTAB 1991) (obligated to amend declaration to acknowledge rights recognized by the terms of a settlement agreement). *Cf. SCOA Industries Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411, 414 (TTAB 1975) (no duty to identify other user where there are arguable differences between the marks).

1103.01(f) Other Requirements

37 C.F.R. § 2.99(b) *If it appears that the applicant is entitled to have the mark registered, subject to a concurrent use proceeding, the mark will be published in the Official Gazette as provided by § 2.80.*

37 C.F.R. § 2.80 ***Publication for opposition.*** *If, on examination or reexamination of an application for registration on the Principal Register, it appears that the applicant is entitled to have his mark registered, the mark will be published in the Official Gazette for opposition. The mark will also be published in the case of an application to be placed in interference or concurrent use proceedings, if otherwise registrable.*

37 C.F.R. § 2.99(c) *If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Trademark Trial and Appeal Board will send a notification to the applicant for concurrent use registration (plaintiff) and to each applicant, registrant or user specified as a concurrent user in the application (defendants). …*

37 C.F.R. § 2.99(d)(1) *The Board's notice of institution will include a web link or web address to access the concurrent use application proceeding contained in Office records.*

When it is determined that an applicant is entitled to have its mark registered, subject to a concurrent use proceeding, the mark will be published for opposition. If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Board will send notice of the institution of the concurrent use proceeding to the applicant and to each entity that has been named as an excepted user by the applicant. The Board's notice of institution will include a web link or web address to access the concurrent use application proceeding contained in Office records. [Note 1.] *See*TBMP § 1106.

When an application seeking concurrent registration by way of a concurrent use proceeding before the Board is approved for publication, it is marked (by the trademark examining attorney) with the following statement:

SUBJECT TO CONCURRENT USE PROCEEDING WITH _____. APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE MARK IN THE AREA COMPRISING _____.

The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the first blank space. The second blank is filled in with the area for which applicant seeks registration, together with any other conditions or limitations to which registration would be restricted.

For information concerning the examination by the trademark examining attorney of a concurrent use application, see TMEP § 1207.04(d) and TMEP § 1207.04(e)(i).

NOTES:

1. *See* 37 C.F.R. § 2.99(b) - 37 C.F.R. § 2.99(d). Concurrent use applicants no longer need to serve the application on the excepted registrants and users. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69956 (Oct. 7, 2016).

1103.02 Application Based on Prior Board Decision

An application seeking concurrent registration on the basis of the Board's final decision in a prior concurrent use proceeding, *see* TBMP § 1102.01, must assert use in commerce of the mark sought to be registered. *See* TBMP § 1103.01(a). The application must also specify and contain all the requirements of 37 C.F.R. § 2.42 (described in TBMP § 1103.01), namely, the requirements that applicant state in the application the area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration, and also state, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses, their areas of use, the goods and/or services on or in connection with which their use is made, the mode of their use, the periods of their use, and the registrations issued to or applications filed by them, if any. [Note 1.] In addition, the applicant should submit a copy of the Board decision upon which it relies to ensure that the processing of its application is not delayed. Although the Board often may obtain, on its own, a copy of the prior Board decision upon which the applicant relies, this is not always possible.

When an application for concurrent registration is based on a final determination by the Board in a prior concurrent use proceeding, that applicant is entitled to a concurrent registration of its mark, a new concurrent use proceeding will not be instituted, that is, the application (if found otherwise acceptable, published, and not opposed, or opposed unsuccessfully) will be forwarded to issue without having to go through a new concurrent use proceeding, provided that the following conditions are met:

(1) The applicant is entitled to registration subject only to the concurrent lawful use of a party or parties to the prior concurrent use proceeding; and

(2) The Board's prior decision specifies applicant's right to concurrent registration; and

(3) A copy of the Board's prior decision is submitted to the trademark examining attorney; and

(4) The concurrent use application complies with the Board's prior decision, in that it seeks registration for the same, or a more limited, geographic area or mode of use than granted to applicant in the prior decision; seeks registration for substantially the same mark or one less confusingly similar to those of the other party or parties in the prior proceeding; and seeks registration for substantially the same goods and/or services as, or more limited goods and/or services than, those listed in the Board's prior specification of applicant's entitlement to concurrent registration [Note 2]; and

(5) The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted in accordance with the Board's prior decision.

If an application seeking concurrent registration on the basis of the Board's determination in a prior concurrent use proceeding meets all of the conditions specified above, a new concurrent use proceeding is unnecessary, because of the legal principles of res judicata and stare decisis. [Note 3.] If any of the conditions are not satisfied, a new concurrent use proceeding will be prepared and instituted. In the event that the first four conditions are met, but an involved registration was not restricted in accordance with the Board's prior decision, a new concurrent use proceeding will be instituted solely for the purpose of restricting the involved registration in accordance with the Board's decision. In such cases, the Board's notice of institution includes a web link or web address to access the concurrent use application proceeding contained in Office records, and an order to the registrant to show cause why its registration should not be restricted in accordance with the Board's prior decision. If no good cause is shown, the registration is ordered restricted, applicant is found entitled to the registration sought, and the concurrent use proceeding is dissolved.

When and if the application is approved for publication, it is marked (by the trademark examining attorney) with the following statement:

REGISTRATION LIMITED TO THE AREA COMPRISING _____ PURSUANT TO CONCURRENT USE PROCEEDING NO. _____. CONCURRENT REGISTRATION WITH _____.

The area specified in the Board's prior decision as the area for which applicant is entitled to registration is inserted in the first blank, together with any other conditions or limitations imposed by the Board. The second blank is filled in with the number of the prior concurrent use proceeding. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the prior concurrent use proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

If all of the conditions are not satisfied, a new concurrent use proceeding is necessary. When and if the application is approved for publication, it is marked (by the trademark examining attorney) with the following statement:

SUBJECT TO CONCURRENT USE PROCEEDING WITH _____. APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE MARK IN THE AREA COMPRISING _____.

The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the first blank space. The second blank is filled in with the area for which applicant seeks registration.

The Board's notice of institution will include a web link or web address to access the concurrent use application proceeding contained in Office records. [Note 4.] *See* TBMP § 1106.

The Board does not determine, in a concurrent use proceeding, the right to concurrent registration of a party that is included in the proceeding only as a common law concurrent user, i.e., a party that does not own an involved application or registration. *See* TBMP § 1108. A party that was included in a prior concurrent use proceeding only as a common law concurrent user may not thereafter obtain a concurrent registration on the basis of the Board's decision in the prior proceeding, without going through a new concurrent use proceeding.

NOTES:

1. *See* 37 C.F.R. § 2.42(b).

2. *Cf.* regarding comparison of marks and goods/services in context of prior registration defense, *Missouri Silver Pages Directory Publishing Corp. v. Southwestern Bell Media, Inc.*, 6 USPQ2d 1028, 1030-31 (TTAB 1988); *Carl Karcher Enterprises, Inc. v. Gold Star Chili, Inc.*, 222 USPQ 979, 981 (TTAB 1983), *recon. denied*, 222 USPQ 727 (TTAB 1983); *Place for Vision, Inc. v. Pearle Vision Center, Inc.*, 218 USPQ 1022, 1023 (TTAB 1983).

3. *Cf.* 37 C.F.R. § 2.99(f).

4. *See* 37 C.F.R. § 2.99(d)(1).

1103.03 Application Based on Court Determination

37 C.F.R. § 2.99(f) *When a concurrent use registration is sought on the basis that a court of competent jurisdiction has finally determined that the parties are entitled to use the same or similar marks in commerce, a concurrent use registration proceeding will not be instituted if all of the following conditions are fulfilled:*

(1) *The applicant is entitled to registration subject only to the concurrent lawful use of a party to the court proceeding; and*

(2) *The court decree specifies the rights of the parties; and*

(3) *A true copy of the court decree is submitted to the examining attorney; and*

(4) *The concurrent use application complies fully and exactly with the court decree; and*

(5) *The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted by the Director in accordance with the court decree.*

If any of the conditions specified in this paragraph is not satisfied, a concurrent use registration proceeding shall be prepared and instituted as provided in paragraphs (a) through (e) of this section.

An application for concurrent registration that is based on a final determination by a court of competent jurisdiction must assert use in commerce of the mark sought to be registered. *See*TBMP § 1103.01(a). The application must also specify and contain all the elements required for an unrestricted registration [Note 1], as well as the additional requirements for concurrent use, namely, the requested geographic area, the goods and/or services, and (if applicable) mode of use for which applicant seeks registration, and also state, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses, their areas of use, the goods and/or services on or in connection with which their use is made, the mode of their use, the periods of their use, and the registrations issued to or applications filed by them, if any. [Note 2.] In addition, the applicant must submit a copy of the court decree upon which it relies.

When an application for concurrent registration is based on a final determination by a court of competent jurisdiction that applicant is entitled to concurrently use its mark, a concurrent use proceeding will not be instituted, that is, the application (if found otherwise acceptable, published, and not opposed, or opposed unsuccessfully) will be forwarded to issue without having to go through a concurrent use proceeding, provided that all of the following conditions, specified in 37 C.F.R. § 2.99(f), are met, namely:

(1) The applicant is entitled to registration subject only to the concurrent lawful use of a party or parties to the court proceeding; and

(2) The court decree specifies the rights of the parties; and

(3) A true copy of the court decree is submitted to the trademark examining attorney; and

(4) The concurrent use application complies fully and exactly with the court decree, [Note 3] and

(5) The excepted use specified in the concurrent use application does not involve a registration, or, if it does, the involved registration has been restricted by the Director in accordance with the court decree.

If any of the above conditions are not satisfied, a concurrent use registration proceeding will be prepared and instituted. [Note 4.] The Board's notice of institution will include a web link or web address to access the concurrent use application proceeding contained in Office records as provided by 37 C.F.R. § 2.99(d)(1). If the first four conditions are met, but the Director, in accordance with the court decree, has not already restricted an involved registration, a concurrent use proceeding will be instituted solely for the purpose of restricting the involved registration in accordance with the court decree. In such case, the Board sends out an order instituting the proceeding and directing the registrant to show cause why its registration should not be restricted in accordance with the court decree. If no good cause is shown, the registration is ordered restricted, applicant is found entitled to the registration sought, and the concurrent use proceeding is dissolved.

When and if the application is approved for publication, it is marked (by the trademark examining attorney) with the following statement:

REGISTRATION LIMITED TO THE AREA COMPRISING _____. PURSUANT TO THE DECREE OF _____. CONCURRENT REGISTRATION WITH _____.

The area granted to applicant by the court is inserted in the first blank, together with any other conditions or limitations imposed by the court. The second blank is filled in with the name of the court, proceeding number, and date of decree. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the court proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

If all of the conditions are not satisfied, a concurrent use proceeding is necessary. When and if the application is approved for publication, it is marked (by the trademark examining attorney) with the following statement:

SUBJECT TO CONCURRENT USE PROCEEDING WITH _____. APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE MARK IN THE AREA COMPRISING _____.

The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the first blank space. The second blank is filled in with the area for which applicant seeks registration.

The Board's notice of institution will include a web link or web address to access the concurrent use application proceeding contained in Office records. [Note 5.] *See* TBMP § 1106.

Jurisdictional requirement, and requirement that there be no likelihood of confusion need not be met. An application for concurrent registration on the basis of a court determination of applicant's right to concurrently use its mark in commerce does not need to meet the jurisdictional requirement of use in commerce prior to the applicable date specified in Trademark Act § 2(d), 15 U.S.C. § 1052(d). For information concerning the dates specified in Trademark Act § 2(d), see TBMP § 1103.01(b). Similarly, such an application is not subject to the requirement that the Director determine, prior to issuance of a concurrent

registration, that confusion, mistake, or deception is not likely to result from the continued concurrent use by the parties of their marks. These two requirements are conditions precedent to the issuance of a concurrent registration by way of a concurrent use proceeding before the Board, but they are not conditions precedent to the issuance of a concurrent registration on the basis of a court decree. The sentence in Trademark Act § 2(d) permitting the Director to issue concurrent registrations when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce is wholly independent of these two provisions. Thus, a concurrent registration may (and should, if otherwise appropriate) be issued on the basis of a court decree even though the application for registration does not claim use in commerce prior to the applicable date specified in Trademark Act § 2(d), and even though there may be likelihood of confusion by reason of the concurrent use of the marks of the parties to the court proceeding. [Note 6.]

NOTES:

1. The application must comply with the requirements of 37 C.F.R. § 2.42(a), described in TBMP § 1103.01(c)-(f) and 37 C.F.R. § 2.32*et al.* , 37 C.F.R. § 2.44 and 37 C.F.R. § 2.45, if applicable.

2. *See* 37 C.F.R. § 2.42(b).

3. *See Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 (CCPA 1976) (application was properly limited geographically and as to the form of the mark, but the specimens appeared to violate the judgment); *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412, 419-20 (CCPA 1961) (applicant entitled to concurrent use application provided it contains conditions and limitations corresponding to those contained in the prior court judgment).

4. *See* 37 C.F.R. § 2.99(f).

5. 37 C.F.R. § 2.99(d)(1).

6. *See Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (CCPA 1976); TMEP § 1207.04(f). *Cf. Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412, 416-17 (CCPA 1961). For information concerning the examination by the trademark examining attorney of a concurrent use application, see TMEP § 1207.04.

1104 Parties to Proceeding; Involved Applications, Registrations

The parties to a concurrent use proceeding are the concurrent use applicant(s), (hereinafter “applicant”) and all of those persons listed in the concurrent use application(s) as exceptions to applicant’s claim of exclusive use (hereinafter “excepted users”). The persons listed as excepted users may themselves own one or more federal applications (either for concurrent registration with applicant, or for an unrestricted registration) or federal registrations for a conflicting mark, or may simply be common law users of a conflicting mark. Thus, a concurrent use proceeding may involve the concurrent use applicant(s) and one or more other applicants, and/or one or more registrants, and/or one or more common law concurrent users. Often, the only parties to a concurrent use proceeding are the concurrent use applicant, and a common law user that does not own an involved application or registration. [Note 1.]

If, after the commencement of a concurrent use proceeding, the concurrent use applicant learns of another person with conflicting concurrent rights, the applicant may file a motion to amend its application to list that person as an additional exception to applicant’s claim to exclusive use. If the motion is granted, the

person listed in the amendment will be added as a party to the proceeding and will be notified of the proceeding by the Board. [Note 2.] Similarly, if the concurrent use applicant learns that a person listed as an exception to applicant's claim of exclusive use has abandoned its mark, or if the person assigns its rights in its mark to the applicant, the applicant may file a motion to amend its application to delete reference to that person. The motion should include an explanation of the facts that serve as the basis for the motion. If the motion is granted, the amendment will be entered, and the person in question will be dropped as a party to the proceeding. [Note 3.]

The applications and/or registrations involved in a concurrent use proceeding include the concurrent use application(s); every conflicting unrestricted application which is identified in the concurrent use application(s) as being owned by a person listed as an exception to the concurrent use applicant's claim of exclusive use, and which has a filing date prior to the filing date of the concurrent use application(s); every conflicting registration identified in the concurrent use application(s) as being owned by a person listed as an exception to the concurrent use applicant's claim of exclusive use; and every registration claimed by the concurrent use applicant(s) in the concurrent use application(s), unless there is no conflict between the mark(s) in such registration(s) and the mark(s) of the other party or parties to the proceeding. [Note 4.] If any identified application has not yet been published in the Official Gazette, or has been published but has not yet cleared the opposition period, the proceeding will be instituted, with the owner of that application being included as a common law user, rather than as an applicant. The Board may, in its discretion, suspend proceedings in the concurrent use proceeding until the unpublished application either becomes abandoned, or is published in the Official Gazette and survives the opposition period; at which time it may be added to the proceeding, and the position of its owner will be changed from that of common law user to applicant. *See* TBMP § 1106. Further, when the Board institutes the concurrent use proceeding, inquiry will be made as to whether any party owns any other application or registration which is for the same or similar mark, and same or similar goods and/or services, and thus should be added to the proceeding. A conflicting application or registration identified in response to this inquiry normally will be added to the proceeding.

However, if a party to the proceeding owns a conflicting application which seeks an unrestricted registration, and which was not filed until after the concurrent use application(s), the trademark examining attorney will suspend action on the subsequent unrestricted application (once the application is otherwise in condition for approval for publication) pending disposition of the concurrent use application(s). [Note 5.] In the event that the concurrent use application(s) matures into concurrent registration(s), the concurrent registration(s) will be cited, under Trademark Act § 2(d), 15 U.S.C. § 1052(d), as a reference(s) against the subsequent unrestricted application. [Note 6.] Alternatively, if the owner of the subsequent unrestricted application amends it to seek concurrent registration, assuming it is otherwise in condition to be published, asserts use in commerce, and meets the jurisdictional requirement for concurrent registration, the application will be published for opposition. *See* TBMP § 1103.01(b). When the Board is informed of the amendment, it may suspend the concurrent proceeding pending the amended application clearing its opposition period. If no opposition is filed, or if all oppositions filed are dismissed or withdrawn, the application will be added to the concurrent use proceeding. If the Board is not advised of the amendment to concurrent use in time to add the application to the ongoing concurrent use proceeding, a new concurrent use proceeding will be instituted. [Note 7.]

The only issue properly before the Board in a concurrent use proceeding concerns the concurrent use applicant's entitlement to registration. The specific territorial rights to which any common law users are entitled are not before the Board except to the extent that their registration rights may be limited by the territorial rights to which applicant proves entitlement. Because common law users do not own involved applications or registrations, any registration rights of a common law user can be determined only if and when such user files an application seeking concurrent registration and a concurrent use proceeding is instituted involving such application. *See* TBMP § 1108.

NOTES:

1. *See Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1456 (TTAB 1991); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 n.5 (TTAB 1990) (unless named as an exception by the concurrent use applicant, a third-party's application may not be joined in a concurrent use proceeding for purposes of determining proper ownership thereof, but an unnamed party may amend its application to seek concurrent registration, in which case such application would become subject to its own concurrent use proceeding); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1308 (TTAB 1984) (two concurrent use applicants).

2. *Cf. Gallagher's Restaurants Inc. v. Gallagher's Farms Inc.*, 3 USPQ2d 1864, 1866 (TTAB 1986) (motion to amend concurrent use application to add additional users denied where it was filed late in proceeding, existence of the users were known to applicant years earlier, and applicant failed to specify the marks or the goods/services allegedly used by those parties).

3. *Cf. Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1453 (TTAB 1991) (although abandonment of application without written consent of every adverse party precludes common law user from claiming any right to federal registration, inasmuch as user reserved right to continue using mark, it will not be dropped as party to concurrent use proceeding), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551, 1553 (S.D. Ohio 1992); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307-08 (TTAB 1984) (applicant not entitled to concurrent use registration where user abandoned application for mark but not its right to continue using mark).

4. *See Boi Na Braza LLC v. Terra Sul Corp.*, 110 USPQ2d 1386, 1389 n.10 (TTAB 2014); *Holmes Oil Co. v Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1149 (TTAB 2011); *Morgan Services Inc. v. Morgan Linen Services Inc.*, 12 USPQ2d 1841, 1842 (TTAB 1989).

5. *See Southwestern Management, Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1020 n.73 (TTAB 2015) (examining attorney suspended action on defendants' pending applications seeking unrestricted registration filed after applicant's application), *aff'd mem.*, 652 F. App'x 971 (Fed. Cir. 2016); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1226 (TTAB 1993) (Board has no jurisdiction over user/registrant's application that was pending before examining attorney unless application is amended to seek concurrent use, and is published without successful opposition, and is added to the proceeding). *See also America's Best Franchising Inc. v. Abbott*, 106 USPQ2d 1540, 1544 (TTAB 2013) (defendant's uninvolved geographically unrestricted application suspended pending disposition of applicant's involved concurrent use applications).

6. *See Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 n.5 (TTAB 1990) (despite parties' treatment of unrelated party's application as being involved in concurrent use proceeding, it is not; Board makes no legal determination regarding ownership of trademark application, but as it was filed after concurrent use application and is pending before examining attorney, if it is not amended to seek concurrent use, applicant's concurrent registration will be a Trademark Act § 2(d) bar to an unrestricted registration to third-party applicant).

7. *See Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1480 (TTAB 1998); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1230 (TTAB 1993); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 n.5 (TTAB 1990).

1105 Applications and Registrations Not Subject to Proceeding

37 C.F.R. § 2.73 *An application that includes section 1(a) of the Trademark Act as a filing basis, or for which an acceptable allegation of use under § 2.76 or § 2.88 has been filed, may be amended to an application for concurrent use registration, provided that the application as amended meets the requirements of § 2.42. The trademark examining attorney will determine whether the application, as amended, is acceptable.*

37 C.F.R. § 2.99(g) *Registrations and applications to register on the Supplemental Register and registrations under the Act of 1920 are not subject to concurrent use registration proceedings. Applications under section 1(b) of the Act of 1946 are subject to concurrent use registration proceedings only after the applicant files an acceptable allegation of use under § 2.76 or § 2.88. Applications based solely on section 44 or section 66(a) of the Act are not subject to concurrent use registration proceedings.*

Applications on Supplemental Register. Applications for registration on the Supplemental Register, registrations on the Supplemental Register, and registrations issued under the Act of 1920 are not subject to concurrent use proceedings. [Note 1.]

Applications under Trademark Act §§ 44 or 66(a). Applications for registration based solely on Trademark Act § 44 or Trademark Act § 66(a), 15 U.S.C. § 1126 or 15 U.S.C. § 1141f(a) are not subject to concurrent use proceedings. [Note 2.]

Applications under Trademark Act § 1(b). Applications to register under Trademark Act § 1(b), 15 U.S.C. § 1051(b), i.e., intent-to-use applications, are subject to concurrent use proceedings only after an acceptable allegation of use under 37 C.F.R. § 2.76 or 37 C.F.R. § 2.88 has been filed. [Note 3.] *See* TBMP § 1103.01(a). If a concurrent use application is filed as an intent-to-use application under Trademark Act § 1(b) rather than as a use application under Trademark Act § 1(a), 15 U.S.C. § 1051(a), the applicant may not amend the application to seek concurrent use until use is effected. [Note 4.] Further, applicants may not file an amendment to allege use in an application under Trademark Act § 1(b) that is the subject of an opposition in an effort to qualify for concurrent use registration. 37 C.F.R. § 2.76(a) provides that an applicant may not file an amendment to allege use after the date the application has been approved for publication. Applications are in a "blackout period" while an opposition is pending. [Note 5.] Should the parties to an opposition wish to go forward with concurrent use registrations, applicant in the opposition may consider abandoning its opposed application and refiling it as a use-based, concurrent use application. If the abandonment is with opposer's consent, judgment will not be entered against applicant, and the opposition can be dismissed without prejudice. [Note 6.] Opposer should also consider amending any pending application it may have to one seeking a concurrent use registration to enable a full adjudication of rights under the marks. For information regarding termination of the opposition in favor of a concurrent use proceeding, see TBMP § 1113.01.

Limitations of rights as against incontestable marks. An "incontestable registration," that is, a registration of a mark the right to use of which has become incontestable pursuant to Trademark Act § 15, 15 U.S.C. § 1065, is subject to a concurrent use proceeding. However, any registration issued to the concurrent use applicant as against the owner of an incontestable registration will be limited (even if applicant is the prior user) to applicant's area of actual use prior to actual or constructive notice of registrant's rights, unless the parties stipulate otherwise. [Note 7.]

The five-year incontestability period for a registration is tolled with respect to an applicant's concurrent rights if, prior to expiration of the five-year period, the applicant files a proper concurrent use application (or an amendment converting its unrestricted application into one seeking concurrent use registration) naming the registrant as an exception to applicant's right of exclusive use. [Note 8.]

NOTES:

1. *See* Trademark Act § 26, 15 U.S.C. § 1094 ; 37 C.F.R. § 2.99(g).

2. *See* 37 C.F.R. § 2.99(g).

3. *See* 37 C.F.R. § 2.99(g). *Cf.* 37 C.F.R. § 2.73.

4. *See* 37 C.F.R. § 2.99(g); TMEP § 1207.04(b).

5. *See* TMEP § 1104.03(b).

6. *See* 37 C.F.R. § 2.135.

7. *See* Trademark Act § 15 and Trademark Act § 33(b)(5), 15 U.S.C. § 1065 and 15 U.S.C. § 1115(b)(5); *Boi Na Braza, LLC v. Terra Sul Corp.*, 110 USPQ2d 1386, 1394-95 (TTAB 2014) (defendant entitled only to specific area in which it established prior rights in view of plaintiff's ownership of a registration, the right to use of which has become incontestable); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 636 (CCPA 1976) (only the right to use may become incontestable, not the registration); *Thriftimart, Inc. v. Scot Lad Foods, Inc.*, 207 USPQ 330, 334 (TTAB 1980) (applicant involved in concurrent use proceeding with registration with incontestable rights is normally only entitled to specific area in which it has established rights prior to actual or constructive notice of the registration).

8. *See Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048, 1050 (TTAB 1982).

1106 Commencement of Proceeding

1106.01 Marking of Concurrent Use Application

When an application seeking concurrent registration by way of a concurrent use proceeding before the Board is approved for publication, it is marked (by the trademark examining attorney) with the following statement:

SUBJECT TO CONCURRENT USE PROCEEDING WITH _____. APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE MARK IN THE AREA COMPRISING _____.

The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the first blank space. The second blank is filled in with the area for which applicant seeks registration.

If an application approved for publication seeks concurrent registration on the basis of the Board's determination, in a prior concurrent use proceeding, of applicant's entitlement thereto, and meets the conditions described in TBMP § 1103.02, so that a new concurrent use proceeding is unnecessary, the application is marked with the following statement:

REGISTRATION LIMITED TO THE AREA COMPRISING_____ PURSUANT TO CONCURRENT USE PROCEEDING NO._____. CONCURRENT REGISTRATION WITH _____.

The area specified in the Board's decision as the area for which applicant is entitled to registration is inserted in the first blank, together with any other conditions or limitations imposed by the Board. The second blank is filled in with the number of the prior concurrent use proceeding. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the prior concurrent use proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

If an application approved for publication seeks concurrent registration on the basis of a court determination of concurrent rights, and meets the conditions of 37 C.F.R. § 2.99(f), *see*TBMP § 1103.03, so that a concurrent use proceeding is unnecessary, the application is marked with the following statement:

REGISTRATION LIMITED TO THE AREA COMPRISING_____ PURSUANT TO THE DECREE OF_____. CONCURRENT REGISTRATION WITH _____.

The area granted to applicant by the court is inserted in the first blank, together with any other conditions or limitations imposed by the court. The second blank is filled in with the name of the court, proceeding number, and date of decree. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the court proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

1106.02 Publication of Concurrent Use Application; Opposition Period

Once the trademark examining attorney has approved the mark for publication and marked the application, it is then published, with the indicated statement, in the Official Gazette for opposition. The status of the application is changed to "Concurrent Use Proceeding Pending" on the date of publication and is reported to the Board. The application is then added to the Board's electronic system and tracked until after the opposition period has passed.

If the application seeking concurrent registration based on a court decree meets the requirements of 37 C.F.R. § 2.99(f), and is not opposed, or all oppositions filed are dismissed or withdrawn, the application goes to issue without the institution of a concurrent use proceeding. [Note 1.] *See*TBMP § 1103.03. Similarly, if the application seeking concurrent registration on the basis of a prior Board concurrent use determination meets the conditions described in TBMP § 1103.02, and is not opposed, or all oppositions filed are dismissed or withdrawn, the application goes to issue without the institution of a new concurrent use proceeding. [Note 2.] *See*TBMP § 1103.02 and TBMP § 1103.03.

Concurrent use proceedings will be instituted (1) if the application seeks concurrent registration by way of a concurrent use proceeding before the Board, and is not opposed, or all oppositions filed are dismissed or withdrawn [Note 3]; (2) if the application seeks concurrent registration on the basis of a court decree but does not meet the requirements of 37 C.F.R. § 2.99(f); or (3) seeks concurrent registration on the basis of the Board's decision in a prior concurrent use proceeding but does not meet the conditions described in TBMP § 1103.02, and the application is not opposed, or all oppositions filed are dismissed or withdrawn [Note 4.] *See*TBMP § 1103.02 and TBMP § 1103.03.

After the opposition period has expired, and no opposition is filed, or all oppositions filed are dismissed or withdrawn the Board then institutes the proceeding, identifies the defending users and sends notice thereof to each party. *See*TBMP § 1106.03 and TBMP § 1106.04. There is no fee for the institution of a concurrent use proceeding.

NOTES:

1. 37 C.F.R. § 2.99(f).

2. *Cf.* 37 C.F.R. § 2.99(f).

3. *See* 37 C.F.R. § 2.99(c).

4. *See* 37 C.F.R. § 2.99(c) and 37 C.F.R. § 2.99(f).

1106.03 Preparing the Record for the Involved Application and Registration Files

The Board identifies and enters into the record any applications or registrations that are to be included in the concurrent use proceeding. For information concerning involved applications and registrations, *see*TBMP § 1104. If any such application has not yet been published in the Official Gazette, or has been published but has not yet cleared the opposition period, the proceeding will be instituted, with the owner of that application being included as a common law user, rather than as an applicant. The Board may, in its discretion, suspend proceedings in the concurrent use proceeding until the unpublished application either becomes abandoned, or is published in the Official Gazette and survives the opposition period. After the application survives the opposition period, it is added to the proceeding, and the position of its owner is changed from that of common law user to applicant. *Cf.*TBMP § 1104 and TBMP § 1108.

1106.04 Preparing Concurrent Use Notices

There is no complaint in a concurrent use proceeding. *Cf.*TBMP § 1003. Instead, after the concurrent use application is published, the Board electronically tracks it until it clears its opposition period, the Board identifies all other applications and registrations, if any, to be included in the proceeding, and then the Board prepares notices for each concurrent use applicant and for each party.

The notice sent to each involved concurrent use applicant advises the applicant of the institution of the proceeding and includes a web link or web address to access the concurrent use proceeding contained in Office records. [Note 1.]

A separate order is issued to the excepted users [Note 2], defending applicants or defending registrants, advising each party that the concurrent use proceeding is thereby instituted and supplying information concerning the filing of an "answer" to the notice and specifying a due date therefor. For information concerning the "answer" in a concurrent use proceeding, see TBMP § 1107. The institution order will set out the parties' conference, disclosures, discovery, trial and briefing periods, unless there is more than one named excepted user, and none of them owns a trademark application or registration. *See*TBMP § 1109. In that case, the trial schedule is issued after all answers are filed; if any defending common law user fails to file an answer, judgment will be entered against that user as a defaulting user. *See*TBMP § 1107. The order will also allow the parties until a specified time to advise the Board of any relevant, but as yet uninvolved, application(s) and/or registration(s), which should be included in the proceeding.

The notice to each party listed as an exception to a concurrent use applicant's claim of exclusive use also specifies the name and address of the concurrent use applicant and the concurrent use applicant's attorney or other authorized representative, if any, together with the concurrent use applicant's mark, goods and/or services, application filing date and serial number, and claimed territory [Note 3]; the name and address of any other involved applicant or registrant; the name and address of any other involved applicant's attorney

or other authorized representative, if any; the mark, goods and/or services, application filing date, application serial number, and claimed territory of any other involved application (if the application is unrestricted, the claimed territory will be described in the notice as "The entire United States"); the mark, goods and/or services, registration filing and issue dates, registration number, and claimed territory of any other involved registration; and the name and address of any other involved party which is simply a common law concurrent user, i.e., does not own an involved application or registration of its mark.

The notices are sent to each involved applicant, in care of the applicant's attorney or other authorized representative, if any; to any involved user; and to any involved registrant. If an applicant is not represented by an attorney but the applicant has appointed a domestic representative, the Board will send the notice to the domestic representative unless the applicant has designated in writing another correspondence address. [Note 4.] In the case of an involved registration, the notice is sent to the registrant itself, or to the registrant'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 5.]

If a party has provided the Office with an email address, the notification may be transmitted via email. [Note 6.] In any proceeding, an undelivered notice from the Board of the commencement of a proceeding may result in notice by publication in the Official Gazette, available for viewing at the USPTO's website (**http://www.uspto.gov**). [Note 7.]

The Board no longer forwards a copy of each concurrent use applicant's involved application(s) with the notice to each party specified in the concurrent use application as an exception to applicant's claim of exclusive use. [Note 8.] The rules also dispense with the requirement that the concurrent use applicant provide the Board with copies of its concurrent use application, for service by the Board, on each excepted party. [Note 9.]

The concurrent use proceeding commences when the Board sends the notices to the parties, and sets the schedule for conferencing, disclosures, discovery, trial and briefing. [Note 10.] If there is more than one named excepted user, and none of them owns a trademark application or registration, the trial schedule is issued after all answers are filed, but the concurrent use proceeding commences when the Board sends the notices to the parties. [Note 11.] Where a concurrent use proceeding has been commenced solely to order a registrant, named as an excepted user in the proceeding, to show cause why its registration should not be restricted to comply with a decision in a prior Board proceeding or with a court decree, the Board does not include a trial schedule when it sends the notices to the parties.

NOTES:

1. *See* 37 C.F.R. § 2.99(d)(1).

2. Excepted users are those parties identified by the applicant as users who are exceptions to applicant's claim of exclusive right to use the mark under Trademark Act § 2(d), 15 U.S.C. § 1052(d).

3. *See* 37 C.F.R. § 2.99(c).

4. *Cf.* 37 C.F.R. § 2.105(c) and 37 C.F.R. § 2.119(d).

5. *Cf.* 37 C.F.R. § 2.113(c).

6. *See* 37 C.F.R. § 2.99(c); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42243 (August 1, 2007). The parties may also, by prior agreement, meet their service obligations by utilizing electronic means such as fax or email. 37 C.F.R. § 2.119(b).

7. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

8. *See* 37 C.F.R. § 2.99(d)(1).

9. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

10. *Cf.* 37 C.F.R. § 2.93.

11. *See* 37 C.F.R § 2.99(c).

1106.05 Locating Excepted Users

It is the responsibility of the concurrent use applicant, which has the burden of proving its entitlement to concurrent registration, to provide information concerning the current address of each specified excepted user, as well as information concerning each user's use of its particular mark in its particular area or mode of use, and the registrations issued to or applications filed by the excepted user, if any. [Note 1.] *See*TBMP § 1103.01(c)-(f) and TBMP § 1108. The address used by the Board in mailing the notice to a specified excepted user is the address provided by the concurrent use applicant in its application, unless the user itself owns an involved application or registration which includes an address more current than the one provided by the concurrent use applicant.

If a notice or other communication sent by the Board to a specified excepted user is returned as undeliverable, the concurrent use applicant will be required to investigate further and furnish the correct address. If the excepted user owns an application or registration, additional notice may be given by publication in the Official Gazette for the period of time prescribed by the Director. [Note 2.] If, however, the excepted user does not own an application or registration, unless and until the concurrent use applicant furnishes the correct address for the user, the proceeding cannot go forward. Alternatively, if, upon further investigation, the concurrent use applicant learns that a specified excepted user has abandoned its use of its mark, the concurrent use applicant may file a motion to amend its application to delete reference to that user. The motion should include an explanation of the facts that serve as the basis for the motion. If the motion is granted, the amendment will be entered, and the user in question will be dropped as a party to the proceeding. *See*TBMP § 1104. Should it come to applicant's attention that all excepted users have abandoned their mark or assigned them to applicant, applicant may file a motion to amend its application to delete the excepted users and to seek a geographically unrestricted registration. If such a motion is granted, the concurrent use proceeding will be dissolved and the application will be republished as a geographically unrestricted application.

If the owner of a registration is listed as an excepted user and the concurrent use applicant is unable, after reasonable investigation, to locate the registrant, applicant may file a petition to cancel the registration owned by the user on the ground of abandonment. The concurrent use proceeding will be suspended pending the outcome of the petition to cancel. If the Board grants the petition to cancel on the ground that the registrant has discontinued use of its mark with no intent to resume use and thereby has abandoned the mark, the concurrent use proceeding will be resumed. The concurrent use applicant may then file a motion to amend its application to delete reference to the registrant as an exception to applicant's exclusive right to use the

mark in commerce, and to seek a geographically unrestricted registration of the mark, if there are no other excepted users listed. If the applicant and the Board are unable to locate the registrant, notice of the filing of the petition to cancel will be published in the Official Gazette. [Note 3.] If the registrant fails to appear within the thirty-day period of time allowed by the notice, default judgment will be entered against the registrant on the claim of abandonment and the petition to cancel will be granted. The concurrent use applicant may then file a motion to amend its application to delete reference to the registrant as an exception to applicant's exclusive right to use the mark in commerce, and to seek a geographically unrestricted registration of the mark if there are no other excepted users listed.

NOTES:

1. *See* 37 C.F.R. § 2.42(b)(4)-(8) and 37 C.F.R. § 2.99(e).

2. 37 C.F.R. § 2.118. The period of time allowed by the notice is typically thirty days.

3. *See* 37 C.F.R. § 2.118.

1107 Answer; Default

There is no complaint in a concurrent use proceeding. *Cf.*TBMP § 1003. Instead, there is a notice which informs the parties of the institution of the proceeding, supplies information concerning the filing and due date of an "answer" to the notice, and sets conferencing, disclosure, discovery, trial, and briefing dates. Where a concurrent use proceeding has been commenced solely to order a registrant, named as an excepted user in the proceeding, to show cause why its registration should not be restricted to comply with a decision in a prior Board proceeding or with a court decree, the Board does not include a trial schedule when it sends the notices to the parties. Where there is more than one named excepted user, and none of them owns a trademark application or registration, the trial schedule is issued after all answers are filed; if any defending common law user fails to file an answer, judgment will be entered against that user as a defaulting user. *See*TBMP § 1107. The notice takes the place of a complaint to the extent that it informs every specified person of the scope of the concurrent registration sought by each concurrent use applicant, and the extent of each concurrent use applicant's acknowledgment of the concurrent rights of others - i.e., the essence of what each concurrent use applicant intends to prove at trial. *See* TBMP § 1103.01(c)-(f) and TBMP § 1106.

The Board does not send a copy of each involved concurrent use application with the notice to every person specified in the application. Instead, the Board's notice of institution will include a web link or web address to access the concurrent use application proceeding contained in Office records at the USPTO website (http://www.uspto.gov). [Note 1.] *See*TBMP § 1103.01(f) and TBMP § 1106.04.

The "answer" in a concurrent use proceeding is a response to the notice. In the "answer," the answering party sets forth its position with respect to the registration(s) sought by the concurrent use applicant(s). [Note 2.]

An answer to the notice is not required of an applicant or registrant whose application or registration is involved in the proceeding, but such a party may file an answer if it so desires. *See*TBMP § 1104. Any other party specified as a concurrent user, e.g., a common law user, or a specified party who owns an application for an unrelated mark not involved in the proceeding, and who thus stands in the position of a common law user, must file an answer to avoid default. Any answer must be filed within the time set in the Board's notice, usually 40 days, or within an extension of time for that purpose. *See* TBMP § 501 and TBMP § 509. [Note 3.]

If a party that is required, under 37 C.F.R. § 2.99(d)(2), to file an answer fails to do so, judgment will be entered against that party precluding the party from claiming any right more extensive than that acknowledged by applicant in the involved concurrent use application(s). However, each concurrent use applicant bears the burden of proving its entitlement to the registration(s) sought as against every party specified in its application(s), including any party against which default judgment for failure to answer has been entered. *See* TBMP § 1108. That is, the concurrent use applicant still will have to prove that there will be no likelihood of confusion by reason of the concurrent use by the parties of their respective marks, and, where necessary, that the parties have become entitled to use their marks as a result of their concurrent lawful use in commerce prior to the applicable date specified in Trademark Act § 2(d), 15 U.S.C. § 1051 (d) [usually, this means use in commerce prior to the earliest application filing date of the application(s), or 1946 Act registration(s) (if any), involved in the proceeding (or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905)]. [Note 4.] *See*TBMP § 1103.01(b). Moreover, if, after the entry of default judgment against a party for failure to answer, the concurrent use applicant seeks to amend its application to narrow the extent of the concurrent rights conceded therein to the defaulting party, the defaulting party will be allowed an opportunity to object thereto. If the amendment is permitted, the defaulting party, should it object to the narrower geographic scope accorded it by the amendment, will be allowed to contest the registration sought by the applicant onlyto the extent that the applicant claims a greater right, as against the defaulting party, than that previously claimed.

When default judgment for failure to file an answer is entered against a party to a concurrent use proceeding, the Board does not continue to send copies of all of the communications issued by the Board in the proceeding to that party, nor do the other parties to the proceeding need to continue serving copies of all papers which they file in the proceeding on the defaulting party. However, a copy of the Board's final decision in the case will be mailed to the defaulting party. Moreover, any request by the concurrent use applicant to amend its application to narrow the extent of the concurrent rights conceded therein to the defaulting party must be served upon that party. If the amendment is permitted, the Board will send a copy of its action on the request, and copies of all further communications issued by the Board in the proceeding, to the defaulting party, provided the Board has a serviceable address. Similarly, after approval of such an amendment, copies of all further papers filed by the other parties to the proceeding should be served on the defaulting party.

If a concurrent use proceeding involves only the concurrent use applicant and one or more specified common law excepted users which do not have an involved application or registration, and default judgment for failure to answer is entered against every specified user, applicant may prove its entitlement to registration as against the defaulting user(s) by an "ex parte" type of showing. *See*TBMP § 1108 for information on how to prove entitlement by making an "ex parte" showing.

NOTES:

1. *See* 37 C.F.R. § 2.99(d)(1).

2. *See, e.g., Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1225-26 (TTAB 1993); *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451, 1453 (TTAB 1991), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723 (TTAB 1990); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307 (TTAB 1984); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 916 (TTAB 1984).

3. *See* 37 C.F.R. § 2.99(d)(2); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307 (TTAB 1984) (concurrent use applicant may amend its application to one seeking an unrestricted registration upon showing that concurrent user has discontinued use of its mark, and not merely abandoned its application for registration).

4. *See* 37 C.F.R. § 2.99(d)(3). *See also Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1229 (TTAB 1993); *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095, 1096 (TTAB 1987); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307 (TTAB 1984).

1108 Issue in Concurrent Use Proceeding; Burden of Proof

37 C.F.R. § 2.99(e) *The applicant for a concurrent use registration has the burden of proving entitlement thereto. If there are two or more applications for concurrent use registration involved in a proceeding, the party whose application has the latest filing date is the junior party. A party whose application has a filing date between the filing dates of the earliest involved application and the latest involved application is a junior party to every party whose involved application has an earlier filing date. If any applications have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. A person specified as an excepted user in a concurrent use application but who has not filed an application shall be considered a party senior to every party that has an application involved in the proceeding.*

37 C.F.R. § 2.116(b) *... A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.*

The issue to be determined in a concurrent use proceeding is the entitlement of the concurrent use applicant(s) to the registration(s) sought, and the extent, if any, to which every other involved application or registration should be restricted as a result thereof. The Board does not determine the right to registration of a party that is included in the proceeding only as a common law concurrent user (i.e., a party that does not own an involved application or registration). The specific territorial rights to which any common law users are entitled are not before the Board except to the extent that their registration rights may be limited by the territorial rights to which applicant proves entitlement. Any registration rights of a common law user can be determined only if such user were to file an application seeking concurrent registration and a concurrent use proceeding is instituted involving such application. [Note 1.]

Each applicant for concurrent registration has the burden of proving its entitlement thereto as against every other party specified in its application as an exception to its claim of exclusive right to use. [Note 2.] *See* TBMP § 1104. That is, a concurrent use applicant must prove that there will be no likelihood of confusion by reason of the concurrent use by the parties of their respective marks, and that the parties have become entitled to use their marks as a result of their concurrent lawful use in commerce prior to the applicable date specified in Trademark Act § 2(d), 15 U.S.C. § 1052(d) [usually, this means use in commerce prior to the earliest application filing date of the application(s), or 1946 Act registration(s) (if any), involved in the proceeding (or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905)]. [Note 3.] *See*TBMP § 1103.01(b) and TBMP § 1103.01(d)(2).

Any other party may attempt to prove any ground or basis for refusal of registration to the concurrent use applicant that may be asserted with respect to an application for an unrestricted registration in an opposition proceeding, as well as other matters, such as, that the concurrent use applicant is entitled to a concurrent registration covering only some of the area specified in its application; that the concurrent use applicant is not entitled to registration at all because it is a bad faith junior user; that applicant does not meet the jurisdictional requirement of use of its involved mark prior to the applicable date specified in Trademark Act § 2(d), *see*TBMP § 1103.01(b); or that applicant's use of its mark is unlawful. [Note 4.]

In a concurrent use proceeding, a junior party stands in the position of plaintiff, in that it is the applicant-plaintiff that is seeking to reduce the geographic area of the senior party-defendant, thereby making the senior party stand in the position of defendant. [Note 5.] When there are two or more concurrent use applications involved in a concurrent use proceeding, the party whose application has the latest filing date is the junior party. A party whose application has a filing date between the filing dates of the earliest involved application and the latest involved application is a junior party to every party whose involved application has an earlier filing date. If any applications have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date, and that applicant will be the junior party. A party which is specified in an involved concurrent use application as an excepted user, but which does not have an involved application, shall be considered a party senior to every party that has an application involved in the proceeding. [Note 6.]

Ex Parte Showing: When a concurrent use proceeding involves only the concurrent use applicant and one or more specified common law excepted users which do not have an involved application or registration, and default judgment for failure to answer is entered against every specified user, applicant still has the burden of proving its entitlement to the registration sought, i.e., that there exists no likelihood of confusion among consumers by reason of the concurrent use by the parties of their respective marks. [Note 7.]

In such case, the concurrent use applicant may prove its entitlement by making an ex parte showing. The availability of making an ex parte showing allows a concurrent use applicant the right to prove its entitlement to registration by less formal procedures (such as by the submission of declaration or affidavit evidence) rather than by more formal procedures (such as depositions upon oral examination). [Note 8.] Such a showing usually suffices if the concurrent use applicant can address many of the factors the Board considers at in settlement agreements. *See*TBMP § 1110. In such a case, the Board, instead of setting formal trial dates, simply allows the concurrent use applicant time in which to submit proof of its entitlement to registration. [Note 9.] In the event the concurrent use applicant fails to make a sufficient ex parte showing, judgment is entered against the concurrent use applicant, the concurrent use proceeding is dissolved and registration to the concurrent use applicant is refused.

NOTES:

1. *See Terrific Promotions Inc. v. Vantex Inc.*, 36 USPQ2d 1349, 1353 (TTAB 1995); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1230 (TTAB 1993); *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451, 1456 (TTAB 1991), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992) (the only issue properly before the Board in a concurrent use proceeding concerns the concurrent use applicant's entitlement to registration); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 n.5 (TTAB 1990) (unless named as an exception by the concurrent use applicant, a third-party's application may not be joined in a concurrent use proceeding for purposes of determining proper ownership thereof, but unnamed party may amend its application to seek concurrent registration, in which case such application would become subject to its own concurrent use proceeding); *The Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133, 1136 (TTAB 1982) (applicant entitled to concurrent registration despite knowledge of existence of other users of mark that came to applicant's attention after it began use of its mark).

2. *See* 37 C.F.R. § 2.99(e); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1309 (Fed. Cir. 1987) (concurrent use applicant not entitled to registration because, despite the fact that it does not seek registration for entire trading area, when its entire trading area is taken into account, confusion with senior user's mark is likely); *Hanscomb Consulting, Inc. v. Hanscomb Ltd.*, 2020 USPQ2d 10085 (TTAB 2019) (concurrent use applicant failed to demonstrate that excepted user's use was solely limited to the geographic limitations set forth in its application; record demonstrated that the parties' area of use overlapped); *Southwestern Management, Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007 (TTAB 2015) (applicant seeking

exclusive right to use "Delmonico's" mark for restaurant services throughout United States except in designated geographic areas in and around New York City, New Orleans and Las Vegas failed to prove that, with appropriate geographic restriction, there would be no likelihood of confusion, mistake or deception in marketplace), *aff'd mem.*, 652 F. App'x 971 (Fed. Cir. 2016); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1484 (TTAB 2014) (concurrent use applicant did not carry his burden of establishing there would be no likelihood of confusion with respect to adjacent territories); *CDS Inc. v. I.C.E.D. Management Inc.*, 80 USPQ2d 1572, 1583-84 (TTAB 2006) (entitlement may still be shown even where parties both advertise on the Internet); *Terrific Promotions Inc. v. Vantex Inc.*, 36 USPQ2d 1349, 1352 (TTAB 1995) (mention of concurrent user in two in-flight airline magazines did not prevent issuance of concurrent use registrations); *Big M. Inc. v. United States Shoe Corp.*, 228 USPQ 614, 616 (TTAB 1985) (concurrent use applicant did not prove entitlement to registration where parties failed to agree to limit actual use to territorial scope of proposed concurrent use registrations); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 917 (TTAB 1984) (applicant entitled to area of actual use plus reasonable area of probable expansion); *Handy Spot Inc. v. J. D. Williams Co.*, 181 USPQ 351, 352 (TTAB 1974) (parties' "mere naked consent agreement" fails to prove entitlement). *Cf. Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988) (in case involving consent agreement regarding parties' use of their respective marks in different territories, overlapping advertising and customer solicitation did not mandate determination that there was a likelihood of confusion.).

3. *See* Trademark Act § 2(d), 15 U.S.C. § 1052(d); 37 C.F.R. § 2.99(e); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1307 (Fed. Cir. 1987) (concurrent use registration refused where junior user admitted use of mark in trading area of senior user; likelihood of confusion in concurrent use proceeding is to be determined on basis of actual territorial use of the respective marks, and not with respect to geographic area "claimed" in the application for concurrent use registration); *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 832 (CCPA 1980); *Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2d 1925, 1933 (TTAB 2015) (motion for summary judgment granted where there is no genuine dispute of material fact that applicant did not use the mark shown in the drawing in commerce prior to the filing date of the application underlying defendant's registration); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1483-84 (TTAB 2014) (concurrent use applicant not entitled to registration because there is a likelihood of confusion in the area where both parties are using their mark); *America's Best Franchising, Inc. v. Abbott*, 106 USPQ2d 1540, 1548-54 (TTAB 2013) (applicant demonstrated likelihood of confusion is avoided by the parties' concurrent use of their marks where applicant's, the junior user, use of its mark was prior to the filing date of defendant's geographically unrestricted application and applicant is entitled to registration of the entire United States excluding defendant's territory of actual use); *CDS, Inc. v. I.C.E.D. Management, Inc.*, 80 USPQ2d 1572, 1581 (TTAB 2006) (registrant is entitled to registration covering the entire United States, "including areas of its use and non-use, subject only to the exception of geographic areas where the junior user can prove prior use"); *Fleming Companies v. Thriftway Inc.*, 809 F. Supp. 38, 26 USPQ2d 1551, 1553 (S.D. Ohio 1992) (party is entitled to concurrent use registration for a given territory only if the party actually used the mark in that territory prior to registration by the other party; plaintiff did not use mark in expanded territory prior to defendant's registration and therefore could not be "lawful" user), *aff'g* 21 USPQ2d 1451, 1455 (TTAB 1991); *Terrific Promotions Inc. v. Vantex Inc.*, 36 USPQ2d 1349, 1353 (TTAB 1995) (good faith second user that has vigorously expanded under mark given most of U.S.); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1229 (TTAB 1993); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 (TTAB 1990) (actual use in a territory is not necessary to establish rights in that territory and depends on a number of factors); *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1229 (TTAB 1989) (as a general rule prior user is entitled to registration covering entire U.S. except for geographic area in which subsequent user has actually used the mark plus an area shown to be within the natural expansion of its business, but rule is not absolute); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879, 884 (TTAB 1985) (primary concern in concurrent use proceeding is the avoidance of likelihood of confusion; applicant unable to establish its entitlement to registration in area claimed where senior user was national

franchise); *Faces, Inc. v. Face's, Inc.*, 222 USPQ 918, 920 (TTAB 1983); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 915 (TTAB 1984).

4. *See DataNational Corp v. Bell South Corp.*, 60 F.3d 1565, 35 USPQ2d 1554, 1557-59 (Fed. Cir. 1995) (the term "use" means use as a trademark; a concurrent use applicant may claim less than the entire country as the place of use but only when there is actual or potential concurrent use of the mark by another lawful user that is not likely to cause confusion, and where mark is generic in the non-claimed area, there can be no lawful user in the non-claimed area), *aff'g* 18 USPQ2d 1862 (TTAB 1991); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1480 (Fed. Cir. 1990) (allegation of bad faith adoption and use of mark in U.S. subsequent to user's adoption in foreign country); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987) (a valid application cannot be filed at all without lawful use in commerce and for purposes of claim of concurrent rights, such lawful use must begin prior to the filing date of any application with which concurrent use is sought); *Fleming Companies v. Thriftway Inc.*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992) (junior user was not lawful user in that it did not lawfully use the mark in expanded territory prior to defendant's registration), *aff'g* 21 USPQ2d 1451, 1455 (TTAB 1991); *Women's World Shops Inc. v. Lane Bryant Inc.*, 5 USPQ2d 1985, 1988 (TTAB 1988) (plaintiff's use, albeit geographically remote, was not lawful because plaintiff had actual knowledge of defendant's prior use); *Pagan-Lewis Motors, Inc. v. Superior Pontiac, Inc.*, 216 USPQ 897, 899 (TTAB 1982) (applicant's first use was neither innocent nor in good faith since applicant had constructive notice of user's mark).

5. *See* 37 C.F.R. § 2.116(b).

6. *See* 37 C.F.R. § 2.99(e).

7. 37 C.F.R. § 2.99(d)(3).

8. *See Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095, 1096 (TTAB 1987) (affidavit of officer of concurrent use applicant submitted vis-à-vis defaulted users). *See also Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451, 1456 (TTAB 1991), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992).

9. For an example of proof of entitlement to concurrent registration in such a situation, see *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095, 1096 (TTAB 1987) (affidavit of officer of concurrent use applicant submitted vis-à-vis defaulted users).

1109 Conduct of Proceeding

Once commenced, a concurrent use proceeding is conducted in the same general manner as an opposition or cancellation proceeding, except that, inter alia, there is no complaint (*see*TBMP § 1106.04 and TBMP § 1107), and thus no motions relating to the complaint, and the "answer" is not an answer in the usual sense of the word, and is not always required. *See*TBMP § 1107. The parties are subject to disclosure and conferencing obligations. The issue to be decided by the Board is the entitlement of the concurrent use applicant(s) to the registration(s) sought, and the extent, if any, to which every other involved application or registration should be restricted as a result thereof. *See*TBMP § 1108. If an answer, when required, is not filed, default judgment is entered against the non-answering party, precluding that party from claiming any right more extensive than that acknowledged in the involved concurrent use application(s), but each concurrent use applicant will still have the burden of proving its entitlement to the registration(s) sought. *See*TBMP § 1107. In certain cases where default judgment is entered for failure to answer, a concurrent

use applicant may be permitted to prove its entitlement to registration by less formal procedures (such as by submission of declaration or affidavit evidence). *See*TBMP § 1107 and TBMP § 1108.

In addition, parties may obtain expedited determination of concurrent use proceedings by stipulating to Accelerated Case Resolution (ACR). *See*TBMP § 528.05(a)(2) and TBMP § 702.04. However, and as noted above, in appropriate circumstances concurrent use cases may be resolved based upon an informal "ex parte" type of showing of entitlement to registration by applicant after default by common law excepted user(s) for failure to answer. *See*TBMP § 1108. As a result, concurrent use applicants are more likely to achieve expedited determination of concurrent use proceedings by means of the informal "ex parte" type of showing.

The order in which the parties offer evidence depends upon whether or not they own an involved application or registration. If two or more parties own an involved concurrent use application, the order in which the parties offer evidence also depends upon the filing dates of such applications. *See*TBMP § 1108.

In addition, the conferencing, disclosure, trial and briefing schedule in a concurrent use proceeding involving three or more parties differs from that in an opposition or cancellation proceeding, because of the multiplicity of parties. Along with the concurrent use notice, the Board sends out an order setting dates in the case. Specifically, the Board sets a deadline for the discovery conference, disclosure dates, and the opening and closing date for discovery, and schedules testimony periods so that each party in the position of plaintiff will have a period for presenting its case in chief against each party in the position of defendant, each party in the position of defendant will have a period for presenting its case and meeting the case of each plaintiff, and each party in the position of plaintiff will have a period for presenting evidence in rebuttal. *See*TBMP § 701. The testimony periods are separated from the discovery period and from each other by 60-day intervals, with intervening deadlines for pretrial disclosures. Similarly, the Board schedules briefing periods so that each party in the position of plaintiff will have a period for filing a main brief on the case, each party in the position of defendant will have a period for filing a main brief and meeting the main brief of each plaintiff, and each party in the position of plaintiff will have a period for filing a reply brief. [Note 1.] *See*TBMP § 801.02(e).

NOTES:

1. *See* 37 C.F.R. § 2.128(a)(2).

1109.01 Sample Trial Schedules - Cases Commenced On or After November 1, 2007

Set forth below is a sample trial and briefing schedule for a concurrent use proceeding involving parties A, B, C, D, and E, where A, B, C, and D are all concurrent use applicants, A's application has the latest filing date, B's application has the next-latest filing date, C's application has the next-latest filing date, D's application has the earliest filing date, and E is a specified concurrent user which does not own an involved application or registration (the trial and briefing schedule would look the same if E were a concurrent use applicant whose application had the earliest filing date, or if E owned an involved registration):

Answer to Concurrent Use Due	6/1/2020
Deadline for Discovery Conference	7/1/2020
Discovery Opens	7/1/2020
Initial Disclosures Due	7/31/2020
Expert Disclosures Due	11/28/2020
Discovery Closes	12/28/2020

A's Pretrial Disclosures Due	2/11/2021
A's 30-day Trial Period Ends	3/28/2021
B’s Pretrial Disclosures Due	4/12/2021
B’s 30-day Trial Period Ends	5/27/2021
C’s Pretrial Disclosures Due	6/11/2021
C’s 30-day Trial Period Ends	7/26/2021
D’s Pretrial Disclosures Due	8/10/2021
D’s 30-day Trial Period Ends	9/24/2021
E’s Pretrial Disclosures Due	10/9/2021
E’s 30-day Trial Period Ends	11/23/2021
A's Rebuttal Disclosures Due	12/23/2021
A's 15-day Rebuttal Period Ends	1/22/2022
B’s Rebuttal Disclosures Due	2/6/2022
B’s 15-day Rebuttal Period Ends	3/8/2022
C’s Rebuttal Disclosures Due	3/23/2022
C’s 15-day Rebuttal Period Ends	4/22/2022
D’s Rebuttal Disclosures Due	5/7/2022
D’s 15-day Rebuttal Period Ends	6/6/2022
E’s Rebuttal Disclosures Due	6/21/2022
E’s 15-day Rebuttal Period Ends	7/21/2022
A's Brief Due	9/19/2022
B's Brief Due	10/19/2022
C's Brief Due:	11/18/2022
D's Brief Due	12/18/2022
E's Brief Due	1/17/2023
A's Reply Brief Due	2/1/2023
B's Reply Brief Due	2/16/2023
C's Reply Brief Due	3/3/2023
D's Reply Brief Due	3/18/2023
E's Reply Brief Due	4/2/2023

Set forth below is another sample trial and briefing schedule for a concurrent use proceeding involving parties X, Y, and Z, where X is a concurrent use applicant, Y owns a registration which is involved in the proceeding, and Z is a specified concurrent user which does not own an involved application or registration:

Answer to Concurrent Use Due	6/1/2020
Deadline for Discovery Conference	7/1/2020
Discovery Opens	7/1/2020
Initial Disclosures Due	7/31/2020
Expert Disclosures Due	11/28/2020
Discovery Closes	12/28/2020
X’s Pretrial Disclosures Due	2/11/2021
X’s 30-day Trial Period Ends	3/28/2021

Y’s Pretrial Disclosures Due	4/12/2021
Y’s 30-day Trial Period Ends	5/27/2021
Z’s Pretrial Disclosures Due	6/11/2021
Z’s 30-day Trial Period Ends	7/26/2021
X’s Rebuttal Disclosures Due	8/10/2021
X’s 15-day Rebuttal Period Ends	9/24/2021
Y's Rebuttal Disclosures Due	10/9/2021
Y's 15-day Rebuttal Period Ends	11/23/2021
Z's Rebuttal Disclosures Due	12/28/2021
Z's 15-day Rebuttal Period Ends	1/7/2022
X's Brief Due	3/8/2022
Y's Brief Due	4/7/2022
Z's Brief Due	5/7/2022
X's Reply Brief Due	5/22/2022
Y's Reply Brief Due	6/6/2022
Z's Reply Brief Due	6/21/2022
Request for Oral Hearing (optional) Due	7/1/2022

The trial and briefing schedule set forth immediately above would look the same if Y and Z were both specified concurrent users that did not own an involved application or registration. If X, Y, and Z were all concurrent use applicants, there would be a separate testimony period and pretrial disclosure due date for each party, and X and Y would each have a separate rebuttal testimony period; each party would also be allowed time to file a brief on the case, but only X and Y would be allowed time in which to file a reply brief.

Set forth below is a sample trial and briefing schedule used where A is a concurrent use applicant, and B, C, and D are named excepted users, none of which own a registration or pending trademark application. In this case, the trial schedule is issued only after the date for answer has passed, and if a defending user fails to file an answer, it will not be included on the schedule.

Answer to Concurrent Use Due	6/1/2020
Deadline for Discovery Conference	7/1/2020
Discovery Opens	7/1/2020
Initial Disclosures Due	7/31/2020
Expert Disclosures Due	11/28/2020
Discovery Closes	12/28/2020
A’s Pretrial Disclosures	2/11/2021
A’s 30-day Trial Period Ends	3/28/2021
B’s Pretrial Disclosures	4/12/2021
B’s 30-day Trial Period Ends	5/27/2021
C’s Pretrial Disclosures	6/11/2021
C’s 30-day Trial Period Ends	7/26/2021
D’s Pretrial Disclosures	8/10/2021
D’s 30-day Trial Period Ends	9/24/2021

A’s Rebuttal Disclosures Due	10/24/2021
A’s 15-day Rebuttal Period Ends	11/23/2021
B's Rebuttal Disclosures Due	12/8/2021
B's 15-day Rebuttal Period Ends	1/7/2022
C's Rebuttal Disclosures Due	1/22/2022
C's 15-day Rebuttal Period Ends	2/21/2022
D's Rebuttal Disclosures Due	3/8/2022
D's 15-day Rebuttal Period Ends	4/7/2022
A's Brief Due	6/6/2022
B's Brief Due	7/6/2022
C's Brief Due	8/5/2022
D's Brief Due	9/4/2022
A's Reply Brief Due	9/19/2022
B's Reply Brief Due	10/4/2022
C's Reply Brief Due	10/9/2022
D's Reply Brief Due	11/3/2022
Request for Oral Hearing (optional) Due	11/13/2022

With the exceptions noted above, the practices and procedures for conducting discovery conferences, serving initial, expert, and pretrial disclosures, taking discovery, filing motions, introducing evidence, briefing the case, presenting oral arguments at final hearing, and seeking review of a decision of the Board, are essentially the same in a concurrent use proceeding as in an opposition or cancellation proceeding.

1110 Settlement Providing for Concurrent Registration

Most concurrent use proceedings before the Board are not litigated to final decision on the merits, but rather are settled on the basis of an agreement between the parties which provides for the issuance to the concurrent use applicant(s) of the concurrent registration(s) sought. Such an agreement is usually filed by the concurrent use applicant(s) together with a request for issuance of the concurrent registration(s) sought.

The Board will not enter judgment on behalf of the concurrent use applicant(s), and find such applicant(s) entitled to concurrent registration on the basis of a settlement agreement, unless the terms of the agreement are sufficient to persuade the Board that confusion, mistake, or deception is not likely to result from the continued concurrent use by the parties of their marks. [Note 1.] If a concurrent use settlement agreement is determined to be insufficient, the Board generally will suspend proceedings and allow the parties time to submit a revised agreement correcting the deficiencies.

Traditionally, the geographic territories set forth in a concurrent use settlement agreement are mutually exclusive. Some additional provisions that may be included in settlement agreements are: (1) agreement by each party not to use or advertise in the geographical area of the other party; (2) agreement that the parties will take whatever steps are necessary to prevent actual confusion; (3) establishment of a “buffer zone” between the geographical areas of the parties; (4) recitation of any specific differences between the respective marks and goods of the parties; (5) information concerning any particular aspects of the goods, services or channels of trade which may help to preclude likelihood of confusion; (6) agreement by the parties to use distinctly different packaging, labeling, signs, or others marks in association with the subject marks; and (7) information as to the length and extent of concurrent use, and whether, in the experience of the parties, such use has resulted in any actual confusion. [Note 2.] These factors are not all inclusive, and the parties

may include any other relevant facts in demonstrating that there is no likelihood of confusion arising from the parties' concurrent use of similar marks in their respective geographical areas.

While internet advertising increases the geographic scope of a party's advertising, measures may be taken to reduce the possibility of consumer confusion with respect to such advertising. Examples include: a statement on each party's website that it is not affiliated with the other party or parties; a statement on the website indicating the party's specific geographic area of use; and displaying the subject mark on the website in close association with another mark or trade name or in a certain form. [Note 3.]

If a settlement agreement does not include every party to the proceeding, each concurrent use applicant still will have the burden of proving its entitlement to registration as against every party to the proceeding that is not also a party to the agreement, even if a default judgment for failure to answer has been entered against a non-included party. [Note 4.]

NOTES:

1. *See* Trademark Act § 2(d), 15 U.S.C. § 1052 (d)); *In re Beatrice Foods Co.*, 166 USPQ 431, 437 (CCPA 1970) (agreements worked out by the parties in good faith should be considered by the Board); *Fleming Cos. v. Thriftway Inc.*, 21 USPQ2d 1451, 1454 (TTAB 1991) (concurrent use applicant not entitled to registration including expanded area of geographic use in view of agreement entered into by its predecessor), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992); *Holmes Oil Co. v Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1150 (TTAB 2011) (persuasiveness of otherwise traditional consent agreement provided in resolution of concurrent use proceeding depends on reasons given that confusion is not likely); *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095, 1096 (TTAB 1987) (agreement persuasive); *Meijer, Inc. v. Purple Cow Pancake House*, 226 USPQ 280, 282 (TTAB 1985) (initial agreement deficient in view of, inter alia, provision allowing for "spill over" advertising); *The Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133, 1136 (TTAB 1982) (agreement between parties to concurrent use proceeding sufficient to show applicant's entitlement to registration; existence of other known users of the same mark as set forth in the final paragraph of the agreement does not render agreement as having been made in bad faith); *Handy Spot Inc. v. J. D. Williams Co.*, 181 USPQ 351, 352 (TTAB 1974) (mere naked agreement wherein parties have not delineated measures taken to preclude likelihood of confusion is not persuasive).

For further information concerning settlement agreements offered in a concurrent use proceeding as a basis for the issuance of the concurrent registration(s) sought, see *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988) (agreements to be given "substantial weight"). *Cf. Houlihan v. Parliament Import Co.*, 921 F.2d 1258, 17 USPQ2d 1208, 1212 (Fed. Cir. 1990) (agreements entitled to "great weight;" although the agreement did not contain explicit provisions designed to avoid confusion or explicit statement that concurrent use of the marks would not cause confusion, the provisions in the agreement reflected recognition by parties that concurrent use by marks in their respective, albeit in contiguous geographic areas, would not cause likelihood of confusion).

2. *See Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988) (agreement between parties given substantial weight); *In re Beatrice Foods Co.*, 166 USPQ 431, 437 (CCPA 1970) ("there can be no better assurance of the absence of any likelihood of confusion, mistake or deception than the parties' promises to avoid any activity which might lead to such likelihood."); *Holmes Oil Co. v Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1150 (TTAB 2011) (traditional consent agreement considered in concurrent use proceeding where only applicant's registration was to be geographically restricted found sufficient); *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095, 1096 (TTAB 1987) (agreement persuasive to show no likelihood of confusion); *The*

Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc., 215 USPQ 1133, 1134-35 (TTAB 1982) (agreement sufficient; concurrent use registration granted). *Cf. Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307-08 (TTAB 1984) (settlement agreement rescinded; concurrent use registration denied).

3. *See CDS Inc. v. I.C.E.D. Management Inc.*, 80 USPQ2d 1572, 1583-84 (TTAB 2006) (entitlement may still be shown even where parties both advertise on the Internet).

4. *See Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095, 1096 (TTAB 1987) (ex parte type showing permitted); *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451, 1456 (TTAB 1991), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992).

1111 Effect of Abandonment of Involved Application

After the commencement of a concurrent use proceeding, if an applicant whose application is the subject of the proceeding abandons its application without the written consent of each adverse party, judgment will be entered against the concurrent use applicant, the proceeding will be dissolved and registration to applicant will be refused. *See*TBMP § 603.

Similarly, where the concurrent use proceeding involves two or more applicants, and one of the applicants files an abandonment of its application without the written consent of each party, judgment is entered against the applicant who filed the abandonment without the written consent of each party, the proceeding is dissolved as to that applicant and registration to such applicant is refused. *See*TBMP § 603. However, where the abandoning applicant reserves its rights to continue using its mark, and the abandoning applicant is also specified as an excepted user in any other application involved in the proceeding, while judgment is entered against the abandoning applicant, the applicant remains a party to the proceeding as a common law concurrent user. Every other applicant that has listed the abandoning applicant as an excepted user will retain the burden of proving its entitlement to registration in view of the acknowledged rights of the abandoning applicant. [Note 1.]

For further information regarding the effect of abandonment of an involved application in a concurrent use proceeding, *see*TBMP § 603.

NOTES:

1. *Cf. Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1453 (TTAB 1991) (although abandonment of application without written consent of every adverse party precludes common law user from claiming any right to federal registration, inasmuch as user reserved right to continue using mark, it will not be dropped as party to concurrent use proceeding), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307-08 (TTAB 1984) (applicant not entitled to concurrent use registration where user abandoned application for mark but not its right to continue using mark).

1112 Effect of Adverse Decision in Opposition or Cancellation

A party which receives an adverse decision, in an opposition, cancellation, or interference proceeding, on the issue of priority of use is not precluded thereby from seeking a concurrent use registration, unless its first use in commerce was subsequent to the earliest application filing date of any conflicting application or registration owned by another party to the opposition, cancellation, or interference proceeding, and that other party does not consent to the grant of a concurrent registration to the applicant. The concurrent use

registration must be sought by filing a new application seeking concurrent use with the prevailing party before the Board. [Note 1.] *See*TBMP § 1103.01(b).

NOTES:

1. *See* Trademark Act § 2(d), 15 U.S.C. § 1052(d); *Rosso and Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 219 USPQ 1050, 1053 (Fed. Cir. 1983) (counterclaim to cancel registration denied). *Cf. U.S. Soil, Inc. v. Colovic*, 214 USPQ 471, 472 (TTAB 1982) (opposition cannot proceed where it has been established through prior litigation that applicant has superior rights, and where opposer only alleges that it has rights in certain geographic areas); *Home Federal Savings & Loan Association v. Home Federal Savings & Loan Association of Chicago*, 205 USPQ 467, 469 (TTAB 1979) (following entry of judgment against applicant for unrestricted registration, applicant may seek registration on a concurrent use basis with all others entitled to use the same term in different geographical areas); *Cook's Pest Control, Inc. v. Sanitas Pest Control Corp.*, 197 USPQ 265, 271 n.5 (TTAB 1977); *Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831, 832 (Comm'r 1984) (a decision in the cancellation proceeding adverse to respondent would not preclude respondent from filing a new application seeking concurrent registration with petitioner).

1113 "Conversion" of Opposition or Cancellation Proceeding to Concurrent Use Proceeding

1113.01 Conversion of Opposition Proceeding

In certain situations, an opposition proceeding may be "converted" into a concurrent use proceeding. In these cases, the opposition proceeding is not actually transformed into a concurrent use proceeding. Rather, the opposition is terminated, usually by dismissal without prejudice, in favor of the concurrent use proceeding. The concurrent use proceeding, in turn, is instituted immediately. In fact, notice of the institution of the concurrent use proceeding is normally included in the order terminating the opposition proceeding. [Note 1.] When this occurs, the party that was in the position of defendant in the opposition proceeding, i.e., the applicant, becomes the party in the position of plaintiff in the concurrent use proceeding and is referred to as the applicant. The party that was in the position of plaintiff in the opposition proceeding, i.e., the opposer, becomes the party in the position of defendant in the concurrent use proceeding and is referred to as the excepted user.

An opposition may be terminated in favor of a concurrent use proceeding in the situations described below:

(1) When an opposition to a concurrent use application is filed by a party specified in the application as an exception to applicant's claim of exclusive use, the opposition may be dismissed without prejudice in favor of a concurrent use proceeding. [Note 2.] This action may be taken by the Board upon its own initiative, or upon motion.

(2) When an opposition to a concurrent use application is filed by a party that is not specified in the application as an exception to applicant's claim of exclusive use, the Board may grant a motion to dismiss the opposition without prejudice in favor of a concurrent use proceeding if opposer files an application for concurrent registration, naming applicant as an exception to its claim of exclusive use. However, the opposition will be suspended and not be dismissed, and the concurrent use proceeding will not be instituted, until opposer's concurrent use application is published in the Official Gazette for opposition, and no opposition is filed, or all oppositions filed are dismissed.

(3) When an opposition to a concurrent use application is filed by a party that is not specified in the application as an exception to applicant's claim of exclusive use, and the opposer does not file an application for concurrent registration, the Board may grant a motion to dismiss the opposition without prejudice in favor of a concurrent use proceeding if applicant amends its application to specify the opposer as an additional

exception to its claim of exclusive use. The Board may grant applicant's amendment to add opposer as an excepted user and dismiss the opposition without prejudice in a single order.

(4) When an opposition is filed against an application for an unrestricted registration, the applicant may file a motion to amend its application to one for concurrent registration, reciting opposer as an exception to applicant's claim of exclusive use, together with a motion to terminate the opposition in favor of a concurrent use proceeding. If opposer consents to the amendment, the opposition will be dismissed without prejudice, and the concurrent use proceeding will be instituted. [Note 3.] If opposer does not consent to the amendment, but applicant consents to entry of judgment against itself with respect to its right to an unrestricted registration, judgment will be entered against applicant, in the opposition, with respect to applicant's right to an unrestricted registration; the amendment will be approved; and a concurrent use proceeding involving the amended application will be instituted, all in one Board order. [Note 4.]

NOTES:

1. *Cf.* 37 C.F.R. § 2.99(c) (in effect providing, inter alia, that when a concurrent use application has been published in the Official Gazette for opposition, a concurrent use proceeding will not be instituted unless no opposition is filed, or unless all oppositions that are filed are dismissed or withdrawn).

2. *See Boi Na Braza, LLC v. Terra Sul Corp.*, 110 USPQ2d 1386, 1388 & n.8 (TTAB 2014) (noting that, had defendant not opposed plaintiff's geographically restricted application, a concurrent use proceeding would have been instituted earlier and defendant would have maintained the option to contest plaintiff's application); *Inland Oil & Transport Co. v. IOT Corp.*, 197 USPQ 562, 564 (TTAB 1977) (applicant's motion to dismiss opposition and institute concurrent use proceeding granted where party named as exception filed opposition against concurrent use application; by setting forth opposer as exception to applicant's exclusive right to use, applicant has, in effect, admitted that it is not entitled to unrestricted registration).

3. *See, e.g., Holmes Oil Co. v Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1149 n.1 (TTAB 2011) (parties stipulated to terminate opposition proceeding in favor of concurrent use proceeding and to an amendment of the application to state geographic restrictions).

4. *See Terrific Promotions Inc. v. Vanlex Inc.*, 36 USPQ2d 1349, 1350 (TTAB 1995) (opposer objected to amendment; judgment entered; concurrent use proceeding instituted); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1229 (TTAB 1993); *Faces, Inc. v. Face's, Inc.*, 222 USPQ 918, 920 (TTAB 1983) (applicant accepted judgment in opposition; concurrent use proceeding instituted).

1113.02 Conversion of Cancellation Proceeding

In appropriate situations, a cancellation proceeding may also be terminated in favor of a concurrent use proceeding, if one party has a concurrent use application reciting the adverse party in the cancellation proceeding as an exception to its claim of exclusive use; the application is published in the Official Gazette for opposition; and no opposition is filed, or all oppositions filed are dismissed or withdrawn. [Note 1.] *See* TBMP § 1112.

NOTES:

1. *Cf. Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831, 832 (Comm'r 1984) (cancellation proceeding not terminated in favor of a concurrent use proceeding, but a decision in the cancellation proceeding adverse to respondent would not preclude respondent from filing a new application seeking concurrent registration with petitioner). *See also Boi Na Braza, LLC v. Terra Sul Corp.*, 110 USPQ2d 1386, 1388 (TTAB 2014)

(after its registration was cancelled, respondent filed a new application seeking a concurrent use registration with petitioner).

1114 Alteration of Restrictions on Concurrent Registration

A concurrent registration may be issued only pursuant to the decision of the Board in a concurrent use proceeding, or on the basis of a final determination, by a court of competent jurisdiction, that more than one person is entitled to use the same or similar marks in commerce. *See* TBMP § 1102.02. A registration cannot be restricted territorially by amendment under Trademark Act § 7(e), 15 U.S.C. § 1057(e), and 37 C.F.R. § 2.173(a). [Note 1.]

A concurrent registrant that wishes to alter a concurrent use restriction to its registration may only do so, if at all, through an appropriate decision in a new concurrent use proceeding before the Board, or by order of a court of competent jurisdiction. A Trademark Act § 7(e) amendment cannot be used to alter a concurrent use restriction. [Note 2.]

However, removal of such a restriction by amendment under Trademark Act § 7(e) may be permitted where an entity that was the only exception to registrant's right to exclusive use of its registered mark assigns its rights in its mark to registrant, so that all rights in the mark are merged in registrant. [Note 3.] Requests to record changes to a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) registration must be filed with the International Bureau. The amendment is not made under Trademark Act § 7. [Note 4.] *See*TBMP § 514.01, for further information regarding amendments to Trademark Act § 66(a) registrations.

In addition, if every concurrent user specified in a concurrent registration abandons its use of its involved mark, and owns no subsisting registration thereof, the owner of the remaining concurrent registration may file a new application for an unrestricted registration of the mark. [Note 5.] *See*TBMP § 1104.

NOTES:

1. *See Morgan Services Inc. v. Morgan Linen Services Inc.*, 12 USPQ2d 1841, 1843 (TTAB 1989); *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383, 1384 (Comm'r 1987); *In re Forbo*, 4 USPQ2d 1415, 1415 (Comm'r 1984).

2. *See Morgan Services Inc. v. Morgan Linen Services Inc.*, 12 USPQ2d 1841, 1843 (TTAB 1989) (amendments to registrations cannot be made under 37 C.F.R. § 2.173); *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383, 1384 (Comm'r 1987) (so-called assignment of concurrent rights does not provide basis for deleting restriction listed in concurrent users' registration); *In re Forbo*, 4 USPQ2d 1415, 1416 (Comm'r 1984) (registrant may not request territorial restriction by way of petition to Commissioner).

3. *See In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383, 1384 (Comm'r 1987) (assignment of rights resulted in removal of limitation on concurrent user's exclusive right to use).

4. *See* 37 C.F.R. § 7.22.

5. *Cf. Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1453 (TTAB 1991) (although abandonment of application without written consent of every adverse party precludes common law user from claiming any right to federal registration, inasmuch as user reserved right to continue using mark, it will not be dropped as party to concurrent use proceeding), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307-08 (TTAB 1984) (applicant

not entitled to concurrent use registration where user abandoned application for mark but not its right to continue using mark).

Chapter 1200 EX PARTE APPEALS

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1201 Propriety of Appeal

1201.01 Readiness of Case for Appeal

Trademark Act § 20, 15 U.S.C. § 1070 ***Appeal from examiner to Trademark Trial and Appeal Board.*** *An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon the payment of the prescribed fee.*

37 C.F.R. § 2.63(b) ***Final refusal or requirement.*** *Upon review of a response, the examining attorney may state that the refusal(s) to register, or the requirement(s), is final.*

(1) *If the examining attorney issues a final action that maintains any substantive refusal(s) to register, the applicant may respond by timely filing:*

(i) *A request for reconsideration under paragraph (b)(3) of this section that seeks to overcome any substantive refusal(s) to register, and comply with any outstanding requirement(s), maintained in the final action; or*

(ii) *An appeal to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142.*

(2) *If the examining attorney issues a final action that contains no substantive refusals to register, but maintains any requirement(s), the applicant may respond by timely filing:*

(i) *A request for reconsideration under paragraph (b)(3) of this section that seeks to comply with any outstanding requirement(s) maintained in the final action;*

(ii) *An appeal of the requirement(s) to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142;* or

(iii) *A petition to the Director under § 2.146 to review the requirement(s), if the subject matter of the requirement(s) is procedural, and therefore appropriate for petition.*

(3) *Prior to the expiration of the time for filing an appeal or a petition, the applicant may file a request for reconsideration of the final action that seeks to overcome any substantive refusal(s) and/or comply with any outstanding requirement(s). Filing a request for reconsideration does not stay or extend the time for filing an appeal or petition. The Office will enter amendments accompanying requests for reconsideration after final action if the amendments comply with the rules of practice in trademark cases and the Act.*

37 C.F.R. § 2.141 ***Ex parte appeals from action of trademark examining attorney.***

(a) *An applicant may, upon final refusal by the trademark examining attorney, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken, within six months of the date of issuance of the final action. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.*

37 C.F.R. § 2.146 ***Petitions to the Director.***

(b) *Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Director.*

On the first or any subsequent reexamination or reconsideration of an application for registration of a trademark, the examining attorney may state that the refusal of the registration or the insistence upon a requirement is final. [Note 1.] When the examining attorney states that the action is final, the applicant's response is limited to an appeal to the Board, or to compliance with any requirement, or to a petition to the Director if a petition is permitted by 37 C.F.R. § 2.63(b). [Note 2.] An applicant may, pursuant to 37 C.F.R. § 2.63(b), file a request for reconsideration, but the submission of such a request does not automatically extend the applicant's time for filing a notice of appeal. Thus, if an applicant submits a request for reconsideration within the six-month time period from the issue date of the final action, but does not file a notice of appeal within that time period, and if the request for reconsideration fails to persuade the examining attorney, and if the examining attorney does not issue a new final refusal, the application will be deemed abandoned. [Note 3.]

An applicant may consider a second refusal on the same ground(s), or a repeated requirement, as final for purposes of appeal. [Note 4.] All grounds and/or requirements must be repeated in order for the second refusal to be considered as final. [Note 5.]

Thus, an application is ripe for appeal when the examining attorney issues a final action, and an appeal may also be taken from a second refusal on the same ground(s) or from a repeated requirement. [Note 6.] However, an Office action that repeats one or more grounds for refusal or requirements but also raises a new ground or requirement may not be considered as final for purposes of appeal. *See*TBMP § 1201.02.

NOTES:

1. *See* Trademark Act § 12(b), 15 U.S.C. § 1062(b); 37 C.F.R. § 2.63(b); TMEP § 714 and TMEP § 714.03.

2. *See* 37 C.F.R. § 2.63(b); TMEP § 715.01. *See also* Trademark Act § 20, 15 U.S.C. § 1070, and TMEP § 1501 and TMEP § 1702.

3. *In re GTE Education Services*, 34 USPQ2d 1478, 1480 (Comm'r 1994).

4. *See In re Roberts* , 87 USPQ2d 1474, 1478 (TTAB 2008); *In re MediaShare Corp.* , 43 USPQ2d 1304, 1305 n.2 (TTAB 1997); *In re Hechinger Investment Co. of Delaware Inc.* , 24 USPQ2d 1053, 1054 n.2 (TTAB 1991); *In re Citibank, N.A.* , 225 USPQ 612, 613 (TTAB 1985). *See also* 37 C.F.R. § 2.141; TMEP § 1501.

5. *In re Page*, 51 USPQ2d 1660, 1662 n.2 (TTAB 1999).

6. *See In re National Association of Veterinary Technicians of America, Inc.* , 2019 USPQ2d 269108, at *2, n.11 (TTAB 2019) (advisory statements made by the examining attorney are not refusals subject to appeal); *In re Peace Love World Live, LLC* , 127 USPQ2d 1400, 1401 (TTAB 2018) (second rationale raised only in an advisory manner during prosecution and raised again by the examining attorney's brief not considered because it was unclear that applicant had "a full opportunity to address the alternative rationale … prior to appeal."); *In re Harley* , 119 USPQ2d 1755, 1757 (TTAB 2016) (advisory statement made by examining attorney is not a refusal to register and not subject to appeal); *In re Roberts* , 87 USPQ2d 1474, 1478 (TTAB 2008); *In re Hechinger Investment Co. of Delaware Inc.* , 24 USPQ2d 1053, 1054 n.2 (TTAB 1991); *In re Citibank, N.A.* , 225 USPQ 612, 613 (TTAB 1985). *See also* Trademark Act § 20, 15 U.S.C. § 1070; 37 C.F.R. § 2.63(b); 37 C.F.R. § 2.141; TMEP § 1501.

1201.02 Premature Final

Trademark Act § 12(b), 15 U.S.C. § 1062(b) *If the application is found not entitled to registration, the examiner shall advise the applicant thereof and of the reason therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, whereupon such time may be extended.*

A refusal of registration or an insistence upon a requirement may be made final by the examining attorney only on the first or any subsequent reexamination or reconsideration of an application; a refusal or requirement may not be made final in a first action. [Note 1.]

An action should not be stated to be final until the applicant has had at least one opportunity to reply to each ground of refusal, and each requirement, asserted by the examining attorney. [Note 2.] Moreover, a final action should not be issued until all matters but for those that are to be the subject of the final action have been resolved, and a clear issue has been developed between the examining attorney and the applicant with respect to each remaining ground of refusal or requirement. [Note 3.] As stated in TMEP § 714.03:

No refusal or requirement may be made final, even if it is a repeated refusal or requirement, unless the entire action is made final. Thus, if the examining attorney makes a new refusal or repeated requirement in a second or subsequent action, any previously issued refusals or requirements may not be made final, but instead should be maintained.

However, it is not considered a new refusal if the examining attorney has a different rationale for a previously made refusal or requirement. [Note 4.]

Examples of new issues that would preclude the issuance of a final action until the applicant has had an opportunity to respond are amendments to the drawing, [Note 5.] and amendments to the Supplemental Register or to assert acquired distinctiveness. [Note 6.] However, if the amendment is irrelevant to an outstanding refusal or is merely cumulative, it is not deemed to raise a new issue. [Note 7.]

If an applicant believes that a refusal to register, or the insistence upon a requirement, has been made final prematurely, the applicant may raise the matter by request to the examining attorney for reconsideration or by contacting the managing attorney or senior attorney in the examining attorney's law office. If the examining attorney does not withdraw the finality, the applicant may file a petition under 37 C.F.R. § 2.146. [Note 8.] If, prior to hearing from the examining attorney, managing attorney or senior attorney, or prior to a decision

on a petition, an applicant chooses to file a notice of appeal in order to preserve its rights to an appeal, the applicant should advise the Board that it believes that the final action is premature or that there is a pending petition on this issue. If the notice of appeal is filed electronically through ESTTA, the applicant should also file through ESTTA, using the "File Documents in a Board Proceeding" menu, and checking the box for "Other motion/submission," an additional paper advising the Board that the final action is premature or that there is a pending petition on this issue. In the rare circumstance that the notice of appeal is submitted as a paper filing, the applicant should so advise the Board in the notice of appeal. See TBMP § 1202.03 regarding the filing of a notice of appeal.

That a final action is premature is not a ground for appeal to the Board. [Note 9.] However, if it comes to the attention of the Board, when an appeal has been filed, that the final action was issued prematurely, the Board will issue an order that vacates the institution order for the appeal, refunds the fee, and remands the application to the examining attorney for appropriate action. That action is generally that the finality of the examining attorney's action is withdrawn and a new nonfinal action may be issued. The Board order will generally indicate that if the examining attorney finds, upon consideration of the applicant's response to the new nonfinal action, that the application is in condition for publication (or for registration, if the application seeks registration on the Supplemental Register), the examining attorney may simply approve the application for publication (or registration on the Supplemental Register); and that if the examining attorney ultimately issues a new final action, and the applicant wishes to appeal, a new notice of appeal should be filed along with the requisite appeal fee.

NOTES:

1. *See* Trademark Act § 12(b), 15 U.S.C. § 1062(b); 37 C.F.R. § 2.63(b); TMEP § 714.01 and TMEP § 1501.

2. TMEP § 714.01. *See also In re Abolio y Rubio S.A.C.I. y G.*, 24 USPQ2d 1152, 1154 (TTAB 1992); *In re Pierce Foods Corp.*, 230 USPQ 307, 308 n.1 (TTAB 1986). *See also In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1769 (TTAB 2016) (examining attorney "instead of just denying the request for reconsideration" should have "issued a new final Office action") (quoting *Petition Decision* (Comm'r June 22, 2015)).

3. TMEP § 714.03. *See also In re Dietrich*, 91 USPQ2d 1622, 1624 (TTAB 2009) (to the extent examining attorney attempted to reject Trademark Act § 2(f) claim for the first time in appeal brief, rejection untimely and not considered); *In re Moore Business Forms Inc.*, 24 USPQ2d 1638, 1638 n.2 (TTAB 1992) (ground for refusal first raised in examining attorney's appeal brief given no consideration).

4. *See In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Paper Doll Promotions Inc.*, 84 USPQ2d 1660, 1665 (TTAB 2007). *See also In re Fantasia Distribution, Inc.*, 120 USPQ2d 1137, 1144 n.21 (TTAB 2016) (examining attorney's argument about evidence of copying not waived because, while not specifically addressed in Office action, examining attorney nonetheless wrote that "the evidence and arguments provided are not sufficient to support the claim" of acquired distinctiveness).

5. *See In re Abolio y Rubio S.A.C.I. y G.*, 24 USPQ2d 1152, 1154 (TTAB 1992).

6. *See In re Audio Book Club Inc.*, 52 USPQ2d 1042, 1043 n.2 (TTAB 1999). *See also*TMEP § 714.05 *et seq. But see In re Heatcon, Inc.*, 116 USPQ2d 1366, 1370 (TTAB 2015) (new nonfinal action not necessary when application was refused on Principal Register as functional and application amended to Supplemental Register).

7. *See In re Heatcon, Inc.*, 116 USPQ2d 1366, 1370 (TTAB 2015) (amendment to Supplemental Register in response to a refusal of registration on ground of functionality does not raise a new issue); *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 (TTAB 1992) (amendment to the Supplemental Register in response to a refusal of registration under Trademark Act § 2(a) does not raise a new issue); *In re GTE Education Services*, 34 USPQ2d 1478, 1480 (Comm'r 1994) (examining attorney properly determined that no new issue had been raised in request for reconsideration of final refusal based on inadequate specimens, where the substitute specimens submitted with the request were deficient for same reason as the original specimens). *See also*TMEP § 714.05, TMEP § 714.05(a), TMEP § 714.05(a)(i) and TMEP § 714.05(a)(ii).

8. *See*TMEP § 714.06.

9. *See*TMEP § 714.06.

1201.03 Premature Appeal

An application is ripe for appeal when the examining attorney issues a final action, and an appeal may also be taken from a second refusal on the same ground(s) or a repeated requirement; an appeal from a first refusal or requirement is premature. *See*TBMP § 1201.01. All grounds and/or requirements must be repeated in order for the second refusal to be considered as final. [Note 1.] If, in response to a final Office action, the applicant files a request for reconsideration that raises a new issue, and does not timely file a notice of appeal, the applicant may not then file an appeal until a final Office action issues with respect to the new issue. [Note 2.]

The Board has no jurisdiction to entertain a premature appeal. Thus, if an appeal is filed prematurely, the Board, in a written order, will notify the applicant that the appeal was filed prematurely, refund the fee and forward the application to the examining attorney for further appropriate action. The examining attorney will normally treat the premature notice of appeal as an incomplete response under 37 C.F.R. § 2.65(a) and allow the applicant time to submit a complete response. If the applicant has also filed a request for reconsideration or an appeal brief, the request for reconsideration or brief may be treated as a response. [Note 3.] In the event that the examining attorney ultimately issues a final action, or a second refusal on the same ground(s) or a repeated requirement, and the applicant wishes to appeal, the applicant should file a new notice of appeal and a new appeal fee.

NOTES:

1. *In re Page*, 51 USPQ2d 1660, 1662 n.2 (TTAB 1999).

2. *In re Virshup*, 42 USPQ2d 1403, 1404 (TTAB 1997) (after final refusal on Principal Register, applicant amended to Supplemental Register; applicant's appeal of initial refusal on Supplemental Register held premature).

3. *In re Virshup*, 42 USPQ2d 1403, 1404 (TTAB 1997).

1201.04 Compliance With Requirements Not Subject of Appeal

37 C.F.R. § 2.142(c) *All requirements made by the examining attorney and not the subject of appeal shall be complied with prior to the filing of an appeal, and the statement of issues in the brief should note such compliance.*

All requirements that have been made by the examining attorney, but which are not to be the subject of appeal, should be complied with prior to the filing of an appeal. If an applicant that files an appeal to the Board fails to comply with such a requirement, the refusal to register may be affirmed by the Board for failure to comply with that requirement, regardless of the disposition made by the Board of the issue or issues that are the subject of appeal. [Note 1.]

NOTES:

1. *See* 37 C.F.R. § 2.142(c); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is amending § 2.142(c) to add that the statement of issues in a brief should note that the applicant has complied with all requirements made by the examining attorney and not the subject of appeal."). *See In re Brack*, 114 USPQ2d 1338, 1343 (TTAB 2015) (refusal affirmed on requirement to submit signed and verified application, propriety of refusal under Section 2(d) not reached); *In re Babies Beat Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990); *In re Cord Crafts Inc.*, 11 USPQ2d 1157, 1157 n.2 (TTAB 1989); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985); *In re Big Daddy's Lounges, Inc.*, 200 USPQ 371, 373 (TTAB 1978). *Cf. In re Walker-Home Petroleum, Inc.*, 229 USPQ 773, 774 (TTAB 1985), and *In re Citibank, N.A.*, 225 USPQ 612, 613 (TTAB 1985).

1201.05 Appeal versus Petition

37 C.F.R. § 2.63(b) ***Final refusal or requirement.*** *Upon review of a response, the examining attorney may state that the refusal(s) to register, or the requirement(s), is final.*

(1) *If the examining attorney issues a final action that maintains any substantive refusal(s) to register, the applicant may respond by timely filing:*

(i) *A request for reconsideration under paragraph (b)(3) of this section that seeks to overcome any substantive refusal(s) to register, and comply with any outstanding requirement(s),maintained in the final action; or*

(ii) *An appeal to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142.*

(2) *If the examining attorney issues a final action that contains no substantive refusals to register, but maintains any requirement(s), the applicant may respond by timely filing:*

(i) *A request for reconsideration under paragraph (b)(3) of this section that seeks to comply with any outstanding requirement(s) maintained in the final action;*

(ii) *An appeal of the requirement(s) to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142; or*

(iii) *A petition to the Director under § 2.146 to review the requirement(s), if the subject matter of the requirement(s) is procedural, and therefore appropriate for petition.*

(3) *Prior to the expiration of the time for filing an appeal or a petition, the applicant may file a request for reconsideration of the final action that seeks to overcome any substantive refusal(s) and/or comply with any outstanding requirement(s). Filing a request for reconsideration does not stay or extend the time for filing an appeal or petition. The Office will enter amendments accompanying requests for reconsideration after final action if the amendments comply with the rules of practice in trademark cases and the Act.*

(4) *Filing a request for reconsideration that does not result in the withdrawal of all refusals and requirements, without the filing of a timely appeal or petition, will result in abandonment of the application for incomplete response, pursuant to § 2.65(a).*

(c) *If a petition to the Director under § 2.146 is denied, the applicant will have six months from the date of issuance of the Office action that repeated the requirement(s), or made it final, or thirty days from*

the date of the decision on the petition, whichever date is later, to comply with the requirement(s). A requirement that is the subject of a petition decided by the Director subsequently may not be the subject of an appeal to the Trademark Trial and Appeal Board.

37 C.F.R. § 2.146 ***Petition to the Director.***

(a) *Petition may be taken to the Director in a trademark case:*

(1) *From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by § 2.63(a) and (b);*

(2) *In any case for which the Act of 1946, Title 35 of the United States Code, or parts 2, 3, 6, and 7 of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Director;*

(3) *To invoke the supervisory authority of the Director in appropriate circumstances;*

(4) *In any case not specifically defined and provided for by parts 2, 3, 6, and 7 of Title 37 of the Code of Federal Regulations; or*

(5) *In an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.*

(b) *Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Director.*

An action taken on a matter arising during the ex parte prosecution of an application for registration may, depending on the nature of the matter and the posture of the case, be reviewable only by appeal to the Board, or only by petition to the Director or by either appeal or petition. The following discussion contains general guidelines for determining whether a matter is appealable or petitionable.

An appeal to the Board may be taken from any final action, second refusal to register on the same ground(s), or repeated requirement issued by the examining attorney during the ex parte prosecution of an application for registration, whether the matter involved in the examining attorney's action is substantive or procedural in nature, except that a formal requirement which was the subject of a petition decided by the Director may not thereafter be the subject of an appeal to the Board. [Note 1.] TBMP § 1201.01.

Substantive questions arising during the ex parte prosecution of an application, including, but not limited to, issues arising under Trademark Act § 2, Trademark Act § 3, Trademark Act § 4, Trademark Act § 5, Trademark Act § 6, and Trademark Act § 23, 15 U.S.C. § 1052, 15 U.S.C. § 1053, 15 U.S.C. § 1054, 15 U.S.C. § 1055, 15 U.S.C. § 1056, and 15 U.S.C. § 1091, are considered to be appropriate subject matter for appeal to the Board (after issuance of a final action, or a second refusal on the same ground(s)), *see*TBMP § 1201.01, but not for petition to the Director. [Note 2.]

A wide variety of matters are petitionable. Petition may be taken to the Director in the following situations:

(1) From any repeated or final formal requirement made by the examining attorney, during the ex parte prosecution of an application, if (i) the requirement is repeated, but the examining attorney's action is not made final and the subject matter of the requirement is appropriate for petition to the Director; [Note 3.] or (ii) the examining attorney's action is made final and is limited to subject matter appropriate for petition to the Director. [Note 4.] If the petition is denied, the applicant will have six months from the date of the Office action which repeated the requirement or made it final, or 30 days from the date of the Director's decision on the petition, whichever is later, to comply with the requirement. A formal requirement that was the subject of a petition to the Director may not thereafter be the subject of an appeal to the Board. [Note 5.]

(2) In any case for which the Act of 1946, or Title 35 of the United States Code, or Part 2 of 37 C.F.R. (i.e., the rules of practice in trademark cases) specifies that the matter is to be determined directly or reviewed by the Director. [Note 6.] Insofar as applications for registration are concerned, this includes petitions to review the denial of requests for extensions of time to file statements of use under 37 C.F.R. § 2.89(g), petitions to review the actions of Post Registration examiners under Trademark Act § 7, Trademark Act § 8, and Trademark Act § 9, 15 U.S.C. § 1057, 15 U.S.C. § 1058, and 15 U.S.C. § 1059, and petitions to record a document in the Trademark Assignment Recordation Branch. [Note 7.]

(3) To invoke the supervisory authority of the Director in appropriate circumstances. [Note 8.] Under this provision, an applicant generally may petition to the Director for relief from, inter alia, a nonfinal refusal to register based on a procedural matter, i.e., an alleged failure of the applicant to comply with a technical requirement of the rules of practice governing trademark cases; or an alleged failure of the examining attorney to act in accordance with those rules and/or proper practice thereunder. [Note 9.]

(4) In any case not specifically defined and provided for by Part 2 of 37 C.F.R. (i.e., the rules of practice in trademark cases). [Note 10.] Under this provision, an applicant may petition the Director with respect to any situation, not covered by the rules, from which the applicant seeks relief.

(5) In an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules which is not also a requirement of the Act of 1946. [Note 11.]

However, petition may not be taken to the Director on a question of substance arising during the ex parte prosecution of an application; nor may petition be taken from a final action of the examining attorney, except that an applicant may petition for relief from an action making a formal requirement final if the action is limited to subject matter appropriate for petition to the Director (i.e., involves questions such as the applicant's alleged failure to comply with one or more of the technical requirements of the rules of practice in trademark cases, rather than a question of substance). [Note 12.]

On appeal, the Board will review only the correctness of a substantive refusal to register, and will not consider the procedural issue of whether the issuance of or failure to issue a substantive refusal was a "clear error." *See*TMEP § 706.01 regarding "clear error." Moreover, an applicant may not challenge by petition the Office's determination of clear error regarding questions of substance, which would include questions arising under Trademark Act §§ 2, 3, 4, 5, 6 and 23. *See* TMEP § 706.01. [Note 13.]

The Board will not consider a matter that is appropriate only for petition. For example, the Board will not review requirements for an amendment to the classification of goods or services; the issue of proper classification is procedural, not substantive, in nature and may only be reviewed upon petition. [Note 14.] Although the issue of an acceptable identification of goods or services may be decided by the Board on appeal, or by petition, a petition may provide an applicant with more flexibility. [Note 15.] For further examples of matters that are appealable and those that are petitionable, see TMEP § 1704.

NOTES:

1. *See* Trademark Act § 20, 15 U.S.C. § 1070; 37 C.F.R. § 2.63(b), 37 C.F.R. § 2.63(c), and 37 C.F.R. § 2.141. *See also* *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1770 (TTAB 2016) (Board will not revisit issue that was the subject of petition decided by the Director); *In re Pony International Inc.*, 1 USPQ2d 1076, 1079 (Comm'r 1986).

2. *See* 37 C.F.R. § 2.146(b); TMEP § 1704; *In re The Du Pont Merck Pharmaceutical Co.*, 34 USPQ2d 1778, 1781 (Comm'r 1995); *In re Mission Pharmacal Co.*, 33 USPQ2d 1060, 1061 (Comm'r 1993); *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393, 1393 (Comm'r 1993); *In re Tetrafluor*

Inc., 17 USPQ2d 1160, 1161 (Comm'r 1990); *In re Hart*, 199 USPQ 585, 586-87 (Comm'r 1978); *In re Stenographic Machines, Inc.*, 199 USPQ 313, 315 (Comm'r 1978).

3. See, in this regard, 37 C.F.R. § 2.146(b), and the preceding paragraph.

4. *See* 37 C.F.R. § 2.63(b) and 37 C.F.R. § 2.146(a)(1); *In re The Du Pont Merck Pharmaceutical Co.*, 34 USPQ2d 1778, 1781 (Comm'r 1995) (proper signatory for an application and statement of use filed by a partnership); *In re Stenographic Machines, Inc.*, 199 USPQ 313, 315 (Comm'r 1978) (requirement for a more particular identification of goods).

5. *See* 37 C.F.R. § 2.63(c). *See also In re Pony International Inc.*, 1 USPQ2d 1076, 1079 (Comm'r 1986).

6. 37 C.F.R. § 2.146(a)(2).

7. *See*TMEP § 1702, TMEP § 1703 and TMEP § 1704.

8. *See* 35 U.S.C. § 2 and 37 C.F.R. § 2.146(a)(3).

9. *See, e.g., In re Mission Pharmacal Co.*, 33 USPQ2d 1060, 1061 (Comm'r 1993) (whether examining attorney acted properly in issuing final Office action); *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393, 1393 (Comm'r 1993) (whether examining attorney properly suspended application); *In re Tetrafluor Inc.*, 17 USPQ2d 1160, 1161 (Comm'r 1990) (whether examining attorney properly refused to allow amendment of drawing to correct an allegedly obvious typographical error); TMEP § 1702 and TMEP § 1703. For further information concerning the matters that are petitionable under this provision, see TMEP § 1707.

10. *See* 37 C.F.R. § 2.146(a)(4).

11. 37 C.F.R. § 2.146(a)(5). For information concerning the meaning of the words "extraordinary situation" *see*TMEP § 1708.

12. *See* 37 C.F.R. § 2.63(b), 37 C.F.R. § 2.146(a), and 37 C.F.R. § 2.146(b); *In re Dermahose Inc.*, 82 USPQ2d 1793, 1796 n.5 (TTAB 2007) (examining attorney's refusal to accept Statement of Use because the signer of the declaration was not the person making the statements in the declaration reviewable by appeal or petition); *In re Tetrafluor Inc.*, 17 USPQ2d 1160, 1161 (Comm'r 1990); *In re Hart*, 199 USPQ 585, 586-87 (Comm'r 1978); *In re Stenographic Machines, Inc.*, 199 USPQ 313, 315 (Comm'r 1978); TMEP § 1702 and TMEP § 1704.

13. *See In re Driven Innovations, Inc.*, 115 USPQ2d 1261, 1264 (TTAB 2015) (applicant's sole recourse to challenge a refusal that was issued during examination of a statement of use under the clear error standard is by appealing the merits of the final refusal to the Board), *reversed and remanded on other grounds*, slip op. No. 16-1094 (Fed. Cir. January 4, 2017). This case expressly overruled those portions of *In re Jump Designs LLC*, 80 USPQ2d 1370, 1373-74 (TTAB 2006) and *In re Sambado & Son Inc.*, 45 USPQ2d 1312, 1314 (TTAB 1997) to the extent that they suggest the applicant could petition the Director for a review of a clear error determination.

14. *In re Faucher Industries Inc.*, 107 USPQ2d 1355, 1357 (TTAB 2013).

15. *In re Faucher Industries Inc.*, 107 USPQ2d 1355, 1357-58 (TTAB 2013) (petition may afford broader scope of possible relief because Director has more flexibility in this area).

1202 Filing an Appeal

1202.01 In General

Trademark Act § 20, 15 U.S.C. § 1070 ***Appeal from examiner to Trademark Trial and Appeal Board.*** *An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon the payment of the prescribed fee.*

37 C.F.R. § 2.141 ***Ex parte appeals from action of trademark examining attorney.***

(a) *An applicant may, upon final refusal by the trademark examining attorney, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken, within six months of the date of issuance of the final action. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.*

(b) *The applicant must pay an appeal fee for each class from which the appeal is taken. If the applicant does not pay an appeal fee for at least one class of goods or services before expiration of the six-month statutory filing period, the application will be abandoned. In a multiple-class application, if an appeal fee is submitted for fewer than all classes, the applicant must specify the class(es) in which the appeal is taken. If the applicant timely submits a fee sufficient to pay for an appeal in at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Board will issue a written notice setting a time limit in which the applicant may either pay the additional fees or specify the class(es) being appealed. If the applicant does not submit the required fee or specify the class(es) being appealed within the set time period, the Board will apply the fee(s) to the class(es) in ascending order, beginning with the lowest numbered class.*

37 C.F.R. § 2.142(a) *Any appeal filed under the provisions of § 2.141 must be filed within six months from the date of the final refusal or the date of the action from which the appeal is taken. An appeal is taken by filing a notice of appeal in written form, as prescribed in § 2.126, and paying the appeal fee.*

An appeal to the Board from an examining attorney's final action, second refusal on the same ground(s), or repeated requirement, is taken by timely filing, *see* TBMP § 1202.02, in the Office both a notice of appeal and the prescribed appeal fee. [Note 1.] *See* TBMP § 1202.04. If the notice of appeal and fee are not timely filed, the application will be deemed to have been abandoned, and the Board cannot entertain the appeal unless the applicant successfully petitions the Director to revive the application. [Note 2.]

All requirements that have been made by the examining attorney, but which are not to be the subject of appeal, should be complied with prior to the filing of an appeal, and the statement of issues in the brief should note such compliance. [Note 3.] If an applicant that files an appeal to the Board fails to comply with such a requirement, the refusal to register may be affirmed by the Board for failure to comply with that requirement, regardless of the disposition made by the Board of the issue or issues that are the subject of appeal. *See* TBMP § 1201.04.

If an application contains multiple classes, and a final refusal or requirement pertains to some, but not all, of the classes in the application, the applicant has the option of (i) filing an appeal for the application as a whole (paying the appeal fee only for the classes for which it wishes to appeal), or (ii) filing a request to divide the application to sever those classes for which there has been no final requirement or refusal and filing an appeal only for the class(es) to which the final refusal or requirement pertains. In the former case,

the application will not be published for opposition (or a registration will not issue in the case of an application on the Supplemental Register) for those classes for which no refusal or requirement was made final until after the appeal is decided. Similarly, if a final refusal or requirement pertains to some but not all of the goods or services in a single class, the applicant has the option of filing a request to divide the application to sever those goods or services from that class. [Note 4.] If no request to divide the application is filed, the application may not proceed to publication (or, in the case of an application on the Supplemental Register, to registration) for those goods or services for which no refusal or requirement has been made, until after the appeal is decided. If a request to divide the application is filed, *see*TBMP § 1205.02, the classes, or the goods or services within a class, for which there is no final requirement or refusal which have been divided out of the application will proceed to publication or registration, as appropriate, and an appeal will be instituted for the remaining classes for which an appeal has been filed. If goods or services have been divided out of a single class, an appeal will be instituted for the application with the remaining goods or services in that class. *See*TBMP § 1202.05.

If an application contains multiple classes and the applicant wishes to appeal a final refusal or requirement in some but not all of the classes, the applicant should indicate in the notice of appeal the classes in which the refusal or requirement is being appealed. Any remaining classes for which there is a final refusal or requirement that is not the subject of the appeal will be deemed abandoned. [Note 5.] However, if the applicant has also filed a request for reconsideration for those classes, after instituting the appeal with respect to the classes which are the subject of the appeal, the Board will suspend proceedings and remand the application to the examining attorney to consider the request for reconsideration. If the examining attorney is not persuaded by the request for reconsideration, the classes for which no appeal has been filed will be deemed abandoned unless the examining attorney issues a nonfinal Office action or a new final refusal (thereby giving the applicant additional time to file a notice of appeal with respect to these classes).

Applicant must notify the Board at the time of filing its notice of appeal whether any other applications are pending with the same or similar marks regardless of whether or not those are on appeal.

NOTES:

1. *See* 37 C.F.R. § 2.6(a)(18). *See also* Trademark Act § 20, 15 U.S.C. § 1070; 37 C.F.R. § 2.141 and 37 C.F.R. § 2.142(a); TMEP § 1501.

2. *See* Trademark Act § 12(b), 15 U.S.C. § 1062; 37 C.F.R. § 2.65(a); 37 C.F.R. § 2.66. *See also*TMEP § 718.02, TMEP § 1501.04, TMEP § 1714, and TMEP § 1714.01(a).

3. 37 C.F.R. § 2.142(c).

4. *Cf. In re UST Global (Singapore) Pte. Ltd.*, 2020 USPQ2d 10435, at *9 & n.29 (TTAB 2020) (affirming disclaimer requirement for entire class even though term found merely descriptive of only a portion of the identified services and applicant had agreed to disclaim the term for that portion, Board notes that similarly situated applicants could instead divide its application and separately appeal the disclaimer requirement for other goods or services within a single class).

5. *See In re MGA Entertainment Inc.*, 84 USPQ2d 1743, 1745 n.1 (TTAB 2007) (applicant did not appeal requirement to delete Class 28 goods, and Board treated Class 28 goods as deleted from application).

1202.02 Time for Appeal

An appeal to the Board may be taken from any final action, second refusal on the same ground(s), or repeated requirement issued by the examining attorney during the ex parte prosecution of an application for registration, except that a formal requirement which was the subject of a petition decided by the Director may not thereafter be the subject of an appeal to the Board. [Note 1.] *See*TBMP § 1201.01 and TBMP § 1201.05.

An appeal to the Board must be filed within six months from the date of the action from which the appeal is taken. [Note 2.] If a notice of appeal is timely filed, but the appeal fee is not, the appeal will be untimely, and the application will be deemed to have been abandoned. *See*TBMP § 1202.01.

A notice of appeal to the Board must be filed through ESTTA in the manner prescribed in 37 C.F.R. § 2.126(a). For more information regarding filing via ESTTA, see TBMP § 110. However, if ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form and must include a written explanation of such technical problems or extraordinary circumstances. [Note 3.] Examining attorney submissions need not be filed through ESTTA because they are filed through USPTO internal electronic systems. [Note 4.] *See* TBMP § 106.03, TBMP § 107, TBMP § 110, and TBMP § 1202.03. In the rare circumstances paper filing is necessary, the certificate of mailing procedure described in 37 C.F.R. § 2.197, and the "Priority Mail Express®" procedure described in 37 C.F.R. § 2.198, are available for the filing of an appeal to the Board. [Note 5.] TBMP § 111.01 and TBMP § 111.02.

During the period between issuance of a final action and expiration of the time for filing an appeal therefrom, an applicant may file a request for reconsideration, with or without an amendment and/or new evidence. [Note 6.] TBMP § 1204. However, the filing of a request for reconsideration will not serve to stay the time for filing an appeal (or for petitioning the Director, if appropriate). [Note 7.] TBMP § 1201.05. If, upon the examining attorney's consideration of the request, all refusals and requirements are not withdrawn, and no appeal or other proper response to the final refusal has been filed during the six months following issuance of the final action, the application will be abandoned. [Note 8.] Thus, if an applicant that has filed a request for reconsideration of a final action wishes to preserve its right to appeal in the event that the request is unsuccessful, the applicant must file an appeal prior to the expiration of the six-month period following issuance of the final action.

If an appeal is late-filed, but the applicant timely filed some other response to the appealed action, such as an amendment or request for reconsideration, the Board will issue a written action informing the applicant of the lateness of its appeal; stating that the late appeal cannot be entertained by the Board; and forwarding the application to the examining attorney for appropriate action with respect to the document that was timely filed. An applicant may petition the Director to revive an application for failure to file a timely appeal, as an appeal is considered a response to an Office action. [Note 9.] However, the unintentional delay standard of 37 C.F.R. § 2.66(a) (revival of abandoned applications) does not apply to applications that were abandoned due to an incomplete response after a final Office action. A request for reconsideration that is not accompanied by a notice of appeal is considered an incomplete response. Therefore, if an applicant files a request for reconsideration but fails to timely file a notice of appeal, and the examining attorney denies the request for reconsideration, it is the Director's practice to deny a petition to revive in such circumstances. [Note 10.]

Ordinarily, if an applicant files a petition to revive for the purpose of filing an appeal, the notice of appeal must be filed through ESTTA, and the petition to revive should be filed through TEAS with a statement that a notice of appeal is being filed with the Board.

NOTES:

1. *See*TMEP § 1501.

2. *See* Trademark Act § 12(b), 15 U.S.C. § 1062; 37 C.F.R. § 2.142(a).

3. *See* 37 C.F.R. § 2.126(b). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69966 (Oct. 7, 2016) ("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.").

4. *See* 37 C.F.R. § 2.142(b)(2). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is amending § 2.142(b)(2) to exempt examining attorney submissions from the ESTTA requirement because they are filed through the Office's internal electronic systems.").

5. *See* 37 C.F.R. § 2.197; 37 C.F.R. § 2.198. Many documents that are filed in connection with the prosecution of an application, including the application itself and an amendment to allege use, may not be filed using the "Priority Mail Express" procedure. *See*TMEP § 305.03. However, the "Priority Mail Express®" procedure is available for filing a notice of appeal.

6. *See* 37 C.F.R. § 2.63(b). *See also*TMEP § 715.02 and TMEP § 715.03.

7. *See* 37 C.F.R. § 2.63(b); TMEP § 715.03 and TMEP § 715.03(c).

8. *See* 37 C.F.R. § 2.63(b) and 37 C.F.R. § 2.142(a). *See also*TMEP § 715.03(a).

9. *See* 37 C.F.R. § 2.66(a) and TMEP § 1714 *et seq.*

10. See TMEP § 1501 regarding notices of appeal, TMEP § 715.03 *et seq.* regarding requests for reconsideration, and TMEP § 1714.01(f)(ii) regarding situations in which the unintentional delay standard does not apply.

1202.03 Notice of Appeal

A notice of appeal is the document by which an applicant appeals from the decision of the examining attorney refusing registration. A notice of appeal must be filed through ESTTA, found at https://estta.uspto.gov. [Note 1.] *See*TBMP § 106.03 and TBMP § 110. Under "File a New Proceeding" choose "Appeal of Refusal to Register" from the drop-down menu, and enter the application serial number; the relevant information will then automatically appear in the form. ESTTA provides the applicant with immediate confirmation of the filing; generates the Board's order instituting the appeal immediately; and provides the applicant the date by which it must file its appeal brief.

If ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form and must include a written explanation of such technical problems or extraordinary circumstances. [Note 2.] See TBMP § 106.03 and TBMP § 1202.02 and the rules and TMEP sections cited therein regarding certificate of mailing and certificate of mailing via Priority Mail Express® procedures. The paper version of the notice of appeal should bear at its top the wording "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL

BOARD," followed by information identifying the application in which the appeal is being filed, namely, the applicant's name, the serial number and filing date of the application, and the involved mark. The notice of appeal need consist only of a simple statement indicating that the applicant appeals from the refusal of registration; reasons for appeal need not be given. If the application has multiple classes, and the appeal is not for all the classes in the application, the applicant should indicate in the notice of appeal the class(es) for which the appeal is taken. *See*TBMP § 1202.05. Only one copy of the notice of appeal should be submitted.

A notice of appeal need not be verified, and it may be signed by the applicant or its attorney or other authorized representative. An electronic signature will be accepted. [Note 3.] *See*TBMP § 106.02. The Board will accept a notice of appeal that is signed by an attorney, even if he or she is not the attorney of record, i.e., there is no power authorizing him or her to act for the applicant. Moreover, the Board will accept a notice of appeal signed by the applicant itself, even if the applicant had appointed an attorney to act for it. However, the Board will continue to correspond only with the attorney of record or, if the applicant has not appointed an attorney, with the applicant itself. **Please Note:** The Trademark Examining Operation will not accept any document, including a request for reconsideration filed along with a notice of appeal, if it is signed by the applicant or an attorney if a different attorney had been appointed to act for the applicant, and the power has not been revoked. [Note 4.]

Although the notice of appeal must be signed, an unsigned notice of appeal will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board. [Note 5.] *See*TBMP § 106.02. The same is true of other unsigned papers filed in an application during an ex parte appeal to the Board. For further information concerning signature of submissions, see TBMP § 106.02.

If the applicant files a request for reconsideration or amendment (including an amendment to allege use) along with the notice of appeal, or at the time of filing the notice of appeal the applicant had filed a request for reconsideration or amendment which is still pending before the examining attorney, the applicant should indicate this by checking the box on the ESTTA form indicating that it has filed a request for reconsideration. The request for reconsideration itself should be filed through TEAS. In the rare circumstances a notice of appeal is filed as a paper submission, the applicant should include in the notice of appeal a statement that a request for reconsideration has been or is being filed; if the request for reconsideration is filed at the same time as the notice of appeal, it should accompany the notice of appeal but not be in the body of the notice of appeal. If the written explanation for paper filing is acceptable, the Board will institute the appeal, suspend proceedings, and remand the application to the examining attorney to consider the request for reconsideration or amendment. *See*TBMP § 1204 and TBMP § 1205.

If the applicant believes that the time is not yet ripe for the filing of a notice of appeal, but has received a final Office action and chooses to file a notice of appeal to preserve its rights, *see*TBMP § 1201.02, the applicant should advise the Board that it believes the final Office action is premature and, if the applicant has filed a petition on this issue, it should so inform the Board. When the notice of appeal is filed electronically through ESTTA, the applicant, after the appeal has been instituted and the electronic system has been updated, (normally 24 hours after the filing of the notice of appeal), should file through ESTTA, using the "File Documents in a Board Proceeding" menu, and checking the box for "Other motion/submission," an additional paper advising the Board that the final action is premature or that there is a pending petition on this issue. In the rare circumstance when the notice of appeal is submitted as a paper filing, the applicant should advise the Board in the notice of appeal of its belief that the final action is premature, or that it has filed a petition.

NOTES:

1. *See* 37 C.F.R. § 2.126(a). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69966, 69970 (Oct. 7, 2016) ("The Office is amending § 2.195(d)(3) by deleting the option of filing notices of ex parte appeal by facsimile. This is a conforming amendment to align § 2.195(d)(3) with the final rules requiring that all filings with the Board be through ESTTA.").

2. *See* 37 C.F.R. § 2.126 for general requirements for submissions to the Board. *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69966 (Oct. 7, 2016) ("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.").

3. *See* 37 C.F.R. § 2.193(a)(2); TMEP § 611.01(c).

4. *See*TMEP § 601.02, TMEP § 604.01 and TMEP § 611.05 *et seq.*

5. *Cf.* 37 C.F.R. § 2.119(e).

1202.04 Appeal Fee

37 C.F.R. § 2.141 ***Ex parte appeals from action of trademark examining attorney.***

(a) *An applicant may, upon final refusal by the trademark examining attorney, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken, within six months of the date of issuance of the final action. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.*

(b) *The applicant must pay an appeal fee for each class from which the appeal is taken. If the applicant does not pay an appeal fee for at least one class of goods or services before expiration of the six-month statutory filing period, the application will be abandoned. In a multiple-class application, if an appeal fee is submitted for fewer than all classes, the applicant must specify the class(es) in which the appeal is taken. If the applicant timely submits a fee sufficient to pay for an appeal in at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Board will issue a written notice setting a time limit in which the applicant may either pay the additional fees or specify the class(es) being appealed. If the applicant does not submit the required fee or specify the class(es) being appealed within the set time period, the Board will apply the fee(s) to the class(es) in ascending order, beginning with the lowest numbered class.*

Because filing through ESTTA is mandatory, fees are collected at the time of filing. However, the following addresses circumstances where fees accompanying paper filings are, in whole or in part, deficient. An ex parte appeal to the Board is taken by timely filing in the Office both a notice of appeal and the prescribed appeal fee for each class for which the appeal is taken. [Note 1.] If a notice of appeal is timely filed, but the appeal fee is not, the appeal will be untimely, and the application will be deemed to have been abandoned. *See*TBMP § 1202.01. In such circumstance, however, the applicant may file a petition to revive. [Note 2.] Further, if a party fails to timely file an appeal fee but has previously given a general authorization to charge all fees that may become due during the pendency of an application to a deposit account, such authorization will be accepted, provided that the deposit account contains sufficient funds. [Note 3.]

The amount of the fee required for an ex parte appeal to the Board is specified in 37 C.F.R. § 2.6(a)(18). If an application in which an appeal is filed has more than one class of goods and/or services [Note 4], the

required fee must be paid for each class in which appeal is taken. [Note 5.] If an appeal is taken in, and an appeal fee is submitted for fewer than all of the classes in the application, the class or classes in which the appeal is taken should be specified. [Note 6.] If the final requirement or refusal does not pertain to all classes in the application, the appeal fee need be submitted only for those classes for which a final requirement or refusal has issued. TBMP § 1202.05.

If an applicant timely submits a fee sufficient to pay for an appeal in at least one class, but the fee submitted is less than the required amount because multiple classes in an application are involved, and the applicant has not specified the class or classes to which the submitted fee applies, the Board will issue a written notice allowing the applicant until a set time in which to submit the required fee or to specify the class or classes appealed. If the required fee is not submitted, or the specification made, within the time set in the notice, the fee submitted will be applied to the classes in ascending order, beginning with the lowest numbered class and including the number of classes in the application for which sufficient fees have been submitted. [Note 7.]

NOTES:

1. 37 C.F.R. § 2.6(a)(18)(i), 37 C.F.R. § 2.6(a)(18)(ii) and 37 C.F.R. § 2.141.

2. *See generally,*TMEP § 1714. *See also*TMEP § 1704.

3. 37 C.F.R. § 2.208(b).

4. *See* 37 C.F.R. § 2.86 and 37 C.F.R. § 2.141(b).

5. 37 C.F.R. § 2.6(a)(18).

6. *See* 37 C.F.R. § 2.141(b) and TMEP § 1403.06.

7. 37 C.F.R. § 2.141(b).

1202.05 Multiple Class Applications

If an application contains multiple classes, and the final refusal or requirement pertains to some but not all of the classes, an applicant may choose to file an appeal for the application as a whole, or it may choose to file a request to divide the application. [Note 1.] See TBMP § 1205.02 regarding requests to divide. In the former case, the classes for which an appeal has not been taken remain part of the application. After a decision on the appeal is rendered, the classes that were not part of the appeal (and those classes for which the refusal or requirement was reversed) will be published for opposition or, in the case of an application on the Supplemental Register, will proceed to registration. If a request to divide is filed along with a notice of appeal, the appeal will be suspended until action is taken on the request to divide. Those classes for which there is no final requirement or refusal, and which have been divided out, will immediately proceed to publication or, in the case of an application on the Supplemental Register, to registration, and will not be delayed pending a decision on the appeal.

Similarly, if a final refusal or requirement pertains to some but not all of the goods or services listed in a single class, the applicant may either file an appeal for the class as a whole, or request that the goods or services for which no final refusal or requirement has been made be divided out of the application, in effect creating two applications for a single class of goods or services. [Note 2.] If no request to divide is filed,

after the appeal is decided, the application containing those goods or services for which no refusal or requirement was made (as well as the other goods or services in the class if the refusal was reversed) will be published for opposition or, in the case of an application on the Supplemental Register, will proceed to registration. If the goods or services for which no refusal or requirement was made were divided out of the parent application and into a child application, the child application will immediately proceed to publication or, in the case of an application on the Supplemental Register, to registration. *See*TBMP § 1205.02.

If the final refusals or requirements do not apply to all the classes in a multiple class application, an appeal fee is required only for those classes for which the appeal is taken, that is, those classes for which a final refusal or requirement is made. This is true whether or not the applicant requests that the application be divided.

If the applicant decides to file an appeal for fewer than all the classes in the application for which final refusals or requirements have issued, the applicant should indicate in the notice of appeal the classes for which the appeal is taken. See TBMP § 1202.04 regarding insufficient appeal fees for all classes in the application to which final refusals or requirements pertain.

NOTES:

1. *See* 37 C.F.R. § 2.87.

2. *Cf. In re UST Global (Singapore) Pte. Ltd.*, 2020 USPQ2d 10435, at *9 & n.29 (TTAB 2020) (affirming disclaimer requirement for entire class even though term found merely descriptive of only a portion of the identified services and applicant had agreed to disclaim the term for those services, Board notes that a similarly situated applicant could instead divide its application and separately appeal the disclaimer requirement for other goods or services within a single class).

1203 Appeal Briefs

If the ground or one of the grounds for refusal is likelihood of confusion with a registered mark, it is suggested, before the applicant and the examining attorney file their respective briefs, that they check the records of the Office to ascertain whether the cited registration has been cancelled or has expired and when maintenance documents are due.

For information about requesting suspension pending a determination as to whether a cited registration has been cancelled or has expired, see TBMP § 1213. See TBMP § 1212 regarding cancellation or assignment of a cited registration.

1203.01 Form 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. § 2.142(b)(2) *Briefs must meet the requirements prescribed in § 2.126, except examining attorney submissions need not be filed through ESTTA. Without prior leave of the Trademark Trial and Appeal Board, a brief shall not exceed twenty-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. A reply brief from the appellant, if any, shall not exceed ten pages in length in its entirety. Unless authorized by the Board, no further briefs are permitted.*

37 C.F.R. § 2.142(b)(3) *Citation to evidence in briefs should be to the documents in the electronic application record by date, the name of the paper under which the evidence was submitted, and the page number in the electronic record.*

A brief filed in an ex parte appeal to the Board must conform to the requirements of 37 C.F.R. § 2.142(b)(2) as well as the general requirements for submissions to the Board specified in 37 C.F.R. § 2.126, including that the brief be double spaced and in at least 11-point type. [Note 1.]

Only one copy of the brief should be submitted. The twenty-five page limit for an appeal brief and the ten page limit for a reply brief do not refer to any exhibits attached to the briefs. However, appendices or exhibits to a brief may not be used to avoid the page limitation. [Note 2.] Material that was not previously made of record should not be submitted with the appeal brief. *See*TBMP § 1203.02(e) and TBMP § 1207.01. Also, the appeal brief is associated with the application file, so papers that are already in the application should not, as a matter of course, be resubmitted as exhibits to the brief. [Note 3.] Most appeal briefs are far less than the twenty-five pages allowed by the rule and, given the limited issues and record in an appeal, the Board will rarely grant a motion for leave to exceed the twenty-five page limit or ten page limit in the case of a reply brief. [Note 4.] If an applicant files a brief that exceeds the twenty-five page limit or a reply brief that exceeds the ten-page limit without prior leave of the Board, the brief will not be considered. If the deadline for filing a brief has not passed, applicant may file a conforming substitute brief together with a motion to accept its substitute brief. Depending on the circumstances of when the brief's nonconformity

comes to the Board's attention, the Board may sua sponte issue an order allowing applicant time to file a conforming brief. The failure to file a conforming appeal brief will not be treated as a failure to file a brief which would result in the dismissal of the appeal. [Note 5.] In such a situation, the examining attorney will still file a brief, and the applicant may file a reply brief, although the reply brief must be limited to arguments that reply to the arguments made in the examining attorney's brief; it may not be used as a substitute for a main brief, and any arguments that are not properly the subject of a reply brief will not be considered.

The Board has the discretion to permit supplemental briefing when appropriate. [Note 6.] Absent a Board order, however, neither an applicant nor an examining attorney may file further briefs after the applicant files its reply. Nor may either do so after the time for applicant to have filed its reply has passed and applicant has not filed a reply. *See*TBMP § 1203.02(c).

The brief should indicate that it is an appeal brief, and include information identifying the application in which it is filed, namely, the applicant's name, the serial number and filing date of the application, and the mark sought to be registered. [Note 7.] When referring to the record, the applicant and examining attorney should cite to the prosecution history for the application, currently the TSDR database. Citation format should be by date, name of the paper under which the evidence was submitted and the page number in the electronic record, for example: November 4, 2013 Office Action, TSDR p. 2. The Examining Attorney and applicant may cite to the TSDR record in .pdf format, but must indicate that they are doing so in their brief. [Note 8.] Where appropriate, reference to the TTABVUE entry and page number, e.g., 1 TTABVUE 2, should also be used. [Note 9.] Case citation should include a citation to The United States Patent Quarterly (USPQ) if the case has appeared in that publication. [Note 10.] *See*TBMP § 101.03 and TBMP § 1203.02(f). The brief need not include the formal requirements, such as a table of contents and description of the record, of a trial brief. [Note 11.] If such items are included, however, they will count as part of the twenty-five page limit.

If a great deal of evidence has been submitted during the examination/prosecution of the application, in the respective briefs, the applicant and the examining attorney are encouraged to highlight the most probative evidence. [Note 12.]

The content of the brief should not include a proposed amendment, a request for remand, or a request for an oral hearing. [Note 13.] Such requests should be filed by separately captioned papers or the Board might not consider them. [Note 14.] *See*TBMP § 1205.01, TBMP § 1207.02 and TBMP § 1216.

For further information concerning the form and contents of the examining attorney's appeal brief, in particular, see TMEP Appendix A.

Briefs must be filed through ESTTA. [Note 15.] If ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, briefs may be filed in paper form and must include a written explanation of such technical problems or extraordinary circumstances. [Note 16.]

NOTES:

1. In some instances, an examining attorney's appeal brief may mistakenly appear to exceed the 25-page limitation in TTABVUE, the Board's online docketing system. *See, e.g., In re Sela Products LLC*, 107 USPQ2d 1580, 1585 (TTAB 2013) (examining attorney appeal brief complied with page limitation). *Cf. In re Cordua Restaurants LP*, 110 USPQ2d 1227, 1229 n.2 (TTAB 2014) ("The Board notes that applicant's appeal brief was single-spaced. Trademark Rule 2.126(b) 37 C.F.R. § 2.126(b) requires all briefs submitted to be double-spaced."), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016). *But see In re University of Miami*, 123 USPQ2d 1075, 1077 n.2 (TTAB 2017) (Board exercised its discretion to consider applicant's

appeal brief and reply that were not double-spaced because it appeared that they would fall within the applicable page limits had they been double-spaced).

2. *In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1596 (TTAB 1999) (applicant's attempt to submit discussion as an appendix to brief treated by Board as an attempt to circumvent the Board's order denying waiver of page limitation, and sanctions imposed); *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (appendices may not be used as a subterfuge to avoid the page limitation).

3. *In re Information Builders Inc.*, 2020 USPQ2d 10444, at *2 n.4 (TTAB 2020) (attaching previously submitted evidence to an appeal brief is unnecessary and impedes efficient disposition of the appeal by the Board; direct citation to evidence in the record is strongly preferred); *In re Allegiance Staffing*, 115 USPQ2d 1319, 1323 (TTAB 2015) (practice of attaching to appeal brief copies of the same exhibits submitted with responses is discouraged); *In re Sela Products LLC*, 107 USPQ2d 1580, 1584 (TTAB 2013) ("It is of far more utility to the Board for the applicant and examining attorney to provide citations directly to the record and, when there are a large number of attachments to an Office action or response, to the specific page number where the attachment may be found."); *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012) (no need to attach additional copies to appeal brief of materials already of record; examining attorney's objections to the duplicative exhibits is overruled because striking the materials already of record would be pointless), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1315 (TTAB 2011); *In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1220 n.9 (TTAB 2008) (attaching exhibits to brief of material already of record only adds to the bulk of the file, and requires Board to determine whether attachments had been properly made of record); *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1475 n.3 (TTAB 2007) (attaching evidence from record to briefs is duplicative and is unnecessary).

4. *See In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1596 (TTAB 1999) (applicant's request for a waiver in order to include an additional 10 pages denied).

5. *See In re Thomas*, 79 USPQ2d 1021, 1023 (TTAB 2006) (Board refused to consider applicant's 29-page brief).

6. *See, e.g., In re James S. Fallon*, 2020 USPQ2d 11249, at *1 (TTAB 2020) (Board allowed applicant and the examining attorney time to file supplemental briefs on a new refusal when application was remanded for issuance of the new refusal after both had filed appeal briefs on the original refusals); *In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1952 (TTAB 2018) (where, after remand, the applicant amended to the Supplemental Register and the examining attorney issued a new refusal, the Board, upon resumption of the appeal, ordered a second set of appeal briefs solely on the new ground for refusal).

7. *Cf.* TMEP § 302.03(a).

8. *Cf. In re United Trademark Holdings, Inc.*, 122 USPQ2d 1796, 1797 n.5 (TTAB 2017) (Board in its opinion cited to the TSDR record in .pdf format).

9. 37 C.F.R. § 2.142(b)(3). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is adding new § 2.142(b)(3) to specify that citation to evidence in briefs should be to the documents in the electronic application record by date, the name of the paper under which the evidence was submitted, and the page number in the electronic record. The amendment is intended to facilitate review of record evidence by the applicant, the examining attorney, the Board, and the public.").

10. *In re Carlson*, 91 USPQ2d 1198, 1199 n.2 (TTAB 2009).

11. *Cf.* 37 C.F.R. § 2.128(b).

12. *See In re Michalko*, 110 USPQ2d 1949, 1951-52 (TTAB 2014) ("Because we must determine whether attachments to briefs are properly of record, citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during the prosecution of the application, requiring more time and effort than would have been necessary if citations directly to the prosecution history were provided.") (citing this section)); *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1315 (TTAB 2011) (attachment to brief of hundreds of pages of exhibits already of record not helpful; instead it would have been helpful to identify, by date of submission and page number in Office's TDR database, the material being referenced in the brief); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1265 (TTAB 2011) (Board would be very critical if examining attorney were to submit an inordinate number of registrations); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010) ("The Board frowns equally upon an applicant or examining attorney submitting hundreds of pages of evidence in the hope that as the Board wades through it we will find something that is probative. When they believe that it is necessary to submit a significant amount of such material, it is incumbent on the applicant and the examining attorney to specify in their briefs those pieces of evidence that they believe are most persuasive of their respective positions, so that the Board can consider that evidence in particular."); *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1585 n.5 (TTAB 2007) ("submitting a large number of third-party registrations without highlighting particularly relevant ones in the appeal brief is not helpful").

13. *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *2 (TTAB 2020) ("Embedded amendments in an appeal brief are not prohibited but they are discouraged because they may be inadvertently overlooked by the Board before the Examining Attorney files his or her brief; if noticed, they may needlessly delay the proceeding."); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1859 (TTAB 2014) ("To the extent applicant seeks to request remand for such consideration by the examining attorney, burying this request in its reply brief is not sufficient for the Board to treat it as a request for remand."); *In re Future Ads LLC*, 103 USPQ2d 1571, 1573 (TTAB 2012) (claim of acquired distinctiveness raised for first time in reply brief should have been made in a separate request for remand); *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 (TTAB 2010) (request for remand should be filed by a separate paper, appropriately captioned "Request for Remand," rather than by a request buried within a paragraph in the middle of a brief).

14. *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *2 (TTAB 2020) ("Embedded amendments in an appeal brief are not prohibited but they are discouraged because they may be inadvertently overlooked by the Board before the Examining Attorney files his or her brief; if noticed, they may needlessly delay the proceeding." Proper procedure is to file separately captioned request for remand with showing of good cause.).

15. *See* 37 C.F.R. § 2.126(a).

16. *See* 37 C.F.R. § 2.126(b). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69966 (Oct. 7, 2016) ("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.").

1203.02 Time for Filing Brief

1203.02(a) Applicant's Main Brief

37 C.F.R. § 2.142(b)(1) *The brief of appellant shall be filed within sixty days from the date of appeal. If the brief is not filed within the time allowed, the appeal may be dismissed. The examining attorney shall, within sixty days after the brief of appellant is sent to the examining attorney, file with the Trademark Trial and Appeal Board a written brief answering the brief of appellant and shall email or mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examining attorney.*

An applicant's main brief in an ex parte appeal to the Board must be filed within sixty days from the date of appeal, or within an extension of time for that purpose, with the requisite fees. [Note 1.] The time for filing the brief is set by rule; filing the notice of appeal through ESTTA automatically generates an acknowledgment; however, in the rare circumstances a notice of appeal is filed in paper with the required written explanation, although the Board attempts to send the applicant an acknowledgement of the receipt of the notice of appeal which indicates the date the brief is due, the failure to receive such acknowledgement does not affect the deadline for such filing. [Note 2.] If no brief is filed, the appeal will be dismissed. [Note 3.] If the brief is filed late, the applicant will be allowed an opportunity to submit an explanation for the late filing; in the absence of an adequate explanation, the appeal will be dismissed. The determination of whether to accept the brief will depend on the circumstances, including the length of time after the due date that the brief is filed, and the reason for the delay.

If the appeal is dismissed for failure to file a timely brief and no timely request to vacate the dismissal has been filed, the applicant's recourse is to file a petition to the Director under the provisions of 37 C.F.R. § 2.146(a)(3). Because such a petition invokes the supervisory authority of the Director, it is determined under the clear error/abuse of discretion standard, that is, whether the Board has committed clear error or abused its discretion in its determination not to accept the late-filed brief. [Note 4.] The applicant should not file a petition to the Director until it has first filed with the Board a request/motion to accept the late-filed brief, and that request/motion has been denied.

Further, a petition to revive is not available when an applicant has failed to file an appeal brief or has filed its appeal brief late. The petition to revive procedure provided in 37 C.F.R. § 2.66(a) applies only to situations in which the applicant did not timely respond to an Office action or notice of allowance. The filing of an appeal brief is not a response to an Office action. Thus, the "unintentional delay" standard of 37 C.F.R. § 2.66(a) does not apply to the determination of whether a late-filed brief will be accepted. [Note 5.]

In the rare circumstances a notice of appeal (accompanied by the required fee) is filed in paper with the required written explanation and with a certificate of mailing by first-class mail pursuant to 37 C.F.R. § 2.197, or the Priority Mail Express® procedure described in 37 C.F.R. § 2.198, the date of mailing specified in the certificate will be used for determining the timeliness of the notice of appeal. However, the actual date of receipt of the notice of appeal in the Office will be used for all other purposes, including the running of the time for filing the applicant's main brief. [Note 6.] TBMP § 111.01 and TBMP § 111.02.

The following applies to situations in which an applicant files a notice of appeal when it has also filed a timely request for reconsideration of a final action, second refusal on the same ground(s), or repeated requirement, and the examining attorney has not yet considered the request for reconsideration when the appeal is filed, or when the applicant files a request for reconsideration along with the notice of appeal. When the applicant files its notice of appeal through ESTTA, it should check the box that indicates that a

request for reconsideration is also being filed. ESTTA will electronically generate the order acknowledging receipt of the appeal and request, suspend further proceedings (including the applicant's time for filing its appeal brief) with respect to the appeal, and remanding the application to the examining attorney for consideration of the request. The request for reconsideration should be filed through TEAS. In the rare circumstances the notice of appeal is a paper submission, the notice of appeal should indicate, in the body of the appeal, that there is a pending request for reconsideration; if a request for reconsideration is being filed contemporaneously with the paper submission of the notice of appeal, it should accompany the notice of appeal. When the written explanation for paper filing is acceptable, proceedings in the appeal will automatically be suspended when a request for reconsideration is pending; the applicant should not file its appeal brief within sixty days of the filing of the notice of appeal, as provided by 37 C.F.R. § 2.142(b)(1), even if the Board has not issued its order suspending proceedings prior to the date the appeal brief would otherwise be due. Nor does the applicant need to verify with the Board that the due date for its brief will be changed if necessary. [Note 7.] *See*TBMP § 1204.

If, upon the examining attorney's consideration of the request for reconsideration, all refusals and requirements are not withdrawn, and a new final refusal or action maintaining the finality of a prior Office action is issued (either in the examining attorney's action on the request for reconsideration, or in a subsequent action), the six-month response clause should be omitted; the application should be returned to the Board; proceedings with respect to the appeal if instituted will be resumed; and the applicant will be allowed time in which to file its appeal brief if one has not already been filed. *See*TBMP § 1205 for the procedure when the request for reconsideration contains an amendment. If the examining attorney approves the application for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. [Note 8.]

NOTES:

1. 37 C.F.R. § 2.6(a)(18)(iii), 37 C.F.R. § 2.6(a)(18)(iv), 37 C.F.R. § 2.6(a)(18)(v), 37 C.F.R. § 2.6(a)(18)(vi), and 37 C.F.R. § 2.6(a)(18)(vii). **Please Note:** there is no fee for filing the first request to extend time to file an appeal brief. 37 C.F.R. § 2.6(a)(18)(iii).

2. *In re Live Earth Products Inc.* , 49 USPQ2d 1063, 1064 (TTAB 1998). *See also* 37 C.F.R. § 2.126(b); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69966 (Oct. 7, 2016) ("In these situations, parties should consider any such paper filing accepted unless the Board indicates otherwise. … The Board will review the explanation accompanying the paper filing in its consideration of the filing, and submissions that do not meet the technical problems or extraordinary circumstances showing will not be considered.").

3. 37 C.F.R. § 2.142(b)(1).

4. *See*TMEP § 1706.

5. *See*TMEP § 1714.01(f)(i)(E).

6. *See* 37 C.F.R. § 2.197; 37 C.F.R. § 2.198. Many documents that are filed in connection with the prosecution of an application, including the application itself and an amendment to allege use, may not be filed using the "Priority Mail Express" procedure. *See*TMEP § 305.03. However, the "Priority Mail Express®" procedure is available for filing a notice of appeal.

7. *See In re Live Earth Products Inc.*, 49 USPQ2d 1063, 1064 (TTAB 1998).

8. *See* TMEP § 715.04.

1203.02(b) Trademark Examining Attorney's Brief

When the applicant's main appeal brief has been received by the Board, the Board sends the application to the examining attorney for preparation of a brief. Within 60 days after the date of the Board's written order forwarding the application to the examining attorney, or within an extension of time for the purpose, the examining attorney must file an appeal brief answering the applicant's main brief. [Note 1.] The examining attorney must also send a copy of the brief to the applicant. [Note 2.] If the examining attorney's brief is late-filed, the Board may exclude it in the absence of an adequate explanation for the late filing. [Note 3.] An examining attorney's failure to file a brief will not result in the application being approved; the Board will simply decide the appeal without the benefit of the brief.

If the examining attorney, having received the application for preparation of an appeal brief, is persuaded by the applicant's appeal brief that the applicant is entitled to the registration sought, the examining attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), and the appeal will be moot. The examining attorney should notify the applicant and Board by telephone or email. [Note 4.] If there is more than one ground of refusal or requirement and the examining attorney determines that one ground or requirement is no longer tenable, the examining attorney should state in the appeal brief that the refusal or requirement has been withdrawn. [Note 5.] The appeal will then go forward on the remaining ground(s)/requirement(s). **Please Note:** Even if the examining attorney does not specifically state in the appeal brief that the refusal or requirement has been withdrawn, the Board may treat the refusal/requirement to have been withdrawn if no mention is made of it in the brief. [Note 6.] *See* TBMP § 1203.02(g).

On the other hand, the examining attorney, having received the application for preparation of an appeal brief, may decide that registration should be refused on an additional ground, or that a new requirement should be made, or that the application should be suspended. In that event, the examining attorney, during the time for and instead of preparing an appeal brief, should send to the Board, with a copy to the applicant, a written request that the application be remanded to him or her for further examination. [Note 7.] For information concerning requests for remand, see TBMP § 1209.02 and TMEP § 1504.05. However, an examining attorney need not request remand in order to make a new argument or change the rationale for a refusal or requirement, as that is not considered to be a new refusal or requirement. [Note 8.] If a request for remand is denied, the Board will reset the examining attorney's time in which to file an appeal brief. [Note 9.] However, if the examining attorney submits a request for remand in order to make a new refusal or requirement, it is the general practice of the Board to grant such a request. *See* TBMP § 1209.02. If the request is granted, the Board will suspend proceedings with respect to the appeal, and remand the application to the examining attorney for further examination in accordance with the request for remand. If, during the course of the further examination, the application is ultimately approved for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. If the examining attorney refuses registration on a new ground, or makes a new requirement, and the new refusal or requirement is ultimately made final, the new final action should not include a six-month response clause; the application should be returned to the Board; and the Board will resume proceedings with respect to the appeal and allow the applicant 60 days in which to submit a supplemental appeal brief directed to the new issue or issues, following which the application will be returned to the examining attorney for preparation of an appeal brief. [Note 10.]

NOTES:

1. 37 C.F.R. § 2.142(b)(1); *In re Wells Fargo & Co.*, 231 USPQ 106, 107 n.2 (TTAB 1986); *In re Tennessee Walking Horse Breeders' and Exhibitors' Association*, 223 USPQ 188 n.3 (TTAB 1984); TMEP § 1501.02. *See also In re Miller Brewing Co.*, 226 USPQ 666, 667 n.4 (TTAB 1985).

2. 37 C.F.R. § 2.142(b)(1). *See In re De Luxe N.V.*, 990 F.2d 607, 26 USPQ2d 1475, 1476 n.3 (Fed. Cir. 1993).

3. *See In re Tennessee Walking Horse Breeders' and Exhibitors' Association*, 223 USPQ 188, 188 n.3 (TTAB 1984).

4. *See*TMEP § 1501.03.

5. *See*TMEP § 1501.03.

6. *See In re MK Diamond Products, Inc.*, 2020 USPQ2d 10882, at *1 n.2 (TTAB 2020) (Board considered final refusal based on request for information under 37 C.F.R. § 2.61(b) withdrawn because the examining attorney did not pursue it in appeal brief).

7. 37 C.F.R. § 2.142(f)(6); TMEP § 1501.02. *Cf. In re Dietrich*, 91 USPQ2d 1622, 1624 (TTAB 2009) (to the extent examining attorney attempted to reject Trademark Act § 2(f) claim for the first time in appeal brief, rejection untimely and not considered); *In re Moore Business Forms Inc.*, 24 USPQ2d 1638, 1638 n.2 (TTAB 1992) (ground for refusal first raised in examining attorney's appeal brief given no consideration).

8. *In re Paper Doll Promotions Inc.*, 84 USPQ2d 1660, 1665 (TTAB 2007). *Cf. In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1401 (TTAB 2018) (Board declined to consider second rationale raised only in an advisory manner during prosecution but raised again by the examining attorney's brief because it was unclear that applicant had "a full opportunity to address the alternative rationale … prior to appeal."); *In re Future Ads LLC*, 103 USPQ2d 1571, 1573 (TTAB 2012) (while examining attorney need not limit arguments made in appeal brief to those raised in Office actions, using the evidence for a totally different purpose not hinted at in the Office actions was unfair based on circumstances of case).

9. *See In re Miller Brewing Co.*, 226 USPQ 666, 667 n.4 (TTAB 1985).

10. *Cf. In re James S. Fallon*, 2020 USPQ2d 11249, at *1 (TTAB 2020) (Board allowed applicant and the examining attorney time to file supplemental briefs on a new refusal when application was remanded for issuance of the new refusal after both had filed appeal briefs on the original refusals).

1203.02(c) Applicant's Reply Brief

Within 20 days from the issue date of the examining attorney's appeal brief, or within an extension of time for the purpose, the applicant may, if it so desires, file a reply brief that shall not exceed ten pages in length in its entirety. [Note 1.] However, the filing of a reply brief is not mandatory. Although there is a fee for filing an appeal brief, none is required for filing a reply brief. [Note 2.]

The reply brief should not include a proposed amendment, a request for remand, or a request for an oral hearing, within the body of the brief. [Note 3.] Such requests should be filed by separately captioned submissions. *See*TBMP § 1205.01, TBMP § 1207.02 and TBMP § 1216.

If the applicant files a reply brief, the Board will notify the examining attorney. If the examining attorney, having read the applicant's reply brief, is persuaded thereby that the applicant is entitled to the registration sought, the examining attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), and the appeal will be moot. The examining attorney should notify the applicant and Board by telephone or email. [Note 4.]

There is no provision in the rules for the filing by the examining attorney of a written response to the applicant's reply brief. However, if the applicant requests an oral hearing, the examining attorney may respond orally, at the oral hearing, to arguments raised in the applicant's reply brief. [Note 5.] Unless instructed or ordered by the Board, supplemental briefs filed after an oral hearing will not be considered. [Note 6.] For further information regarding oral hearings, see TBMP § 1216.

NOTES:

1. *Cf.* 37 C.F.R. § 2.6(a)(18)(vi) and 37 C.F.R. § 2.6(a)(18)(vii).

2. *See* 37 C.F.R. § 2.142(b)(1), 37 C.F.R. § 2.142(b)(2); *In re Gena Laboratories, Inc.*, 230 USPQ 382, 383 n.4 (TTAB 1985); *In re Randall & Hustedt*, 226 USPQ 1031, 1033 n.2 (TTAB 1985). *Cf. In re Gale Hayman Inc.*, 15 USPQ2d 1478 n.3 (TTAB 1990). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is amending § 2.142(b)(2) to … add [ ] that a reply brief from an appellant shall not exceed ten pages in length and that no further briefs are permitted unless authorized by the Board.").

3. *See In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1859 (TTAB 2014) ("To the extent applicant seeks to request remand for such consideration by the examining attorney, burying this request in its reply brief is not sufficient for the Board to treat it as a request for remand."). TMEP § 1501.03. *Cf. In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *2 (TTAB 2020) ("Embedded amendments in an appeal brief are not prohibited but they are discouraged because they may be inadvertently overlooked by the Board before the Examining Attorney files his or her brief; if noticed, they may needlessly delay the proceeding.").

4. *See*TMEP § 1501.03.

5. *See*TMEP § 1501.02(c). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69960, 69968 (Oct. 7, 2016) ("The Office is amending § 2.142(b)(2) to … add [ ] that a reply brief from an appellant shall not exceed ten pages in length and that no further briefs are permitted unless authorized by the Board.").

6. *In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1778 n.3 (TTAB 2017) (Board refused to consider unauthorized supplemental brief filed after oral hearing), *aff'd*, 749 F. App'x 987 (Fed. Cir. 2018).

1203.02(d) Extension of Time for Filing Brief

An extension of time for filing an appeal brief in an ex parte appeal to the Board may be granted by the Board upon written request showing good cause for the requested extension. [Note 1.] The determination of good cause will be based upon all relevant circumstances, including the length of time of any previously granted extensions and the reason(s) for the requested extension(s). Thus, a reason such as the press of other business, which may be sufficient to show good cause for a first extension of thirty days, may not be sufficient for a second extension of time. Depending on the totality of the circumstances, good cause has been found when there has been an appointment of a new attorney, illness, the need to get instructions from a foreign

applicant, and attempting to negotiate a consent agreement. If a request is found not to be sufficient to warrant an extension, the Board may allow applicant a limited period of time, such as ten days, in which to file the appeal brief, or may grant the requested extension, but advise that no further extensions will be granted absent a showing of extraordinary circumstances.

No fee is required for a first request for an extension of time to file an appeal brief. [Note 2.] However, a second or subsequent request for an extension of time to file an appeal brief must be accompanied by the requisite fee. [Note 3.]

NOTES:

1. *See In re Miller Brewing Co.*, 226 USPQ 666, 667 n.4 (TTAB 1985). *See also In re Tennessee Walking Horse Breeders' and Exhibitors' Association*, 223 USPQ 188, 188 n.3 (TTAB 1984).

2. 37 C.F.R. § 2.6(a)(18)(iii).

3. 37 C.F.R. § 2.6(a)(18)(iv) and 37 C.F.R. § 2.6(a)(18)(v).

1203.02(e) Material Submitted with Briefs

The record in the application should be complete prior to the filing of an appeal. [Note 1.] *See*TBMP § 1207.01. It is not necessary to attach as exhibits to a brief evidence that is already in the application because the appeal brief is associated with the application. Such evidence should not, as a matter of course, be resubmitted as exhibits to the brief. [Note 2.] *See*TBMP § 1203.01.

Exhibits attached to a brief that were not made of record during examination are untimely, and generally will not be considered. [Note 3.] *See*TBMP § 1207.01. However, if the examining attorney, in their brief, discusses the exhibits attached to the applicant's brief without objecting to them, or if the applicant discusses, in its reply brief, exhibits attached to the examining attorney's brief without objection, they may be deemed to have been stipulated into the record and may be considered. *See*TBMP § 1207.03.

Evidentiary references made in briefs but not supported by timely submissions may not be considered. [Note 4.]

NOTES:

1. 37 C.F.R. § 2.142(d).

2. *In re Information Builders Inc.*, 2020 USPQ2d 10444, at *2 n.4 (TTAB 2020) (attaching previously submitted evidence to an appeal brief is unnecessary and impedes efficient disposition of the appeal by the Board). *Cf. Life Zone Inc. v. Middleman Group, Inc.*, 87 USPQ2d 1953, 1955 n.4 (TTAB 2008) (same in inter partes context).

3. *See In re tapio GmbH*, 2020 USPQ2d 11387, at *3 (TTAB 2020) ("screen shots" from applicant's website that were embedded in applicant's brief and other materials that were first filed with applicant's brief not considered); *In re James S. Fallon*, 2020 USPQ2d 11249, at *2 (TTAB 2020) (copy of applicant's patent drawing first submitted as exhibit to applicant's brief not considered); *In re Minerva Associates, Inc.*, 125 USPQ2d 1634, 1636 n.9 (TTAB 2018) (applicant's copy of specimen filed in its co-pending application attached to appeal brief not considered); *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767 (TTAB 2016)

(copy of patent excerpt submitted with appeal brief not considered); *In re Fiat Group Marketing & Corporate Communications S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014) (examining attorney's objection to applicant's submission of registrations with appeal brief sustained); *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013) (copies of documents pertaining to district court litigation submitted with applicant's appeal brief not considered); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (exhibits attached to applicant's supplemental brief not considered; noted that evidence could have been submitted during the period of further examination after remand); *In re City of Houston*, 101 USPQ2d 1534, 1536-37 (TTAB 2012) (copies of third-party registrations submitted for first time with reply brief are untimely and will not be considered, but list of such registrations submitted during examination will be considered for whatever limited probative value it has), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re District of Columbia*, 101 USPQ2d 1588, 1591-92 (TTAB 2012) (third-party registrations submitted for first time with appeal brief are not considered), *aff'd sub nom. In re City of Houston*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147-48 (TTAB 2011) (materials submitted with reply brief, after two requests for remand were denied, were not of record and, because reply brief discussed materials at length, reply brief also not considered); *In re Brouwerij Bosteels*, 96 USPQ2d 1414 (TTAB 2010) (exhibits attached to applicant's supplemental reply brief not considered); *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1322 (TTAB 2010); *In re Quantum Foods Inc.*, 94 USPQ2d 1375, 1377 n.2 (TTAB 2010) (page from applicant's website submitted with appeal brief not considered); *In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009) (third-party registrations and excerpt from registrant's website submitted with supplemental appeal brief not considered); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1334 (TTAB 2009) (submissions with reply brief not considered); *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1379 n.3 (TTAB 2008) (previously unsubmitted materials attached to applicant's brief not considered); *In re Tea and Sympathy Inc.*, 88 USPQ2d 1062, 1063 n.2 (TTAB 2008) (exhibits submitted for first time with applicant's appeal brief and declaration attached to reply brief not considered); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 n.5 (TTAB 2007) (entry from online encyclopedia submitted for first time with reply brief untimely and not of record); *In re Genitope Corp.*, 78 USPQ2d 1819 n.3 (TTAB 2006) (materials from applicant's website submitted for first time with examining attorney's brief not considered); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1050 (TTAB 2006) (declaration by applicant's president submitted for first time with applicant's appeal brief not considered); *In re Promo Ink*, 78 USPQ 1301, 1303-04 (TTAB 2006); *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); *In re Couture*, 60 USPQ2d 1317, 1319 n.3 (TTAB 1999); *In re Zanova Inc.*, 59 USPQ2d 1300, 1302 (TTAB 2001) ("By attempting to introduce evidence with its reply brief, applicant has effectively shielded this material from review and response by the Examining Attorney"; material submitted with reply brief not considered); *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1446 n.2 (TTAB 2000) (although applicant had properly submitted copies of third-party registrations, additional registrations listed in applicant's brief, which were not commented on by examining attorney in her brief, not considered); *In re Polo International Inc.*, 51 USPQ2d 1061,1062 n.2 (TTAB 1999) (typed list of third-party registrations submitted with applicant's brief which were objected to by examining attorney, not considered); *In re U.S. Cargo Inc.*, 49 USPQ2d 1702, 1703 n.2 (TTAB 1998) (third-party registrations submitted with reply brief not considered); *In re North American Free Trade Association*, 43 USPQ2d 1282, 1287 n.9 (TTAB 1997) (letter submitted with applicant's brief was not made of record during prosecution, and therefore not considered); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 (TTAB 1997) (copy of unpublished case submitted with applicant's reply brief not considered).

Cf. In re Osterberg, 83 USPQ2d 1220, 1221 n.2 (TTAB 2007) ("clean" version, with nonmaterial edits, of declaration submitted during examination that was attached as exhibit to appeal brief considered because the two versions of the declaration substantially the same); *In re Consolidated Specialty Restaurants Inc.*, 71 USPQ2d 1921, 1922 n.1 (TTAB 2004) (although applicant submitted new evidence with its brief, subsequently examining attorney was granted remand of application, and therefore examining attorney had opportunity to consider this evidence and respond thereto; exhibit was considered of record).

4. *See In re Procter & Gamble Co.*, 105 USPQ2d 1119, 1120 (TTAB 2012) (applicant withdrew references in brief to third-party registrations it inadvertently failed to attach to responses during examination; applicant's footnote reference to a journal not considered because it was being offered for its evidentiary value on evidence not properly introduced).

1203.02(f) Cases Which May Be Cited

Prior to January 23, 2007, the Board's policy had been that decisions which were not designated as "citable as precedent" or "for publication in full" were not citable authority. [Note 1.] Since January 23, 2007, the Board has permitted citation to any Board decision. [Note 2.] However, the practice of citing decisions designated as "not a precedent" is not encouraged because they are not binding upon the Board, nor are they a substitute for evidence needed to support or traverse a refusal. [Note 3.] Nonetheless, such decisions may be cited for whatever persuasive value they might have. [Note 4.] *See* TBMP § 101.03.

When cases are cited in a brief, the case citation should include a citation to the USPQ if the case has appeared in that publication. [Note 5.] *See*TBMP § 101.03 andTBMP § 801.03. Citation to a non-precedential case may be to TTABVUE by docket entry and page number.

NOTES:

1. *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1897 n.2 (TTAB 2001); *In re Polo International Inc.*, 51 USPQ2d 1061, 1063 n.3 (TTAB 1999); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 (TTAB 1997); *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1275 n.9 (TTAB 1992).

2. *Citation of Opinions to the Trademark Trial and Appeal Board*, O.G. Notice (Jan. 23, 2007).

See, e.g., *In re UST Global (Singapore) Pte. Ltd.*, 2020 USPQ2d 10435, at *7 n.23 (TTAB 2020) (non-precedential decisions are not binding on the Board, nor a substitute for evidence needed to support a refusal); *In re tapio GmbH*, 2020 USPQ2d 1138, at *10 n.30 (TTAB 2020) ("Generally, the practice of citing non-precedential opinions is not encouraged." Board found unpersuasive non-precedential decisions decided on different records); *In re Society of Health and Physical Educators*, 127 USPQ2d 1584, 1587 n.7 (TTAB 2018) ("Board decisions which are not designated as precedent are not binding on the Board, but may be cited and considered for whatever persuasive value they may hold."); *In re Morrison & Foester LLP*, 110 USPQ2d 1423, 1427, n.6 (TTAB 2014) ("Although parties may cite to non-precedential decisions, the Board does not encourage the practice."); *In re the Procter & Gamble Co.*, 105 USPQ2d 1119, 1120-21 (TTAB 2012) (citation to non-precedential opinions permitted but not encouraged; non-precedential decisions not binding on the Board).

4. *See In re Society of Health and Physical Educators*, 127 USPQ2d 1584, 1587 n.7 (TTAB 2018) ("Board decisions which are not designated as precedent are not binding on the Board, but may be cited and considered for whatever persuasive value they may hold.").

5. *In re Carlson*, 91 USPQ2d 1198, 1199 n.2 (TTAB 2009). Bloomberg Law ceased publishing the USPQ in print form in December 2018.

1203.02(g) Waiver of Claim or Requirement in Brief

If an applicant, in its appeal brief, does not assert an argument made during prosecution, it may be deemed waived by the Board. [Note 1.] Similarly, if an applicant, in its appeal brief, complies with a requirement

and the examining attorney does not discuss the requirement, or if the examining attorney does not discuss a ground for refusal in their brief, the requirement or refusal may be deemed withdrawn. [Note 2.] *See*TBMP § 1203.02(b). However, if an applicant seeks to comply with a requirement, the better practice is to file a separately captioned request to remand with a showing of good cause rather than simply offering the amendment as part of its brief. *See*TBMP § 1205. [Note 3.]

NOTES:

1. *See In re MK Diamond Products, Inc.*, 2020 USPQ2d 10882, at *1 n.2 (TTAB 2020) (Board considered final refusal based on request for information under 37 C.F.R. § 2.61(b) withdrawn because the examining attorney did not pursue it in appeal brief); *In re Katch, LLC*, 2019 USPQ2d 233842, at *1-2 (TTAB 2019) (applicant who briefed only the refusal under Section 23(c) waived its appeal of the refusal to registration under Trademark Sections 1, 2, 3 and 45); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1950 n.2 (TTAB 2001) (applicant did not, in its appeal brief, pursue claim of inherent distinctiveness, and therefore the claim was not considered by Board). *See also In re Rainier Enterprises, LLC*, 2019 USPQ2d 463361, *2-3 (TTAB 2019) (failure to address refusals is a basis for dismissing the appeal); *In re Harley*, 119 USPQ2d 1755, 1758 (TTAB 2016) (failure to address refusals is a basis for affirming the examining attorney's refusal on all grounds); *In re E5 LLC*, 103 USPQ2d 1578, 1579 n.1 (TTAB 2012) (during prosecution, applicant argued that mark was unitary but did not maintain argument in its appeal brief). *Cf. In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1852 n.31 (TTAB 2012) (applicant mentioned claim of acquired distinctiveness in original appeal brief but not again in supplemental appeal brief; because the examining attorney addressed the point in supplemental brief, Board considered the claim).

2. *See In re S. Malhotra & Co.*, 128 USPQ2d 1100, 1102 n.3 (TTAB 2018) (refusals to register based on requirements for translation and transliteration statements deemed moot because examining attorney suggested statements during prosecution, applicant accepted them in its brief, and the Board entered them); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1512 n.2 (TTAB 2001) (requirement for translation deemed moot because applicant, in its appeal brief, offered translation, and examining attorney, in her appeal brief, did not address issue).

3. *Cf. In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *2 (TTAB 2020) ("Embedded amendments in an appeal brief are not prohibited but they are discouraged because they may be inadvertently overlooked by the Board before the Examining Attorney files his or her brief; if noticed, they may needlessly delay the proceeding." Proper procedure is to file separately captioned request for remand with showing of good cause.).

1204 Effect of Request for Reconsideration of Final Action

During the period between issuance of a final action and expiration of the time for filing an appeal therefrom, an applicant may file a request for reconsideration, with or without an amendment and/or new evidence. [Note 1.] However, the filing of a request for reconsideration will not serve to stay the time for filing an appeal (or for petitioning the Director, if appropriate). [Note 2.] TBMP § 1201.02 and TBMP § 1201.05. If, upon the examining attorney's consideration of the request, all refusals and requirements are not withdrawn, and no appeal or other proper response to the final refusal has been filed during the six months following issuance of the final action, the application will be abandoned. [Note 3.] TBMP § 1202.02. Thus, if an applicant which has filed a request for reconsideration of a final action wishes to preserve its right to appeal in the event that the request is unsuccessful, the applicant also must file an appeal prior to the expiration of the six-month period following issuance of the final action.

When an applicant files, in response to a final action or a second refusal on the same ground(s), or a repeated requirement, both a request for reconsideration and an appeal, the request for reconsideration should be made by separate submission and should specify the reasons why the applicant believes reconsideration is warranted. The request for reconsideration should not be combined in the body of the notice of appeal. When the notice of appeal is filed through ESTTA, the applicant should check the box stating that a request for reconsideration has been filed. The request for reconsideration should be filed separately through TEAS. In the rare circumstances the notice of appeal is a paper submission, the applicant should indicate, in the notice of appeal, that a request for reconsideration has also been filed. *See*TBMP § 1202.03.

A request for reconsideration filed more than six months from a final action is treated by the Board as a request for remand regardless of the manner in which it is captioned. *See*TBMP § 1209.04. Further, once applicant has filed an appeal brief, a request for reconsideration, even if filed within six months of a final action, is treated as a request for remand for which good cause must be shown. *See*TBMP § 1209.04. As with a request for reconsideration, a request for remand should not be combined with the applicant's appeal brief, but should be made by a separate document. [Note 4.]

When an applicant which has filed a timely request for reconsideration of a final action, second refusal on the same ground(s), or repeated requirement, also files a timely appeal through ESTTA and checks the "request for reconsideration" box on the ESTTA form, the system will automatically generate an order instituting the appeal, suspending further proceedings (including the applicant's time for filing its appeal brief) with respect to the appeal, and remanding the application to the examining attorney for consideration of the request.

In the rare circumstances the applicant files its notice of appeal as a paper submission and also files a request for reconsideration, or has a request for reconsideration pending, the notice of appeal should indicate this. When the written explanation for paper filing is acceptable, a Board paralegal will then send the applicant an order, to the same effect as the order automatically generated when the notice of appeal is filed through ESTTA. However, because the order is not automatically generated, it will not issue immediately. Where an applicant has timely filed both a notice of appeal on paper and a request for reconsideration, but has not heard from the Board within sixty days with regard to the appeal and reconsideration request, the applicant should not file its appeal brief. [Note 5.] Rather, it may assume that the Board will institute the appeal, if the written explanation for the paper filing is acceptable, and then suspend proceedings and remand the application to the examining attorney, so that the due date for the appeal brief will be reset in the event that the examining attorney denies the request for reconsideration. [Note 6.] The applicant does not need to verify with the Board that the due date for its brief on appeal will be changed if necessary. [Note 7.] TBMP § 1203.02(a). However, the applicant may wish to make a status inquiry with the Board if it has not received an institution and suspension order within sixty days of the filing of the notice of appeal.

If the request for reconsideration raises a new issue, the examining attorney must give the applicant an opportunity to respond before issuing a new final refusal and returning the application to the Board. New issues are typically raised by a request for reconsideration which amends the application to seek registration under the provisions of Trademark Act § 2(f), 15 U.S.C. § 1052(f), or to seek registration on the Supplemental Register, or to amend the identification of goods or services, if a requirement for an acceptable identification of goods or services was not the subject of the final Office action. See TBMP § 1201.02 for examples of new issues that would preclude the issuance of a final action. [Note 8.] If the examining attorney believes that the outstanding issue(s) can be resolved, the examining attorney may contact the applicant and attempt to work out a resolution. [Note 9.]

In the rare circumstance when an applicant files its notice of appeal and a request for reconsideration at the same time by a paper submission, the examining attorney occasionally may act on the request for

reconsideration before the Board can institute the appeal and remand the application. In that event, if the notice of appeal filed in paper form is accepted, the Board will institute the appeal after the examining attorney acts on the request for reconsideration. Depending on the action the examining attorney has taken, the Board will either remand the application to the examining attorney (generally to await the applicant's response to a nonfinal Office action) or, if the examining attorney has denied the request for reconsideration, will proceed with the appeal, and allow the applicant 60 days from the issue date of the Board order in which to file its appeal brief. [Note 10.] The date for filing the appeal brief is reset in this situation because the applicant, at the time it filed its notice of appeal and request for reconsideration, had the expectation that the Board would follow its normal procedure and suspend proceedings in the appeal. [Note 11.]

If, after suspension and remand for consideration by the examining attorney of a timely request for reconsideration, the examining attorney approves the application for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. The applicant will receive notification of the approval for publication when the Office issues a computer-generated notice of publication. The applicant may also ascertain the status of the application by checking the TSDR database. If, upon the examining attorney's consideration of the request, all refusals and requirements are not withdrawn, and a new final refusal to register or action maintaining the finality of a prior Office action is issued (either in the examining attorney's action on the request for reconsideration, or in a subsequent action), the six-month response clause should be omitted; the application should be returned to the Board; proceedings with respect to the appeal will be resumed; and the applicant will be allowed time in which to file its appeal brief. The examining attorney must, prior to returning the application to the Board to resume proceedings in the appeal, issue a written Office action apprising the applicant of that fact, indicating the examining attorney's withdrawal and maintenance of any refusals or requirements and acceptance of any amendments; it is not sufficient to make a note in the application file and return the application to the Board. The new final Office action does not give the applicant an automatic right to file a request for reconsideration, as is the case with a first final Office action; a request for reconsideration may only be filed during the period between issuance of a final action and expiration of the time for filing an appeal therefrom, and because an appeal had previously been filed, any request for further consideration of the application by the examining attorney must be by a request for remand, for which good cause must be shown. *See* TMEP § 715.04(b). [Note 12.]

If an appeal is late-filed, but the applicant timely filed a request for reconsideration, the Board will issue an order informing the applicant of the lateness of its appeal, stating that the late appeal cannot be entertained by the Board, and forwarding the application to the examining attorney for consideration of the request for reconsideration. *See* TBMP § 1202.02.

A timely request for reconsideration of an appealed action may be accompanied by an amendment and/or by additional evidence. *See* TBMP § 1207.04. The evidentiary record in an application should be complete prior to the filing of an appeal, and additional evidence filed after appeal normally will be given no consideration by the Board. [Note 13.] *See* TBMP § 1207. The Board will regard additional evidence a proper part of the record on appeal if it is submitted, together with a request for reconsideration, before the expiration of the six-month response period, even if it is submitted after the notice of appeal is filed. [Note 14.] However, if the applicant has already filed a brief, then the Board will treat the request for reconsideration as a request for remand for which good cause must be shown, even if the request is filed within six months of the final Office action. *See* TBMP § 1207.04 and TMEP § 715.04(b). Also, if the examining attorney denies a request for reconsideration filed with a notice of appeal, a second request for reconsideration will be treated as a request for remand even if it is filed within six months of the final Office action, and therefore additional evidence filed with the second request will become part of the record only if the request for remand is granted upon a showing of good cause. *See* TBMP § 1207.02 and TBMP § 1209.02.

If the examining attorney, upon consideration of a request for reconsideration (made with or without new evidence), does not find the request persuasive, and issues a new action, the examining attorney may submit therewith new evidence directed to the issue(s) for which reconsideration is sought. [Note 15.] Unless the action is a nonfinal action, the applicant may not submit additional evidence, even in response to evidence submitted by the examining attorney. If the applicant wishes to submit additional evidence, it must file a request for remand with a showing of good cause. [Note 16.] TBMP § 1207.02 and TBMP § 1209.04.

For more information about requests for reconsideration filed after issuance of a final action but before filing of a notice of appeal, see TMEP § 715.03. For more information about requests for reconsideration filed in conjunction with a notice of appeal, see TMEP § 715.04. For more information about requests for remand, see TBMP § 1209.02.

NOTES:

1. *See* 37 C.F.R. § 2.63(b). *See also* TMEP § 715.03; *In re Petroglyph Games, Inc.* , 91 USPQ2d 1332, 1334 (TTAB 2009) (new evidence may be filed with request for reconsideration). Requests for consistency review under the Consistency Initiative do not impact the time to file an appeal or serve to suspend the appeal. In addition, although the request is entered into the application TSDR record, the Office will not respond directly to the request and any evidence submitted with such request will not be considered. See **https://www.uspto.gov/trademarks/trademark-updates-and-announcements/consistency-initiative** for further information on the Consistency Initiative.

2. *See* 37 C.F.R. § 2.63(b). *See also*TMEP § 715.03 and TMEP § 715.03(c).

3. *See* 37 C.F.R. § 2.63(b). *See also*TMEP § 715.03.

4. *See In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 828 (TTAB 1984).

5. Should the applicant file an appeal brief in this situation, the Board will normally remand the application to the examining attorney to consider the request for reconsideration and, if the refusal of registration is maintained or a new final refusal issues, will upon resumption of proceedings in the appeal give the applicant an opportunity to submit a supplemental appeal brief directed to any arguments or evidence in the examining attorney's action. *Cf. In re Husqvarna Aktiebolag*, 91 USPQ2d 1436, 1437 (TTAB 2009) (because Board was not aware of applicant's request for reconsideration which was filed two days before notice of appeal, the order instituting the appeal allowed applicant sixty days to file its appeal brief; examining attorney, unaware of either notice of appeal or appeal brief, issued nonfinal Office action, and subsequently another final refusal, and returned application to Board for resumption of appeal; applicant requested that it be permitted to file second brief, and Board accepted it as operative brief).

6. For information concerning the actions that an examining attorney may take in response to a request for reconsideration of a final action, see TMEP § 715.04, TMEP § 715.04(a) and TMEP § 715.04(b). *See also In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 n.8 (TTAB 1992).

7. *In re Live Earth Products Inc.*, 49 USPQ2d 1063, 1064 (TTAB 1998).

8. *See*TMEP § 714.05. *See also In re Adlon Brand Gmbh & Co. KG*, 120 USPQ2d 1717, 1725 (TTAB 2016) ("Neither Applicant's new evidence and arguments regarding the outstanding refusal under Section 2(e)(4), submitted with its request for reconsideration, nor the Examining Attorney's submission of additional evidence regarding the same refusal, provided in response to that request, raised a new issue such as to make

appropriate a nonfinal Office Action that would have allowed a six-month response period.") (citations omitted).

9. *In re Faucher Industries Inc.*, 107 USPQ2d 1355, 1358 13 (TTAB 2013) (Board encourages "open and frank discussion" between applicant and the examining attorney to resolve issue of identification and classification of goods).

10. If an applicant files its notice of appeal through ESTTA and indicates it is filing a request for reconsideration, the appeal will be instituted and the application remanded immediately. However, occasionally the examining attorney will not be aware that an appeal has been filed when he or she acts on the request for reconsideration. Whether the appeal is filed through ESTTA or on paper, if the examining attorney is not aware that a notice of appeal has been filed when he or she acts on the request for reconsideration, the Board will take action on the appeal as indicated above. Because the applicant has already filed a notice of appeal, the applicant may ignore any comment by the examining attorney about filing a notice of appeal made in the denial of a request for reconsideration.

11. *See In re Live Earth Products Inc.*, 49 USPQ2d 1063 (TTAB 1998).

12. Cf. TMEP § 716.02(b) regarding issuance of a new nonfinal Office action when no appeal has been filed.

13. *See* 37 C.F.R. § 2.142(d).

14. *See In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1598 n.4 (TTAB 1999); *In re Corning Glass Works*, 229 USPQ 65, 66 n.5 (TTAB 1985), and *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 828 n.3 (TTAB 1984).

15. *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 (TTAB 2010); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1201 (TTAB 2009). *Cf. In re Hughes Furniture Industries Inc.*, 114 USPQ2d 1134, 1135-36 (TTAB 2015) (request for remand to comply with particular requirement did not give examining attorney right to submit evidence in support of refusal that was not subject of remand request).

16. *See* 37 C.F.R. § 2.142(d); *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 (TTAB 2010); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1201 (TTAB 2009).

1205 Amendment of Application During Appeal

1205.01 In General

This section only addresses an amendment made in an application during a pending appeal, that is, before a final decision on the merits has been issued.

1205.01(a) Amendments and Requests for Reconsideration

If, within six months following the issuance of a final action, or a second refusal on the same ground(s), or a repeated requirement, an applicant files both an amendment to its application and a notice of appeal to the Board, and the examining attorney has not yet acted on the amendment when the notice of appeal is filed, the applicant should check the box on the ESTTA notice of appeal form indicating that it has filed a request for reconsideration. *See*TBMP § 1204. In the rare circumstances the applicant files its notice of appeal as

a paper submission and also files an amendment, or has an amendment pending with the examining attorney, the applicant should indicate this in the notice of appeal. *See*TBMP § 1202.03 and TBMP § 1204.

The Board will acknowledge receipt of the amendment and appeal, institute the appeal and suspend further proceedings (including the applicant's time for filing its appeal brief) with respect to the appeal, *see* TBMP § 1203.02(a), and remand the application to the examining attorney for consideration of the amendment. The Board's remand letter will also include instructions to the examining attorney with respect to the further actions that may and/or should be taken by the examining attorney in conjunction with the examining attorney's consideration of the amendment. [Note 1.] TBMP § 1204. If the examining attorney believes that the outstanding issue(s) can be resolved, the examining attorney may contact the applicant and attempt to work out a resolution. Although the examining attorney may submit evidence with respect to any issues relevant to the amendment, the examining attorney may not assert a new refusal or requirement or submit evidence unrelated to the amendment or material submitted therewith unless the examining attorney files with the Board a request under 37 C.F.R. § 2.142(f)(6) for remand to assert the new refusal or requirement or to submit additional evidence, and the request is granted. [Note 2.] *See* TBMP § 1207.02 and TBMP § 1209.02.

When an applicant files a notice of appeal through ESTTA and checks the box that it has filed a request for reconsideration, an order will be electronically generated that institutes the appeal, suspends proceedings in it, and remands the application to the examining attorney for consideration of the amendment/request for reconsideration. Although the notice of appeal is filed through ESTTA, if the applicant is filing an amendment/request for reconsideration contemporaneously with the filing of the notice of appeal, that document should be filed through TEAS, through which responses to Office actions are electronically filed.

In the rare circumstances the notice of appeal is filed by a paper submission, and the applicant has also timely filed an amendment, but has not heard from the Board within sixty days with regard to the appeal and amendment, the applicant should not file its appeal brief. Rather, it may assume that the Board will institute the appeal if the written explanation for paper filing is acceptable, and then suspend proceedings and remand the application to the examining attorney, so that the due date for the appeal brief will be reset in the event that the amendment does not place the application in condition for publication (or registration, in the case of an application on the Supplemental Register). The applicant does not need to verify with the Board that the due date for its brief on appeal will be changed if necessary. [Note 3.] TBMP § 1203.02(a). However, the applicant may wish to make a status inquiry with the Board if it has not received an institution and suspension order within sixty days of the filing of the notice of appeal.

If the examining attorney is persuaded, on the basis of the amendment, that the applicant is entitled to the registration sought, the examining attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), and the appeal will be moot. The examining attorney should notify the applicant and the Board by telephone or email that the amendment has been accepted and the application has been approved. [Note 4.] The applicant will also receive notification that the application has been approved for publication when the Office issues a computer-generated notice of publication; in addition, the applicant may ascertain the status of the application by checking the TSDR database.

If the examining attorney, after consideration of the amendment, accepts the amendment but adheres to the final refusal to register, either because there are other grounds for refusal or requirements which have not been satisfied, or because the amendment, while acceptable, does not obviate the requirement/refusal, the examining attorney should issue a written action to that effect. That is, the Office action should indicate that the amendment has been accepted, and also indicate what refusals/requirements remain. The six-month response clause should be omitted; the application should be returned to the Board; proceedings with respect to the appeal will be resumed; and the applicant will be allowed time in which to file its appeal brief. If the

examining attorney refuses to accept the amendment, and the amendment raises a new issue, the examining attorney must allow the applicant an opportunity to respond before issuing a final refusal and returning the application to the Board. Therefore, the first Office action that considers and refuses the amendment must be a nonfinal action, and must include the six-month response clause. See TBMP § 1201.02 and TMEP § 714.05 *et seq.* and TMEP § 715.04(b) regarding amendments which raise new issues.

NOTES:

1. For information concerning the actions which may be taken by the examining attorney upon consideration of the amendment, *see*TMEP § 715.04, TMEP § 715.04(a) and TMEP § 715.04(b). *See also In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 n.8 (TTAB 1992); *In re Abolio y Rubio S.A.C.I. y G.*, 24 USPQ2d 1152, 1153-54 (TTAB 1992); *In re Pierce Foods Corp.*, 230 USPQ 307, 308 n.1 (TTAB 1986). *But see In re Integrated Embedded*, 120 USPQ2d 1504, 1510-12 (TTAB 2016) (applicant advised of option to amend to Supplemental Register during prosecution of application but did not do so; reservation of a right does not constitute an amendment in the alternative).

2. *See In re Hughes Furniture Industries, Inc.*, 114 USPQ2d 1134, 1135-36 (TTAB 2015) (application was remanded to consider applicant's proposed disclaimer, it was not permissible for examining attorney to submit evidence in support of refusal that was not the subject of remand request).

3. *See In re Live Earth Products Inc.*, 49 USPQ2d 1063, 1064 (TTAB 1998).

4. *See*TMEP § 715.04 and TMEP § 1501.05.

1205.01(b) Amendments and Requests for Remand

1205.01(b)(1) In General

If an applicant that has filed a timely appeal to the Board files an amendment to its application more than six months after the issuance of the final action, or the second refusal on the same ground(s), or the repeated requirement from which the appeal was taken, the Board will treat the amendment as a request for remand. *See*TBMP § 1209.04. The Board will also treat as a request for remand an amendment filed after the filing of a notice of appeal, even if filed within six months of the final action, if the examining attorney had previously acted on an amendment or request for reconsideration after the filing of the notice of appeal. Similarly, if the amendment is filed along with the applicant's appeal brief or thereafter, even if filed within six months of the final action, the Board will treat the submission as a request for remand. *See*TBMP § 1204. The amendment must accompany the request for remand. Both the request and the amendment should be submitted through ESTTA. The amendment should not be filed separately through TEAS.

A request for remand to consider an amendment will be granted upon a showing of good cause. Good cause will generally be found, for example, when the amendment is an attempt to comply with a requirement, such as an amendment to the identification of goods or services in response to a requirement for an acceptable identification, when the amendment will obviate a ground for refusal, such as an amendment to the Supplemental Register or an amendment to assert a Trademark Act § 2(f) claim (15 U.S.C. § 1052(f)) in order to avoid or overcome a refusal under Trademark Act § 2(e)(1), Trademark Act § 2(e)(2) or Trademark Act § 2(e)(4), 15 U.S.C. § 1052(e)(1), 15 U.S.C. § 1052(e)(2) or 15 U.S.C. § 1052(e)(4), or when the examining attorney consents to remand for consideration of the amendment. [Note 1.] However, whether good cause will be found will depend, in part, on the stage of the appeal at the time the amendment is filed, including the reason given for the delay. [Note 2.] If the request for remand is granted, the Board will suspend

proceedings with respect to the appeal and remand the application to the examining attorney for consideration of the amendment. The Board's remand letter will also include instructions to the examining attorney with respect to the further actions that may and/or should be taken by the examining attorney in conjunction with the examining attorney's consideration of the amendment.

Remand in an ex parte appeal is a matter of discretion with the Board, and the Board may refuse to remand for consideration of an amendment filed more than six months after the date of the action from which the appeal was taken, or an amendment filed after the examining attorney had, after the filing of a notice of appeal, acted on a request for reconsideration or an amendment. In such cases remand may be refused if, for example, the amendment was filed in bad faith, or would serve no useful purpose. [Note 3.] Further, if remand is made, the Board's instructions to the examining attorney concerning the handling of the amendment, and further action in connection therewith may differ for an amendment filed more than six months after the date of the action from which the appeal was taken and those given by the Board for an amendment filed within six months after that date. For example, if an amendment is filed at the point the examining attorney's brief is due, the Board may direct the examining attorney that if the amendment is not acceptable the examining attorney should simply indicate this in the appeal brief, or if the amendment is acceptable but does not overcome the refusal, the examining attorney may include in the appeal brief argument and evidence directed to the amendment, while the applicant may address this in the reply brief. [Note 4.]

If an appeal is late-filed, but the applicant timely filed an amendment to its involved application, the Board will issue a written action informing the applicant of the lateness of its appeal; stating that the late appeal cannot be entertained by the Board; and forwarding the application to the examining attorney for appropriate action with respect to the amendment.

NOTES:

1. *In re Hughes Furniture Industries, Inc.*, 114 USPQ2d 1134, 1135 (TTAB 2015) (applicant's seeking to comply with requirement for disclaimer constituted good cause).

2. *See, e.g., In re Thomas White International Ltd.*, 106 USPQ2d 1158, 1160 n.2 (TTAB 2013) ("at this late juncture applicant would not be able to show good cause" for a proposed amendment made in its appeal brief to expand the goods to cover related services after applicant previously deleted services from the application).

3. *See In re Big Pig Inc.*, 81 USPQ2d 1436, 1437-38 (TTAB 2006) (applicant's request for remand after filing of reply brief denied; because proposed claim of ownership of a registration was irrelevant, and clarification of the nature of its typed drawing was unnecessary, applicant failed to show good cause).

4. *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 n.2 (TTAB 2010).

1205.01(b)(2) Preferred Practices for Amending an Application during Appeal

Although the Board may entertain a request for remand to allow the examining attorney to consider a proposed amendment when the request for remand is filed before the Board issues a final decision, see TBMP § 1218. Recently in *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *1 (TTAB 2020), the Board clarified:

As a best practice, an applicant seeking to obviate a refusal by proposing an amendment to an application should propose the amendment as early as possible during prosecution. If that does not occur, then the Board strongly prefers that an applicant make such an amendment in a request for reconsideration filed soon after

the issuance of a final Office action but prior to the applicant's deadline for filing a notice of appeal. Doing so provides an opportunity for the issue to be addressed before the appeal stage. If an applicant has missed that opportunity, then the next preferred alternative is to file a separately captioned request for remand and suspension of proceedings with the Board, ideally prior to the deadline for filing an appeal brief, so that the Board can make a prompt ruling on the request and the examining attorney does not have to draft a potentially unnecessary appeal brief. If the Board decides to remand the application to the examining attorney, it will suspend the appeal for consideration by the examining attorney of an amendment which might obviate the refusal (and thus the appeal). Embedded amendments in an appeal brief are not prohibited but they are discouraged because they may be inadvertently overlooked by the Board before the Examining Attorney files a brief; if noticed, they may needlessly delay the proceeding. In instances such as this where the Examining Attorney does not consent to a proposed amendment embedded in a brief but objects, the Board typically treats the proposed amendment as a request for remand for further examination, and considers whether good cause has been shown.

However, occasionally an applicant fails to follow the preferred practices noted above and will include an amendment as part of its brief. If this amendment is noted by the Board (and frequently it will not be noted if it is not made by a separate submission), the Board will treat the proposed amendment as a request for remand, and consider whether good cause has been shown in determining the request. *See*TBMP § 1205.01(b)(1). If the Board does not note the request, but the examining attorney, upon reviewing applicant's appeal brief, considers the amendment and allows it, the amendment will be entered. In such a circumstance, the preferred practice is for the examining attorney to specifically state in their brief that the amendment is accepted. However, if the examining attorney makes no reference to the amendment and merely treats the application as having been amended, the Board will treat the amendment as having been accepted. [Note 1.] If the examining attorney, upon noting the proposed amendment in the applicant's brief, believes that the amendment raises a new issue or that further examination would be required as a result of the amendment, the examining attorney should contact the Board and advise that the brief contains an amendment that should be considered as a request for remand. *See*TBMP § 1205.01(a).

NOTES:

1. *See In re S. Malhotra & Co.*, 128 USPQ2d 1100, 1102 n.3 (TTAB 2018) (refusals to register based on requirements for translation and transliteration statements deemed moot because examining attorney suggested statements during prosecution, applicant accepted them in its brief, and the Board entered them); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1512 n.2 (TTAB 2001) (one ground for refusal was requirement for translation of mark; because applicant offered translation in appeal brief and examining attorney did not address the issue in his brief, Board treated requirement as moot).

1205.02 Request to Divide

An applicant may submit a request to divide the application to divide out goods or services within a class, or entire classes prior to, with, or after the filing of a notice of appeal. [Note 1.] An applicant may wish to submit such a request in a situation where a refusal to register or requirement applies only to certain classes in a multi-class application or to certain goods or services within a class in either a single-class or multi-class application. *See*TBMP § 1202.05.

Procedures for when a request to divide is filed within six months of the issuance of the appealed final refusal or requirement (i.e., prior to or with the notice of appeal) are discussed below. If a request to divide is submitted after an appeal is instituted, the request should be filed with the Board through ESTTA, rather than directed to the examining attorney or filed through the TEAS system. In ESTTA, the applicant should "identify paper" by checking the "Other Motions/Papers" box and identifying the paper as a request to

divide. The Board will determine whether to suspend action on the appeal and forward the application to the ITU/Divisional Unit, or defer the processing of the request to divide and continue proceedings in the appeal. Such a determination will be based on such factors as the reason for the request to divide (e.g., if the division will result in the withdrawal of the refusal as to certain of the classes) and the stage of the appeal.

Filing a request to divide with the Board must be through ESTTA. If ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form and must include a written explanation of such technical problems or extraordinary circumstances. [Note 2.]

NOTES:

1. See generally 37 C.F.R. § 2.87 and TMEP § 1110 regarding requests to divide.

2. *See* 37 C.F.R. § 2.126.

1205.02(a) Request to Divide When Notice of Appeal is Submitted Electronically

When an applicant submits a notice of appeal through ESTTA, and submits at the same time or has pending a request to divide, the applicant should not check the "request for reconsideration" box on the ESTTA form unless it has pending or is contemporaneously filing a request for reconsideration/amendment. The request to divide is not considered to be either a request for reconsideration or an amendment. The applicant should file the notice of appeal through ESTTA and the contemporaneously or previously filed request to divide through TEAS. The applicant will receive an electronically generated order instituting the appeal, and requesting the applicant to contact the Board paralegal to whom the application has been assigned so that appropriate action can be taken on the request to divide, depending on the circumstances. If the notice of appeal is limited to the classes which the applicant seeks to have divided out of the application, the appeal will be instituted for those classes, proceedings in the appeal will be suspended, and the Board will forward the application to the ITU/Divisional Unit of the Office for action on the request to divide. After the request to divide has been processed, the application for which no appeal has been filed will be forwarded to the examining attorney for appropriate action, while the application to which the appeal applies will be returned to the Board. The Board will then resume proceedings in the appeal with respect to that application, and allow the applicant 60 days in which to submit its appeal brief. If the notice of appeal applies to classes in each of the divided applications, both applications will be returned to the Board, which will resume proceedings in the appeal with respect to both applications, and allow the applicant 60 days in which to submit its appeal briefs. [Note 1.] The Board may also consolidate the appeals. *See*TBMP § 1214.

If the applicant has pending or is simultaneously filing a request for reconsideration/amendment with the request to divide and the notice of appeal, the applicant should check the appropriate box on the ESTTA form. The electronically generated order instituting the appeal will suspend proceedings in the appeal and remand the application to the examining attorney to consider both the request for reconsideration/amendment and the request to divide. The examining attorney will then forward the application and the request to divide to the ITU/Divisional Unit of the Office for action on the request to divide. After the request to divide has been processed the applications will be sent to the examining attorney, who will then decide the request for reconsideration/amendment in the same procedure that is followed for any request for reconsideration or amendment. *See*TBMP § 1204 and TBMP § 1205. If registrability is not found on the basis of these documents, the examining attorney will return to the Board the application or applications containing the class or classes for which the appeal has been instituted. As for the application containing the classes for which no timely appeal was filed, unless the examining attorney issues a new final action with respect to that application, the applicant may not subsequently submit a notice of appeal.

NOTES:

1. However, the applicant may not subsequently submit a notice of appeal for any classes for which it had not previously filed a timely notice of appeal.

1205.02(b) Request to Divide When Notice of Appeal is Submitted on Paper due to ESTTA Technical Problems or Extraordinary Circumstances

The following information applies in the rare circumstances when a notice of appeal is filed as a paper submission, because ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, and a request to divide is also filed. An applicant that files a request to divide or that has pending a request to divide at the time it files its notice of appeal should advise the Board of the request to divide in the notice of appeal.

If the applicant files with the notice of appeal or has pending at the time the appeal is filed only a request to divide, the Board will institute the appeal if the written explanation for paper filing is acceptable, suspend proceedings in it, and forward the application to the ITU/Divisional Unit of the Office for action on the request to divide. If the appeal applies to only one of the applications resulting from the division, then after the request to divide has been processed the application for which no appeal has been filed will be forwarded to the examining attorney for appropriate action, while the application to which the appeal applies will be returned to the Board. The Board will then resume proceedings in the appeal with respect to that application, and allow the applicant 60 days in which to submit its appeal brief. If the appeal applies to both applications, the Board will resume action in the appeals with respect to both applications. In the latter situation, the Board may consolidate the appeals.

If the applicant files a request to divide as well as a request for reconsideration/amendment with its notice of appeal (or if these requests are pending with the examining attorney at the time the notice of appeal is filed), the Board will institute the appeal if the written explanation for paper filing is acceptable, suspend proceedings in it, and remand the application to the examining attorney to arrange for processing of the request to divide and then to decide the request for reconsideration/amendment in the same procedure that is followed for any request for reconsideration or amendment. *See*TBMP § 1204 and TBMP § 1205. If registrability is not found on the basis of these documents, the examining attorney will return to the Board the application or applications containing the class or classes for which the appeal has been instituted. As for the application containing the class or classes for which no timely appeal was filed, unless the examining attorney issues a new final action with respect to that application, the applicant may not subsequently submit a notice of appeal.

1206 Amendment to Allege Use; Statement of Use

1206.01 Amendment to Allege Use

An amendment to allege use under Trademark Act § 1(c), 15 U.S.C. § 1051(c), may be filed in an intent-to-use application, i.e., an application under Trademark Act § 1(b), 15 U.S.C. § 1051(b), at any time between the filing of the application and the date the examining attorney approves the mark for publication. Thereafter, an allegation of use may be submitted only as a statement of use under Trademark Act § 1(d), 15 U.S.C. § 1051(d), after the issuance of a notice of allowance under Trademark Act § 13(b)(2), 15 U.S.C. § 1063(b)(2). [Note 1.] Thus, an amendment to allege use filed during the pendency of an ex parte appeal to the Board is timely. [Note 2.] As a result, an applicant with an intent-to-use based application that wishes to attempt to

overcome a refusal by amending its application to the Supplemental Register may, if use has commenced during the course of the appeal, file an amendment to allege use.

If an applicant that has filed an amendment to allege use during the six-month response period following issuance of a final action also files a timely appeal, and the examining attorney has not yet acted on the amendment to allege use when the appeal is filed, or if the applicant files an amendment to allege use along with the notice of appeal, the amendment to allege use will be handled by the Board in the same manner as any other amendment filed during the six-month response period following issuance of a final action. *See*TBMP § 1205.

When the notice of appeal is filed through ESTTA, the applicant should check the box stating that a request for reconsideration has been filed. *See*TBMP § 1202.03. If the applicant has not previously filed the amendment to allege use, at the same time it files its notice of appeal it should file the amendment to allege use through TEAS. The filing of the notice of appeal through ESTTA, coupled with the checking of the request for reconsideration box, will electronically generate an order instituting the appeal, suspending action on it, and remanding the application to the examining attorney to consider the amendment to allege use. Filing the notice of appeal via ESTTA is required. [Note 3.]

In the rare circumstances the applicant files its notice of appeal through a paper submission, because ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, it should indicate in the notice of appeal that it has pending, or is contemporaneously filing, an amendment to allege use. [Note 4.] If the written explanation for paper filing is acceptable, the Board will acknowledge receipt of the appeal and amendment to allege use, suspend further proceedings (including the applicant's time for filing its appeal brief) with respect to the appeal, and remand the application to the examining attorney for consideration of the amendment to allege use. The applicant should not file its appeal brief within sixty days of the filing of the notice of appeal, as provided by 37 C.F.R. § 2.142(b)(1), even if the Board has not issued its order suspending proceedings prior to the date the appeal brief would otherwise be due. Nor does the applicant need to verify with the Board that the due date for its brief will be changed if necessary. *See*TBMP § 1203.02(a).

If, in the course of examination of the amendment to allege use, the application is approved for publication (or for registration, in the case of an application amended to seek registration on the Supplemental Register), or becomes abandoned, the appeal will be moot. The examining attorney should so notify the applicant and the Board, by telephone or email. [Note 5.] If the examining attorney, after consideration of the amendment to allege use, adheres to the final refusal to register, or ultimately issues a new final refusal to register, which may include a refusal based on information in the amendment to allege use, the six-month response clause should be omitted from the paper; the application should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein. [Note 6.]

If an applicant that has filed a timely appeal to the Board files an amendment to allege use more than six months after issuance of the appealed action, the Board may, in its discretion, suspend proceedings with respect to the appeal and remand the application to the examining attorney for consideration of the amendment to allege use. Alternatively, the Board may continue proceedings with respect to the appeal, thus deferring examination of the amendment to allege use until after final determination of the appeal. If the final determination of the appeal is adverse to the applicant, the amendment to allege use will be moot.

NOTES:

1. *See* 37 C.F.R. § 2.76(a). *See also In re Sovran Financial Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1991).

2. *See* 37 C.F.R. § 2.76(a); TMEP § 1104.03 and TMEP § 1104.07.

3. *See* 37 C.F.R. § 2.126(a); *see also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD, 81 Fed. Reg. 69950, 69966 (October 7, 2016) ("The Office is amending § 2.126 to renumber paragraph (a) and (b) and to add new paragraph (a) to require that submissions to the Board must be made via ESTTA. The amendment codifies the use of electronic filing.").

4. *See* 37 C.F.R. § 2.126(b). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD, 81 Fed. Reg. 69950, 69966 (October 7, 2016) (discussing the procedure for paper filings). For information concerning examination by the examining attorney of an amendment to allege use filed in conjunction with a notice of appeal, see TMEP § 1104.07.

5. *See*TMEP § 1104.07.

6. *See*TMEP § 1104.07.

1206.02 Statement of Use

A statement of use under Trademark Act § 1(d), 15 U.S.C. § 1051(d), is premature if it is filed in an intent-to-use application, i.e., an application under Trademark Act § 1(b), 15 U.S.C. § 1051(b), prior to the issuance of a notice of allowance under Trademark Act § 13(b)(2), 15 U.S.C. § 1063(b)(2). [Note 1.]

A notice of allowance is not issued in an intent-to-use application (for which no amendment to allege use under Trademark Act § 1(c), 15 U.S.C. § 1051(c), has been timely filed and accepted) unless and until the application is approved for publication, and then published in the Official Gazette for opposition, and no timely opposition is filed or all oppositions filed are dismissed and no interference is declared. [Note 2.] *See*TBMP § 219.

Therefore, a statement of use filed during an ex parte appeal to the Board generally is premature. A premature statement of use will not be considered. [Note 3.] Instead, the premature statement of use will be returned to the applicant and the fee will be refunded.

NOTES:

1. *See* 37 C.F.R. § 2.88(a).

2. *See* Trademark Act § 13(b)(2), 15 U.S.C. § 1063; 37 C.F.R. § 2.81(b); TMEP § 1109.04.

3. *See* 37 C.F.R. § 2.88(a).

1207 Submission of Evidence During Appeal

1207.01 General Rule — Evidence Submitted After Appeal Untimely

37 C.F.R. § 2.142(d) *The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal. If the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney should submit a request to the Board to suspend the appeal and to remand the application for further examination.*

The evidentiary record in an application should be complete prior to the filing of an ex parte appeal to the Board. [Note 1.] *See*TBMP § 1203.02(e).

However, if the applicant or the examining attorney submits excerpts from articles during examination, the nonoffering party may submit the complete article, even if such submission is made after the appeal is filed. [Note 2.] If the nonoffering party wishes to have the entire article considered, the better practice is to submit the article with a request for remand. However, because the party submitting the excerpt of the article had the opportunity to review the entire article, if the article is submitted with an appeal brief, the Board need not remand the application, and may instead consider the article as part of the record. [Note 3.] *See also*TBMP § 1208.01.

If evidence that was previously unavailable comes to the applicant's or examining attorney's attention after an appeal is filed, the proper procedure is to submit a request to the Board to suspend the appeal and remand the application. [Note 4.] *See*TBMP § 1209.02 and TBMP § 1209.04.

NOTES:

1. 37 C.F.R. § 2.142(d). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is amending § 2.142(d) to clarify that evidence should not be filed with the Board after a notice of appeal is filed. The amendment more directly states the prohibition.").

For decisions issued in 2000 and after, see also *In re James S. Fallon*, 2020 USPQ2d 11249, at *2 (TTAB 2020) (applicant's submission of a patent drawing with its appeal brief was untimely and therefore not considered); *In re tapio GmbH*, 2020 USPQ2d 11387, at *3 (TTAB 2020) (Board sustained the examining attorney's objection and declined to consider the Internet screen shots embedded in applicant's brief, Internet exhibit and declarations attached to brief); *In re ADCO Industries – Technologies, L.P.*, 2020 USPQ2d 53786, at *2 (TTAB 2020) (evidence submitted for the first time in supplemental trial brief not considered); *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767 (TTAB 2016) (copy of patent excerpt submitted with appeal brief not considered); *In re Fiat Group Marketing & Corporate Communications S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014) (examining attorney's objection to applicant's submission of registrations with appeal brief sustained); *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013) (copies of documents pertaining to district court litigation submitted with applicant's appeal brief not considered); *In re Midwest Gaming & Entertainment LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (new evidence submitted with reply brief is "untimely and therefore not part of the record for this case"); *In re HSB Solomon Associates LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) (printouts submitted with reply brief not considered); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (exhibits attached to applicant's supplemental brief not considered; noted that evidence could have been submitted during the period of further examination after remand); *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147-48 (TTAB 2011) (materials submitted with reply brief, after two requests for remand were denied, were not of record and, because reply brief discussed materials at length, reply brief also not considered); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1990-91 (TTAB 2011) (documents from file of cited registration submitted with applicant's appeal brief are late-filed and not considered; examining attorney's objection sustained); *In re Van Valkenburgh*, 97 USPQ2d 1757, 1768 n.32, 1769 (TTAB 2011) (applicant has responsibility to make sure that the record is complete prior to filing a notice of appeal); *In re Trans Continental Records Inc.*, 62 USPQ2d 1541, 1541 n.2 (TTAB 2002) (materials from web search engines submitted with appeal brief not considered); *In re Lamb-Weston Inc.*, 54 USPQ2d 1190, 1191 n.2 (TTAB 2000).

For decisions issued prior to 2000, see also *In re Psygnosis Ltd.*, 51 USPQ2d 1594 (TTAB 1999); *In re Posthuma*, 45 USPQ2d 2011, 2012 n.2 (TTAB 1998) (third-party registration attached to appeal brief not

considered); *In re Wada*, 48 USPQ2d 1689 n.2 (TTAB 1998) (evidence submitted with reply brief not considered), *aff'd*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); *In re L.C. Licensing Inc.*, 49 USPQ2d 1379, n.3 (TTAB 1998) (third-party registrations first submitted with appeal brief not considered); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 (TTAB 1997) (new material attached to appeal and reply briefs, and submitted at oral hearing and subsequent to hearing untimely and not considered); *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992); *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1756 n.9 (TTAB 1991); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882, 1884 n.5 (TTAB 1988); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224, 1226 n.2 (TTAB 1987); *In re Gold's Gym Enterprises Inc.*, 3 USPQ2d 1716 n.2 (TTAB 1987); *In re International Environmental Corp.*, 230 USPQ 688, 690 (TTAB 1986); *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1348 (TTAB 1984); *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, 223 USPQ 363 n.3 (TTAB 1984); *In re Carvel Corp.*, 223 USPQ 65, 66 (TTAB 1984); *In re Jos. Schlitz Brewing Co.*, 223 USPQ 45, 46 n.1 (TTAB 1983); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827 n.1 (TTAB 1984); *In re Jeep Corp.*, 222 USPQ 333, 336 n.3 (TTAB 1984); *In re Pierre Fabre S.A.*, 221 USPQ 1210, 1212 n.2 (TTAB 1984); *In re Development Dimensions International, Inc.*, 219 USPQ 161, 162 n.2 (TTAB 1983); *In re Gagliardi Brothers, Inc.*, 218 USPQ 181, 183 (TTAB 1983); *In re Royal Viking Line A/S*, 216 USPQ 795, 797 n.3 (TTAB 1982).

Cf. In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986); *In re Volvo White Truck Corp.*, 16 USPQ2d 1417, 1419 n.4 (TTAB 1990).

2. *See In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986) (if only a portion of an article is submitted, that portion is not thereby insulated from the context from whence it came).

3. *But see In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1597-98 (TTAB 1999) (if, after appeal, an applicant attempts to submit a full printout of articles from the NEXIS database which were revealed in an examining attorney's search, but which were not introduced by the examining attorney, such articles are considered to be additional evidence and therefore untimely).

4. 37 C.F.R. § 2.142(d); *see* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is further amending § 2.142(d) for clarity, including by specifying that an appellant or examining attorney who desires to introduce additional evidence after an appeal is filed should submit a request to the Board to suspend the appeal and remand the application for further examination."); *see also In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1244 n.4 (TTAB 2010) (registration that issued after notice of appeal and submitted with appeal brief not considered, applicant could have filed a request for remand).

1207.02 Request to Remand for Additional Evidence

If an applicant or examining attorney wishes to introduce additional evidence after an appeal has been filed, the applicant or examining attorney may file a written request with the Board to suspend the appeal and remand the application for further examination. [Note 1.]

A request under 37 C.F.R. § 2.142(d) to suspend and remand for additional evidence must be filed prior to the rendering of the Board's final decision on the appeal. [Note 2.] In addition, the request must include a showing of good cause therefor (which may take the form of a satisfactory explanation as to why the evidence was not filed prior to appeal), and be accompanied by the additional evidence sought to be introduced. [Note 3.] The length of the delay in making the request after the reason for the remand becomes known, or the point in the appeal process at which the request for remand is made, will be considered in the determination of whether good cause exists. Generally, the later in the appeal proceeding that the request for remand is filed, the stronger the reason that must be given for good cause to be found. [Note 4.]

Examples of circumstances that have been found to constitute good cause for a remand for additional evidence include the following:

(1) The evidence was not previously available. [Note 5.] Even if the evidence was not previously available, good cause may not be found if the newly available evidence is merely cumulative in nature. Thus, if the examining attorney requests remand in order to submit an article which was published subsequent to the filing of the appeal, but which is of substantially the same nature as articles previously made of record, the request may be denied. Nor can the examining attorney use the subsequent publication of a single article to make of record articles which were previously available. Similarly, if the applicant requests remand to make of record its most recent monthly sales or advertising figures in support of a Trademark Act § 2(f), 15 U.S.C. § 1052(f), claim, the request may be denied. There is a point at which prosecution or examination must come to an end.

(2) A new attorney for the applicant, or a new examining attorney, has taken over the case and wishes to supplement the evidence of record. The transfer of a case from one firm member to another is not considered by the Board to constitute good cause for a remand under the "new attorney" rationale. However, the transfer of the case from in-house counsel to an outside firm is treated as a new attorney taking over the case. Similarly, a different examining attorney being assigned the application is treated as a new attorney taking over the case.

(3) The applicant and examining attorney have agreed to the remand. [Note 6.]

In addition, because a consent agreement offered in response to a refusal to register under Trademark Act § 2(d), 15 U.S.C. § 1052(d), is inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability [Note 7], the Board will grant a request to suspend and remand for consideration of a consent agreement if the request, accompanied by the consent agreement, is filed at any time prior to the rendering of the Board's final decision on the appeal.

If a request to remand for additional evidence is granted, the nonrequesting party may submit additional evidence in response to the evidence submitted with the request. [Note 8.] However, depending on the stage of the appeal, the Board may direct that any responsive evidence be submitted with a supplemental brief. [Note 9.]

When an applicant's request to suspend and remand for additional evidence is granted, and the application is remanded to the examining attorney for further examination, the examining attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), or adhere to the action from which the appeal was taken. The examining attorney may also issue a new nonfinal action asserting any new refusal or requirement necessitated by the new evidence. The examining attorney may not, however, assert a new refusal or requirement unrelated to the new evidence unless the examining attorney files with the Board a request under 37 C.F.R. § 2.142(f)(6) for remand to assert the new refusal or requirement, and the request is granted. If the examining attorney is persuaded, on the basis of the new evidence, that the applicant is entitled to the registration sought, and approves the application for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. The applicant will receive notification that the application has been approved for publication when the Office issues a computer-generated notice of publication; in addition, the applicant may ascertain the status of the application by checking the TSDR database. If the examining attorney, after consideration of the new evidence, adheres to the final refusal to register, or ultimately issues a new final refusal to register, the six-month response clause should be omitted; the application should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein.

When an examining attorney's request to suspend and remand for additional evidence is granted, the Board, in its action granting the request, will allow the examining attorney time in which to issue an Office action

relating to the new evidence to be submitted therewith and, depending on the circumstances, will either direct the examining attorney to issue a nonfinal action so that the applicant can respond with argument and evidence, or to issue an Office action omitting the six-month response clause and return the application to the Board. If the applicant's appeal brief has already been filed, applicant will be allowed an opportunity, if it so desires, to file a supplemental brief directed to the new evidence submitted by the examining attorney.

For more information about requests for remand by examining attorneys, see TMEP § 1209.02. For more information about requests for remand by applicants, see TBMP § 1209.04.

NOTES:

1. *See* 37 C.F.R. § 2.142(d). *See also In re Information Builders Inc.*, 2020 USPQ2d 10444, at *3 n.5 (TTAB 2020) ("To the extent Applicant wished to introduce additional evidence after its appeal had been filed, Applicant should have filed a written request with the Board to suspend the appeal and remand the application for further examination pursuant to Trademark Rule 2.142(d)"); *In re tapio GmbH*, 2020 USPQ2d 11387, at *3-4 n.11 (TTAB 2020); *In re James S. Fallon*, 2020 USPQ2d 11249, at *2 (TTAB 2020); *In re I-Coat Co.*, 126 USPQ2d 1730, 1734 n.15 (TTAB 2018); *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1696 (TTAB 1992); *In re Wells Fargo & Co.*, 231 USPQ 95, 101 n.24 (TTAB 1986); *In re Big Wrangler Steak House, Inc.*, 230 USPQ 634, 635 n.4 (TTAB 1986); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 766 n.6 (TTAB 1986); *In re Chung, Jeanne & Kim Co.*, 226 USPQ 938, 940 n.6 (TTAB 1985); *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1348 (TTAB 1984); *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, 223 USPQ 363 n.3 (TTAB 1984); *In re Carvel Corp.*, 223 USPQ 65, 66 (TTAB 1984); *In re Jos. Schlitz Brewing Co.*, 223 USPQ 45, 46 n.1 (TTAB 1983); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827 n.1 (TTAB 1984); *In re Jeep Corp.*, 222 USPQ 333, 336 n.3 (TTAB 1984); *In re Consolidated Foods Corp.*, 218 USPQ 184, 186 n.2 (TTAB 1983); *In re Royal Viking Line A/S*, 216 USPQ 795, 797 n.3 (TTAB 1982). *See also In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767 (TTAB 2016) (request for remand under 37 C.F.R. § 2.142(d) is appropriate procedure; 37 C.F.R. § 2.122(e) for inter partes proceedings is inapplicable).

2. *See In re Johanna Farms, Inc.*, 223 USPQ 459, 460 (TTAB 1984); *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984).

3. *See In re Adlon Brand Gmbh & Co.*, 120 USPQ2d 1717, 1725 (TTAB 2016) (applicant's request for remand, included in applicant's brief, denied, explaining that proper procedure "was to file with the Board, after the filing of the appeal but before briefing, a request for remand with a showing of good cause."); *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147 (TTAB 2011) (applicant's request for remand denied for failure to show good cause); *In re Big Wrangler Steak House, Inc.*, 230 USPQ 634, 635 n.4 (TTAB 1986); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986); *In re Chung, Jeanne & Kim Co.*, 226 USPQ 938, 940 n.6 (TTAB 1985); *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1348 (TTAB 1984); *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, 223 USPQ 363, 636 n.3 (TTAB 1984); *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984); and *In re Historic Wharf's Associates, Inc.*, 222 USPQ 92, 93 n.1 (TTAB 1984).

4. *See In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147 (TTAB 2011) (denial of request for remand made after appeal briefs filed); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1334 (TTAB 2009) (request for remand denied for failure to show good cause so late in the appeal). *See also In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1756 n.9 (TTAB 1991).

5. *See In re Zanova Inc.*, 59 USPQ2d 1300, 1302 (TTAB 2001); *In re Central Sprinkler Co.*, 49 USPQ2d 1194 n.2 (TTAB 1998) (applicant's request for remand made in its appeal brief in order to allow examining

attorney to consider additional third-party registrations denied because such evidence could have been submitted earlier in the prosecution).

6. *See, e.g., In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at *1 & n.3 (TTAB 2020) (Board sua sponte remanded applications to the examining attorney to consider evidence submitted by applicant with its reply brief because the evidence was responsive to a previous Rule 2.61 request for information by the examining attorney, and applicant submitted it with the examining attorney's asserted consent).

7. *See, e.g., In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969, 970 (Fed. Cir. 1985); *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973).

8. *See In re Northland Aluminum Products, Inc.*, 221 USPQ 1110, 1112 (TTAB 1984), *aff'd*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). *Cf. In re Development Dimensions International, Inc.*, 219 USPQ 161, 162 (TTAB 1983).

9. *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 n.2 (TTAB 2010).

1207.03 Evidence Considered Due to Actions of Nonoffering Party

Evidence submitted after appeal, without a granted request to suspend and remand for additional evidence, *see*TBMP § 1207.02, may be considered by the Board, despite its untimeliness, if the nonoffering party (1) does not object to the new evidence, and (2) discusses the new evidence or otherwise affirmatively treats it as being of record. [Note 1.] In such a situation, the Board may consider evidence submitted by the nonoffering party to rebut the untimely evidence. [Note 2.]

Third-party registrations may not be made of record by merely listing them in response to an Office Action. "It is well-established that in order to make third-party registrations properly of record, 'applicant should submit copies of the registrations themselves, or the electronic equivalent thereof' from the USPTO's electronic databases. ..." [Note 3.]

If the applicant, during the prosecution of the application, provided a listing of third-party registrations, without also submitting actual copies of the registrations, and the examining attorney did not object or otherwise advise the applicant that a listing is insufficient to make such registrations of record at a point when the applicant could cure the insufficiency, the examining attorney will be deemed to have waived any objection as to the admissibility of the list. [Note 4.] See TBMP § 1208.02 regarding third-party registrations, including discussion of evidentiary value of such listings.

NOTES:

1. *See, e.g., In re MK Diamond Products, Inc.*, 2020 USPQ2d 10882, at *1 n.5 (TTAB 2020) (Board treated registration as of record because applicant submitted substantial portions of the registration's file history as a basis for argument throughout prosecution, and the examining attorney addressed the registration the office actions and brief, and did not object to its discussion); *In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (because the examining attorney addressed applicant's registrations in her brief and neither objected to the discussion of the other, Board treated both registrations as though they were of record); *In re Sadoru Group Ltd.*, 105 USPQ2d 1484, 1485, 1489 n.6 (TTAB 2012) (examining attorney stated she did not object to consideration of untimely evidence accompanying applicant's brief); *In re Heeb Media LLC*, 89 USPQ2d 1071, 1072 (TTAB 2008) (examining attorney pointed out untimeliness of evidence attached to applicant's brief, but considered it and relied on it, and therefore Board treated it as of record); *In re*

Litehouse Inc., 82 USPQ2d 1471, 1475 n.2 (TTAB 2007) (third-party registrations submitted for first time with applicant's appeal brief considered because examining attorney did not object in her brief and instead presented arguments in rebuttal of this evidence); *In re Homeland Vinyl Products Inc.*, 81 USPQ2d 1378, 1381 n.5 (TTAB 2006) (declarations submitted for first time with applicant's appeal brief treated of record because examining attorney did not object and addressed the evidence on the merits); *In re Rodale Inc.*, 80 USPQ2d 1696, 1699 n.4 (TTAB 2006) (Board considered summary of applicant's prior registrations presented for the first time in its appeal brief because the examining attorney did not object and also presented substantive arguments regarding the registrations); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372 (TTAB 2006) (examining attorney, after noting that evidence submitted with applicant's appeal brief was untimely, specifically stated in her brief that she did not object to it); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 n.5 (TTAB 2001) ("evidence" of sales mentioned for first time in applicant's brief and thus not timely submitted, but because in her brief examining attorney treated the information as though of record, Board did also); *In re Urbano*, 51 USPQ2d 1776, 1778 n.4 (TTAB 1999) (third-party registrations submitted with examining attorney's brief considered of record because applicant did not object and discussed the evidence on its merits in reply brief); *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1756 n.9 (TTAB 1991); *In re Nuclear Research Corp.*, 16 USPQ2d 1316, 1317 n.2 (TTAB 1990); *In re Dana Corp.*, 12 USPQ2d 1748, 1749 n.8 (TTAB 1989); *In re Pencils Inc.*, 9 USPQ2d 1410, 1411 (TTAB 1988).

See also In re Wells Fargo & Co., 231 USPQ 95, 101 n.24 (TTAB 1986); *In re Weather Channel, Inc.*, 229 USPQ 854 n.3 (TTAB 1985); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 766 n.6 (TTAB 1986); *In re Cotter & Co.*, 228 USPQ 202, 204 n.2 (TTAB 1985); *In re Chung, Jeanne & Kim Co.*, 226 USPQ 938, 946 n.6 (TTAB 1985); *In re Bee Pollen From England Ltd.*, 219 USPQ 163, 165 n.4 (TTAB 1983); *In re Development Dimensions International, Inc.*, 219 USPQ 161 n.2 (TTAB 1983).

2. *See In re Development Dimensions International, Inc.*, 219 USPQ 161 (TTAB 1983).

3. *In re City of Houston*, 101 USPQ2d 1534, 1536 n.5 (TTAB 2012) (evidentiary submissions "should be made prior to appeal or, if after appeal, pursuant to a remand of the matter to the examining attorney for further examination. Trademark Rule 2.142(d).") (quoting *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996) (citing *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994)), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013).

4. *See In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012) ("[T]he examining attorney's failure to advise applicant of the insufficiency of the list of registrations when it was proffered during examination constituted a waiver of any objection to consideration of that list. Accordingly, we will consider the ... list of registrations ... 'for whatever limited probative value such evidence may have,'" (citing *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001))), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013). *See also In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298, at *4 n.17 (TTAB 2020) (because the examining attorney failed to object during prosecution to applicant's improper listing of registrations, which would have allowed applicant to cure the deficiency, Board deemed the objection waived on appeal); *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (although applicant first submitted a copy of its own registration with its appeal brief, Board viewed examining attorney as having treated registration of record because applicant referenced it in argument made in two responses during prosecution and examining attorney addressed the argument and therefore considered the registration; nor did examining attorney object to the registration as untimely filed); *In re Hayes*, 62 USPQ2d 1443, 1445 n.3 (TTAB 2002) (Board considered third-party registrations submitted with reply brief because applicant had submitted copies of Official Gazettes showing marks published for opposition during prosecution, and examining attorney did not advise applicant that copies of the registrations were necessary to make them of record); *In re Boyd Gaming Corp.*, 57 USPQ2d 1944, 1945 n.4 (TTAB 2000). *Cf. In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1314-15 n.3 (TTAB 2011) (examining attorney was not required

to advise applicant that reference to a third-party registration was insufficient to make such registration of record when reference was made for the first time in a request for reconsideration which was denied).

1207.04 Evidence Filed with Timely Request for Reconsideration

A timely request for reconsideration of an appealed action may be accompanied by additional evidence, which will thereby be made part of the evidentiary record in the application. [Note 1.] There is no need, in such a situation, for a 37 C.F.R. § 2.142(d) request to suspend and remand for additional evidence. Evidence submitted with a timely request for reconsideration of an appealed action, that is, a request filed during the six-month response period following issuance of the appealed action, is considered by the Board to have been filed prior to appeal, even if the notice of appeal was, in fact, filed earlier in the six-month response period than the request for reconsideration. *See*TBMP § 1204. However, if the applicant has already filed a brief, then the Board will treat the request for reconsideration as a request for remand for which good cause must be shown, even if the request for reconsideration is filed within six months of the final Office action. [Note 2.] *See*TBMP § 1204.

When a timely request for reconsideration of an appealed action is filed (with or without new evidence), the examining attorney may submit, with their response to the request, new evidence directed to the issue(s) for which reconsideration is sought. [Note 3.] However, the applicant may not submit additional evidence in response to any evidence submitted by the examining attorney unless the examining attorney's action is a nonfinal action to which a response may be filed. Otherwise, if the applicant wishes to submit additional evidence, it must file a request for remand. [Note 4.] *See*TBMP § 1207.01 and TBMP § 1207.02. This is the case even if the response is filed within six months of the final Office action. If the examining attorney denies a request for reconsideration after a notice of appeal is filed, a second request for reconsideration will be treated as a request for remand even if it is filed within six months of the final Office action. *See*TBMP § 1204, TBMP § 1207.02 and TBMP § 1209.04.

NOTES:

1. *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1334 (TTAB 2009).

2. *See also* TMEP § 715.04(b).

3. *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1201 (TTAB 2009) (evidence submitted in response to request for reconsideration that is filed with notice of appeal is part of the application record); *In re Giger*, 78 USPQ 1405, 1406-07 (TTAB 2006). *See also In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767 (TTAB 2016) (may submit evidence in a request for reconsideration to a "subsequent final refusal").

4. *See* 37 C.F.R. § 2.142(d); *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 (TTAB 2010).

1207.05 Submission of Evidence upon Remand for New Refusal

Additional evidence may be submitted, both by the examining attorney and by the applicant, if (1) an appealed application is remanded by the Board for further examination under 37 C.F.R. § 2.142(f)(1) (i.e., a sua sponte remand by the Board when it appears to the Board that an issue not previously raised may render the mark of the applicant unregistrable), *see* TBMP § 1209.01, or under 37 C.F.R. § 2.142(f)(6) (i.e., a remand by the Board upon written request by the examining attorney when it appears to the examining attorney that an issue not involved in the appeal may render the mark of the applicant unregistrable), *see*TBMP § 1209.02, and (2) the examining attorney, upon remand, does, in fact, issue a new refusal to register or a new

requirement. [Note 1.] If no new refusal or requirement is made, and the examining attorney instead returns the application to the Board, no additional evidence may be submitted. [Note 2.]

NOTES:

1. *See In re Yarnell Ice Cream*, 2019 USPQ2d 265039, at *3 (TTAB 2019) (Board sua sponte remanded application to the Examining Attorney to consider the presence of the word "Applicant's" in amended identification of goods); *In re Bank America Corp.*, 229 USPQ 852, 853 n.4 (TTAB 1986).

2. *See In re Diet Tabs, Inc.*, 231 USPQ 587, 588 n.3 (TTAB 1986).

1207.06 Letter of Protest Evidence

A third party that has objective evidence bearing upon the registrability of a mark in a pending application may bring such evidence to the attention of the Office by filing, with the Office of the Deputy Commissioner for Trademark Examination Policy, a "letter of protest" that complies with the requirements of 37 C.F.R. § 2.149. [Note 1.] The Deputy Commissioner will determine if the submission complies with the requirements of Trademark Rule 2.149 and whether any submitted evidence should be included in the application record for consideration by the examining attorney. *See*TBMP § 215. During prosecution, evidence included in the application record as a result of the letter of protest procedure and relied upon by the Examining Attorney or submitted with any Office action will be considered by the Board as evidence of record. . [Note 2.] If the examining attorney issues an Office action that includes any materials submitted with the letter of protest, that material becomes part of the record of the application for appeal. *See*TBMP § 1207.06.

Proceedings in an ex parte appeal will not be suspended pending determination by the Deputy Commissioner of a letter of protest. However, if the Deputy Commissioner determines that the letter of protest submission complies with the requirements of Rule 2.149 and includes submitted evidence in the application record, and the examining attorney wishes to rely on the evidence to support the appealed refusal of registration and have it made of record in the appeal, the examining attorney may file a written request with the Board, pursuant to 37 C.F.R. § 2.142(d), to suspend the appeal and remand the application for further examination. *See*TBMP § 1207.02 for information concerning a request for remand for additional evidence.

The request must be filed prior to the rendering of the Board's final decision on the appeal, and must be accompanied by the additional evidence included in the record as a result of the letter of protest procedure that is sought to be relied upon. *See*TBMP § 1207.02. In addition, the request must include a showing of good cause therefor, in the same manner as any other request to remand for additional evidence. *See*TBMP § 1207.02 for information concerning good cause for a remand for additional evidence.

Evidentiary value of material submitted by a third party through the letter of protest procedure will depend on whether it meets evidentiary requirements for authentication or foundation, identified as to nature or source. [Note 3.]

NOTES:

1. *See*TMEP § 1715 *et seq.*

2. *See In re Information Builders Inc.*, 2020 USPQ2d 10444, at *5 n.11 (TTAB 2020) (evidence submitted with the Letter of Protest Memorandum and relied upon by the examining attorney was properly of record).

3. *See In re Information Builders Inc.*, 2020 USPQ2d 10444, at *5 n.11 (TTAB 2020) ("…the evidence submitted with the Letter of Protest Memorandum does not carry any more weight than the other evidence submitted during prosecution. … we have considered each piece of evidence, including the evidence submitted with the Letter of Protest Memorandum, for whatever probative value it merits."); *In re Urbano*, 51 USPQ2d 1776, 1778-79 and 1778 n.5 (TTAB 1999) (documents submitted in connection with the letter of protest were of limited evidentiary value because no affidavits or other evidence establishing foundation, and no information establishing authenticity or source).

1208 Treatment of Evidence

The Board generally takes a somewhat more permissive stance with respect to the admissibility and probative value of evidence in an ex parte proceeding than it does in an inter partes proceeding. [Note 1.] That is, in an ex parte proceeding the Board tolerates some relaxation of the technical requirements for evidence and focuses instead on the spirit and essence of the rules of evidence. [Note 2.]

For example, the Board may be somewhat more lenient in its approach in the consideration of surveys in ex parte proceedings than inter partes proceedings. [Note 3.] Also, the affidavit or 37 C.F.R. § 2.20 declaration is an established method for the introduction of evidence in an ex parte proceeding without the option of cross examination. [Note 4.] In an inter partes proceeding, however, evidence offered in affidavit or 37 C.F.R. § 2.20 declaration form must be in conformance with the Federal Rules of Evidence and is subject to the right of any adverse party to elect and take cross examination of that witness. [Note 5.] TBMP § 703 (Taking and Introducing Testimony).

It is the better practice to provide evidence as to sales figures and the like by affidavit or declaration. However, representations by the applicant's counsel may, in certain circumstances, be accepted. [Note 6.] Affidavits or declarations may have probative value even if they are form documents, or are prepared by the applicant's attorney. [Note 7.] Affidavits or declarations also may have probative value even if they lack corroboration. [Note 8.]

However, while the evidentiary requirements in an ex parte record are less formal than in an inter partes context, documents submitted by a third party by letter of protest must still comply with inter partes evidentiary requirements of foundation and authentication to have evidentiary value. [Note 9.] Similar to inter partes proceedings, in an ex parte appeal, evidence properly made of record may be cited by either the examining attorney or by the applicant for any permissible purpose. [Note 10.]

For information as to how the Court of Appeals for the Federal Circuit, in reviewing a decision of the Board on an ex parte appeal, evaluates the sufficiency of the evidence offered by the examining attorney, see the cases cited in the note below. [Note 11.]

NOTES:

1. *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1597 (TTAB 2018; *In re Sela Products LLC*, 107 USPQ2d 1580, 1584 (TTAB 2013) ("…the Board does not, in ex parte appeals, strictly apply the Federal Rules of Evidence, as it does in inter partes proceedings.").

2. *See In re Hudson News Co.*, 39 USPQ2d 1915, 1920 n.10, 1924 n.18 (TTAB 1996), *aff'd without opinion* (Fed. Cir. 1997) (Board allowed NEXIS evidence to show psychological effect of color blue, despite hearsay nature, recognizing the difficulty for examining attorney to establish such fact without relying on NEXIS evidence; Board also accepted sufficiency of evidence showing features of applicant's trade dress were

common, recognizing that USPTO's limited resources constrain an examining attorney's ability to acquire photographs of interiors of retail establishments); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996); *In re Murphy Door Bed Co.*, 223 USPQ 1030, 1032 n.9 (TTAB 1984). *See also In re Berman Brothers Harlem Furniture Inc.*, 26 USPQ2d 1514, 1515 (TTAB 1993).

3. *Compare In re General Mills IP Holdings II, LLC*, 124 USPQ2d 1016 (TTAB 2017) and *In re Country Music Association Inc.*, 100 USPQ2d 1824 (TTAB 2011) *with In re Wilcher Corp.*, 40 USPQ2d 1929, 1934 (TTAB 1996); *In re Pillsbury Co.*, 174 USPQ 318, 320 (TTAB 1972).

4. *See, e.g.*, 37 C.F.R. § 2.41(b); *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1597 (TTAB 2018); *In re Manco Inc.*, 24 USPQ2d 1938, 1941 n.8 (TTAB 1992); *In re Bauhaus Designs Canada Ltd.*, 12 USPQ2d 2001, 2004 (TTAB 1989); *In re Motorola, Inc.*, 3 USPQ2d 1142, 1143 (TTAB 1986); *In re Peterson Manufacturing Co.*, 229 USPQ 466, 468 (TTAB 1986); *In re Melville Corp.*, 228 USPQ 970, 972 (TTAB 1986); *In re Gammon Reel, Inc.*, 227 USPQ 729, 731 (TTAB 1985); *In re Original Red Plate Co.*, 223 USPQ 836, 838 (TTAB 1984).

5. *See* 37 C.F.R. § 2.123(a)(1).

6. *See In re Pitney Bowes, Inc.*, 125 USPQ2d 1417, 1420 (TTAB 2018) (Board considered response to Office action signed by applicant's in-house counsel because response clarified the specimen's direct reference to the services that were at issue); *In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1276 (TTAB 2016) (although it is preferable for applicant to submit information in affidavit or declaration form with supporting documentation, Board considered representations of counsel because of supporting documentary evidence in the record); *In re First Craft Inc.*, 76 USPQ2d 1183, 1185 n.3 (TTAB 2005) (although it is better practice to present information in affidavit or declaration form with supporting documentation, Board considered representations by applicant's counsel because examining attorney did not object to their form and representations not contradicted by anything in the record); *In re EBSCO Industries Inc.*, 41 USPQ2d 1917, 1923 n.5 (TTAB 1997) (examining attorney never objected to attorney's representations, and figures not contradicted by other information). *Compare In re Teledyne Indus., Inc.*, 696 F.2d 968, 217 USPQ 9, 11 (Fed. Cir. 1982); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1466 n.11 (TTAB 2017) (the unsworn statement of applicant's counsel in an Office action response regarding the complexity and manufacturing cost of a VAWT design not considered); *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2007-08 (TTAB 2013) (disregarding outside counsel's conclusory unverified statements regarding marketing of goods).

7. *See In re Hotels.com, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532, 1536 (Fed. Cir. 2009) (use of same words in 64 form declarations submitted to show a widely held view "does not eliminate all value of the evidence"); *In re Data Packaging Corp.*, 453 F.2d 1300, 172 USPQ 396, 399 (CCPA 1972) (fact that affidavits were drafted by applicant's attorney and were practically identical in wording detracts little or nothing from their sufficiency to make out a prima facie case of trademark recognition); *In re Pingel Enterprise Inc.*, 46 USPQ2d 1811, 1822 n.15 (TTAB 1998) (fact that applicant's attorney assisted consumers in preparing statements--form letters--to show acquired distinctiveness does not make the submissions less honest or valid).

But see In re Lorillard Licensing Co., 99 USPQ2d 1312, 1318-20 (TTAB 2011) (Board did not find more that 6500 form declarations from "customers" and more than 4100 form declarations from dealers very probative of applicant's claim of acquired distinctiveness); *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1984 (TTAB 2009) (Board viewed four form declarations with skepticism because they were contradicted by the weight of the record); *In re Audio Book Club Inc.*, 52 USPQ2d 1042, 1047 (TTAB 1999) (fact that 49 form letters were couched in legal terms and presumably drafted by applicant's counsel raises some questions as

to whether signers understood the legal import of their statements); *In re Benetton Group S.p.A.*, 48 USPQ2d 1214, 1217 (TTAB 1998) (form statements that do not provide basic background information about the declarants and their experience with applicant have limited probative value); *In re EBSCO Industries Inc.*, 41 USPQ2d 1917, 1923 n.5 (TTAB 1997) (declarations deserve little weight because there are questions as to whether they reflect views of the declarants since declarants filled in only their names and addresses in forms, and declarants failed to notice that drawing was missing from the declaration when the focus of the declaration was the configuration shown in the drawing). *See also In re Pharmavite LLC*, 91 USPQ2d 1778, 1782 (TTAB 2009) (conclusory statements in declaration that design functions as a mark, without evidentiary support, insufficient); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1649 (TTAB 2008) (declarations offering nothing more than conclusory statement, without reasons, not persuasive).

8. *See In re American Cruise Lines, Inc.*, 128 USPQ2d 1157, 1159-60 (TTAB 2018) (statements in the declaration of applicant's officer and statements in the consent agreement did not need to be corroborated by additional evidence). *See also In re Farrenkopf*, 713 F.2d 714, 219 USPQ 1, 6 (Fed. Cir. 1983) (an affidavit is a competent form of evidence in ex parte proceedings before the PTO to the extent that it refers to matters known to or observed by the affiant); *In re Clarke*, 356 F.2d 987, 148 USPQ 665, 668 & n.3 (CCPA 1966) (it is legally erroneous to label an affidavit on relevant facts "incompetent" on the basis that it is self-serving and uncorroborated, although those two circumstances may go to its weight).

9. *See In re Urbano*, 51 USPQ2d 1776, 1779 n.6 (TTAB 1999) (affidavit should have been submitted to identify and authenticate documents that are not clearly identified as to nature or source and are not self-authenticating).

10. *In re Guild Mortgage Co.*, 2020 USPQ2d 10279, at *10 n.4 (TTAB 2020) (Board clarified that in ex parte proceedings, evidence properly made of record may be cited by either the examining attorney or by the applicant for any permissible purpose).

11. *In re Budge Manufacturing Co.*, 857 F.2d 773, 8 USPQ2d 1259, 1261 (Fed. Cir. 1988) (Court, being mindful that the USPTO has limited facilities for acquiring evidence--it cannot, for example, be expected to conduct a survey of the marketplace or obtain consumer affidavits--concludes evidence of record is sufficient to establish a prima facie case of deceptiveness); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985) ("... practicalities of the limited resources available to the PTO are routinely taken into account in reviewing its administrative action.").

1208.01 Evidence from NEXIS Database, Printed Publications, or Online Publications

The applicant or the examining attorney may submit articles or excerpts from articles taken from periodicals or NEXIS and other similar databases as evidence. [Note 1.] Such material is evidence of how a term or mark may be perceived, rather than of the truth of the underlying information in the article. [Note 2.] The probative value of stories from newswires varies. They may be treated as having minimal evidentiary value when it is not clear that such stories have appeared in any publication available to the consuming public. In such cases, the wire service stories are competent to show how their authors used particular terms, but they are not necessarily assumed to have influenced the attitudes of prospective customers. [Note 3.] On the other hand, newswire stories have been considered as having an effect when there is reason to believe that the relevant consumers have been exposed to the articles. [Note 4.] As for articles from foreign publications, the probative value of such articles is evaluated on a case-by-case basis, with consideration given to the nature of the involved goods or services and the growing availability and use of the Internet as a resource for news. [Note 5.]

It is not necessary that all articles retrieved by a search of NEXIS or other databases be submitted and, indeed, the Board discourages such submissions where they are unnecessarily cumulative or not probative. [Note 6.] Examining attorneys and applicants should not submit articles or excerpts that are not relevant. [Note 7.] However, if an examining attorney submits a sample of articles, it should be representative of the articles retrieved by the search. [Note 8.] Further, if an examining attorney submits a very limited number of articles without indicating that it is a representative sample of a certain number of articles, the Board will assume that these are the only articles that support the examining attorney's position. [Note 9.]

If the applicant or the examining attorney submits excerpts from articles, the nonoffering party may submit the complete article, even if such submission is made after the appeal is filed. See TBMP § 1207.01 for general rule that evidence submitted after appeal is untimely. If only a portion of an article is submitted, that portion is not thereby insulated from the context from whence it came. [Note 10.] If the nonoffering party wishes to have the entire article considered, the better practice is to submit the article with a request for remand. However, because the party submitting the excerpt of the article had the opportunity to review the entire article, if the article is submitted with an appeal brief, the Board need not remand the application, and may instead consider the article as part of the record. However, if, after appeal, an applicant attempts to submit a full printout of articles which were revealed in an examining attorney's search, but which were not introduced by the examining attorney, such articles are considered to be additional evidence and therefore untimely. [Note 11.]

NOTES:

1. *In re Shiva Corp.*, 48 USPQ2d 1957, 1958 (TTAB 1998).

2. *See In re Viventia Biotech Inc.*, 80 USPQ2d 1376, 1379 (TTAB 2006) (use of term in articles shows authors' belief that term is appropriate way to describe goods and that readers will understand the meaning of the term); *In re Lamb-Weston Inc.*, 54 USPQ2d 1190, 1192 (TTAB 2000) (use of term in articles, particularly those periodicals with a general circulation, reflects a perception that the public is familiar with the term and will readily understand it); *In re Hudson News Co.*, 39 USPQ2d 1915, 1920 n.10 (TTAB 1996) (Board allowed use of NEXIS evidence to show psychological effect of color blue, despite applicant's hearsay objection, noting the difficulties for examining attorneys to establish this kind of fact, and although the evidence has a hearsay element, there is no bias in the evidence, which was not prepared for purposes of the case), *aff'd without opinion*, 114 F.3d 1207 (Fed. Cir. 1997). *See also In re Adlon Brand Gmbh & Co.*, 120 USPQ2d 1717, 1720-21 (TTAB 2016) (use of social media postings to show public exposure to and perception of surname).

3. *In re International Business Machines Corp.*, 81 USPQ2d 1677, 1683 n.10 (TTAB 2006) (newswire stories do not have the same probative value as stories appearing in newspapers and magazines); *In re Classic Media Inc.*, 78 USPQ2d 1699, 1701 n.2 (TTAB 2006) (nothing to indicate that wire service report was distributed and thus has minimal probative value in that public's exposure to the use of the phrase in the wire report cannot be judged); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 n.7 (TTAB 2001) (newswire stories, presumably unpublished, and stories from foreign publications, not considered).

4. *In re Toshiba Medical Systems Corp.*, 91 USPQ2d 1266, 1268 (TTAB 2009) (Business Wire article considered); *In re Cell Therapeutics Inc.*, 67 USPQ2d 1795, 1798 (TTAB 2003) (given that newswire stories are likely to reach the public via the Internet, they now have more probative value than in the past, in this case the relevant public consisted of highly sophisticated medical doctors and researchers who would have access to newswire stories).

5. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007) (information originating on foreign websites or in foreign news publications that are accessible to the United States public may be relevant to discern U.S. consumer impression of a proposed mark); *In re Odd Sox LLC*, 2019 USPQ2d 370879, * 5-6 (TTAB 2019); *In re Cell Therapeutics, Inc.*, 67 USPQ2d 1795, 1798 (TTAB 2003). *But see In re tapio GmbH*, 2020 USPQ2d 11387, at *8 n.31 (TTAB 2020) (evidence of individuals with the surname "Tapio" residing in Finland of little probative value); *In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983, at *3 n.7 (TTAB 2019) (foreign websites, although in English, not considered because directed to local foreign consumers and no basis to conclude U.S. consumers likely to have been exposed to them); *In re AOP LLC*, 107 USPQ2d 1644, 1649 n.3 (TTAB 2013) (submissions from the examining attorney made in languages other than English not considered); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1265 n.9 (TTAB 2011) (website for Australian brewery not considered because no basis to conclude U.S. consumers exposed to it); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1307 n.3 (TTAB 2006) (article in London edition of Financial Times not evidence of goods/place association because nothing to show that London edition distributed in the United States); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1538 n.2 (TTAB 1998) (in the absence of evidence of the extent of circulation of foreign publications in the United States, they cannot serve to show the significance in this country of the designation at issue); *In re Wilcher Corp.*, 40 USPQ2d 1929, 1931 (TTAB 1996) (in absence of evidence establishing substantial circulation of foreign publications in the United States, they are not competent to show significance of term to general U.S. public).

6. *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, at *1 (TTAB 2019) (multiple submissions of the same evidence is discouraged because it is unnecessarily cumulative); *In re Homes & Land Publishing Corp.*, 24 USPQ2d 1717, 1718 (TTAB 1992) (it is not necessary that an examining attorney submit all stories found, especially where there are a large number of them). *Cf. In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245-46 (TTAB 2010) (Board criticized applicant for submitting over 300 pages of Internet material, much of which was duplicative or irrelevant).

7. *See In re Adlon Brand Gmbh & Co.*, 120 USPQ2d 1717, 1719 (TTAB 2016) (Board disregards duplicative articles); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010) ("[I]t is important that applicants and examining attorneys carefully consider the materials retrieved by their Internet searches and make a judicious submission of the results."); *In re Couture*, 60 USPQ2d 1317, 1318 n.2 (TTAB 1999) (many excerpts were repetitive or used the searched term for services not related to the applicant's); *In re Lamb-Weston Inc.*, 54 USPQ2d 1190, 1192 (TTAB 2000) (articles which bear no relationship to applicant's goods are irrelevant). *See also In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1339 n.10 (TTAB 2009) (Board approved examining attorney's Internet search of involved mark that included limitation to goods at issue).

8. *See In re Trans Continental Records Inc.*, 62 USPQ2d 1541, 1544 (TTAB 2002) (although the examining attorney described the NEXIS articles which were submitted as a "sample," Board concerned by the fact that the NEXIS search retrieved 441 articles, and the first of the ten stories submitted was number 257). *See also In re Homes & Land Publishing Corp.*, 24 USPQ2d 1717, 1718 n.1 (TTAB 1992) (Board criticized examining attorney's submission of only 3 articles of the 18 retrieved and characterization of them as a "sampling"; "saying that the three articles are only a sampling of the evidence is not the same as saying that they are a 'representative sample' thereof").

9. *In re The Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 n.2 (TTAB 1989) (although NEXIS search uncovered 48 stories, examining attorney submitted only two excerpts; Board concluded that, because the examining attorney is presumed to have made the best case possible, the 46 stories not made of record did not support the examining attorney's position, and suggested that if there had been additional stories supporting the position the examining attorney should have submitted a larger number and indicated whether or not

they were representative of the rest); *In re Federated Department Stores Inc.*, 3 USPQ2d 1541, 1542 n.2 (TTAB 1987) (examining attorney submitted 3 of 18 NEXIS articles retrieved; Board assumed that the three excerpts selected were the best support of the examining attorney's refusal to register available from that source).

10. *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986).

11. *In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1597-98 (TTAB 1999).

1208.02 Cited Registrations and Third-Party Registrations and Applications

In the context of an ex parte appeal of a Section 2(d) refusal, the file of the cited registration(s) is not automatically of record. [Note 1.] Rather, for the prosecution file history of a cited registration(s) to be considered, it must be timely introduced as evidence. [Note 2.]

With regard to third-party registrations, the Federal Circuit, in *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681 (Fed. Cir. 2010), exercised its discretion to take judicial notice of a third party's registrations. However, the Board's well-established practice is not to take judicial notice of third-party registrations when an applicant or examining attorney requests that such notice be taken during the course of an appeal. [Note 3.] This practice also applies to registrations owned by the applicant or registrant that are not the subject of the appeal. [Note 4.]

37 C.F.R. § 2.142(d) provides that the record in an appeal must be complete prior to the filing of an appeal, *see*TBMP § 1203.02(e) and TBMP § 1207.01, and to allow the applicant or the examining attorney to, in effect, add to the record during the appeal would subvert the rule and require the Board to re-examine the application during the appeal, based on the expanded record. Thus, to make a third-party registration of record, or a registration owned by the applicant or registrant not the subject of the appeal, a copy of the registration (from either the electronic records of the Office or the paper USPTO record) showing the current status and title of the registration must be submitted. [Note 5.] Mere listings of registrations, or copies of private company search reports, are not sufficient to make the registrations of record. [Note 6.] However, there are limited circumstances in which the Board will consider such listings. In particular, if an applicant includes a listing of registrations in a response to an Office action, and the examining attorney does not advise the applicant that the listing is insufficient to make the registrations of record at a point when the applicant can correct the error, the examining attorney will be deemed to have waived any objection to consideration of the list itself, for whatever probative value it may have. [Note 7.] TBMP § 1207.03. Similarly, if the examining attorney discusses the registrations in an Office action or brief, without objecting to them, the registrations will be treated as stipulated into the record. [Note 8.] See TBMP § 1207.03 regarding evidence considered due to actions of nonoffering party. However, the Board will not consider more than the information provided by the applicant. [Note 9.] Thus, if the applicant has provided only a list of registration numbers and/or marks, the list will have very limited probative value. [Note 10.]

An improper listing of third-party registrations will not be considered if the list is submitted at a point where the applicant cannot correct the format of the submission and if the examining attorney does not discuss the registrations or otherwise treat them as of record. [Note 11.]

Third-party applications, as opposed to registrations, have no probative value other than as evidence that the applications were filed. [Note 12.] Further, the Board will not take judicial notice of status changes in third-party applications in terms of whether such applications eventually issued to registration. [Note 13.]

Expired or cancelled third-party registrations generally are evidence only of the fact that the registrations issued. [Note 14.] The Board may choose not to consider expired or cancelled third-party registrations. [Note 15.]

NOTES:

1. *In re Sela Products LLC*, 107 USPQ2d 1580, 1583 (TTAB 2013) ("there is no equivalent rule for ex parte proceedings that makes the file of a cited registration of record").

2. *In re Sela Products LLC*, 107 USPQ2d 1580, 1583 (TTAB 2013) (had applicant submitted the registration file during the prosecution of the involved application the Board would have considered it).

3. *Compare In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1688 (Fed. Cir. 2010) (where applicant's expert identified a third-party's trademarks in her report before the agency, the court of appeals could take judicial notice of the registrations of the identified marks) *with* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69955 (Oct. 7, 2016) (no judicial notice of USPTO records; "The official record of a Board proceeding must be complete, accurate, and reliable, especially because in direct appeals to the Federal Circuit the court's review of the Board's decision is confined to the four corners of the administrative record. … The burden of creating a complete evidentiary record by introducing in documentary form information contained in the USPTO's trademark file records is most appropriately borne by the party wishing to introduce such evidence rather than by the Board."). *See* Fed. R. Evid. 201(b)(2); *Group One, Ltd. v. Hallmark Cards*, 407 F.3d 1297, 1306 (Fed. Cir. 2005) (upholding district court's taking of judicial notice of the fact of a patent's reinstatement).

4. *In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (Board declined to take judicial notice of registrations owned by applicant).

5. *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (mere listing of third-party registrations in brief insufficient to make them of record); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372 (TTAB 2006); *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1456 n.2 (TTAB 1998); *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). *See also In re Fiat Group Marketing & Corporate Communications S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014) (examining attorney's objection to applicant's submission of third-party registration with appeal brief sustained).

6. *In re Hoefflin*, 97 USPQ2d 1174, 1177 (TTAB 2010); *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996).

7. *See In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1594 n.40 (TTAB 2014) (objection waived where examining attorney, in continuing a refusal, failed to advise applicant that mere listing of third-party registrations was insufficient to make them of record); *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012) ("[T]he examining attorney's failure to advise applicant of the insufficiency of the list of registrations when it was proffered during examination constituted a waiver of any objection to consideration of that list. Accordingly, we will consider the ... list of registrations ... 'for whatever limited probative value such evidence may have,'" (citing *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001)), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re District of Columbia*, 101 USPQ2d 1588, 1591 (TTAB 2012) (examining attorney's objection overruled where on remand applicant submitted copies of the third-party registrations it listed in its response to the first Office action), *aff'd sub nom. In re City of Houston*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1717 (TTAB 2011) (specific data provided by applicant considered because examining attorney did not advise applicant that a listing of registrations was insufficient when applicant had time to

cure the defect). *See also In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (applicant listed particulars of third-party applications/registrations in response to first Office action, and because examining attorney did not advise applicant that the listing was insufficient to make applications/registrations of record at a point where applicant could have corrected the error, the list was considered on appeal); *In re Hayes*, 62 USPQ2d 1443, 1445 n.3 (TTAB 2002) (Board considered third-party registrations submitted with reply brief because applicant had submitted copies of Official Gazettes showing marks published for opposition during prosecution, and examining attorney did not advise applicant that copies of the registrations were necessary to make them of record); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001) (examining attorney's objection, raised in appeal brief, to "mere listing" of registrations deemed waived because it was not interposed in response to applicant's reliance on such listing in its response to initial Office action, listing considered for whatever probative value it might have, with Board noting that the listing did not indicate whether registrations were on the Principal or the Supplemental Register). **Please Note:** The *Broyhill Furniture* case does not provide authority for submission (or consideration) of the full registrations on appeal. *See In re City of Houston*, 101 USPQ2d 1534, 1537 n.7 (TTAB 2012), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013).

8. *See In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (although the Board does not take judicial notice of registrations, because the examining attorney addressed applicant's registrations in her brief and neither objected to the discussion of the other, Board treated both registrations as though they are of record); *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 n.6 (TTAB 1999) (examining attorney did not object to listing of third-party registrations, rather he treated the registrations as if they were of record); *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998) (examining attorney did not object to and treated as of record listings from a commercial trademark search report submitted by applicant during prosecution, so Board considered material).

9. *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (Board treated listing of particulars of third-party applications/registrations submitted by applicant as stipulated into record only to the extent that the specific data provided by applicant was considered); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001) (listing of registration information considered for whatever probative value it might have, with Board noting that the listing did not indicate whether registrations issued on the Principal or the Supplemental Register).

10. *See In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1264 n.6 (TTAB 2011) (Board considered TESS listings for whatever probative value they had); *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1380 (TTAB 2006).

11. *In re HSB Solomon Associates LLC*, 102 USPQ2d 1269, 1273-74 (TTAB 2012) (website references in applicant's request for reconsideration not considered because, even if examining attorney had advised applicant of the insufficiency, there was not time to cure it); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (even if copies of third-party registrations had been submitted with brief, they would have been untimely and would not be considered); *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (listing of third-party registration information submitted with request for reconsideration not considered because at the time it filed the list applicant no longer had an opportunity to add to the record of the application and correct the evidentiary insufficiency of the submission); *In re Caserta*, 46 USPQ2d 1088, 1090 n.4 (TTAB 1998) (list of third-party registered marks from an unidentified source submitted with request for reconsideration, and objected to by examining attorney, not considered).

12. *In re Team Jesus LLC*, 2020 USPQ2d 11489, at *3 n.29 (TTAB 2020) ("an application would be evidence only of the fact that it was filed, and therefore has no probative value"); *In re Wal-Mart Stores, Inc.*, 129

USPQ2d 1148, 1159 (TTAB 2019) (cancelled registrations, abandoned applications, and pending applications are not probative support for applicant's argument of "consumer perceptions [of the subject marks] in the marketplace"); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016) (a pending application is evidence only that the application was filed on a certain date); *In re Toshiba Medical Systems Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366 n.7 (TTAB 2007); *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

13. *In re Binion*, 93 USPQ2d 1531, 1535 n.3 (TTAB 2009).

14. *Action Temporary Services v. Labor Force, Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (cancelled registrations are not evidence of any existing rights in a mark); *In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1159 (TTAB 2019) (cancelled registrations, abandoned applications, and pending applications are not probative of "consumer perceptions [of the subject marks] in the marketplace"); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006) (expired or cancelled registrations generally are evidence only of the fact that the registrations issued).

15. *See In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1159 (TTAB 2019) (expired or cancelled registrations generally are evidence only of the fact that the registrations issued); *In re Hartz Hotel Services Inc.*, 102 USPQ2d 1150, 1152 n.5 (TTAB 2012) (Board did not consider four cancelled third-party registrations submitted by applicant).

1208.03 Internet Material, Social Media and Multimedia Materials

Material obtained through the Internet or from websites is acceptable as evidence in ex parte proceedings. [Note 1.] To make Internet material properly of record, the offering party must provide the full address (URL) for the web page, and the date it was accessed or printed, either by the information displayed on the web page itself, or by providing this information in an Office action or an applicant's response. Prior to 2018, the Board preferred, but did not require, this identifying information. In 2018, the Board extended the admissibility requirements for Internet materials set forth in *Safer Inc. v. OMS investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) (" *Safer*") to ex parte appeals, and now requires Internet printouts to include a date and source/URL. [Note 2.] For more information about *Safer* and inter partes proceedings, see TBMP § 704.08(b).

The preferred practice for applicants and examining attorneys is to provide web pages that identify the URL and access date directly on the web pages themselves so that the nonoffering party may readily verify the document through the date and source information and, if accurate, rebut the probative value of the document by showing that there has been a significant change to the document as submitted by the offering party. [Note 3.] Providing only the link without the material attached is not sufficient to introduce it into the record. [Note 4.]

If an examining attorney does not include the URL and the date when the Internet evidence was accessed or printed and the applicant objects, the Board will not consider the material. [Note 5.] However, if the applicant does not object to the non-complying material, the Board may consider the material for whatever probative value it may have. [Note 6.] Similarly, the Board will not consider non-complying Internet evidence filed by an applicant if, in the first Office action following the response in which the non-complying material was submitted, the examining attorney objects and advises the applicant how to properly make the Internet evidence of record, and the examining attorney maintains the objection in their appeal brief. Otherwise, the Board may consider the objection to be waived. [Note 7.]

Because website contents and search engine results are accessible by the consuming public (although search engine results may be retrieved only if members of the public enter the identical search strategy), they constitute evidence of potential public exposure. [Note 8.] Website evidence may also be used to show the translation of a word or term. [Note 9.] Material obtained from an applicant's website, or that of a third party, may provide information about, for example, products or services, customers, and channels of trade, although their probative value will vary depending on the facts of the particular case. [Note 10.] Evidence from websites located outside the United States may have probative value depending on the circumstances, including whether it is likely that U.S. consumers have been exposed to the foreign website [Note 11] and whether the website is in English (or has an optional English language version). [Note 12.] The nature of the goods or services may make it more likely that U.S. consumers will encounter foreign websites in the field in question [Note 13.] Cf. TBMP § 1208.01 regarding articles appearing in foreign publications

A search result summary from a search engine, such as Yahoo! or Google, which shows use of a phrase as key words by the search engine, is of limited probative value. Such search results do not show use of a term or phrase as a heading, link or content on a website, or there may be insufficient text to show the context within which a term is used. [Note 14.] Use in a search summary may indicate only that the two words in an overall phrase appear separately in the website literature. [Note 15.] Nor does the fact that a search by an Internet search engine retrieves a large number of hits have probative value. [Note 16.] Likewise, search engine results consisting solely of images are problematic because they provide no indicia of what image is depicted. [Note 17.] The better practice is to provide a complete copy of the web page and image from the originating website so as to provide evidentiary context. [Note 18.] The Board will not take judicial notice of Internet searches. [Note 19.]

Applicants and examining attorneys should submit only relevant materials that are retrieved by an Internet search. The Board discourages submissions that are unnecessarily cumulative or not probative. [Note 20.] *See* TBMP § 1208.01. If a large number of web pages are submitted, it is preferable for the applicant and examining attorney to highlight in their briefs the most probative evidence. [Note 21.] *See* TBMP § 1203.01.

Definitions available from an online resource, including online dictionaries and translations, that are readily available and therefore capable of being verified are acceptable. [Note 22.] In general, evidence from online dictionaries that do not otherwise appear in printed format should be submitted prior to appeal so that the nonoffering party has an opportunity to check the reliability of the evidence and/or timely offer rebuttal evidence. [Note 23.] The Board will not take judicial notice of such material unless the online dictionary definitions are from references that are the electronic equivalent of a print dictionary or have regular fixed editions. [Note 24.] TBMP § 1208.04.

The Board previously accepted Wikipedia evidence only if the nonoffering party had an opportunity to rebut it. However, in the last several years excerpts from Wikipedia have frequently been submitted during the prosecution of an application and have rarely been rebutted by an updated excerpt. The Board now may consider evidence taken from Wikipedia submitted with a denial of a request for reconsideration. An applicant who wishes to rebut such evidence may request a remand to submit other evidence that may call into question the accuracy of the particular Wikipedia information [Note 25.] The Board notes that the better practice with respect to Wikipedia evidence is to corroborate the information with other reliable sources, including Wikipedia's sources. The Board also will consider dictionary definitions taken from Urban Dictionary (urbandictionary.com), a collaborative online dictionary of slang terms, so long as the non-offering party has an opportunity to rebut that evidence by submitting other definitions. [Note 26.]

The Board also will consider Internet blog postings as well as individual comments thereto, and accord such evidence the appropriate probative value depending on its source of origin and its relationship to the issue

at hand. [Note 27.] In addition, the Board will consider multimedia evidence [Note 28], including video files submitted during examination through TEAS. [Note 29.]

The Board may consider evidence obtained from social media sites such as Facebook, Twitter, Instagram, and LinkedIn. [Note 30.] In addition, the Board may consider U.S. patents and patent applications obtained from the USPTO electronic patent database as evidence, where appropriate. [Note 31.]

It is the obligation of the examining attorney and applicant to ensure that Internet evidence made of record is complete. [Note 32.]

NOTES:

1. *See, e.g., In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018).

2. *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018) (applying *Safer* to evidence submitted by examining attorneys and applicants in ex parte cases); *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1593 (TTAB 2018) (applying *Safer* to evidence submitted by examining attorneys in ex parte cases, noting importance because "it ensures that an applicant can verify the information presented in the case."); *In re Mueller Sports Medicine, Inc.*, 126 USPQ2d 1584, 1586-87 (TTAB 2018) (applying *Safer* to evidence submitted by examining attorneys in ex parte cases and stating intention to hold applicants to the same standard).

3. *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 n.14 (TTAB 2018). *See*TMEP § 710.01(b).

4. *In re ADCO Industries – Technologies, L.P.*, 2020 USPQ2d 53786, at *2 (TTAB 2020) (web addresses or hyperlinks are insufficient to make the underlying webpages of record); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1195 n.21 (TTAB 2018) (Board does not consider websites for which only links are provided); *In re Olin Corp.*, 124 USPQ2d 1327, 1332 n.15 (TTAB 2017) ("Because the information displayed at a link's Internet address can be changed or deleted, merely providing a link to a website is insufficient to make information from that site of record."); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1462 n.8 (TTAB 2017) (providing only a web address or hyperlink is insufficient to make such materials of record); *In re Powermat Inc.*, 105 USPQ2d 1789, 1791 (TTAB 2013) (same); *In re White*, 73 USPQ2d 1713, 1716 n.5 (TTAB 2004); *In re International Business Machines Corp.*, 81 USPQ2d 1677, 1682 n.9 (TTAB 2006) (Board considered web pages that did not include web addresses because applicant did not object to them). *See also In re Fantasia Distribution, Inc.*, 120 USPQ2d 1137, 1143 n.13 (TTAB 2016) (Board considered still frame information about a video provided in witness declaration but not video itself because providing link to YouTube video does not suffice to introduce evidence into the record); *In re HSB Solomon Associates LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) (Board will not utilize web address to access site and consider whatever content appears).

5. *See In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018) ("Accordingly, we have recently held that to properly make such website evidence of record, a trademark examining attorney must include the URL and the date when the material was accessed, and that if an examining attorney fails to do so, and the applicant objects, the material will not be considered."). *Accord In re Mueller Sports Medicine, Inc.*, 126 USPQ2d 1584, 1586-87 (TTAB 2018) (by failing to object to Internet excerpts submitted by the examining attorney that did not include URLs and access dates, applicant waived its objections to the submission of those websites). *See also*TMEP § 710.01(b).

6. *In re Mueller Sports Medicine, Inc.*, 126 USPQ2d 1584, 1586 (TTAB 2018) (by failing to object to Internet excerpts submitted by the examining attorney that did not include URLs and access dates, applicant waived its objections to the submission of those websites).

7. *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018); *In re Mueller Sports Medicine, Inc.*, 126 USPQ2d 1584, 1586-87 (TTAB 2018). *Cf. In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1594 n.40 (TTAB 2014) (objection waived where examining attorney, in a continuing refusal, failed to advise applicant that mere listing of third-party registrations was insufficient to make them of record); *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012) (objection waived where examining attorney failed to advise applicant of the insufficiency of a list of third-party registration when it was proffered during examination), *aff'd*, 731 F.3d 1327 (Fed. Cir. 2013); *In re 1st USA Realty Professionals*, 84 USPQ2d 1581, 1584 (TTAB 2007) (allowing evidence of one list of third-party registrations submitted in response to an initial Office action because the examining attorney did not advise applicant of the insufficiency of the list while there was still time to correct the mistake, but giving no consideration to a second list submitted by applicant with a request for reconsideration).

8. *In re Mr. Recipe, LLC*, 1087 n.4 (TTAB 2016) (stories are probative of the perceptions of the authors and of the content received by the readers); *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002). *See, e.g., In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1157 (TTAB 2019) (examining attorney not required to establish that a particular online source or website "has significant web traffic" to establish its competence just as there is no requirement to establish the circulation or actual readership of a magazine or newspaper; applicants are free to challenge the probative value of a particular website and even websites that are not frequently visited may demonstrate how the authors use the term and how it will be perceived by the readers); *In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1829 (TTAB 2011) (printouts from web pages are not per se incompetent to show a term is generic).

9. *In re Nieves & Nieves, LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015) ("We find that the articles from non-U.S. publications have some probative value in this case because it concerns the perception of the general U.S. public—the relevant consumers of the goods in the application—regarding the identity of a celebrity who lives and travels outside of the United States."); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 n.3 (TTAB 2008) (Board considered translation from www.babelfish.altavista.com); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 (TTAB 2006) (Board considered entries from WordReference.com Dictionnaire Francais-Anglais and Babel Fish Translation).

10. *See, e.g., In re Mueller Sports Medicine, Inc.*, 126 USPQ2d 1584, 1587 n.6 (TTAB 2018) ("The GOOGLE BOOKS Internet excerpts did not include the name of the book from which it was taken or the book's author. Besides including the URL and date the GOOGLE BOOKS Internet excerpt was accessed, to provide better context for the excerpt, the Trademark Examining Attorney should have included the front or cover page showing the book title and author's name and the page showing the copyright notice."); *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1593-94, and 1595 n.19 (TTAB 2018) (evidence of a cached website may be admissible if there is a date and URL on the web page, but is not probative where applicant asserted an objection and provided a printout of a web page, indicating that the cached site referenced was no longer active).

11. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007) (information originating on foreign websites that are accessible to the United States public may be relevant to discern U.S. consumer impression of a proposed mark); *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1596 (TTAB 2018) ("While evidence of foreign use may in some cases be probative, in this case it does not serve to tell us the norms specific to pet owners in the United States, who are the relevant consumers."); *In re Florists' Transworld Delivery Inc.*, 106 USPQ2d 1784, 1786 (TTAB 2013) (applicant's relevancy objection

to evidence submitted by the examining attorney obtained from foreign websites overruled because evidence regarding the significance of the color black on floral packaging "would be difficult to locate"); *In re International Business Machines Corp.*, 81 USPQ2d 1677, 1681 n.7 (TTAB 2006) (web page from foreign source considered because case involved computer technology, and "it is reasonable to consider a relevant article regarding computer hardware" from an English-language website from another country); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1050 (TTAB 2006) (a consumer in the United States may turn to foreign websites when researching products they may wish to purchase); *In re Remacle*, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002) (professionals in medicine, engineering, computers, telecommunications and other fields are likely to utilize all available resources, regardless of country of origin or medium, and the Internet is a resource that is widely available to these same professionals and to the general public in the United States). *Cf. Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2021 n.9 (TTAB 2014) ("Articles submitted by opposer from foreign publications (e.g., The Economist) have not been considered insofar as opposer did not provide evidence of U.S. circulation").

12. *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1634 n.8(TTAB 2017) (quotes in Euros indicated online store not U.S.-based; no evidence of exposure by U.S. consumers to the website, reducing its probative value of the perception of the term by U.S. consumers; but evidence not wholly discounted, as U.S. consumers may have some exposure to such websites retrieved from an Internet search); *In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1781 n.10 (TTAB 2017) (as one factor, Board considered Canadian websites in English), *aff'd*, 749 F. App'x 987 (Fed. Cir. 2018).

13. *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1634 n.8 (TTAB 2017) (quotes in Euros indicated online store not U.S.-based; no evidence of exposure by U.S. consumers to the website, reducing its probative value of the perception of the term by U.S. consumers; but evidence not wholly discounted, as U.S. consumers may have some exposure to such websites retrieved from an Internet search); *In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1781 n.10 (TTAB 2017) ("Potential consumers of Applicant's scientific research services and product testing services are likely to encounter the foreign websites as part of a search for companies that offer services related to the research, testing and development of products that are designed to improve one's health and well-being, particularly research that can be applied to indoor environments such as a workplace."), *aff'd*, 749 F. App'x 987 (Fed. Cir. 2018).

14. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) ("Search engine results—which provide little context to discern how a term is actually used on the web page that can be accessed through the search result link—may be insufficient to determine the nature of the use of a term or the relevance of the search results to registration considerations"); *In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1156 n.38 (TTAB 2019) ("Web-based information that includes greater context for the use of a term, such as a complete webpage, will have greater probative value in determining how a term will be perceived."); *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2062 n.4 (TTAB 2013) (Google search engine results had "limited probative value"; insufficient text to show context); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011) (search engine results submitted by examining attorney not considered because they did not provide sufficient context to have any probative value); *In re Innovative Cos.*, 88 USPQ2d 1095, 1099 n.4 (TTAB 2008); *In re Tea and Sympathy Inc.*, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1050 (TTAB 2006); *In re Thomas*, 79 USPQ2d 1021, 1026 (TTAB 2006) (Google hits without any context for the hits is irrelevant); *In re International Business Machines Corp.*, 81 USPQ2d 1677, 1679 n.3 (TTAB 2006) (listings of search results from Google database of limited probative value because the excerpts are extremely truncated); *In re Remacle*, 66 USPQ2d 1222, 1223 n.2 (TTAB 2002) (results of search by Yahoo! search engine of little probative value, largely because insufficient text available to determine the nature of the information and, thus, its relevance). *But see In re Hotels.com L.P.*, 87 USPQ2d 1100, 1105 n.7 (TTAB 2008), *aff'd*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed.

Cir. 2009) (although websites referenced in summary format, sufficient information in the summary to understand the context of usage).

15. *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002).

16. *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2062 n.3 (TTAB 2013) (while Google search engine retrieved over 100,000 results, evidence was of "limited probative value"); *In re BetaBatt Inc.*, 89 USPQ2d 1152, 1153 n.1 (TTAB 2008) (no probative weight given to fact that search using Google search engine retrieved 22,200 hits; further, "hit list" does not corroborate that there are 22,200 relevant references).

17. *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010) (much of the 300 pages of Internet material submitted by applicant unhelpful because duplicative, or reference different terms, or for services in different fields or otherwise irrelevant).

18. *In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1156 n.38 (TTAB 2019) ("Web-based information that includes greater context for the use of a term, such as a complete webpage, will have greater probative value in determining how a term will be perceived."); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010) (criticizing applicant for not pointing out in brief specific Internet evidence believed to be most probative of its position when significant amount of material made of record: "it is incumbent on the applicant and the examining attorney to specify in their briefs those pieces of evidence that they believe are most persuasive of their respective positions, so that the Board can consider that evidence in particular").

19. *In re Viventia Biotech Inc.*, 80 USPQ2d 1376, 1377 (TTAB 2006).

20 *In re Change Wind Corp.*, 123 USPQ2d 1453, 1463 n.9 (TTAB 2017).

21. *In re Change Wind Corp.*, 123 USPQ2d 1453, 1463 n.9 (TTAB 2017) ("The better practice is to use the image search result page to click through to the originating website and obtain a copy of the original image on the originating website in order to provide the context from which evidentiary points the party proffering the image wishes to make can be supported.").

22. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007); *See also In re Geller*, 751 F.3d 1355, 110 USPQ2d 1867, 1868 n.2 (Fed. Cir. 2014) (court, in noting that appellants do not contest the Board's reliance on an online dictionary definition of "terrorism," nonetheless pointed out that other more specific definitions could be found in various international treaties and national statutes but found that it was "certainly adequate for the purposes of this case."); *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153 (TTAB 2009) (Board considered definition from Encarta online dictionary, made of record by examining attorney).

23. *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002); *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). *Cf. In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1201 (TTAB 2009) (Internet evidence submitted with denial of request for reconsideration properly of record; if applicant wanted to challenge the evidence, it should have filed a request for remand); *In re Carlson*, 91 USPQ2d 1198, 1199 n.2 (TTAB 2009) (if applicant wished to raise questions about probative value of online dictionary definition submitted with examining attorney's final office action he should have submitted guidelines for dictionary with a request for reconsideration).

24. *See In re Swatch Group Management Services AG*, 110 USPQ2d 1751, 1755, n.9 (TTAB 2014) ("In this case, the definition proffered is from the online dictionary found at <merriam-webster.com>, and we

take notice of it"); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590 n.8 (TTAB 2008); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

25. *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1633 n.6 (TTAB 2018) (In the past, the Board "has been reluctant to consider Wikipedia excerpts submitted with the denial of a request for reconsideration, reasoning that although the opportunity to request remand to submit new evidence is available to applicants, the application record should be complete prior to the filing of an ex parte appeal." But now, such excerpts submitted with a denial of a request for reconsideration will be considered, "keeping in mind that an applicant has an opportunity to rebut such entry, when necessary, by requesting remand to submit rebutting evidence."). **PLEASE NOTE:** this is a change in Board practice.

Cf. In re Bay State Brewing Co., 117 USPQ2d 1958, 1959 n.3, (TTAB 2016) (applicant had ample opportunity to rebut Wikipedia evidence submitted by Examining Attorney but did not); *In re Hinton*, 116 USPQ2d 1051, 1053 n.10 (TTAB 2015) ("The Board gives guarded consideration to evidence taken from Wikipedia, bearing in mind the limitations inherent in this reference work, so long as the non-offering party has an opportunity to rebut the evidence by submitting other evidence that may call its accuracy into question."); *In re Carrier Consulting Group*, 84 USPQ2d 1028, 1032-33 (TTAB 2007). *See also In re Swatch Group Management Services AG*, 110 USPQ2d 1751, 1754 n.4 (TTAB 2014) (Board considered Wikipedia evidence submitted with examining attorney's first office action which applicant had an opportunity to rebut); *In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1382 n.2 (TTAB 2012) (Wikipedia evidence considered because examining attorney had opportunity to rebut the evidence); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 nn.4, 6, 7 (TTAB 2009) (considering Wikipedia evidence attached to Office action and applicant's response); *In re Grand Forest Holdings Inc.*, 78 USPQ2d 1152, 1153, 1154 n.3 (TTAB 2006) (considering "illuminating" entry from Wikipedia submitted with Office action and subsequent update submitted by applicant). See also TMEP § 710.01(b).

26. *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2062 n.3 (TTAB 2013) (Board considered entries obtained from the online Urban Dictionary because they were submitted early enough to afford applicant an opportunity to submit any alternative meanings or otherwise question the reliability of the definitions).

27. *See In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1157 (TTAB 2019) (information from the Internet, websites and blog posts is admissible as evidence of information available to the public and the manner the applied-for term is used or would be understood by the public); *In re Geller*, 751 F.3d 1355, 110 USPQ2d 1867, 1870 (Fed. Cir. 2014) (the Board, in noting that "the probative value of the blog comments … is less than that of the articles themselves due to the anonymity of the authors," did not err in concluding that such comments shed light on the meaning of the term "Islamisation"); *In re Morrison & Foerster LLP*, 110 USPQ2d 1423, 1424 n.2 (TTAB 2014) ("These blog postings are from what appear to be well-established media sources with national circulation and public exposure as well as more obscure blogs for which we cannot ascertain the degree of exposure. As such, we are aware that many of the blogs may simply reflect the perception of a single author and not that of the general public.").

28. *In re General Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1025 n.56 (TTAB 2017) (Board considered audio-visual materials containing television commercials in evaluating whether applicant's proposed single color mark had acquired distinctiveness).

29. *In re Fantasia Distribution, Inc.*, 120 USPQ2d 1137, 1143 n.13 (TTAB 2016) (TEAS accepts multimedia evidence, including video files under 30 MB).

30. *See In re DePorter*, 129 USPQ2d 1298, 1299-1307 (TTAB 2019) (Board considered widespread use by many third parties of #MAGICNUMBER108 on social media such as Twitter and Instagram as evidence

of consumer perception of proposed mark as an informational message not a source identifier); *In re Adlon Brand GmbH & Co.*, 120 USPQ2d 1717, 1720 (TTAB 2016) (Board considered social media evidence relating to individuals bearing the surname Adlon because "they illustrate the ways in which members of the public may be exposed to people who bear the surname ADLON.").

31. *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *4 (TTAB 2020) (proof of mere descriptiveness may originate from applicant's own descriptive use of its proposed mark, or portions thereof, in U.S. patents obtained or patent applications filed by applicant; and such proof also may be found in U.S. patents or patent applications of third parties.).

32. *In re tapio GmbH*, 2020 USPQ2d 11387, at *3 (TTAB 2020) (exhibits purportedly uploaded with applicant's request for reconsideration but not appearing in the TSDR record not considered by the Board).

1208.04 Judicial Notice

The Board may take judicial notice of dictionary definitions, acronyms, and abbreviations including definitions, acronyms and abbreviations in technical dictionaries, translation dictionaries and online dictionaries which exist in printed format or that have regular fixed editions. [Note 1.] Definitions found in slang dictionaries are also appropriate for judicial notice. [Note 2.]

The Board may also take judicial notice of encyclopedia entries, census data, standard reference works and of commonly known facts. [Note 3.]

The Board will generally not take judicial notice of definitions or entries found only in online dictionaries or reference works not available in a printed format [Note 4]; however, it will take judicial notice of definitions or entries from references that are the electronic equivalent of a print reference work or that have regular fixed editions. [Note 5.] The Board will not take judicial notice of dictionary definitions if it is not clear what the source of the material is. [Note 6.]

The Board normally does not take judicial notice of a term based on English spoken in another country, such as a dictionary definition reflecting "British English." [Note 7.] However, there are circumstances where information originating outside the United States but accessible within this country may be probative as to U.S. consumer impression of a proposed mark, and the Board may exercise its discretion to take judicial notice of such information. [Note 8.] The Board will not utilize a link or reference to a website's Internet address to consider content that may appear there. [Note 9.]

The Board's well-established practice is not to take judicial notice of third-party registrations when an applicant or examining attorney requests that such notice be taken during the course of an appeal. [Note 10.] *See* TBMP § 1208.02. There are several reasons for this practice. First, the record should be complete before the filing of any appeal to the Board. *See* 37 C.F.R. § 2.142(d); TBMP § 1203.02(e), TBMP § 1203.01, TBMP § 1207.01, and TBMP § 1208.02. Once an appeal has been filed, the proper way to seek to add evidence to the record is to file a written request with the Board to suspend the appeal and remand the application for further examination. *See*TBMP § 1207.02. Second, the proper way to make third-party registrations of record is not to list them, but to "submit copies of the registrations themselves, or the electronic equivalent thereof, from the USPTO's electronic databases." *See generally*TBMP § 1207.03. Third, and more fundamental, the Board's judicial notice practice, as well as these other practices, are designed to encourage applicants (and examining attorneys) to fully raise their arguments during prosecution, where they can be more efficiently resolved, and to avoid unnecessary or inefficient appeals.

The Board will not take judicial notice of facts not commonly known. [Note 11.] Even where facts are commonly known and accepted, however, the Board is not required to take judicial notice because the taking of judicial notice is discretionary.

For a full discussion of judicial notice in the inter partes context, see TBMP § 704.12.

NOTES:

1. For decisions issued in 2000 and after, see *In re tapio GmbH*, 2020 USPQ2d 11387, at *3 n.10 (TTAB 2020) (Board took judicial notice of "CT" as an abbreviation for the state of Connecticut from online version of Merriam-Webster Dictionary); *In re Morinaga Nyuguo Kabushiki Kaisha*, 120 USPQ2d 1738, 1744 n.4 (TTAB 2016) (Board took judicial notice of the locations of Puyallup, Washington and Mount Rainer); *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767-1768 (TTAB 2016) (Board may take judicial notice of online dictionary definitions also available in printed form); *In re Cordua Rests. LP*, 110 USPQ2d 122, 1229 n.4 (TTAB 2014) (Board took judicial notice of the definitions of "churrasco" from English language dictionaries), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (Board may take judicial notice of online dictionaries that exist in printed format or have regular fixed editions); *In re Thomas White International Ltd.*, 106 USPQ2d 1158, 1160 n.1 (TTAB 2013) (judicial notice taken from dictionary existing in print format); *In re Future Ads LLC*, 103 USPQ2d 1571, 1572 (TTAB 2012) (judicial notice taken of definition from online dictionary stating it was from a specified print dictionary); *In re Premiere Distillery LLC*, 103 USPQ2d 1483, 1484 (TTAB 2012) (judicial notice taken of online dictionary reference based on Random House Dictionary); *In re Jonathan Drew, Inc.*, 97 USPQ2d 1640, 1642 n.4 (TTAB 2011) (Board may take judicial notice of dictionaries, including online dictionaries which exist in print format); *In re Greenliant Systems, Inc.*, 97 USPQ2d 1078, 1080 n.5 (TTAB 2010) (same); *In re Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010) (judicial notice taken of definitions from Random House Dictionary as accessed at the website www.dictionary.com); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1338 (TTAB 2009) (judicial notice taken of definitions in The Dictionary of Multimedia Terms & Acronyms, Illustrated Computer Dictionary for Dummies and The Computer Glossary); *In re Hotels.com, L.P.*, 87 USPQ2d 1100, 1103 (TTAB 2007) (definition from The American Heritage Dictionary of the English Language, retrieved from bartleby.com website), *aff'd*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 n.3 (TTAB 2008) (judicial notice taken of definition in Cassell's Spanish-English English-Spanish Dictionary); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1285 n.2 (TTAB 2006) (judicial notice taken of definition in Cassell's New French Dictionary); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1957 (TTAB 2006) (judicial notice taken of definitions in Computer Desktop Encyclopedia and Dictionary of Computer and Internet Terms); *In re Reed Elsevier Properties Inc.*, 77 USPQ2d 1649, 1653 n.8 (TTAB 2005) (definition from net.speak--the internet dictionary), *aff'd*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007); *In re Isabella Fiore LLC*, 75 USPQ2d 1564, 1568 n.7 (TTAB 2005) (judicial notice taken of translation in Cassell's Italian Dictionary); *In re Styleclick.com*, 58 USPQ2d 1523, 1525 (TTAB 2001) (definitions from computer dictionaries, i.e., net.speak—the internet dictionary, The Computing Dictionary and The Illustrated Dictionary of Microcomputers); *In re 3Com Corp.*, 56 USPQ2d 1060, 1061 n.3 (TTAB 2000) (judicial notice of definitions in technical reference works).

For decisions issued before 2000, see *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209, 1210 n.6 (TTAB 1999) (dictionary definition submitted with examining attorney's brief); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1537 (TTAB 1998) (well settled that dictionary listings comprise matter of which Board can take judicial notice); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 (TTAB 1998) (definitions from Webster's New Geographical Dictionary submitted with examining attorney's appeal brief); *In re North American Free Trade Association*, 43 USPQ2d 1282, 1285 n.6 (TTAB 1997) (definition from Black's Law Dictionary); *In re Analog Devices Inc.*, 6 USPQ2d 1808, 1810 n.2 (TTAB 1988) (judicial

notice of technical trade dictionaries such as IEEE Standard dictionary of Electric and Electronics Terms) *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

2. *In re Wilcher Corp.*, 40 USPQ2d 1929, 1933 n.4 (TTAB 1996).

3. For decisions issued in 2000 and after, see, e.g., *In re Guild Mortgage Company*, 2020 USPQ2d 10279, at *7 nn.26-28 (TTAB 2020) (Board took judicial notice of the distance between the respective addresses of the applicant and registrant and "the substantial size" of the populations of San Diego and Los Angeles); *In re tapio GmbH*, 2020 USPQ2d 11387, at *13 n.46 (TTAB 2020) (Board took judicial notice of 2010 U.S. Census records for the top 1,000 surnames); *In re S. Malhotra & Co.*, 128 USPQ2d 1100, 1103 n.5 (TTAB 2018) (Board took judicial notice of "Detailed Languages Spoken at Home and Ability to Speak English for the Population 5 Years and Over for the United States: 2009-2013," published by the U.S. Census to find that Greek is a common, modern language); *In re Weiss Watch Co.*, 123 USPQ2d 1200, 1205 n.10 & n.12 (TTAB 2017) (Board took judicial notice that "eszett" is the letter ß in the German alphabet from online translation dictionary Langenscheidt Dictionary at en.langenscheidt.com/german-english/eszett and separately that one origin of the surname WEISS is a German habitational name from Dictionary of American Family Names (Oxford University Press 2003)); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1087 n.3 (TTAB 2016) (Board may take judicial notice of information from encyclopedias); *In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1271 n.7 (TTAB 2016) (Board may take judicial notice of U.S. Census Report); *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (Board took judicial notice that beer is often relatively inexpensive, subject to impulse purchase, and often ordered orally in a bar or restaurant); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127 n.6 (TTAB 2015) (Board took judicial notice of the August 2013 United States Census Bureau's "Language Use in the United States: 2011" report, indicating that after English, Spanish is the most commonly spoken language in the United States, and over 12% of the United States population speaks Spanish); *In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015) (Board took judicial notice of two online government reports providing statistics of Internet use in the United States); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.24 (TTAB 2013) (judicial notice taken of entry for "tea" from Encyclopedia Britannica); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1338 (TTAB 2009) (judicial notice taken of listing in Computer Desktop Encyclopedia); *In re Tokutake Industry Co.*, 87 USPQ2d 1697, 1700 n.1 (TTAB 2008) (census data); *In re Yeley*, 85 USPQ2d 1150, 1153 nn.10, 11 (TTAB 2007) (judicial notice taken of The Little Giant Encyclopedia of Names, and that some persons use initials in lieu of a given name); *In re Thermo LabSystems Inc.*, 85 USPQ2d 1285, 1291 (TTAB 2007) (common knowledge that places are often named after individuals); *In re Joint-Stock Co. "Baik"*, 84 USPQ2d 1921, 1923 n.2 (TTAB 2007) (judicial notice taken of entry for Baikal Lake in Encyclopedia International); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 (TTAB 2006) (Baton Rouge is the capital of Louisiana); *In re Isabella Fiore LLC*, 75 USPQ2d 1564, 1566 n.5 (TTAB 2005) (Statistical Abstract of the United States regarding population of the United States; the population of the United States is a fact of which judicial notice can be taken); *In re Eddie Z's Blinds and Drapery Inc.*, 74 USPQ2d 1037, 1038 n.3 (TTAB 2005) (definition in McGraw Hill Computer Desktop Encyclopedia); *In re Consolidated Specialty Restaurants Inc.*, 71 USPQ2d 1921, 1927 (TTAB 2004) (judicial notice taken of Merriam-Webster's Geographical Dictionary and The Columbia Gazetteer of North America); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n.5 (TTAB 2001) (judicial notice taken of The Encyclopedia of Furniture, The Complete Guide To Furniture Styles, and Seng Furniture Facts showing that Danish, Scandinavian and Mediterranean are styles of furniture); *In re Major League Umpires*, 60 USPQ2d 1059, 1060 n.2 (TTAB 2001) (the National League is part of Major League Baseball); *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 n.5 (TTAB 2001) (common knowledge that radio broadcasts may be heard in real-time on the Internet).

For decisions issued before 2000, see, e.g., *In re Dial-A-Mattress Operating Corp.*, 52 USPQ2d 1910, 1916 (TTAB 1999) toll-free telephone area codes such as "1-888" are used by numerous persons and businesses), *rev'd on other grounds*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (*In re Astra Merck Inc.*, 50 USPQ2d 1216, 1219 (TTAB 1998) (judicial notice taken of Physician's Desk Reference and other PDR publications); *In re U.S. Cargo Inc.*, 49 USPQ2d 1702, 1704 n.3 (TTAB 1998) ("U.S." means the United States, and the United States is a geographic area with defined boundaries); *In re Perry Manufacturing Co.*, 12 USPQ2d 1751, 1752 (TTAB 1989) (New York is world-renowned center of culture and high fashion and people from throughout world go to New York to purchase latest styles in clothing, from haute couture to off-the-rack garments).

Compare, *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 (TTAB 2006) (Board denied request for judicial notice that Moulin Rouge is a famous Parisian nightclub and that its name served as title of a film starring Nicole Kidman that was nominated for an Academy Award); *In re Viventia Biotech Inc.*, 80 USPQ2d 1376, 1377 (TTAB 2006) (Board did not take judicial notice of Internet search); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1379 n.7 (TTAB 2006) (Board would not take judicial notice of "scholarly reviews" of an essay).

4. *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1768 (TTAB 2016) (on appeal, Board will not take judicial notice of definitions from Wikipedia or commercial websites that do not constitute dictionary definitions); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 n.5 (TTAB 2007) (Board would not take judicial notice of online encyclopedia); *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). *See also In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002); *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1447 n.3 (TTAB 2000).

5. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (judicial notice taken of definition from Merriam-Webster Online Dictionary and Thesaurus); *In re Dietrich*, 91 USPQ2d 1622, 1631 n.15 (TTAB 2009) (judicial notice taken of definition from Merriam-Webster Online Dictionary from www.merriam-webster.com); *In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1334 n.1 (TTAB 2009) (judicial notice taken of definition from Dictionary.com because from The Random House Unabridged Dictionary); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590 n.8 (TTAB 2008) (judicial notice taken of definition from Merriam-Webster Online Dictionary); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) (judicial notice taken of definition from *Encarta Dictionary* because it is readily available in specifically denoted editions via the Internet and CD-ROM).

Please Note: the Board will consider definitions found only in online dictionaries if made of record during the prosecution of the application. *See* TBMP § 1208.03.

6. *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1768 (TTAB 2016) (on appeal, Board will not take judicial notice from excerpts that do not indicate source); *In re Gregory*, 70 USPQ2d 1792, 1793 (TTAB 2004) (judicial notice not taken of photocopies submitted with examining attorney's brief because neither the pages nor brief specified the dictionaries from which the copies were made).

7. *In re Future Ads LLC*, 103 USPQ2d 1571, 1572 n.2 (TTAB 2012) (Board declined to take judicial notice of term from Cambridge Dictionaries Online because definition stated it was "British English"). *Cf. In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311, 1313 (TTAB 2014).

8. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007) ("The probative value, if any, of foreign information sources must be evaluated on a case-by-case basis.").

9. *In re Future Ads LLC*, 103 USPQ2d 1571, 1572 n.3 (TTAB 2012) (Board did not take judicial notice of online dictionary definition because only the link to the website was provided). *Cf. In re HSB Solomon Associates LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) (Board will not utilize web address to access site and consider whatever content appears).

10. *In re House Beer, LLC*, 114 USPQ2d 1073, 1075 (TTAB 2015) (Board does not take judicial notice of files of applications or registrations residing in the Office, including entries in file of cited registration); *In re Wada*, 48 USPQ2d 1689, 1689 n.2 (TTAB 1998) (request in reply brief that Board take judicial notice of "thousands of registered marks incorporating the term NEW YORK for products and services that do not originate in New York state or city" denied), *aff'd*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1717 n.18 (TTAB 2011); *In re Jonathan Drew, Inc.*, 97 USPQ2d 1640, 1644 n.11 (TTAB 2011); *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998); *In re Caserta*, 46 USPQ2d 1088, 1090 n.4 (TTAB 1998) (Board refused to take judicial notice of the characters listed in registrations and their manner of use); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69955 (Oct. 7, 2016) (no judicial notice of USPTO records; "The official record of a Board proceeding must be complete, accurate, and reliable, especially because in direct appeals to the Federal Circuit the court's review of the Board's decision is confined to the four corners of the administrative record. … The burden of creating a complete evidentiary record by introducing in documentary form information contained in the USPTO's trademark file records is most appropriately borne by the party wishing to introduce such evidence rather than by the Board."). *See also In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1767-68 (TTAB 2016) (on appeal, Board denied request to take judicial notice of patent).

11. *In re tapio GmbH*, 2020 USPQ2d 1138, at *11 n.39 (TTAB 2020) (Board declined to take judicial notice "that TAPIO identifies an East Finnish forest spirit god of Finnish mythology, because we do not believe that this a commonly known fact, at least in the United States.").

1208.05 Applicant's Own Materials

An applicant's materials, such as its website or advertisements describing its goods or services, or specimens showing use of its mark, may be considered. [Note 1.] Additionally, an applicant's patent or patent application may also be considered. [Note 2.] This is the case even if the applicant files its application based on an intent-to-use or changes the basis of its application to intent-to-use. [Note 3.]

An applicant's submissions of expert reports [Note 4] and surveys [Note 5] are considered for their probative value.

NOTES:

1. *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017) (as a matter of law, the Board "did not err by considering the explanatory text of the specimens in the descriptiveness inquiry"); *In re James S. Fallon*, 2020 USPQ2d 11249, at *9-10 (TTAB 2020) (Board considered applicant's own website advertisement touting product features in affirming mere descriptiveness refusal); *In re Emergency Alert Sols. Group, LLC*, 122 USPQ2d 1088, 1091 n.16, 1092 (TTAB 2017) (Board considered applicant's own webpage and specimen describing its services in affirming genericness refusal); *In re Weiss Watch Co.*, 123 USPQ2d 1200, 1202 (TTAB 2017) (Board, in affirming surname refusal, considered applicant's website stating that WEISS is the surname of Applicant's founder and head watchmaker).

2. *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *4 (TTAB 2020).

3. *In re Hunter Fan Co.*, 78 USPQ2d 1474, 1476 n.2 (TTAB 2006) (specimen submitted when application based on Trademark Act § 1(a) remains of record even though applicant later amended its application to Trademark Act § 1(b)); *In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006) (examining attorney may introduce evidence that applicant's own literature supports descriptiveness of term despite the fact that application based on intent-to-use; fact that applicant has filed an intent-to-use application does not limit the examining attorney's evidentiary options or shield an applicant from producing evidence that it may have in its possession).

4. *See, e.g., In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1830-31 (TTAB 2011).

5. *See, e.g., In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1831-32 (TTAB 2011).

1208.06 Confidential Material

Submissions filed in ex parte examination and subsequent appeal proceedings cannot be filed under seal pursuant to a protective order unless so issued or ordered by any court or by the Board. 37 C.F.R. § 2.27(d), 37 C.F.R. § 2.27(e). [Note 1.]

NOTES:

1. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1962 n.6 (TTAB 2016) (consent agreement, in addition to supporting registration, provides the public with notice of the basis on which the USPTO allowed registration). *Compare Holmes Oil Co. v. Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1150 n.4 (TTAB 2011) (parties' confidential consent agreement referred to in general terms).

1209 Remand

1209.01 Upon Board's Own Initiative

37 C.F.R. § 2.142 ***Time and manner of ex parte appeals.***

(f)(1) *If, during an appeal from a refusal of registration, it appears to the Trademark Trial and Appeal Board that an issue not previously raised may render the mark of the appellant unregistrable, the Board may suspend the appeal and remand the application to the examining attorney for further examination to be completed within the time set by the Board.*

(2) *If the further examination does not result in an additional ground for refusal of registration, the examining attorney shall promptly return the application to the Board, for resumption of the appeal, with a written statement that further examination did not result in an additional ground for refusal of registration.*

(3) *If the further examination does result in an additional ground for refusal of registration, the examining attorney and appellant shall proceed as provided by §§ 2.61, 2.62, and 2.63. If the ground for refusal is made final, the examining attorney shall return the application to the Board, which shall thereupon issue an order allowing the appellant sixty days from the date of the order to file a supplemental brief limited to the additional ground for the refusal of registration. If the supplemental brief is not filed by the appellant within the time allowed, the appeal may be dismissed.*

(4) *If the supplemental brief of the appellant is filed, the examining attorney shall, within sixty days after the supplemental brief of the appellant is sent to the examining attorney, file with the Board a written brief answering the supplemental brief of appellant and shall email or mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examining attorney.*

(5) *If an oral hearing on the appeal had been requested prior to the remand of the application but not yet held, an oral hearing will be set and heard as provided in paragraph (e) of this section. If an oral hearing had been held prior to the remand or had not been previously requested by the appellant, an oral hearing may be requested by the appellant by a separate notice filed not later than ten days after the due date for a reply brief on the additional ground for refusal of registration. If the appellant files a request for an oral hearing, one will be set and heard as provided in paragraph (e) of this section.*

If, during an ex parte appeal to the Board, it appears to the Board that an issue not previously raised may render the mark of the applicant unregistrable, the Board may issue a written action suspending the appeal and remanding the application to the examining attorney for further examination with respect to that issue. [Note 1.] However, the Board normally will not remand an application for consideration of a requirement or ground for refusal if the examining attorney had previously made that requirement or refused registration on that ground and then withdrew it. [Note 2.]

The Board may also sua sponte remand an application to the examining attorney if, after examination and/or briefing has been completed, a decision in another case is rendered that is likely to have a bearing on the examining attorney's position [Note 3] or if the nonproffering party consents to the submission of new evidence, even at a late stage of the appeal. [Note 4.] Or the Board may remand an application for clarification of the issues on appeal, where, for example, the examining attorney and the applicant appear to be arguing different grounds of refusal.

The further examination must be completed within the time set by the Board, or within an extension of time for that purpose. [Note 5.]

If the examining attorney, upon consideration of the issue specified in the Board's remand letter, does not believe that the specified issue renders the mark of the applicant unregistrable, the examining attorney must promptly return the application to the Board with a written statement that further examination did not result in an additional requirement or ground for refusal of registration. [Note 6.] The Board will then resume proceedings with respect to the appeal, and take further appropriate action. The issues ultimately determined by the Board will be those that were the subject of the appeal; no consideration will be given to the issue that was the subject of the remand. [Note 7.]

If, on the other hand, the further examination does result in an additional requirement or ground for refusal of registration, the examining attorney and the applicant should proceed as specified in 37 C.F.R. § 2.61 through 37 C.F.R. § 2.63. [Note 8.] If the additional requirement or ground for refusal of registration is ultimately made final, the six-month response clause should be omitted from the Office action; the application should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein. Specifically, the Board will issue an order allowing the applicant 60 days from the date of the order in which to file a supplemental brief directed (solely) to the additional ground for refusal of registration. [Note 9.]

If the applicant fails to file a supplemental brief within the specified 60-day period, or during an extension of time for that purpose, the appeal may be dismissed. [Note 10.] If the applicant files a supplemental brief, the Board will forward the application to the examining attorney. Within 60 days after the date of the Board's written action forwarding the application to the examining attorney, or within an extension of time for that purpose, the examining attorney must file a written brief answering the supplemental brief of the applicant. If the examining attorney had not previously submitted an appeal brief, the written brief may answer not just the applicant's supplemental brief, but also its original appeal brief. [Note 11.] The examining attorney must also send a copy of their brief to the applicant. [Note 12.] If the examining attorney's brief is late-filed, the Board may exclude it in the absence of an adequate explanation for the late filing. [Note 13.] TBMP §

1203.02(b). Within 20 days from the date of the examining attorney's brief, or within an extension of time for the purpose, the applicant may, if it so desires, file a reply brief. [Note 14.] The filing of a reply brief is not mandatory. If the applicant files a reply brief, the Board will notify the examining attorney so that it can be reviewed.

If an oral hearing on the appeal had been requested by the applicant prior to the remand of the application, but had not yet been held, the oral hearing will be set after the expiration of the applicant's time for filing a reply brief or, depending on the circumstances, a supplemental reply brief directed to the additional ground for refusal of registration. [Note 15.] If an oral hearing had been held prior to the remand, or had not previously been requested by the applicant, an oral hearing may be requested by the applicant by separate submission filed not later than 10 days after the due date for a reply brief on the additional ground for refusal of registration; the oral hearing will be set by the Board upon receipt of the request. [Note 16.]

If the examining attorney is persuaded by the applicant's supplemental brief and/or reply brief that the additional requirement or ground for refusal of registration should be withdrawn, the examining attorney should issue a written action withdrawing the requirement or additional ground, and return the application to the Board for resumption of proceedings in the appeal.

The examining attorney may not, upon remand under 37 C.F.R. § 2.142(f)(1), make a requirement or refuse registration on a new ground not specified in the Board's remand letter. If the examining attorney, upon remand, wishes to make a requirement or refuse registration on a new ground not specified in the Board's remand letter, the examining attorney must file a request with the Board, pursuant to 37 C.F.R. § 2.142(f)(6), for jurisdiction to make a requirement or refuse registration on the new ground. Nor may the examining attorney, upon remand under 37 C.F.R. § 2.142(f)(1), submit evidence relating to a requirement or ground not specified in the Board's remand letter. [Note 17.] For information on informalities which are noted by the Board in its final decision, but for which remand was not considered necessary, see TBMP § 1217.

For information concerning the submission of new evidence after remand for refusal of registration on an additional ground, see TBMP § 1207.05.

NOTES:

1. 37 C.F.R. § 2.142(f)(1). *See In re Opryland USA Inc.*, 1 USPQ2d 1409, 1411 (TTAB 1986); *In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986); *In re Johanna Farms, Inc.*, 223 USPQ 459, 461 (TTAB 1984). *See also In re Wella A.G.*, 858 F.2d 725, 8 USPQ2d 1365, 1369 (Fed. Cir. 1988), *rev'g* 230 USPQ 77, 79 (TTAB 1986).

2. *In re Bed & Bars Ltd.*, 122 USPQ2d 1546, 1548 n.2 (TTAB 2017) ("the Board normally will not remand an application for consideration of a ground of refusal if the Examining Attorney … had previously refused registration on that ground and then withdrew the refusal").

3. *See In re Dekra e.V.*, 44 USPQ2d 1693, 1694-95 (TTAB 1997) (after briefs were filed, the Federal Circuit issued a decision with applicability to the case; Board remanded case to examining attorney to consider refusal in light of that decision). *See also In re Consolidated Specialty Restaurants Inc.*, 71 USPQ2d 1921, 1922 (TTAB 2004) (Board granted examining attorney's request for remand in view of Federal Circuit decision setting forth new standard for primarily geographically deceptively misdescriptive marks).

4. *See, e.g., In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at *1 & n.3 (TTAB 2020) (Board sua sponte remanded applications to the examining attorney to consider evidence submitted by applicant

with its reply brief because the evidence was responsive to a previous Rule 2.61 request for information by the examining attorney, and applicant submitted it with the examining attorney's asserted consent).

5. 37 C.F.R. § 2.142(f)(1).

6. *See* 37 C.F.R. § 2.142(f)(2). *See In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986).

7. *See In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986).

8. 37 C.F.R. § 2.142(f)(3).

9. 37 C.F.R. § 2.142(f)(3).

10. 37 C.F.R. § 2.142(f)(3).

11. *See In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1918 (TTAB 1998).

12. 37 C.F.R. § 2.142(f)(4).

13. *Cf. In re Tennessee Walking Horse Breeders' and Exhibitors' Association*, 223 USPQ 188 n.3 (TTAB 1984).

14. 37 C.F.R. § 2.142(f)(4).

15. 37 C.F.R. § 2.142(f)(5).

16. 37 C.F.R. § 2.142(f)(5).

17. *See In re W.W. Henry Co.*, 82 USPQ2d 1213, 1213-14 (TTAB 2007) (because claimed date of first use and use in commerce is subsequent to application filing date, final decision allowed applicant to file either an amendment to the dates of use or an amendment to the basis for the application); *In re Sandberg & Sikorski Diamond Corp.*, 42 USPQ2d 1544, 1545 n.1 (TTAB 1996) (in final decision, Board recommended that applicant, if it ultimately prevailed, amend description of mark to clearly set forth claim); *In re EBSCO Industries Inc.*, 41 USPQ2d 1913, 1915 n.3 (TTAB 1996) (if applicant ultimately prevailed, it should file an amended drawing).

1209.02 Upon Request by Trademark Examining Attorney

37 C.F.R. § 2.142(f)(6) *If, during an appeal from a refusal of registration, it appears to the examining attorney that an issue not involved in the appeal may render the mark of the appellant unregistrable, the examining attorney may, by written request, ask the Board to suspend the appeal and to remand the application to the examining attorney for further examination. If the request is granted, the examining attorney and appellant shall proceed as provided by §§ 2.61, 2.62, 2.63 and 2.64. After the additional ground for refusal of registration has been withdrawn or made final, the examining attorney shall return the application to the Board, which shall resume proceedings in the appeal and take further appropriate action with respect thereto.*

If, during an ex parte appeal to the Board, it appears to the examining attorney that an issue not involved in the appeal may render the mark of the applicant unregistrable, the examining attorney may file a written

request with the Board to suspend the appeal and remand the application for further examination. [Note 1.] Such a request may be filed at any point in the appeal prior to the Board's rendering a final decision, including at the point the examining attorney is to submit an appeal brief or supplemental appeal brief. [Note 2.]

Because the mandate of the USPTO is to register only eligible marks, an examining attorney's request for remand will generally be granted unless there is no valid basis for the request, e.g., remand is requested to require a disclaimer of a term which is not part of the mark. If the examining attorney's request for remand is granted, the Board will forward the application to the examining attorney for further examination in accordance with the request. In its action granting the request, the Board will allow the examining attorney a specified time in which to issue an Office action pursuant to the request. Thereafter, the examining attorney and applicant should proceed as provided in 37 C.F.R. § 2.61 through 37 C.F.R. § 2.64. [Note 3.]

If, upon remand, the examining attorney determines that registration should not be finally refused on the additional ground or that it is appropriate to withdraw the requirement mentioned in the request for remand, the examining attorney should issue a written Office action in which the six-month response clause is omitted and return the application to the Board; proceedings with respect to the appeal will be resumed and further appropriate action will be taken therein. [Note 4.] If the examining attorney determines, after considering applicant's response to the nonfinal Office action, that a final refusal on that ground should issue or that a requirement should be made final, the examining attorney should issue a new action, omitting the six-month response clause, which makes the refusal final as to both the additional ground and/or requirement and the ground(s) and/or requirements asserted in the previous final action. The application should then be returned to the Board, and proceedings in the appeal will be resumed. For information as to the further action taken by the Board, i.e., for information concerning the filing of supplemental briefs, and a request for oral hearing, see TBMP § 1209.01. [Note 5.]

The examining attorney may not, upon remand under 37 C.F.R. § 2.142(f)(6), make a requirement or refuse registration on a new ground not mentioned in the examining attorney's request for remand. If the examining attorney, upon remand, wishes to make a new requirement or refuse registration on a new ground not mentioned in the request for remand, the examining attorney must file a new request with the Board for jurisdiction to make a new requirement or refuse registration on the new ground. Nor may the examining attorney submit evidence that does not relate to the requirement or ground mentioned in the request for remand; thus, the examining attorney may not submit evidence that supports the grounds for refusal on which the appeal was originally filed.

In addition, the examining attorney may also request remand for other reasons, including, for example, to request information from an applicant regarding a previously issued refusal. [Note 6.]

For information concerning the submission of new evidence after remand for refusal of registration on an additional ground, see TBMP § 1207.05.

NOTES:

1. 37 C.F.R. § 2.142(f)(6). *See, e.g.*, *In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at *1 (TTAB 2020) (Board granted examining attorney's request for remand for consideration of new evidence that raised a potential ownership issue).

2. *See In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at *1 (TTAB 2020) (Board granted examining attorney's request for remand after full briefing of appeal; subsequently supplemental briefing allowed); *In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1918 (TTAB 1998) (Board granted examining

attorney's request for remand which was filed after submission of applicant's appeal brief and supplemental appeal brief in order to allow examining attorney to refuse registration on additional ground).

3. *See* 37 C.F.R. § 2.142(f)(6). *Cf.* 37 C.F.R. § 2.142(f)(3).

4. *See* 37 C.F.R. § 2.142(f)(6).

5. *See In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1918 (TTAB 1998).

6. *See In re Vox Populi Registry Ltd.*, 2020 USPQ2d 11289, at *2 (TTAB 2020) (in reviewing Board's prior order granting examining attorney's request for remand, Board found good cause for remand existed based on the examining attorney's request for additional information as to the nature of applicant's contract with ICANN; such information was relevant to the failure to function refusal), appeal filed, No. 2021-1496 (Fed. Cir. Dec. 31, 2020).

1209.03 Upon Determination of Letter of Protest

A third party that has objective evidence bearing upon the registrability of a mark in a pending application may bring such evidence to the attention of the Office by filing, with the Office of the Deputy Commissioner for Trademark Examination Policy, a "letter of protest" that complies with the requirements of 37 C.F.R. § 2.149. [Note 1.] TBMP § 1207.06. The Deputy Commissioner will determine if the submission complies with the requirements of Trademark Rule 2.149 and whether any submitted evidence should be included in the application record for consideration by the examining attorney. *See*TBMP § 215.

Proceedings in an ex parte appeal will not be suspended pending determination by the Deputy Commissioner of a letter of protest. However, if the Deputy Commissioner determines that the letter of protest submission complies with the requirements of Rule 2.149 and includes submitted evidence in the application record, and the examining attorney, having considered the evidence, believes that an issue not involved in the appeal may render the mark of the applicant unregistrable, the examining attorney may file a written request with the Board, pursuant to 37 C.F.R. § 2.142(f)(6), to suspend the appeal and remand the application for further examination.

For information concerning requests for remand for a new refusal or new requirement, and the further proceedings in the case if such a request is granted by the Board, see 37 C.F.R. § 2.142(f)(6), and TBMP § 1209.02.

NOTES:

1. *See*TMEP § 1715.

1209.04 Upon Request by Applicant

A request filed by an applicant to remand the application to the examining attorney that is filed within six months of the issuance of a final Office action is treated as a request for reconsideration, whether it is denominated as such, or is captioned as a request for remand, unless applicant has already filed a brief. *See*TBMP § 1204. Requests for reconsideration are granted by the Board as a matter of right. *See*TBMP § 1204. If the request is filed more than six months after the issuance of the final refusal (generally after the filing of the notice of appeal), or within six months from issuance of a final Office Action but after the applicant has filed a brief, it will be treated as a request for remand, for which good cause must be shown,

whether it is captioned as a request for remand or as a request for reconsideration. *See*TBMP § 1204 and TBMP § 1207.04.

Requests for remand are generally filed by applicants because they wish to make additional evidence of record, or because they wish to amend the application. Applicants may also request remand so that the examining attorney can consider a refusal in light of a recently decided case or amended Trademark Rule. [Note 1.] No matter what the purpose, the request for remand must include a showing of good cause. [Note 2.] In determining whether good cause has been shown, the Board will consider both the reason given and the point in the appeal at which the request for remand is made. For examples of circumstances that have been found to constitute good cause for a remand for the purpose of submitting additional evidence, see TBMP § 1207.02. For examples of what constitutes good cause for the purpose of amending an application, see TBMP § 1205.01.

If the applicant has not filed its appeal brief prior to filing the request for remand, it should not do so until the Board has acted on the remand request. If the request is denied, the Board will allow the applicant time in which to file its appeal brief. If the request for remand is granted, the Board will suspend proceedings with respect to the appeal, and remand the application to the examining attorney for consideration of the request for remand. The Board's order granting the remand and the directions to the examining attorney contained therein will depend on the nature of the remand request and the circumstances. [Note 3.] If the request for remand is for the purpose of submitting additional evidence, see TBMP § 1207.02. If the request for remand is for the purpose of submitting an amendment to the application, see TBMP § 1205.01. The examining attorney may only consider the matter for which the application has been remanded. The examining attorney may not use the remand in order to submit evidence in connection with a refusal or requirement that is not the subject of the remand request. [Note 4.] To submit such evidence, reinstate a refusal or requirement, or make a new refusal or requirement, the examining attorney would have to file separate request for remand. [Note 5.] *See*TBMP § 1207.02.

NOTES:

1. *But see In re Datapipe, Inc.*, 111 USPQ2d 1330, 1331 (TTAB 2014) (applicant's alternative request for remand to consider informal nonpublic examination guide denied).

2. *See In re Martin Container, Inc.*, 65 USPQ2d 1058, 1060 (TTAB 2002) (request for remand filed after notice of appeal in view of recent ruling by the Court of Appeals for the Federal Circuit). *Cf. In re Adlon Brand Gmbh & Co.*, 120 USPQ2d 1717, 1725 (TTAB 2016) ("Applicant's brief on the case is not the appropriate avenue for raising an objection to examination procedures. If Applicant believed that the issuance of the June 8, 2014 Office Action was procedurally erroneous, or if Applicant desired more time to address the Examining Attorney's new evidence, Applicant's recourse was to file with the Board, after the filing of the appeal but before briefing, a request for remand with a showing of good cause.") (citation omitted).

3. *See*TMEP § 1504.05.

4. *In re Hughes Furniture Industries, Inc.*, 114 USPQ2d 1134, 1136 (TTAB 2015) (examining attorney's submission of evidence on likelihood of confusion refusal unacceptable when applicant's remand request was solely to comply with requirement for disclaimer).

5. 37 C.F.R. § 2.142(d). *See In re Hughes Furniture Industries, Inc.*, 114 USPQ2d 1134, 1136 (TTAB 2015) ("If, upon considering the request for remand the Examining Attorney wished to submit additional evidence regarding the Section 2(d) refusal (which was not affected by the disclaimer), the Examining Attorney should

have filed with the Board her own request for remand for the purpose of submitting additional evidence in support of the likelihood of confusion refusal.”).

1210 Approval for Publication During Appeal

The examining attorney may withdraw an appealed refusal to register, and approve the involved application for publication (or for registration, in the case of a Supplemental Register application), at any time prior to issuance of the Board’s decision in the case. [Note 1.] *See, e.g.,* TBMP § 1203.02(b), TBMP § 1203.02(c), TBMP § 1204, TBMP § 1205, and TBMP § 1207.02. When the examining attorney does so, the appeal becomes moot.

The examining attorney should notify the applicant and the Board by telephone or email that the application is being approved for publication (or registration). [Note 2.]

NOTES:

1. TMEP § 1501.03.

2. TMEP § 1501.03.

1211 Abandonment During Appeal

37 C.F.R. § 2.68 ***Express abandonment (withdrawal) of application.***

(a) ***Written document required.*** *An applicant may expressly abandon an application by filing a written request for abandonment or withdrawal of the application, signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2). A request for abandonment or withdrawal may not subsequently be withdrawn.*

(b) ***Rights in the mark not affected.*** *Except as provided in § 2.135, the fact that an application has been expressly abandoned shall not affect any rights that the applicant may have in the mark set forth in the abandoned application in any proceeding before the Office.*

During an ex parte appeal to the Board, i.e., before the Board issues a final decision [Note 1], the applicant may expressly abandon its involved application by filing in the Office a written statement of abandonment or withdrawal of the application. [Note 2.] The abandonment or withdrawal must be signed by the applicant or its attorney or other authorized representative. [Note 3.] A request for abandonment or withdrawal may not be subsequently withdrawn. [Note 4.]

The express abandonment, during an ex parte appeal to the Board, of the applicant’s involved application will not, in any proceeding in the Office, affect any rights that the applicant may have in the mark that is the subject of the abandoned application. [Note 5.]

In contrast, after the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of its involved application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. [Note 6.] TBMP § 602.01 and TBMP § 603.

NOTES:

1. *See In re Information Builders Inc.*, 2021 USPQ2d 228, at *1 n.1 (TTAB 2021) (defining "final decision" as final dispositive ruling that ends litigation on the merits before the Board).

2. *In re Information Builders Inc.*, 2021 USPQ2d 228, at *4 & n.4 (TTAB 2021) (applicant's attempt to circumvent adverse final decision by filing express abandonment (without prejudice) under 37 C.F.R. § 2.68, with no mandate from the Federal Circuit and no order from the Director directing Board to give effect to the express abandonment, is impermissible under 37 C.F.R. § 2.142(g), would frustrate the administrative process, and runs contrary to the principle of finality of judgments).

3. 37 C.F.R. § 2.68(a).

This amendment requiring a signature to the abandonment, effective February 17, 2015, is "intended to provide applicants, registration owners, and the public assurance of the accuracy of the status of applications or registrations after filings are received by the Office." MISCELLANEOUS CHANGES TO TRADEMARK RULES OF PRACTICE AND THE RULES OF PRACTICE IN FILINGS PURSUANT TO THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS, 80 Fed. Reg. 2303, 2307 (January 16, 2015).

4. 37 C.F.R. § 2.68(a). *See also Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 2 USPQ2d 1264, 1267 (1st Cir. 1987). *Cf. In re Honeywell Inc.*, 8 USPQ2d 1600, 1601-02 (TTAB 1988) (preclusive effect of prior final judgment arising out of an ex parte case); *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1583 (TTAB 1987); *Lukens Inc. v. Vesper Corp.*, 1 USPQ2d 1299, 1301 (TTAB 1986), *aff'd*, 831 F.2d 306 (Fed. Cir. 1987).

5. 37 C.F.R. § 2.68(b).

6. 37 C.F.R. § 2.135.

1212 Cancellation or Assignment of Cited Registration

Often, in an ex parte appeal to the Board, the asserted ground (or one of the asserted grounds) for refusal of registration is Trademark Act § 2(d), 15 U.S.C. § 1052(d), that is, that applicant's mark so resembles a mark registered in the USPTO as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, or to cause mistake, or to deceive.

If, during the pendency of an ex parte appeal involving a refusal to register under Trademark Act § 2(d), 15 U.S.C. § 1052(d), the cited registration is cancelled, or is assigned to the applicant, the appeal will be moot insofar as that issue is concerned. If the refusal to register on the basis of the cancelled or assigned registration is the only issue involved in the appeal, the Board will dismiss the appeal as moot, and the application will be sent to the examining attorney for approval for publication (or for registration, in the case of a Supplemental Register application). If the appeal involves additional issues, it will go forward solely on the additional issues.

When an application has been rejected under Trademark Act § 2(d), 15 U.S.C. § 1052(d), and the refusal to register has been appealed to the Board, it is recommended that the applicant periodically check the status of the cited registration. *See* TBMP § 1203. The applicant should immediately notify the Board if the applicant learns that the registration has expired or been cancelled, or if the registration is assigned to the applicant.

1213 Suspension of Appeal

Prior to the issuance of the Board's decision in an ex parte appeal, proceedings with respect to the appeal may be suspended by the Board upon written request by the applicant showing good cause for the requested suspension. [Note 1.] *Cf.*TBMP § 510. Examples of situations in which the Board may suspend proceedings in an appeal, at the request of the applicant, are listed below:

(1) The applicant is involved in a civil action or a Board inter partes proceeding, that may be dispositive of the issue(s) involved in the appeal, or the applicant has filed a Petition to the Director that may have a bearing on the appeal—the Board may suspend pending final determination of the civil action or Board inter partes proceeding.

(2) Another application that involves the same issue is also on appeal to the Board—the Board may suspend pending final determination of the appeal in the other application.

(3) A registration cited as a reference, under Trademark Act § 2(d), 15 U.S.C. § 1052(d), against applicant's mark is the subject of a cancellation proceeding before the Board.

(4) A registration cited as a reference, under Trademark Act § 2(d), 15 U.S.C. § 1052(d), against applicant's mark is due, or will soon be due, for an affidavit of continued use (or excusable nonuse) under Trademark Act § 8 or Trademark Act § 71, 15 U.S.C. § 1058 or 15 U.S.C. § 1141k, [Note 2.] or for an application for renewal under Trademark Act § 9 or Trademark Act § 70, 15 U.S.C. § 1059 or 15 U.S.C. § 1141j. [Note 3.] The Board may suspend the appeal pending determination of whether the registration will continue in existence or will, instead, be cancelled or expire. If an applicant requests suspension based on the possibility that the cited registration may be cancelled for failure to file an affidavit of continued use, the Board will grant such request if the Board acts on the request after the 5th anniversary of the issue date of the registration. If an applicant requests suspension based on the possibility that the cited registration will expire for failure to renew it, the Board will grant such request if the Board acts on the request after the 9th anniversary of the issue date or the renewal date for the registration.

If it comes to the attention of the examining attorney, in the case of a refusal based on likelihood of confusion with a registered mark (Trademark Act § 2(d), 15 U.S.C. § 1052(d)), that the grace period for filing an affidavit of continued use or an application for renewal for the cited registration has passed, and Office records do not indicate that such items have been submitted, the examining attorney may request remand so the application can be suspended pending final disposition of the cited registration. [Note 4.] In that situation, the Board will issue an order suspending the appeal and remanding the case to the examining attorney. If the cited registration is cancelled or expires, and that registration forms the only basis for refusal, the examining attorney will approve the application for publication (or for registration in the case of a Supplemental Register application), and the appeal will be moot. The examining attorney should so notify the applicant and the Board by telephone or email. If the Trademark Act § 2(d), 15 U.S.C. § 1052(d) refusal is only one of the issues of the appeal, the examining attorney should notify the Board that the refusal with respect to that registration has been withdrawn, and the Board will then resume proceedings in the appeal. If it is determined that an appropriate affidavit or renewal application was timely filed for the cited registration and has been accepted, the examining attorney should notify the Board, and return the application to the Board. The Board will then resume proceedings in the appeal.

If the grace period for filing the appropriate affidavit or renewal application for the cited registration has not yet expired, the examining attorney may request that the Board suspend proceedings in the appeal. In that case, the Board will issue an order advising the applicant the Board is suspending proceedings in the appeal, and giving the applicant the opportunity to inform the Board if it wishes the appeal to proceed without waiting for a determination as to whether the cited registration will be cancelled or will expire. If the applicant wishes the appeal to proceed, the cited registration will be treated as existing and valid. If the appeal is

suspended, and if an appropriate affidavit or renewal application is filed and accepted for the cited registration, the examining attorney should notify the Board. The Board will then resume proceedings in the appeal.

If it comes to the attention of the examining attorney that another application that involves the same issue is on appeal to the Board, the examining attorney may request suspension of the appeals, and also may request that the appeals be consolidated. *See*TBMP § 1214.

A request by either the applicant or the examining attorney for suspension of proceedings before the Board in an ex parte appeal must be filed prior to the issuance of the Board's final decision in the case. For example, an applicant that has appealed a refusal to register under Trademark Act § 2(d), 15 U.S.C. § 1052(d) (i.e., a refusal to register on the ground that the applicant's mark so resembles a registered mark as to be likely to cause confusion) may not wait until it receives the Board's decision on appeal and then, if the decision is adverse, file a petition to cancel the cited registration and request suspension of proceedings in the appeal pending the final determination of the cancellation proceeding. [Note 5.]

When proceedings have been suspended at the request of the applicant in an ex parte appeal to the Board, and the event for which proceedings have been suspended occurs, as, for example, when a civil action for which proceedings have been suspended has been finally determined, the applicant should file a submission notifying the Board thereof as soon as that knowledge comes to the applicant's attention. When an appeal has been suspended pending a determination of whether a cited registration will be cancelled or will expire, the applicant should monitor the status of the cited registration on a monthly basis and should advise the Board as soon as it ascertains either that the registration has been cancelled or has expired, or that the required document has been accepted by the USPTO.

The Board will then resume proceedings and take further appropriate action in the appeal. If the cited registration has been cancelled or has expired, and it was the only bar to registration, the appeal will be dismissed as moot. If the cited registration formed only one basis of the refusals or requirements on appeal, the Board will resume proceedings in the appeal with respect to the remaining issues.

In addition, the Board may sua sponte suspend action in the appeal. For example, when the refusal of registration, or one of the grounds of refusal, is based on Trademark Act § 2(d), 15 U.S.C. § 1052(d), and it appears that the cited registration will be cancelled for failure to file an affidavit of continued use or will expire for failure to renew, the Board will suspend action when an ex parte appeal has been assigned to a judge for final decision, and the due date for filing an affidavit or application for renewal of the cited registration falls on or before the date the case is assigned for decision. The due date is the anniversary date of the registration, and does not include the grace period. In this situation, the applicant will be advised that the Board is suspending proceedings in the appeal, and will be given the opportunity to inform the Board if it wishes the Board to render a decision without waiting to determine whether the cited registration will be cancelled or will expire. If the applicant wishes the Board to proceed with a decision, the cited registration will be treated as existing and valid.

The Board may also sua sponte suspend proceedings if the Board is aware of a pending civil action, an appeal of a Board decision, or a Board inter partes proceeding or another appeal that may be dispositive of or have a direct bearing on the issues in the appeal.

Proceedings in an ex parte appeal may also be suspended by the Board if the application is remanded to the examining attorney, as, for example, for (1) consideration of an amendment to the application, or (2) consideration of a request for reconsideration of a final action, or (3) assertion of a new ground of refusal, or (4) submission of additional evidence or (5) to consider the effect of a decision in another Board proceeding, appeal or civil action that may have a direct bearing on the issues in the appeal. *See*TBMP § 1202.02, TBMP

§ 1203.02(a), TBMP § 1203.02(b), TBMP § 1204, TBMP § 1205, TBMP § 1206.01, TBMP § 1207.02, TBMP § 1207.06, and TBMP § 1209. However, proceedings will not be suspended for consideration of a request for review under the USPTO Consistency Initiative. *See*TBMP § 1204.

NOTES:

1. *Cf.* 37 C.F.R. § 2.117.

2. A Trademark Act § 66(a), 15 U.S.C. § 1141f(a), registration is subject to the Trademark Act § 71 requirements for affidavits of continued use (or excusable nonuse). A Trademark Act § 71 affidavit is filed with the USPTO.

3. A renewal under Trademark Act § 70, 15 U.S.C. § 1141j refers to a renewal of the international registration underlying a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) registration. A Trademark Act § 66(a) registration will be cancelled under Trademark Act § 70 for failure to renew the international registration on which it is based. Renewals of international registrations are filed directly with the International Bureau, not the USPTO. If the underlying international registration is not renewed, the International Bureau will notify the USPTO that the international registration has expired. The corresponding extension of protection to the United States will expire as of the expiration date of the international registration and the Trademark Act § 66(a) registration will be cancelled by the USPTO. *See* Trademark Act § 70, 15 U.S.C. § 1141j.

4. *See*TMEP § 716.02(e).

5. *See In re Vycom Electronics Ltd.*, 21 USPQ2d 1799, 1800 (Comm'r 1986).

1214 Consolidation

When an applicant has filed an ex parte appeal to the Board in two or more copending applications, and the cases involve common issues of law or fact, the Board, upon request by the applicant or examining attorney or upon its own initiative, may order the consolidation of the appeals for purposes of briefing, oral hearing, and/or final decision. [Note 1.] *Cf.*TBMP § 511. The Board may also consider two or more cases in one opinion even if they have not been consolidated. [Note 2.] Even if the Board renders its decisions on two appeals in a single opinion, the appeals will not necessarily be consolidated. [Note 3.]

Although cases consolidated prior to briefing may be presented on the same brief, they do not have to be. The applicant (and/or the examining attorney) may file a different brief in each case, if the applicant (and/or the examining attorney) so desires. When consolidated cases are to be presented on the same brief, the brief should bear the serial number of each consolidated application, and a copy of the brief should be submitted for each application. Also, citations to the evidentiary record should be by serial number, as well as the date of the Office action or response and the TSDR page number. *See*TBMP § 1203.01.

Applicant must notify the Board at the time of filing its notice of appeal and throughout the appeal whether any other applications are pending with the same or similar marks regardless of whether or not those are on appeal.

NOTES:

1. *See, e.g., In re S. Malhotra & Co.*, 128 USPQ2d 1100, 1102 (TTAB 2018) (Board sua sponte consolidated two appeals); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1085 (TTAB 2016) (Board consolidated appeals

in two applications upon examining attorney's motion); *In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012) (Board sua sponte consolidated two appeals); *In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1827 (TTAB 2011) (same); *In re America Online Inc.*, 77 USPQ2d 1618, 1618 (TTAB 2006) (Board consolidated appeals in four applications upon applicant's motion); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031, 1033 (TTAB 1997); (Board sua sponte considered appeals in five applications together and rendered single opinion); *In re Pebble Beach Co.*, 19 USPQ2d 1687, 1687 (TTAB 1991); *In re Del E. Webb Corp.*, 16 USPQ2d 1232, 1233 (TTAB 1990) (proceedings consolidated because issue in two appeals the same); *In re Anton/Bauer Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988) (applicant requested after hearing on one appeal that appeals be consolidated; Board granted and decided appeals in single decision); *In re Weber-Stephen Products Co.*, 3 USPQ2d 1659, 1662 n.7 (TTAB 1987); *In re Petersen Manufacturing Co.*, 2 USPQ2d 2032, 2033 (TTAB 1987) (four appeals consolidated for oral hearing and decision); *In re San Diego National League Baseball Club, Inc.*, 224 USPQ 1067, 1608 (TTAB 1983) (appeals consolidated for oral hearing and decision).

2. *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042, 1043 (TTAB 2013) (two appeals involving common issues of law and fact decided in a single opinion); *In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009) (because appeals involved common questions of law and fact and records were practically identical, Board decided both in a single opinion); *In re Vertex Group LLC*, 89 USPQ2d 1694, 1695 (TTAB 2009) (because of virtually identical issues presented in appeals for two applications, Board issued single opinion); *In re Supply Guys Inc.*, 86 USPQ2d 1488, 1490 (TTAB 2008) (because issues and record similar, Board issued one opinion that addressed applicant's three applications); *In re Orange Communications Inc.*, 41 USPQ2d 1036, 1037-39 (TTAB 1996); *In re Sandberg & Sikorski Diamond Corp.*, 42 USPQ2d 1544, 1546 (TTAB 1996) (because issues and record in each case essentially identical, Board rendered decision as to two applications in a single opinion, noting that applicant and examining attorney treated the cases as consolidated for purposes of briefs and oral hearing).

3. *In re Hudson News Co.*, 39 USPQ2d 1915, 1916 n.5 (TTAB 1996) (Board issued a single opinion in interest of judicial economy, but each appeal stands on its own merits), *aff'd without opinion* (Fed. Cir. 1997).

1215 Alternative Positions

Just as the examining attorney may refuse registration on alternative grounds (such as, that applicant's mark, as applied to its goods and/or services, is either merely descriptive or deceptively misdescriptive of them within the meaning of Trademark Act § 2(e)(1), 15 U.S.C. § 1052(e)(1)), so, too, the applicant may, in appropriate cases, take alternative positions with respect to a refusal to register. For example, where registration has been refused on the ground that the applicant's mark, as applied to its goods and/or services, is merely descriptive of them, the applicant may take the position that its mark is not merely descriptive, and, alternatively, assert a claim, under the provisions of Trademark Act § 2(f), 15 U.S.C. § 1052(f), that its mark has become distinctive of its goods and/or services in commerce. [Note 1.] *Cf.* TBMP § 309.03 and TBMP § 311.02(b). However, it is the applicant's responsibility to make clear that it is taking alternative positions. [Note 2.]

When an applicant asserts alternative positions, and is not willing to accept registration on the basis of its "fallback" position unless the Board determines, on appeal, that the applicant's primary position is not well taken, the applicant should make its wishes clear both to the examining attorney and to the Board. For example, when the applicant, in response to a refusal on the ground of mere descriptiveness, has asserted alternatively that its mark is not merely descriptive and that the mark has become distinctive through its use in commerce, but the applicant is not willing to accept a registration issued under Trademark Act § 2(f), 15 U.S.C. § 1052(f) on the basis of the claim of acquired distinctiveness unless the Board holds, on appeal from

the refusal to register, that the mark is merely descriptive, the applicant should clearly state that its claim is "in the alternative." [Note 3.] Otherwise, if the examining attorney finds the applicant's claim of acquired distinctiveness to be persuasive (and there is no other outstanding ground for refusal to register), the examining attorney will approve the application for publication on that basis, and any registration issued to the applicant will be issued under the provisions of Trademark Act § 2(f), 15 U.S.C. § 1052(f). [Note 4.]

If, in an application that is the subject of an ex parte appeal to the Board, the applicant has asserted alternative positions (such as, that its mark is not merely descriptive of its goods and/or services, and that the mark has, in any event, become distinctive of its goods and/or services in commerce; or that its mark has become distinctive of its goods and/or services in commerce, and that the mark is, in any event, registrable on the Supplemental Register), the examining attorney should clearly state their position with respect to each of the applicant's alternative claims. [Note 5.]

In the event the applicant has clearly taken alternative positions during prosecution, but has only argued one position in briefing the appeal, the Board has the discretion to consider at final decision arguments made during prosecution. [Note 6.]

NOTES:

1. *See, e.g., In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1419 (TTAB 2010); *In re E S Robbins Corp.*, 30 USPQ2d 1540, 1541 (TTAB 1992); *In re Analog Devices Inc.*, 6 USPQ2d 1808, 1808-09 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989); *In re Engineering Systems Corp.*, 2 USPQ2d 1075, 1075 (TTAB 1986); *In re Seaman & Associates Inc.*, 1 USPQ2d 1657, 1657 (TTAB 1986); *In re Professional Learning Centers, Inc.*, 230 USPQ 70, 71 n.2 (TTAB 1986); *In re American Home Products Corp.*, 226 USPQ 327, 328 (TTAB 1985); TMEP § 1212.02(c).

See also for additional situations in which an applicant has taken alternative positions: *In re SnoWizard, Inc.*, 129 USPQ2d 1001, 1002 n.3 (TTAB 2018) (although applicant sought registration under Section 2(f), Board considered, in the alternative, whether the applied-for mark is product packaging and is inherently distinctive, because applicant advanced the argument throughout prosecution and briefing); *In re Beds & Bars Ltd.*, 122 USPQ2d 1546 (TTAB 2017) (applicant maintains mark not primarily merely a surname and alternatively requests to amend application to Supplemental Register); *In re Fantasia Distribution, Inc.*, 120 USPQ2d 1137, 1138 (TTAB 2016) (applicant maintained design not ornamental and asserted acquired distinctiveness in the alternative); *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012) (applicant clearly consented to entry of disclaimers only in the alternative because on appeal applicant maintained that the terms were not descriptive); *In re Binion*, 93 USPQ2d 1531, 1538 (TTAB 2009) (applicant asserted that his mark was not primarily merely a surname and in the alternative that it had acquired distinctiveness); *In re Reed Elsevier Properties Inc.*, 77 USPQ2d 1649, 1652 (TTAB 2005), *aff'd*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007); *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1436 (TTAB 2005); *In re Lillian Vernon Corp.*, 225 USPQ 213, 213 (TTAB 1985); *In re Narwood Productions, Inc.*, 223 USPQ 1034, 1036 (TTAB 1984); *In re Anania Associates, Inc.*, 223 USPQ740, 740 n.1 (TTAB 1984); *In re Perfect Fit Industries, Inc.*, 223 USPQ 92, 93 (TTAB 1984); *In re House of Windsor, Inc.*, 221 USPQ 53, 54 n.3 (TTAB 1983); *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 (TTAB 1983); *In re Harrington*, 219 USPQ 854, 855 n.1 (TTAB 1983). *Cf. In re American Cruise Lines, Inc.*, 128 USPQ2d 1157, 1157 n.1 (TTAB 2018) (although applicant offered, in the alternative, a claim of acquired distinctiveness in part as to AMERICAN, "Applicant did not argue on appeal the underlying requirement based on AMERICAN being considered geographically descriptive.").

2. *See In re Heatcon, Inc.*, 116 USPQ2d 1366, 1369-70 (TTAB 2015) (applicant did not make amendment to Supplemental Register in the alternative); *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012)

(in request for reconsideration and on appeal, applicant clearly asserted alternative positions with respect to the disclaimer requirement); *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1897 n.2 (TTAB 2001) (applicant did not assert Trademark Act § 2(f) claim in the alternative); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 n.2 (TTAB 1997) (Board found that applicant had abandoned its claim that its mark was inherently distinctive early in the prosecution and therefore Board refused to consider claim of inherent distinctiveness made in reply brief, or to view the claim of acquired distinctiveness as an alternative claim); *In re Sandberg & Sikorski Diamond Corp.*, 42 USPQ2d 1544, 1546 n.2 (TTAB 1996) (applicant did not pursue its contention that the marks were inherently distinctive during prosecution, and Board found this claim to have been waived).

Cf. In re Thomas Nelson, Inc., 97 USPQ2d 1712, 1713 (TTAB 2011) (applicant maintained claim of acquired distinctiveness under Trademark Act § 2(f) in the alternative, but better practice would have been for examining attorney to have reviewed files of applicant's prior registrations to determine whether applicant had previously conceded the mark was merely descriptive).

But see In re Olin Corp., 124 USPQ2d 1327, 1329-30 (TTAB 2017) (although applicant never explicitly requested registration under Section 2(f), because the examining attorney "afforded applicant the benefit of doubt" by construing its arguments in response to the surname refusal as an apparent claim of acquired distinctiveness in the alternative, the Board treated the claim as such); *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1195 n.3 (TTAB 1998) (Board considered registrability on both Principal and Supplemental Registers even though applicant's amendment to the Supplemental Register was originally not made in the alternative, noting that examining attorney continued to refuse registration on both registers, and subsequent papers of both applicant and examining attorney, including request for reconsideration and decision on that request, discussed the amendment as being in the alternative); *In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1419 n.7 (TTAB 2010) (although applicant did not expressly claim acquired distinctiveness in the alternative, Board treated the claim as such because it was filed after examining attorney requested a remand of the application to consider a new issue); *In re Binion*, 93 USPQ2d 1531, 1538 (TTAB 2009) (although applicant did not couch his Trademark Act § 2(f) claim in the alternative when he argued against surname refusal, because applicant and examining attorney treated the claim as an alternative one Board did as well).

3. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1685 n.8 (Fed. Cir. 2010) (if applicant asserts mark is inherently distinctive and asserts acquired distinctiveness in the alternative, and if examining attorney accepts claim of acquired distinctiveness, examining attorney must give applicant option to either appeal refusal of inherent distinctiveness or accept registration under Trademark Act § 2(f)).

4. *See*TMEP § 1212.02(c).

5. *See*TMEP § 1212.02(c).

6. *In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1952 (TTAB 2018) (where applicant clearly indicated during prosecution that its amendment to the Supplemental Register was made in the alternative, but in its brief, focused solely on the issue of genericness and did not argue against the descriptiveness refusal, the Board exercised its discretion to consider arguments applicant made during prosecution with regard to the descriptiveness refusal).

1216 Oral Hearing

37 C.F.R. § 2.142(e)

(1) *If the appellant desires an oral hearing, a request should be made by a separate notice filed not later than ten days after the due date for a reply brief. Oral argument will be heard by at least three Administrative Trademark Judges or other statutory members of the Trademark Trial and Appeal Board at the time specified in the notice of hearing, which may be reset if the Board is prevented from hearing the argument at the specified time or, so far as is convenient and proper, to meet the wish of the appellant or the appellant's attorney or other authorized representative. Appellants, examining attorneys, and members of the Board may attend in person or, at the discretion of the Board, remotely.*

(2) *If the appellant requests an oral argument, the examining attorney who issued the refusal of registration or the requirement from which the appeal is taken, or in lieu thereof another examining attorney as designated by a supervisory or managing attorney, shall present an oral argument. If no request for an oral hearing is made by the appellant, the appeal will be decided on the record and briefs.*

(3) *Oral argument will be limited to twenty minutes by the appellant and ten minutes by the examining attorney. The appellant may reserve part of the time allowed for oral argument to present a rebuttal argument.*

For information concerning oral hearings in inter partes proceedings before the Board, see TBMP § 802. What follows below is information pertaining specifically to oral hearings in ex parte appeals to the Board.

An oral hearing is not mandatory in an ex parte appeal to the Board, but will be scheduled if a timely request therefor is filed by the applicant, with the requisite fee. [Note 1.] If the applicant does not request an oral hearing, the appeal will be decided on the record and briefs. [Note 2.] The record and brief, therefore, are of paramount importance. In the vast majority of cases, an oral hearing is not requested. An examining attorney may not request an oral hearing. An oral hearing is particularly useful in ex parte cases involving complex issues, a complex record,, where the goods or services identified in the applicant's application (or a cited registration) are highly technical or unfamiliar, or where an issue on appeal is not clearly defined. In addition, the oral hearing sometimes provides an opportunity for the applicant and examining attorney to work out an agreement that results in approval of the application for publication (or for registration, in the case of a Supplemental Register application).

If the applicant desires an oral hearing in an ex parte appeal to the Board, the applicant should file a written request not later than 10 days after the due date for applicant's reply brief. The request should be a separate document, and not included in an applicant's brief, reply brief, or other submission filed with the Board. The request for oral hearing must be filed through ESTTA, which includes "Request for oral hearing" among the list of entries identifying the type of submission being filed. In the rare circumstances it is filed on paper, only one copy of such request should be submitted. The request should include three tentative dates and times for the oral hearing and whether the applicant would like to appear at the oral hearing in person or by video conference. The Board will then send the applicant a notice specifying the date, time and location of the hearing. If the request for an oral hearing does not include tentative dates, the Board will issue an order requesting the applicant to provide possible dates between six and fourteen weeks beyond the mailing date of the order, and upon receipt will send the applicant a notice of hearing specifying the date, time, and location of the hearing. If there is no timely response to the Board's order, the request for oral hearing will be considered waived, and the matter will be submitted for decision on the record and briefs. Ordinarily, hearings are scheduled on Tuesdays, Wednesdays and Thursdays between 10:00 a.m. and 3:00 p.m. (Eastern Time).

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. For hearings held at the offices of the Board, a party may request, and the Board in its discretion may allow, attendance via video conference from another location. [Note 3.] A video hearing will be conducted in the same manner as if conducted entirely in the hearing room. An applicant should request a hearing by video conference in its written request for an oral hearing, or in its response to the Board order acknowledging that request and directing the applicant's further

action. An applicant is expected to appear in person unless it clearly states, in its initial request for oral hearing or in its response to the Board's order, its intent to participate by video conference. An applicant 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.

An applicant that requests attendance at the oral hearing via video conferencing is responsible for arranging and paying for its video connection, and the Board cannot assist the applicant in this endeavor. The USPTO does not provide the applicant with the means to participate by video conference. The Board's order scheduling the hearing will specify the software that the Board uses for the video connection, and the applicant must use compatible technology. If an applicant plans to attend the hearing by video conference, it is the applicant's responsibility to contact a USPTO video conference technician at VTCOPSDITSLIST@uspto.gov no fewer than three business days prior to the confirmed hearing date, setting forth the application serial number(s), the date and time of the hearing, and the type of equipment that the applicant plans to use. A USPTO video conference technician will arrange a test of the equipment that the applicant plans to use. The Board will liberally grant remote attendance, but retains discretion to account for any technological limitations. *See*TBMP § 802.03.

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 appear via video or phone. [Note 4.] The time for oral hearing may be reset if the Board is prevented from holding the hearing at the specified time, or, so far as is convenient and proper, to meet the wishes of the applicant (or the applicant's attorney or other authorized representative) or the examining attorney. [Note 5.] If an applicant wishes to reschedule an oral hearing, it must file a written request through ESTTA stating the reasons for the request, whether the examining attorney has agreed to the rescheduling, and submit three non-consecutive dates and times within four to eight weeks from the original hearing date. Applicant must follow-up the written request by telephoning the Board's Hearings and Decisions ProgramSpecialist (whose contact information appears on the scheduling order). In general, upon a request to reset a hearing date, Board practice is to reschedule the oral hearing. However, absent compelling circumstances or mutual agreement between the applicant and the examining attorney, the Board may not change a hearing date if the request for rescheduling is made within two weeks of the scheduled hearing date. Moreover, the Board may deny a request to reschedule if multiple requests, including stipulations and consented requests, to reschedule have been filed. Both the reason for the rescheduling request, and the time in advance of the hearing at which it is made, will be considered in determining whether the request is granted. [Note 6.]

If the applicant requests an oral hearing, the examining attorney who issued the Office action from which the appeal was taken, or another examining attorney who has been designated for the purpose by a supervisory or managing attorney, must appear at the hearing and present an oral argument. [Note 7.] If the examining attorney requires a rescheduling of the oral hearing, he or she should advise the Hearings and Decisions Program Specialist of the Board, by telephone or email, not later than two weeks prior to the scheduled hearing date. If circumstances arise which prevent the examining attorney from providing such notice, another examining attorney should be designated by a supervisory or managing attorney to appear at the oral hearing. In the rare instances in which the applicant appears but the examining attorney does not, the oral hearing will be held without the examining attorney; only the applicant will present its oral argument.

The applicant is allowed 20 minutes for its oral argument, and the examining attorney is allowed 10 minutes. If the applicant so desires, it may reserve a portion of its 20 minutes to use for rebuttal argument. [Note 8.] There is no requirement that the applicant and the examining attorney use all of their allotted time. Often, an ex parte appeal to the Board is of such nature that oral arguments thereon may be presented in considerably less than the allotted time. On the other hand, if, because of the complexity or novelty of the issues, an applicant feels that it needs more than 20 minutes for oral argument, it should file a written request with the

Board for additional time. [Note 9.] *Cf.*TBMP § 802.05. If the request is granted, the examining attorney will also be allowed additional time.

For information concerning audiotaping, visual aids, videoconferencing and the nature of an oral hearing before the Board, *see*TBMP § 802.06, TBMP § 802.07, TBMP § 802.03 and TBMP § 802.08, respectively.

The oral hearing is not an opportunity to present new evidence to the Board. Documents offered at the hearing that were not properly made of record will not be considered unless consented to by the nonoffering party, in which case they will be deemed to have been stipulated into the record. [Note 10.] Similarly, an applicant is not permitted to file a supplemental brief following an oral hearing unless instructed or ordered by the Board to do so. [Note 11.]

If an applicant decides, after submitting a request for oral hearing, that it no longer desires an oral hearing, it should submit a written waiver of the oral hearing request through ESTTA. The matter will then be taken off of the Board's oral hearing docket and scheduled to be decided on the record and the briefs.

Further inquiries regarding oral hearings may directed to TTABHearings@uspto.gov.

NOTES:

1. 37 C.F.R. § 2.6(a)(24) and 37 C.F.R. § 2.142(e)(1).

2. 37 C.F.R. § 2.142(e)(2).

3. 37 C.F.R. § 2.142(e)(1). *See, e.g., In re Datapipe, Inc.*, 111 USPQ2d 1330, 1332 (TTAB 2014) (counsel for applicant appeared via videoconference at oral hearing).

4. *See* Trademark Act § 17, 15 U.S.C. § 1067; 37 C.F.R. § 2.142(e)(1); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) ("The Office is amending § 2.142(e)(1) to clarify that all statutory members of the Board may hear oral argument. The Office is further amending § 2.142(e)(1) to add that appellants, examining attorneys, and members of the Board may attend oral argument in person or, at the discretion of the Board, remotely. The amendment codifies current Office practice and is consistent with the Office's amendments to § 2.129(a).").

5. 37 C.F.R. § 2.142(e)(1).

6. *See In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1214 n.2 (TTAB 2000) (applicant's request to reschedule hearing received three hours before the scheduled hearing because of "a sudden conflict of time" was denied; Commissioner [now Director] denied petition stating that Board has wide discretion in scheduling or rescheduling oral hearings).

7. *See* 37 C.F.R. § 2.142(e)(2).

8. 37 C.F.R. § 2.142(e)(3).

9. 37 C.F.R. § 2.129(a).

10. *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1337 (TTAB 1997) (exhibits in booklet submitted at oral hearing which had not previously been made of record were not considered).

11. *In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1778 n.3 (TTAB 2017) (Board refused to consider unauthorized supplemental brief filed after oral hearing), *aff'd*, 749 F. App'x 987 (Fed. Cir. 2018).

1217 Final Decision

For general information concerning final decisions in proceedings before the Board, see TBMP § 803. What follows below is information pertaining specifically to final decisions in ex parte appeals to the Board. [Note 1.]

In determining an ex parte appeal, the Board reviews the appealed decision of the examining attorney to determine if it was correctly made. The Board need not find that the examining attorney's rationale was correct in order to affirm the refusal to register, but rather may rely on a different rationale. [Note 2.] Further, while the examining attorney may not raise a new ground for refusal of registration during appeal, except upon remand by the Board for the purpose, *see*TBMP § 1209, the examining attorney is not precluded from raising, during appeal, new arguments and/or additional case citations in support of a ground for refusal which was timely raised and is a subject of the appeal. [Note 3.]

If there is more than one refusal or requirement that is the subject of an appeal, the Board will normally consider all issues in the appeal, even if the decision on one issue would make a decision on a second issue moot or inconsistent. [Note 4.] However, in certain circumstances after the Board has affirmed one requirement or refusal it will not reach any further requirement or refusal. [Note 5.]

Because each class in a multi-class application is considered to be a separate application, the Board may affirm a refusal as to one class and reverse a refusal as to a different class. [Note 6.] For general information about partial refusals, including refusals as to less than all of the identified goods or services in a class, see TBMP § 1202.01, TBMP § 1202.02 and TBMP § 1202.05.

When the Board has issued its final decision in an ex parte appeal, the examining attorney is without jurisdiction to take any further action therein. [Note 7.] Similarly, the Board has no authority, either in its final decision on appeal or thereafter, to remand the case to the examining attorney for further examination. A case that has been considered and decided on appeal to the Board may be reopened only as provided in 37 C.F.R. § 2.142(g), as discussed below. [Note 8.] *See*TBMP § 1218. That is, while the Board, in its final decision in an opposition, concurrent use, or interference proceeding, may include a remand of the application (except a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) application) [Note 9.] to the examining attorney for further examination with respect to a matter which appears to render the mark of an applicant unregistrable but which was not tried under the pleadings in the case, *see*TBMP § 515 [Note 10], the Board cannot include such a remand in its final decision in an ex parte appeal.

However, if, at final decision in an ex parte appeal, it appears to the Board that an issue not previously raised may render the mark of the applicant unregistrable, the Board may, without deciding the issue(s) on appeal, suspend the appeal and remand the application to the examining attorney for further examination. [Note 11.] *See*TBMP § 1209.01. Alternatively, if the issue not previously raised is an application defect that can easily be corrected by the applicant, the Board may elect to decide the issue(s) on appeal, and include in its decision a recommendation that applicant voluntarily correct the defect if it prevails on the appealed issue(s). [Note 12.] Further, when the Board issues a final decision in an appeal involving an intent-to-use application, it does not preclude the examining attorney from issuing a new refusal or requirement arising in the examination of the statement of use. [Note 13.]

NOTES:

1. *See In re Information Builders Inc.*, 2021 USPQ2d 228, at *1 n.1 (TTAB 2021) (defining "final decision" as final dispositive ruling that ends litigation on the merits before the Board).

2. *See In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1401-02 (TTAB 2018) (Board declined to consider second rationale raised only in an advisory manner during prosecution but raised again by the examining attorney's brief because it was unclear that applicant had "a full opportunity to address the alternative rationale … prior to appeal."); *In re Harley*, 119 USPQ2d 1755, 1758 (TTAB 2016) (applicants' failure to address refusals is a basis for affirming the examining attorney's refusal on all grounds); *In re AFG Industries Inc.*, 17 USPQ2d 1162, 1163 (TTAB 1990); *In re Avocet, Inc.*, 227 USPQ 566, 567 (TTAB 1985); *In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 343 n.2 (TTAB 1985). *Cf. Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1009 (Fed. Cir. 1988); *Ilco Corp. v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 188 USPQ 485, 488 (CCPA 1976); *Hunt v. Treppschuh and Hentrich*, 523 F.2d 1386, 187 USPQ 426, 428 (CCPA 1975).

3. *See In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 342 n.2 (TTAB 1985).

4. *In re Carlton Cellars, LLC*, 2020 USPQ2d 10150, at *5 (TTAB 2020) (Board affirmed refusal to register for failure to comply with requirements for acceptable identification and for payment of application filing fees: "failure to comply with a legitimate requirement is sufficient grounds for refusal of registration"); *In re ADCO Industries – Technologies, L.P.*, 2020 USPQ2d 53786, at *2 (TTAB 2020) (failure to comply with Rule 2.61(b) information request by itself is a sufficient ground to refuse registration); *In re Ocean Technology, Inc.*, 2019 USPQ2d 450686, at *1-3 (TTAB 2019) (Board affirmed refusals based on both failure to function as a mark and failure to comply with Rule 2.61(b) information request; however, Board noted that affirmance of the refusal based on the Rule 2.61(b) information request is a sufficient basis, in itself, to deny registration of applicant's mark); *In re Morinaga Nyuguo Kabushiki Kaisha*, 120 USPQ2d 1738, 1748 (TTAB 2016) (Board affirmed refusal based on likelihood of confusion and reversed refusal based on geographic misdescriptiveness); *In re Heatcon, Inc.*, 116 USPQ2d 1366, 1379 (TTAB 2015) (although finding that configuration was functional rendered requirement regarding drawing moot, Board addressed the drawing refusal "for completeness"); *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009) (Board found applied-for phrase generic, but also found that if not generic, the phrase has not acquired distinctiveness); *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1984 (TTAB 2009) (functionality refusal affirmed and in the alternative Board affirmed that configuration fails to function as a source-indicator and has not acquired distinctiveness); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (affirmance of refusal that mark is merely descriptive made the question of whether disclaimer applicant sought to enter moot; for purposes of deciding that issue, applicant's mark was assumed, arguendo, to be not merely descriptive); *In re Cheezwhse.com Inc.*, 85 USPQ2d 1917, 1921-22 (TTAB 2008) (requirement for product information affirmed; goods assumed, for purposes of determining refusals on grounds of geographic descriptiveness and deceptive geographic misdescriptiveness, to come from place named in mark and not to come from place named in mark, respectively); *In re MGA Entertainment Inc.*, 84 USPQ2d 1743, 1747 (TTAB 2007) (although Board found no trademark rights in the identified goods had been created, it also considered the refusal that the mark was not inherently distinctive and found that acquired distinctiveness was not shown, assuming arguendo that the identified goods were goods in trade); *In re Howard Leight Industries LLC*, 80 USPQ2d 1507, 1508 (TTAB 2006) (functionality refusal affirmed and in the alternative Board affirmed refusal on the ground that configuration is non-distinctive and has not acquired distinctiveness).

5. *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010) (Board determined likelihood of confusion with respect to only one of the two cited registrations); *In re Davey Products Pty Ltd.*, 92 USPQ2d

1198, 1201-02 (TTAB 2009) (Board determined likelihood of confusion with respect to only one of the two cited registrations); *In re DTI Partnership LLP*, 67 USPQ2d 1699, 1702 (TTAB 2003) (affirmance of requirement for product information was sufficient basis to refuse registration; Board declined to reach merits of refusal based on mere descriptiveness because applicant's failure to submit required information hindered Board's ability to assess the latter refusal).

6. *In re Katch, LLC*, 2019 USPQ2d 233842 (TTAB 2019) (genericness refusal affirmed as to Class 35 services, but reversed as to Class 42 services); *In re Wielinski*, 49 USPQ2d 1754, 1760 (TTAB 1998) (affirming refusal to register only as to class 16 and reversing refusal to register as to all other classes); *In re Harry N. Abrams, Inc.*, 223 USPQ 832, 836 (TTAB 1984) (affirming refusal to register as to class 14 and reversing refusal to register as to all remaining classes). *See also In re Information Builders Inc.*, 2021 USPQ2d 228, at *3 n.3 (TTAB 2021) (if final decision affirming refusal to register is expressly limited to certain goods or services or to less than all of the classes in a multiple-class application, application will be abandoned only as to those goods or services).

7. *See, e.g.*, *In re Hamilton Bank*, 222 USPQ 174, 179 (TTAB 1984); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397 n.2 (TTAB 1982); TMEP § 1501.06.

8. *See In re Carlton Cellars, LLC* , 2020 USPQ2d 10150, at *5 (TTAB 2020); *In re Johanna Farms, Inc.* , 223 USPQ 459, 460 (TTAB 1984) (after final decision issues, Board cannot entertain any request for additional prosecution except as provided in 37 C.F.R. § 2.142(g)); *In re Mercedes Slacks, Ltd.* , 213 USPQ 397, 397 n.2 (TTAB 1982). *See also Information Builders Inc.* , 2021 USPQ2d 228, at *4 & n.4 (TTAB 2021) (applicant's attempt to circumvent adverse final decision by filing express abandonment (without prejudice) under 37 C.F.R. § 2.68, with no mandate from the Federal Circuit and no order from the Director directing Board to give effect to the express abandonment, is impermissible under 37 C.F.R. § 2.142(g), would frustrate the administrative process, and runs contrary to the principle of finality of judgments).

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

10. 37 C.F.R. § 2.131.

11. 37 C.F.R. § 2.142(f)(1).

12. *See In re Forney Industries, Inc.*, 127 USPQ2d 1787, 1788 n.3 (TTAB 2018) (Board notes necessity of remand for further examination, if the applicant successfully appeals Board's decision, "to ensure compliance with the requirements for a complete application and acceptable specimens in support of registration" with regard to mark description amendment), *vacated and remanded on other grounds*, 955 F.3d 940, 2020 USPQ2d 10310 (Fed. Cir. 2020); *In re W.W. Henry Co.*, 82 USPQ2d 1213, 1213-14 (TTAB 2007) (because claimed date of first use and use in commerce were subsequent to application filing date, final decision allowed applicant to file either an amendment to the dates of use or an amendment to the basis for the application); *In re Sandberg & Sikorski Diamond Corp.*, 42 USPQ2d 1544, 1545 n.1 (TTAB 1996) (in final decision, Board recommended that applicant, if it ultimately prevailed, amend description of mark to clearly set forth claim); *In re EBSCO Industries Inc.*, 41 USPQ2d 1913, 1915 n.3 (TTAB 1996) (if applicant ultimately prevailed, it should file an amended drawing); *In re Lativ Systems, Inc.*, 223 USPQ 1037 n.1 (TTAB 1984); *In re Wallyball, Inc.*, 222 USPQ 87, 88 n.2 (TTAB 1984).

13. *See*TMEP § 1109.07 *et seq.*; *In re Husqvarna Aktiebolag*, 91 USPQ2d 1436, 1439 (TTAB 2009) (when examining attorney examines statement of use, if the specimens fail to show that the mark is used for services as described by applicant, the examining attorney may refuse registration on this basis).

1218 Reopening (Amendment, Etc. After Final Decision)

37 C.F.R. § 2.142(g) *An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under section 6 of the Act of 1946 or upon order of the Director, but a petition to the Director to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated.*

Once an application has been considered and decided by the Board on appeal, i.e., the Board has issued a final decision, applicant's course of action normally is limited to a request for reconsideration of the Board's decision, and/or the filing of an appeal therefrom, either by way of an appeal to the Court of Appeals for the Federal Circuit, or by way of a civil action seeking review of the Board's decision. [Note 1.] *See*TBMP § 1219. An application may not be "reopened," that is, an applicant may not amend its application, or submit additional evidence, at this stage, except in two very limited situations. [Note 2.] They are as follows:

(1) The application may be reopened by the Board for entry of a disclaimer under Trademark Act § 6, 15 U.S.C. § 1056; [Note 3.] and

(2) The application may be reopened upon order of the Director, but a petition to the Director to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated. [Note 4.]

When a decision of the Board affirming a refusal to register in an ex parte case has been appealed to the United States Court of Appeals for the Federal Circuit, the Court may remand the application for further action, such as further examination and the submission of additional evidence. [Note 5.]

NOTES:

1. *In re Information Builders Inc.*, 2021 USPQ2d 228, at *1 n.1 (TTAB 2021) (defining "final decision" as final dispositive ruling that ends litigation on the merits before the Board).

2. *See* 37 C.F.R. § 2.142(g); *In re Information Builders Inc.* , 2021 USPQ2d 228, at *4 & n.4 (TTAB 2021) (applicant's attempt to circumvent adverse final decision by filing express abandonment (without prejudice) under 37 C.F.R. § 2.68, with no mandate from the Federal Circuit and no order from the Director directing Board to give effect to the express abandonment, is impermissible under 37 C.F.R. § 2.142(g), would frustrate the administrative process, and runs contrary to the principle of finality of judgments); *In re Carlton Cellars*, LLC, 2020 USPQ2d 10150, at *5 (TTAB 2020) (applicant's failure to comply with requirements for acceptable identification and to pay required application filing fees cannot be remedied after final decision issues); *In re House Beer, LLC*, 114 USPQ2d 1073, 1077 n.15 (TTAB 2015) (once final decision issues, applicant cannot request suspension of appeal to seek cancellation of cited registration); *In re Brack*, 114 USPQ2d 1338, 1343 (TTAB 2015) (applicant's failure to comply with requirement to sign and verify application prior to appeal cannot be remedied after issuance of decision); *In re Faucher Industries Inc.*, 107 USPQ2d 1355, 1357 (TTAB 2013) ("the Board cannot re-write the application to reinstate an identification previously discarded by the applicant, nor can it re-open the application for amendment of the identification by applicant."); *In re Societe D'Exploitation de la Marque Le Fouquet's*, 67 USPQ2d 1784, 1789 (TTAB 2003) (no authority to remand after decision on appeal for amendment to filing basis); *In re Hines*, 32 USPQ2d 1376, 1377 (TTAB 1994) (reconsideration); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 n.3 (TTAB 1986).

3. 37 C.F.R. § 2.142(g); *In re Guaranteed Rate, Inc.*, 2020 USPQ2d 10869, at *10 n.50 (TTAB 2020) (disclaimer requirement affirmed, but requirement will have been met if applicant submits disclaimer within 30 days, and application will proceed since disclaimer requirement was only issue on appeal); *In re*

Information Builders Inc., 2020 USPQ2d 10444, at *11-12 (TTAB 2020) (same, and adds that the disclaimer must be submitted before applicant files any appeal of the final decision; in addition, "[t]he submission of the required disclaimer, however, will not overcome the refusal to register under Section 2(d) of the Trademark Act and does not serve to toll the time to appeal the Board's decision."); *In re UST Global (Singapore) Pte. Ltd.*, 2020 USPQ2d 10435, at *9 & n.30 (TTAB 2020) (same, and adds that a request to reopen an application after the Board renders a final decision does not toll the time for filing an appeal of the Board's decision); *In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1835 (TTAB 2011) (requirement for a disclaimer in part affirmed, applicant allowed time to submit disclaimer); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1288 (TTAB 2006) (requirement for disclaimer affirmed, but decision would be set aside if applicant submits disclaimer within 30 days); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1958 (TTAB 2006) (requirement for disclaimer affirmed, but applicant allowed 30 days to submit the disclaimer and decision affirming the requirement would be set aside); *In re Crystal Geyser Water Co.*, 85 USPQ2d 1374, 1379 (TTAB 2007) (requirement for disclaimer affirmed, but applicant allowed 30 days to submit required disclaimer and decision would be set aside); *In re Petite Suites Inc.*, 21 USPQ2d 1708, 1710 (Comm'r 1991) (Board has authority to remand application, after decision by Board on appeal, for entry of a disclaimer); *In re S. D. Fabrics, Inc.*, 223 USPQ 56, 57 n.1 (TTAB 1984) (Board accepts disclaimers after decision by Board on appeal where the disclaimer puts the application in condition for publication without the need for any further examination).

4. *See* 37 C.F.R. § 2.142(g); *In re Adlon Brand Gmbh & Co.* , 120 USPQ2d 1717, 1724 (TTAB 2016) (applicant cannot make a conditional request for remand based on the outcome of the Board's decision on appeal); *In re Integrated Embedded* , 120 USPQ2d 1504, 1512 (TTAB 2016) (once final decision rendered request to amend to Supplemental Register not possible); *In re Faucher Industries Inc.* , 107 USPQ2d 1355, 1357 (TTAB 2013) ("the Board cannot re-write the application to reinstate an identification previously discarded by the applicant, nor can it re-open the application for amendment of the identification by applicant."); *In re Phillips-Van Heusen Corp.* , 63 USPQ2d 1047, 1047 n.2 (TTAB 2002) (request in applicant's brief that if the refusals are maintained the application be amended to the Supplemental Register denied because application which has been decided on appeal will not be reopened); *In re Taverniti, SARL* , 228 USPQ 975, 976 (TTAB 1985) (since applicant's registration was not part of evidentiary record before Board when it decided case, registration can be given no consideration in the absence of a successful petition to the Commissioner [now Director] to reopen); *In re Taverniti, SARL* , 225 USPQ 1263, 1264 n.3 (TTAB 1985) (it has been practice of the Commissioner [now Director] to refuse to reopen, after final decision, for amendment to the Supplemental Register); *In re Johanna Farms, Inc.* , 223 USPQ 459, 460 (TTAB 1984) (Board has no jurisdiction to remand an application, after final decision, for submission of new evidence; only the Commissioner [now Director] has authority, after final decision, to remand for the purpose of reopening the application; *In re S. D. Fabrics, Inc.* , 223 USPQ 56, 57 n.1 (TTAB 1984) (after a case has been decided on appeal, an amendment to the Supplemental Register may be accepted only by the Commissioner [now Director] upon petition, and Commissioner has in past denied petitions to reopen to amend to the Supplemental Register); *In re Dodd International, Inc.* , 222 USPQ 268, 270 (TTAB 1983) (Board denied request to reopen application, after final decision, for amendment to Supplemental Register, quoting 37 C.F.R. § 2.142(g)); *In re Vesper Corp.* , 8 USPQ2d 1788, 1789 n.3 (Comm'r 1988) (petitions to reopen are granted only when proposed amendment would place application in condition for publication, subject to updating search, and no other examination by examining attorney would be required); *In re Vycom Electronics Ltd.* , 21 USPQ2d 1799, 1800 (Comm'r 1986) (petition to reopen to allow applicant to file and litigate petition to cancel cited registration denied); *In re Mack Trucks, Inc.* , 189 USPQ 642, 643 (Comm'r 1976) (petition to reopen for letter of consent and for amendment of identification of goods denied; applicant, having elected to proceed, prior to Board's decision, without letter of consent assumed the risk of an adverse decision by Board and does not establish sufficient cause to reopen; also, both the letter of consent and amendment would require further examination beyond an updating search); *Ex parte Simoniz Co.* , 161 USPQ 365, 366 (Comm'r 1969) (petition to reopen for amendment to Supplemental Register denied; applicant

elected a course of action and had a hearing and an adjudication thereon); TMEP § 1501.06. *Cf. In re Information Builders Inc.* , 2021 USPQ2d 228, at *4 & n.4 (TTAB 2021) (applicant's attempt to circumvent adverse final decision by filing express abandonment (without prejudice) under 37 C.F.R. § 2.68, with no mandate from the Federal Circuit and no order from the Director directing Board to give effect to the express abandonment, is impermissible under 37 C.F.R. § 2.142(g), would frustrate the administrative process, and runs contrary to the principle of finality of judgments).

5. *See In re Guild Mortgage Co.* , 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019) (remanded because Board failed to consider 8th du Pont factor in likelihood of confusion analysis notwithstanding that applicant had submitted evidence and made substantive arguments about that factor); *In re Spirits International N.V.* , 563 F.3d 1347, 90 USPQ2d 1489, 1496 (Fed. Cir. 2009) (application remanded because Board applied incorrect standard for materiality in determining mark geographically deceptive); *In re Les Halles De Paris J.V.* , 334 F.3d 1371, 67 USPQ2d 1539, 1542 (Fed. Cir. 2003) (remanded because Board applied standard that had been changed in interim); *In re California Innovations Inc.* , 329 F.3d 1334, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003) (remanded for Board to consider record in light of new test set out by Court); *In re Lowrance Electronics Inc.* , 14 USPQ2d 1251, 1251 (TTAB 1989). *Cf. In re Information Builders Inc.* , 2021 USPQ2d 228, at *4 & n.4 (TTAB 2021) (applicant's attempt to circumvent adverse final decision by filing express abandonment (without prejudice) under 37 C.F.R. § 2.68, with no mandate from the Federal Circuit and no order from the Director directing Board to give effect to the express abandonment, is impermissible under 37 C.F.R. § 2.142(g), would frustrate the administrative process, and runs contrary to the principle of finality of judgments); *In re Forney Industries, Inc.*, 127 USPQ2d 1787, 1788 n.3 (TTAB 2018) (Board notes necessity of remand for further examination, if the applicant successfully appeals Board's decision, "to ensure compliance with the requirements for a complete application and acceptable specimens in support of registration" with regard to mark description amendment), *vacated and remanded on other grounds*, 955 F.3d 940, 2020 USPQ2d 10310 (Fed. Cir. 2020).

1219 Review of Final Decision

1219.01 By Request for Reconsideration

37 C.F.R. § 2.144 ***Reconsideration of decision on ex parte appeal.*** *Any request for rehearing or reconsideration, or modification of the decision, must be filed within one month from the date of the decision. Such time may be extended by the Trademark Trial and Appeal Board upon a showing of sufficient cause.*

For general information concerning requests for rehearing, reconsideration, or modification of a final decision of the Board, *see*TBMP § 543 and TBMP § 544. What follows below is information pertaining specifically to requests for rehearing, reconsideration, or modification of a final decision of the Board in an ex parte appeal.

An applicant that has filed an ex parte appeal to the Board, received a final decision therein from the Board, and is dissatisfied with that decision, may file a request for rehearing, reconsideration, or modification of the decision. The applicant must file the request within one month from the date of the decision. The time for filing the request may be extended by the Board upon a showing of sufficient cause. [Note 1.]

The Board may also rehear, reconsider, or modify its final decision, in an ex parte appeal, at the request of the examining attorney. [Note 2.] The examining attorney must file the request within one month of the date of the final decision, unless the time is extended by the Board upon a showing of sufficient cause. [Note 3.]

If a request for rehearing, reconsideration, or modification of the Board's final decision in an ex parte appeal is timely filed, applicant's time for filing an appeal, or for commencing a civil action for review of the Board's decision, will expire no later than sixty-three (63) days after action on the request. [Note 4.] An applicant need not request reconsideration before it files an appeal of the Board's final decision, but if an applicant requests reconsideration, it must do so before it files a notice of appeal. [Note 5.] For more information concerning the time for filing a notice of appeal of the Board's final decision in an ex parte appeal, see TBMP § 902.02.

NOTES:

1. 37 C.F.R. § 2.144.

2. *See In re Squaw Valley Development Co.*, 80 USPQ2d 1264, 1266 (TTAB 2006); *In re Ferrero S.p.A.*, 22 USPQ2d 1800, 1800 (TTAB 1992), *recon. denied*, 24 USPQ2d 1061 (TTAB 1992) (in the absence of statutory or regulatory prohibition, Board has inherent authority to entertain examining attorney's request for reconsideration); TMEP § 1501.07.

3. *See In re Ferrero S.p.A.*, 24 USPQ2d 1061, 1062 n.1 (TTAB 1992); TMEP § 1501.07.

4. *See* 37 C.F.R. § 2.145(d)(4).

5. 37 C.F.R. § 2.145(a)(1). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69969 (Oct. 7, 2016) ("The Office is further amending § 2.145(a)(1) to add that it is unnecessary to request reconsideration before filing an appeal of a Board decision, but a party requesting reconsideration must do so before filing a notice of appeal.").

1219.02 By Appeal

An applicant that has filed an ex parte appeal to the Board, received a final decision therein from the Board, and is dissatisfied with that decision, may have remedy by way of an appeal to the United States Court of Appeals for the Federal Circuit, or by way of a civil action for review of the decision of the Board. [Note 1.] A copy of the notice of appeal must be filed with the Board via ESTTA. [Note 2.] It is unnecessary to request reconsideration of a final decision before filing any such appeal; however, a party requesting reconsideration must do so before filing a notice of appeal. [Note 3.]

For information concerning the taking of an appeal from a final decision of the Board, see TBMP § 901, TBMP § 902, and TBMP § 903.

When a decision of the Board affirming a refusal to register in an ex parte case has been appealed to the United States Court of Appeals for the Federal Circuit, the Court, during the pendency of the appeal, may remand the application for further examination and the submission of additional evidence. *See*TBMP § 1218.

NOTES:

1. Trademark Act § 21, 15 U.S.C. § 1071; 37 C.F.R. § 2.145.

2. 37 C.F.R. § 2.145; MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69969 (Oct. 7, 2016) ("The Office also is amending the provisions in § 2.145

that require copies of notices of appeal, notices of election, and notices of civil action to be file with the Trademark Trial and Appeal Board to specify that such notices must be filed with the Board via ESTTA. These amendments codify the use of electronic filing and enhance the Office's ability to properly handle applications, registrations, and proceedings while on review in federal court.").

3. 37 C.F.R. § 2.145.

1220 Termination of Appeal

When the Board issues a final decision in an ex parte appeal, the Board does not terminate the appeal until after the period to seek judicial review has expired and no review has been sought. If an applicant files an appeal to the Federal Circuit or a civil action, the Board does not act to terminate the ex parte appeal proceeding until after the court review action has been finally determined.

For an appeal to the Federal Circuit, the Board normally will not act until after the mandate issues and the time for petitioning for review to the U.S. Supreme Court has expired with no review being sought, and if U.S. Supreme Court review is sought, until after the Supreme Court denies a petition for certiorari or if it grants certiorari, until after the Supreme Court issues its decision.

For review by civil action, the Board normally will not act until after the period to file an appeal of the district court's decision to a circuit court of appeals has expired with no appeal being filed. If an appeal of the district court's decision is filed, then the Board's termination procedures are the same as those for an appeal to the Federal Circuit.

Attachment A

APPENDIX OF FORMS

APPENDIX A: CERTIFICATE OF MAILING – SUGGESTED FORMAT

APPENDIX B: [RESERVED.]

APPENDIX C: CERTIFICATE OF SERVICE SUGGESTED FORMAT

APPENDIX D: DESIGNATION OF DOMESTIC REPRESENTATIVE

APPENDIX E: SAMPLE TRIAL ORDER – STANDARD

APPENDIX F: SAMPLE TRIAL AND BRIEFING ORDER WITH A COUNTERCLAIM

APPENDIX G: [RESERVED.]

APPENDIX H: SAMPLE TRIAL ORDERS FOR CONCURRENT USE PROCEEDINGS

APPENDIX I: NOTICE OF APPEAL – SUGGESTED FORMAT

APPENDIX A Certificate of Mailing Suggested Format

Certificate of Mailing

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

ATTN: Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

on _____ _____

Date Signature

_____

Typed or printed name of person signing certificate

APPENDIX B [Reserved.]

APPENDIX C

Certificate of Service Suggested Format

Shown below is a suggested format for a certificate of service:

I hereby certify that a true and complete copy of the foregoing (*insert title of submission*) has been served on (*insert name of opposing counsel or party*) by forwarding said copy on (*insert date of mailing*), via email (*or insert other appropriate method of delivery*) to: (*set out name and address of opposing counsel or party*).

_____

Signature

APPENDIX D

Designation of Domestic Representative

(Name of Domestic Representative), whose postal address is _____ _____, is hereby designated (Name of Designating Party)'s representative upon whom notice or process in this proceeding may be served.

_____

(Signature of Designating Party)

_____

(Identification of Person Signing)

_____

(Date of Signature)

APPENDIX E

Sample Trial Order -- Standard

Time to Answer	**7/1/2020**
Deadline for Discovery Conference	**7/31/2020**
Discovery Opens	**7/31/2020**
Initial Disclosures Due	**8/30/2020**
Expert Disclosures Due	**12/28/2020**
Discovery Closes	**1/27/2021**
Plaintiff's Pretrial Disclosures Due	**3/13/2021**
Plaintiff's 30-day Trial Period Ends	**4/27/2021**
Defendant's Pretrial Disclosures Due	**5/12/2021**
Defendant's 30-day Trial Period Ends	**6/26/2021**
Plaintiff's Rebuttal Disclosures Due	**7/11/2021**
Plaintiff's 15-day Rebuttal Period Ends	**8/10/2021**
Plaintiff's Opening Brief Due	**10/9/2021**

Defendant's Brief Due	**11/8/2021**
Plaintiff's Reply Brief Due	**11/23/2021**
Request for Oral Hearing (optional) Due	**12/3/2021**

APPENDIX F

Sample Trial Order and Briefing With a Counterclaim

Answer to Counterclaim Due	**7/2/2020**
Deadline for Discovery Conference	**8/1/2020**
Discovery Opens	**8/1/2020**
Initial Disclosures Due	**8/31/2020**
Expert Disclosures Due	**12/29/2020**
Discovery Closes	**1/28/2021**
Plaintiff's Pretrial Disclosures	**3/14/2021**
30-day testimony period for plaintiff's testimony to close	**4/28/2021**
Defendant/Counterclaim Plaintiff's Pretrial Discloser	**5/13/2021**
30-day testimony period for defendant and plaintiff in the counterclaim to close	**6/27/2021**
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosure Dure	**7/12/2021**
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	**8/26/2021**
Counterclaim Plaintiff's Rebuttal Disclosures Due	**9/10/2021**
15-day rebuttal period for plaintiff in the counterclaim to close	**10/10/2021**
Brief for plaintiff due	**12/9/2021**
Brief for defendant and plaintiff in the counterclaim due	**1/8/2022**
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	**2/7/2022**
Reply brief, if any, for plaintiff in counterclaim due	**3/4/2022**
Request for Oral Hearing (optional) Due	**3/4/2022**

APPENDIX G[RESERVED.]

APPENDIX HSample Trial Orders for Concurrent Use Proceedings

See TBMP §1109.01 for sample trial schedules for concurrent use proceedings.

APPENDIX INotice of Appeal – Suggested Format

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

.....

(Name of applicant)

.....

(Serial Number of application)

.....

(Filing date of application)

.....

(Mark)

NOTICE OF APPEAL

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration.

By.....

(Signature)

.....

(Identification of person signing)