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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.

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. TBMP § 704.05(b) and TBMP § 704.06(b). Exhibits to briefs are generally unnecessary and are discouraged. [Note 1.] The parties should cite to the evidence in the trial record, and not attach previously-filed evidence to their briefs. 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 2.] 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 3.]

For information concerning briefs and oral hearings in ex parte appeals, see TBMP § 1203.01 and TBMP § 1216, respectively.

#### NOTES:

1. *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) (submission of duplicative papers is a waste of time and resources, and is a burden on the Board).

2. *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) (opposer's pleaded claims not argued in its brief deemed waived); *Central Garden and Pet Co. v. Dorskocil Manufacturing Co.*, 108 USPQ2d 1134, 1136 (TTAB 2013) (pleaded claim not argued in brief deemed waived); *Syndicat Des Proprietaires Viticulteurs De Chateaufneuf 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...”); *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), *appeal dismissed as moot*, slip op. 2012-1260 (Fed. Cir. 2012).

3. *Nahshin v. Product Source Intl 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.”).

## **801.02 Time for Filing**

### **37 CFR § 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 he has lost interest in the case, judgment may be entered against plaintiff.*

## **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.

For further information concerning the 37 CFR § 2.128(a)(3) order to show cause procedure, see TBMP § 536. For information on extensions of time, see TBMP § 509.

### **NOTES:**

1. 37 CFR § 2.128(a)(1).
2. 37 CFR § 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 CFR § 2.128 resulted in entry of judgment).

## **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 CFR § 2.128(a)(1).
2. 37 CFR § 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.

### **NOTES:**

1. 37 CFR § 2.128(a)(1).
2. 37 CFR § 2.128(a)(1).

## **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. If a party in the position of defendant files such a brief, it may be stricken, or given no consideration, by the Board. TBMP § 539. The party in the position of defendant may counter any arguments raised in plaintiff's reply brief during oral argument. [Note 1.]

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. *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**

In certain special situations, the Board will set, by written action, the due dates for the filing of briefs on the case. This occurs 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 are not to 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.

#### **NOTES:**

1. 37 CFR § 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 CFR § 2.121(b)(2).

### **801.03 Form and Contents of Brief**

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

*(a) Submissions may be made to the Trademark Trial and Appeal Board on paper where Board practice or the rules in this part permit. 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.*

*(b) Submissions may be made to the Trademark Trial and Appeal Board electronically via the Internet where the rules in this part or Board practice permit, according to the parameters established by the Board and published on the web site of the Office. Text in an electronic submission must be in at least 11-point type and double-spaced. Exhibits pertaining to an electronic submission must be made electronically as an attachment to the 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(e) must be submitted 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 be submitted.*

**37 CFR § 2.128(b)** *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.*

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 CFR § 2.126. A party may file a brief on the case either on paper or electronically through ESTTA (Electronic System for Trademark Trials and Appeals), the Board's electronic filing system. ESTTA is the preferred method for filing. See TBMP § 110.09 for further information regarding ESTTA. The requirements for each form of submission are set out in 37 CFR § 2.126(a) and 37 CFR § 2.126(b). [Note 1.] See TBMP § 106.03.

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 CFR § 2.128(b).

As provided in 37 CFR § 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 2.] Exhibits or appendices to a brief, not being part of the brief itself, are not included within the page limit. [Note 3.] 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 4.] Nevertheless, appendices to a brief may not be used to avoid the page limitation. [Note 5.]

For information concerning motions for leave to file a brief exceeding the page limit, see 37 CFR § 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 Patent Quarterly (USPQ), if the case has appeared in that publication. [Note 6.] See TBMP § 101.03. As of December 27, 2006, 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. If a non-precedential decision does not appear in the USPQ or the USPTO's public electronic database, the citing party should append a copy of the decision to the motion or brief in which the decision is cited. [Note 7.] See TBMP § 101.03.

While parties may cite relevant cases from any jurisdiction, the Board relies primarily on precedent from the Court 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 8.] 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.

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 should be limited to the key points in defendant's brief which plaintiff believes require clarification or response.

**Confidential information.** Except for materials filed under seal pursuant to a protective order, the files of applications and registrations which are the subject matter of pending proceedings before the Board and all pending proceeding files and exhibits thereto are available for public viewing on the USPTO web site via TTABVUE at <http://ttabvue.uspto.gov/>. [Note 9.] See TBMP § 412.05. Therefore, only the particular portion of a brief that discloses confidential information should be filed in paper form under seal or designated as confidential in ESTTA pursuant to a protective order. If a party submits a brief containing confidential information under seal or designated as confidential in ESTTA, the party must also submit for the public record a redacted version of the brief. [Note 10.] For information regarding inspection and copying of files in person, see TBMP § 121. Note, however, that since 2001, the majority of records in Board proceedings are stored in electronic form and available for public view via TTABVUE.

Confidential portions of the brief, if any, must be submitted in accordance with 37 CFR § 2.126(d). To be handled as confidential, and kept out of the public record, submissions to the Board that are confidential must be designated as confidential in ESTTA using the separate filing option or filed in paper under a separate cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. The filing of confidential



matter via ESTTA is strongly encouraged. A copy of the submission with the confidential portions redacted must also be submitted. [Note 11.] See TBMP § 120.02 and TBMP § 412.04. For further information regarding the filing of confidential matter and information regarding ESTTA, see TBMP § 110.09 and TBMP § 412.04.

The Board's standard protective order is applicable during disclosure, discovery and trial in all proceedings, unless modified by the parties. [Note 12.] 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 CFR § 2.126 previously provided for the filing of briefs via CD-ROM. However, because parties may now file briefs electronically through the ESTTA system, there is no need to file briefs by CD-ROM and, therefore, the rules no longer provide for the filing of a brief on a CD-ROM. If a brief is submitted on a CD-ROM, it will not be scanned into the electronic database and, therefore, it will not become part of the official record. The only time a party may file a CD-ROM is as an exhibit to a deposition where the proffering party authenticates and introduces audio and/or video evidence.

2. *Conorzio 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).

3. See 37 CFR § 2.128(b); *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (raising evidentiary objections in appendices was not viewed as subterfuge to avoid page limit); *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 *Conorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894, 1896 n.3 (TTAB 1992).

4. See *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (appropriate evidentiary objections may be raised in appendix or separate paper rather than in text of brief); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992).

5. *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (appendices may not be used as a subterfuge to avoid the page limitation).

6. 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).

7. See *Corporacion Habanos SA v. Rodriguez*, 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).

8. *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1506 n.2 (TTAB 2008).
9. 37 CFR § 2.27(d) (“the official records of applications and all proceedings relating thereto are available for public inspection”). *See also, 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).
10. 37 CFR § 2.27(d) and 37 CFR § 2.27(e), and 37 CFR § 2.126(c); *Duke University v. Haggard Clothing Inc.*, 54 USPQ2d 1443, 1445 (TTAB 2000).
11. 37 CFR § 2.126(c).
12. 37 CFR § 2.116(g).

#### **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). 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.

#### **802 Oral Hearing**

##### **37 CFR § 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 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. 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.*

## **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. The oral hearing provides a party with one last opportunity to emphasize its strongest arguments, and to refute its adversary's arguments. It is particularly useful in cases with complex issues or a complex record, or where the defendant needs to respond to arguments in the plaintiff's reply brief. If neither party requests an oral hearing, the case will be decided on the evidence made of record during the testimony periods.

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

### **NOTES:**

1. 37 CFR § 2.116(f).
2. See 37 CFR § 2.123(l).

## **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 either via ESTTA or by paper (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.] Any party to the proceeding may request a 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 CFR § 2.129(a).

### **802.03 Time and Place of Hearing**

When a timely request for an oral hearing on the case has been filed by a party to an inter partes proceeding before the Board, the Board sets the date and time for the hearing, and sends each party a written notice of hearing specifying the date, time, and location of the hearing. [Note 1.] Oral hearings are only scheduled on Tuesdays, Wednesdays and Thursdays between 10:00 a.m. and 3:00 p.m. (Eastern Standard Time). In setting an oral hearing, it is the normal practice of the Board to telephone the parties, or their attorneys or other authorized representatives, to determine a convenient date and time for the hearing. A written notice formally scheduling the hearing is mailed.

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 attendance via video connection from another location. A video conference will be conducted in the same manner as if conducted entirely in the hearing room. To request a hearing by video conference, a party should make the request in its written request for an oral hearing. A party may also request attendance through a video conference when the Board contacts the party to schedule the date and time for the hearing. The party requesting attendance at the oral hearing through a video conference is responsible for arranging and paying for its video connection. The Board uses an ISDN telephone line and the party attending the hearing through a video connection must use compatible technology. The Board will contact the party attending the hearing through a video conference to test the video connection no later than the day before the hearing.

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.] If a party elects not to attend a scheduled hearing, the party should notify the Board, well in advance of the scheduled hearing date, that it will not attend the hearing.

If a party that requested an oral hearing fails to appear at the appointed time, without giving prior notice to the Board of its nonappearance, the failure to appear will be construed by the Board as a withdrawal of the request for an oral hearing. Any new request for an oral hearing will be granted only upon a showing that the failure to appear was occasioned by extraordinary circumstances.

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 3.] 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, 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. When the 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 chief judge's secretary by telephone, 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 the parties agree to reset 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. [Note 4.] However, parties should not file repeated requests to reset an oral hearing.

For information concerning requests to reset an oral hearing, see TBMP § 541.01.

#### NOTES:

1. 37 CFR § 2.129(a).
2. 37 CFR § 2.129(a).
3. 37 CFR § 2.129(a).
4. *See* 37 CFR § 2.129(b).

### 802.04 Before Whom Held

An oral hearing is held before a panel of at least three judges of the Board. [Note 1.] Normally, an oral hearing panel consists of only three judges. If for some reason a judge on a panel of three that held the oral hearing is unable to participate in the final decision, another judge may be substituted at final decision for the missing 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 their 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. 37 CFR § 2.129(a). *See also Trademark Act § 17, 15 U.S.C. § 1067; Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417, 420 n.8 (CCPA 1972) (where only one Board member signed decision, court presumed the proper number participated in decision).

**Please Note:** judges no longer provide a handwritten signature on decisions.

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). *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"), and *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 § 6 of the Patent Act to convene an expanded panel which includes not only BPAI administrative patent judges, but also one or more of the senior executive officers of the PTO identified in that section, including himself or herself). Cf. 15 U.S.C. § 1067 (containing similar provisions for the TTAB).

See also *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 CFR § 2.129(a).
2. *See 37 CFR § 2.129(a); U.S. Navy v. United States Manufacturing Co.*, 2 USPQ2d 1254, 1955 (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. 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.

### **802.07 Visual Aids, etc.**

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

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

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

## NOTES:

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

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

## **802.08 Nature of Hearing**

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

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

A person presenting oral arguments should be prepared to answer questions from the judges at any point in the arguments. If exhibits or visual aids have been brought to the oral hearing, they should be shown to the adversary before they are shown to the judges. 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 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 which 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 *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545, 1547-51 (Fed. Cir. 1994) (en banc).

Every judge assigned to decide the case does not read the 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 mailed to every party to the proceeding. All final decisions are posted on the USPTO website and available for public viewing via TTABVUE and the USPTO e-FOIA database. Both databases



may be accessed by proceeding number and other criteria. A link to the USPTO e-FOIA databases is available on the Board's webpage under "Board Decisions" at <http://des.uspto.gov/Foia/TTABReadingRoom.jsp>. For information regarding access to files, see TBMP § 120.

Trademark Act § 21, 15 U.S.C. § 1071, and 37 CFR § 2.145 govern any appeal from a final decision of the Board. See TBMP Chapter 900 regarding appeals.

#### NOTES:

1. See Trademark Act § 17, 15 U.S.C. § 1067.
2. See, e.g., *In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010) (two judges in augmented panel wrote dissent).

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

A party may file a request for rehearing, reconsideration, or modification of a decision issued after final hearing. [Note 1.] The request must be filed within one month from the date of decision and a responsive brief, if any, is due within 15 days of the date of service of the request. For information concerning requests for rehearing, reconsideration, or modification of a decision issued after final hearing, see TBMP § 543.

#### NOTES:

1. 37 CFR § 2.129(c).

### **805 Final Decision Remand to Examining Attorney**

***37 CFR § 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 reference 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 or Trademark Act § 44, 15 U.S.C. § 1051 or 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 in the proceeding, may, in addition to determining the pleaded matters, remand the application to the trademark 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 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 a Trademark Act § 1 or Trademark Act § 44, 15 U.S.C. § 1051 or 15 U.S.C. § 1126, application 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 CFR § 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 CFR § 2.131.

#### **NOTES:**

1. 37 CFR § 2.131. *See, e.g., Board of Trustees of University of Alabama v. Pitts*, 107 USPQ2d 2001 n.1 (TTAB 2013) (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. The same is true when a proceeding ends by stipulation of the parties, or by a 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 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 electronic folder, containing all the papers filed therein, including filings marked as Confidential pursuant to a protective order, is updated to “Terminated.”
- (2) Exhibits which were filed in the case which were not able to be scanned are returned to the party who submitted them unless the party who filed them directs the Board to discard them.

- (3) The electronic folder for the opposition is updated by selecting the option to send the application to issuance of a notice of allowance under 37 CFR § 2.81(b), in an intent-to-use application for which no amendment to allege use under 37 CFR § 2.76 has been submitted and accepted; or for issuance of a registration pursuant to 37 CFR § 2.81(a).
- (4) The termination of the opposition proceeding will cause an automatic update to the status of the application which is being allowed for issuance, which releases it back to the Trademark Examining Operation for the issuance of a notice of allowance or issuance of a registration.
- (5) When republication of the application at issue is necessary, the status of the application is updated which automatically queues the application to republish.
- (6) When reexamination of the application by the trademark examining attorney pursuant to a 37 CFR § 2.131 request for remand has been granted, the status of the application is updated accordingly and the application is sent to the trademark examining attorney's queue for further action. *See* TBMP § 805.
- (7) If the applicant has abandoned the subject application or if the Board orders the application to be abandoned, the status of the application is updated to "Abandoned."
- (8) Physical application files, that is, those that are not electronic, are stored at the USPTO warehouse. If the application is a physical file, it will remain at the USPTO warehouse pending its destruction approximately three years after abandonment.
- (9) When a decision of the Board granting a petition for cancellation becomes final, the subject registration is cancelled by separate order of the Director. Upon the cancellation order by the Director, the cancellation proceeding is terminated in the same manner as an opposition.
- (10) When a decision of the Board dismissing the petition for cancellation becomes final, the termination of the cancellation proceeding occurs the same as an opposition proceeding.

If an opposition or cancellation proceeding is part paper file and part electronic file, the same procedures for the termination of the partially electronic file are followed as those involved in a fully electronic file. The involved application/registration is also processed in the same manner as one involved in a fully electronic file. In addition, the Board normally takes the following steps:

- (1) The physical file, with the papers filed prior to the file becoming an electronic folder, will be sent to the USPTO warehouse where terminated inter partes proceeding files are stored.
- (2) Confidential materials, filed under protective order prior to the creation of the electronic folder, will be returned to the party who filed them, unless the party filing them directs the Board to have them discarded.

- (3) Exhibits which were filed prior to the file becoming an electronic folder and/or which are not able to be scanned into the Board's electronic system will be returned to the party who filed them, unless the party filing them directs the Board to have them discarded.

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. [Note 1.] Board practice requires that the written notice be filed within one month after the expiration of the time for appeal or civil action. If a party files a civil action, but fails to notify the Board, the Board, believing that its decision has become final, will terminate the proceeding. As a result, a registration may be issued or cancelled prematurely, while the civil action seeking review of the Board's decision is still pending. For further information regarding appeal of a Board decision, see TBMP Chapter 900.

For further information regarding access to files, see TBMP § 120.

#### **NOTES:**

1. 37 CFR § 2.145(c).

### **807 Status of Application After Proceeding**

***37 CFR § 2.136 Status of application on termination of proceeding.*** *On termination of a proceeding involving an application, the application, if the judgment is not adverse, returns to the status it had before the institution of the proceedings. If the judgment is adverse to the applicant, the application stands refused without further action and all proceedings thereon are considered terminated.*

When an opposition, concurrent use or interference proceeding ends with a judgment which is not adverse to an involved applicant, the application returns to the status it had before commencement of the proceeding, unless the Board indicates in its decision that the application must be republished for some reason, or includes in its decision a 37 CFR § 2.131 remand to the trademark examining attorney. [Note 1.] See TBMP § 805.

If the proceeding ends with a judgment that is adverse to the applicant, the application stands refused, the status of the application is updated with an "ABANDONED" status and all proceedings are considered terminated. [Note 2.]

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. 37 CFR § 2.136.

2. 37 CFR § 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); and *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).

3. See *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1551 n.3 (TTAB 2011).