TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP)

Third Edition
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PREFACE TO THE THIRD EDITION

The second edition of the Trademark Manual of Board Procedure ("TBMP") last was revised in 2004. Since then, practice before the Trademark Trial and Appeal Board ("Board") has significantly changed. This third edition of the TBMP incorporates these many and varied changes in a revised format.

Perhaps the most significant practice development captured in this third edition of the manual is the Board's adoption of a modified disclosure and conferencing regime for inter partes proceedings commenced on or after November 1, 2007. In an effort to align Board practice more closely with the federal court practice familiar to many who litigate before the Board, all parties to opposition, cancellation and concurrent use proceedings are now obliged to conduct a discovery conference to discuss settlement, narrowing of claims and defenses, and plans for disclosure and discovery. In addition, parties must now make initial, expert testimony, and pretrial disclosures. Revisions reflecting the adoption of the Board's disclosure and conferencing regime are found throughout this edition, and discussed extensively in Chapters 400 and 700.

Next, this edition of the TBMP highlights the Board's emphasis on Accelerated Case Resolution ("ACR"), an alternative method of dispute resolution designed to provide parties with a more efficient and less costly method of obtaining a decision on the merits, thus holding the potential for savings in party resources. A detailed discussion of ACR and ACR-type trial efficiencies can be found in Chapters 500 and 700. Where relevant, ACR is also mentioned in other chapters or sections of the TBMP.

Lastly, this updated edition of the TBMP reflects the shift in Board practice from paper to electronic filing and record keeping, and the predominant use of the Board's electronic filing system ("ESTTA") and electronic case file system ("TTABVUE") by practitioners, both of which are accessible at the Board's web page. Chapter 100 now includes a detailed explanation of ESTTA, and tips for practitioners regarding the use of ESTTA are found throughout the manual.

These are only a few of the developments in Board practice reflected in this latest edition. In addition to many others, practitioners will also find more detailed explanations regarding Madrid Protocol applications in Chapters 200 and 600 as well as concurrent use proceedings (Chapter 1100) and ex parte proceedings (Chapter 1200).

This third edition incorporates all statutory changes, as well as changes to the Trademark Rules of Practice and Federal Rules where applicable as of November 15, 2010. Updated Board and Federal Circuit case citations have been added as

well, to reflect the burgeoning list of precedential orders and decisions issued by the Board since 2006, which now includes close to 300 entries.

In terms of formatting, this edition of the TBMP eliminates the use of footnotes, opting instead for notes at the end of each section or subsection to facilitate ready reference to the associated text. All cross references to the TBMP are now included in the text. For practical ease, the updated version also eliminates the use of "supra" to refer to a previously cited case or authority. All citations to older "TIPS" articles published in the Trademark Reporter have been removed. Practitioners interested in references to these articles may view the second edition of the TBMP, which remains available at the Board home page of the USPTO web site.

In keeping with the Board's commitment to innovations in electronic government, this edition is available online at the Board home page of the USPTO web site in a searchable format. This edition of the TBMP will facilitate searching of its contents by readers and more frequent and easier updating of the manual by the Board. Given the Board's continuing commitment to issue a significant number of precedential orders and decisions, and the evolving nature of Board practice, the Board intends to update the TBMP on a frequent basis.

The many Board judges and attorneys who contributed to the thorough updating of the TBMP are deserving of thanks from the Office and user groups who will benefit from this resource. In particular, thanks are extended to Administrative Trademark Judge Carlisle Walters, who developed an initial framework for the revision project, and most of all to Administrative Trademark Judge Angela Lykos, who has labored tirelessly for many months to supervise the work of the participating judges and attorneys. All users of the manual will be well-served by the attention to detail exercised by Judge Lykos.

Gerard Rogers
Chief Administrative Trademark Judge
Trademark Trial and Appeal Board

INTRODUCTION

The purpose of this manual is to provide practitioners with basic information generally useful for litigating 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, where applicable, as of November 15, 2010. 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.

The manual will be updated periodically.

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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ATTENTION: TBMP editor

The title of the manual is abbreviated as "TBMP". A citation to a section of the manual may be written as "TBMP § _____" (e.g. "TBMP § 110.01," "TBMP § 113.06," etc.).

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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 ("CFR"); the rules pertaining to assignments in trademark cases, which may be found in Parts 3 and 7 of 37 CFR; and the rules relating to the conduct of practitioners and the representation of others before the United States Patent and Trademark Office ("USPTO" or "Office") which may be found in Parts 10 and 11 of 37 CFR. 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 CFR may be obtained at a nominal cost from the U.S. Government Printing Office. Title 37 of the CFR may also be found online at the Government Printing Office web site at: www.gpoaccess.gov/cfr/index.html, or on the USPTO web site at: www.uspto.gov/trademarks/law/index.jsp.

Information regarding proposed and final rule changes to Title 37 is also posted on the USPTO web site at www.uspto.gov/news/index.jsp.

NOTES:

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

101.02 Federal Rules

***37 CFR § 2.122(a)* Rules of Evidence.** *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 of Title 37 of the Code of Federal Regulations.*

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," 37 CFR § 2.116(a), and by the Federal Rules of Evidence. [Note 1.]

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 2.] *See* TBMP § 1208.

NOTES:

1. 37 CFR § 2.122(a). *See 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.*, *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 Labs. Inc. v. Naturally Vitamin Supplements Inc*., 1 USPQ2d 1445, 1448, n.20 (TTAB 1986) (Fed. R. Evid. 401).

2. *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 (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 (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.

Decisions of the Board, the Director, and the Court of Appeals for the Federal Circuit appear in the United States Patents Quarterly ("USPQ"), a periodical publication of The Bureau of National Affairs, Inc., Washington, D.C. ("BNA"), and may also be found in Reed Elsevier, Inc.'s LEXIS/NEXIS legal database, and in the Intellectual Property Library of West Publishing Company's WESTLAW database. Board decisions are also available on public electronic databases at the Board home page of the USPTO web site at http://des.uspto.gov/Foia/TTABReadingRoom.jsp (final decisions), and at TTABVUE http://ttabvue.uspto.gov (docket information and full images of Board files).

Decisions that are designated by the Board "citable as precedent," "precedent of the Board," or "for publication in full"are citable as precedent. Decisions which are not so designated, or which

are designated for publication only in digest form, are not binding on the Board, but may be cited for whatever persuasive weight to which they may be entitled. 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 [as listed above]. 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 1.]

Any cited decision of the Board or another court, which appears in the USPQ, should include a citation to the USPQ, in addition to any citation to an official reporter (if any), such as the Federal Reporter or Federal Supplement. [Note 2.] *See* TBMP § 801.03 (inter partes briefs); TBMP § 1203.02(f) (ex parte briefs).

NOTES:

1. *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 http://des.uspto.gov/Foia/TTABReadingRoom.jsp and files of Board proceedings are available at http://ttabvue.uspto.gov/.

2. *In re Carlson*, 91 USPQ2d 1198, 1199 (TTAB 2009) (case citations should include citation to *United States Patent Quarterly* (USPQ), if the case appears in that publication.).

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 web site at www.uspto.gov/main/newsandnotices.htm.

101.05 Trademark Trial and Appeal Board Manual of Procedure

The Trademark Trial and Appeal Board Manual of Procedure ("TBMP") (this Manual) is a compilation of statutory, regulatory, and decisional authority relevant to Board practice and procedure. It is written as a guide for both the Board and practitioners. 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 from time to time to incorporate changes in applicable statutes, rules, and case law, and to reflect changes in Board practice. [Note 2.] Practitioners consulting 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.

NOTES:

1. *Rosenruist-Gestao E Servicos LDA v. Virgin Enters. Ltd*., 511 F.3d 437, 85 USPQ2d 1385, 1393 (4th Cir. 2007) (quoting 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: Chief Administrative Trademark Judge
Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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 is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition. [Note 2.]

Similarly, 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 3.]

NOTES:

1. *See* Trademark Act § 17, Trademark Act § 18, Trademark Act § 20, Trademark Act § 24, 15 U.S.C. § 1067, 15 U.S.C. § 1068, 15 U.S.C. § 1070, 15 U.S.C. § 1092.

2. *FirstHealth of the Carolinas Inc. v. CareFirst of Md. Inc*., 479 F.3d 825, 81 USPQ2d 1919, 1921 (Fed. Cir. 2007) (quoting TBMP); *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 Fed. Appx. 865 (Fed. Cir. July 11, 2007), *cert. den'd,* 552 U.S. 1109 (2008); *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc*., 62 USPQ2d 1857, 1858 (TTAB 2002), *aff'd*, 300 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003) (no jurisdiction to decide issues arising under state dilution laws); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) (Board cannot adjudicate unfair competition issues); *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 Int'l, 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 Mfg. 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).

3. *Harjo v. Pro-Football, Inc*., 50 USPQ2d 1705, 1710 (TTAB 1999) (no authority to declare provisions of the Trademark Act unconstitutional nor to determine whether Trademark Act § 2(a) is overbroad or vague), *rev'd on other grounds*, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003); *Zirco Corp. v. American Tel. and Tel.* Co., 21 USPQ2d 1542, 1544 (TTAB 1991) (no jurisdiction to determine whether Trademark Act § 7(c), the constructive use provision, violates the commerce clause of the constitution); *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). *Cf. Capital Speakers Inc. v. Capital Speakers Club of Washington, D.C. Inc*., 41 USPQ2d 1030, 1034 n.3 (TTAB 1996) (no authority to determine whether private activities rendered to members of private club constitute "commerce").

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, under Trademark Act § 12(a), 15 U.S.C. § 1062(a), in the Official Gazette of the United States Patent and Trademark Office. [Note 1.] *See* TBMP § 303 (Who May Opposer 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 Opposer 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.

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

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

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

5. 37 CFR § 2.91(a).

6. Trademark Act § 12(b), Trademark Act § 20, 15 U.S.C. § 1062(b), 15 U.S.C. § 1070; 37 CFR § 2.141, 37 CFR § 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 CFR § 2.120(i)(2), 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 § 528.05(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 … include[s] 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.] Interlocutory motions, requests, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Board Administrative Trademark Judge ("judge") or by a single interlocutory attorney ("attorney") to whom such authority has been delegated. [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, (Electronic System for Trademark Trials and Appeals), the Board's electronic filing system. The parties may enter their changes of address and representation using ESTTA. For further information regarding ESTTA, *see* TBMP § 110.09.

NOTES:

1. *See Yamaha Int'l 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 Yamaha Int'l Corp. v. Hoshino Gakki Co*., 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *La Maur, Inc. v. Bagwells Enter., 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 CFR § 2.127(c).

5. 37 CFR § 2.129(a), 37 CFR § 2.142(e)(1).

6. *See* 37 CFR § 2.129(a), 37 CFR § 2.142(e)(1).

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

ATTN: Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451. [Note 1.]

NOTES:

1. Mail box designations (BOX TTAB) and fee notations (FEE – NO FEE) are no longer required.

104 Business to be Conducted in Writing

37 CFR § 2.191 *All business with the Office should be transacted in writing. The personal appearance of applicants or their representatives at the Office is unnecessary. The action of the Office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.*

With the exceptions of discovery conferences with Board participation, *see* TBMP § 401.01, telephone conferences, *see* TBMP § 413.01 and TBMP § 502.06, all business with the Board should be transacted in writing. 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 CFR § 2.120(i)(2), or upon oral argument at final hearing, if a party so desires, as provided in 37 CFR § 2.129. Decisions of the Board will be based exclusively on the written record before it. [Note 1.]

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 (Comm'r 1991).

105 Contact With Board Personnel

37 CFR § 10.93(b) *In an adversary proceeding, including any inter partes proceeding before the Office, a practitioner shall not communicate, or cause another to communicate, as to the merits of the cause with a judge, official, or Office employee before whom the proceeding is pending, except:*

(1) *In the course of official proceedings in the cause.*

(2) *In writing if the practitioner promptly delivers a copy of the writing to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.*

(3) *Orally upon adequate notice to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.*

(4) *As otherwise authorized by law.*

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 e-mail.

NOTES:

1. 37 CFR § 10.93(b).

106 Identification, Signature, and Form of Submissions

106.01 Identification of Submissions

A document 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 name and 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, and should bear at the top of the first page both the application serial number, and the inter partes proceeding number and title. 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 Examining Operation, and should bear at the top of its first page both the registration number, and the inter partes proceeding number and title. [Note 2.]

NOTES:

1. 37 CFR § 2.194.

2. 37 CFR § 2.194.

106.02 Signature of Submissions

37 CFR § 2.119(e) *Every paper 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 paper will not be refused consideration if a signed copy is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.*

37 CFR § 11.14(e) *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. Any individual may appear in a trademark or other non-patent matter in his or her own behalf. Any individual may appear in a trademark matter for:*

(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, if such firm, partnership, corporation, or association is a party to a trademark proceeding pending before the Office.*

37 CFR § 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.*

<u>37 CFR § 2.193</u> 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, by facsimile transmission (§ 2.195(c)), or through TEAS or ESTTA.

***(b)** Copy of original signature. If a copy, such as a photocopy or facsimile 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 he or she 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 name 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 in printed or typed form immediately below or adjacent to the signature, or identified elsewhere in the filing (e.g., in a cover letter or other document that accompanies the filing).*

***(e)** Proper person to sign. Documents filed in connection with a trademark application or registration must be signed by a proper person.*

* * * *

***(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 §§ 10.23(c)(15) and 11.18(d) 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 CFR § 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.] For documents filed via ESTTA, the electronic signature entered on the ESTTA form is sufficient as the required signature for the entire submission. [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 via ESTTA, *see* TBMP § 110.09.

A party may act in its own behalf in a proceeding before the Board, or an attorney or other authorized representative 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. [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 CFR § 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 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 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 paper itself is vital because mail 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. For precisely this reason, parties are strongly encouraged to file submissions to the Board via ESTTA. *See* TBMP § 110.09.

In accordance with 37 CFR § 2.193(b), either the original of the signed document, or a legible copy thereof, may be filed with the Board. If a copy is filed, 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.] *See* TBMP § 107 (regarding facsimile copies).

Notwithstanding the requirement that a document filed before the Board be signed, an unsigned document 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.]

NOTES:

1. 37 CFR § 2.193(d); 37 CFR § 2.193(e); 37 CFR § 2.119(e); and 37 CFR § 11.18(a).

2. 37 CFR § 2.102(a), 37 CFR § 2.111(b); *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 Indus. Inc. v. Guardian Indus. Corp*., 73 USPQ2d 1926, 1927 (TTAB 2005).

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

4. 37 CFR § 11.14.

5. *See* 37 CFR § 11.14(e).

6. 37 CFR § 11.18. *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 CFR § 11.18.

7. 37 CFR § 2.193(e)(10).

8. 37 CFR § 2.119(e) and 37 CFR § 11.18(a); *Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017 (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. 37 CFR § 2.193(d).

10. 37 CFR § 2.193(b).

11. 37 CFR § 2.119(e).

106.03 Form of Submissions

***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 the text on one side only of each sheet;*

(2) *A paper submission must be 8 to 8.5 inches (20.3 to 21.5 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.*

Submissions may be made to the Board on paper or via the Internet through ESTTA, the Board's electronic filing system, as permitted by the rules or Board practice. For example, the rules provide that an opposition against a Trademark § 1 or § 44 application, or a request for extension of time to oppose a § 1 or § 44 application, may either be filed on paper or through ESTTA, but that an opposition against a Trademark Act § 66(a) application, or a request for extension of time to oppose a § 66(a) application, may only be filed through ESTTA. [Note 1.] The rules which previously permitted submissions on CD-ROM have been revoked; all submissions should now be made on paper or through ESTTA.

The requirements for each form of submission to the Board, including a confidential submission, are specified at 37 CFR § 2.126. The requirements for paper submissions are set out in part (a) of 37 CFR § 2.126. 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 2.]

A document filed with the Board must be either the original or a legible copy thereof, on good quality paper. [Note 3.] *See also* TBMP § 107 (fax copies). Extra copies of a document should not be submitted. [Note 4.]

The requirements for electronic submissions over the Internet can be found in part (b) of 37 CFR § 2.126. Submissions over the Internet are made through ESTTA which is available on the USPTO web site. [Note 5.] 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: http://estta.uspto.gov. For more information regarding ESTTA, *see* TBMP § 110.09.

The Board encourages 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. Except when filing extensions of time to oppose or oppositions to Madrid Protocol applications, ESTTA filing is optional. 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 Express Mail procedures). *See* TBMP § 110, *et seq.* (Certificates of Mailing), and TBMP § 111, *et seq.* (Express Mail).

Use of ESTTA is mandatory 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). 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. Similarly, a notice of opposition not filed through ESTTA against such an application will not be instituted. [Note 6.] Once a notice of opposition is filed, subsequent submissions may be filed either on paper, or through ESTTA.

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 e-mail 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 e-mail inquiries within two business days. The e-mail address is for technical ESTTA questions only. **Documents will not be accepted for filing by e-mail**.

Exhibits to a submission are also subject to the requirements of 37 CFR § 2.126. Exhibits pertaining to a paper submission must be filed on paper and must comply with the requirements for a paper submission. [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. [Note 8.] *See* TBMP § 110.09(c)(3) regarding size limitations.

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 paper or digitized 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 CFR § 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. [Note 9.] The Board strongly recommends that confidential materials 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 CFR § 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.

NOTES:

1. 37 CFR § 2.101(b) (filing of oppositions); 37 CFR § 2.102(a) (filing of extensions of time to oppose).

2. *See* Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act; Final Rule, 68 Fed. Reg. 55748, 55760 (September 26, 2003).

3. 37 CFR § 2.193.

4. *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).

5. 37 CFR § 2.2(g).

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

7. 37 CFR § 2.126(a)(6).

8. 37 CFR § 2.126(b).

9. 37 CFR § 2.126(c).

107 How and Where to File Papers and Fees

***37 CFR § 2.195* Receipt of trademark correspondence.**

(a) Date of receipt and Express Mail date of deposit. Trademark correspondence received in the Office is given a filing date as of the date of receipt except as follows:

(1) *The Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted electronically under paragraph (a)(2) of this section or transmitted by facsimile under paragraph (a)(3) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.*

(2) *Trademark-related correspondence transmitted electronically will be given a filing date as of the date on which the Office receives the transmission.*

(3) *Correspondence transmitted by facsimile will be given a filing date as of the date on which the complete transmission is received in the Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the filing date will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.*

(4) *Correspondence filed in accordance with § 2.198 will be given a filing date as of the date of deposit as "Express Mail" with the United States Postal Service.*

(b) Correspondence delivered by hand. *Correspondence may be delivered by hand during hours the Office is open to receive correspondence.*

(c) Facsimile transmission. *Except in the cases enumerated in paragraph (d) of this section, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 2.196. To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application, registration or proceeding before the Office. The application serial number, registration number, or proceeding number should be entered as a part of the sender's identification on a facsimile cover sheet.*

(d) *Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:*

*** * * ***

(3) *Correspondence to be filed with the Trademark Trial and Appeal Board, except notices of ex parte appeal;*

*** * * ***

(e) Interruptions in U.S. Postal Service.

(1) *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 "Express Mail Post Office to Addressee" service who was unable to deposit the correspondence with the United States Postal*

Service due to the interruption or emergency may petition the Director to consider such correspondence as filed on a particular date in the Office.

(2) *The petition must:*

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

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

(iii) *Include a statement that the correspondence would have been deposited with the United States Postal Service on the requested filing date but for the designated interruption or emergency in ''Express Mail'' 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 Express Mail on the requested filing date.*

(3) *Paragraphs (e)(1) and (e)(2) of this section do not apply to correspondence that is excluded from the Express Mail procedure pursuant to § 2.198(a)(1).*

The Board strongly encourages electronic filing using ESTTA for all submissions in Board proceedings. However, for those documents that are being delivered to the Office, the specific requirements 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:

ATTN: Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

With the exception of a notice of ex parte appeal to the Board, or in the absence of a specific request by the Board, documents to be filed with the Board may not be filed by facsimile transmission ("fax"). [Note 1.] If documents other than the notice of appeal in an ex parte appeal are filed with the Board by fax transmission, they will not receive a filing date.

However, the Board will accept, and give filing dates to, documents that had been faxed to, for example, local counsel, when the fax copies are, in turn, properly filed by other means. [Note 2.]

The Board does not accept any filings by e-mail. For information on filing submissions via ESTTA, (Electronic System for Trademark Trials and Appeals), the Board's electronic filing system, *see* TBMP § 110.09.

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

NOTES:

1. 37 CFR § 2.195(d)(3). *See e.g.*, *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280 (TTAB 2008) (facsimile filing of notice of opposition not accepted). A notice of ex parte appeal to the Board may be faxed to (571) 273-0059, and may include a certificate of transmission pursuant to 37 CFR § 2.197 (Certificate of mailing or transmission). Although a notice of ex parte appeal may be filed by fax, filers are strongly urged to use ESTTA for the best and most expeditious service.

2. The Board retains the discretion to explicitly direct a party to file a paper by fax in individual circumstances for the convenience of the Board. Due to the availability of electronic filing through ESTTA, however, fax filing is rarely requested by the Board. In the event the Board directs a filing by fax, the filing party will be advised of the correct telephone number to use. The filer may include a certificate of transmission pursuant to 37 CFR § 2.197 (Certificate of mailing or transmission).

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.

ESTTA documents 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 e-mail filing receipt including the ESTTA tracking number. If the filer does not receive an on-screen acknowledgement and an e-mail 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 1.]

In the case of a document 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 intended for the Board 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. 37 CFR § 2.195(a)(2). *See* TBMP § 110.09 and http://estta.uspto.gov for instructions for filing via ESTTA.

109 Filing Date

***37 CFR § 2.195* Receipt of trademark correspondence.**

(a) Date of receipt and Express Mail date of deposit*. Trademark correspondence received in the Office is given a filing date as of the date of receipt except as follows:*

(1) *The Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted electronically under paragraph (a)(2) of this section or transmitted by facsimile under paragraph (a)(3) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.*

(2) *Trademark-related correspondence transmitted electronically will be given a filing date as of the date on which the Office receives the transmission.*

(3) *Correspondence transmitted by facsimile will be given a filing date as of the date on which the complete transmission is received in the Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the filing date will be the next succeeding day that is not a Saturday, Sunday, or Federal holiday within the District of Columbia.*

(4) *Correspondence filed in accordance with § 2.198 will be given a filing date as of the date of deposit as "Express Mail" with the United States Postal Service.*

(b) Correspondence delivered by hand*. Correspondence may be delivered by hand during hours the Office is open to receive correspondence.*

(c) Facsimile transmission*. Except in the cases enumerated in paragraph (d) of this section, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See §2.196. To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application, registration or proceeding before the Office. The application serial number, registration number, or proceeding number should be entered as a part of the sender's identification on a facsimile cover sheet.*

(d) *Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:*

* * * *

(3) *Correspondence to be filed with the Trademark Trial and Appeal Board, except notices of ex parte appeal;*

* * * *

(e) Interruptions in U.S. Postal Service*.*

(1) *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 "Express Mail Post Office to Addressee" service who was unable to deposit the correspondence with the United States Postal Service due to the interruption or emergency may petition the Director to consider such correspondence as filed on a particular date in the Office.*

(2) *The petition must:*

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

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

(iii) *Include a statement that the correspondence would have been deposited with the United States Postal Service on the requested filing date but for the designated interruption or emergency in ''Express Mail'' 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 Express Mail on the requested filing date.*

(3) *Paragraphs (e)(1) and (e)(2) of this section do not apply to correspondence that is excluded from the Express Mail procedure pursuant to § 2.198(a)(1)*

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. Once a request is transmitted electronically, the system immediately provides the sender with an e-mail acknowledgement of receipt. For more information regarding ESTTA, *see* TBMP § 110.09.

Mailed or hand-delivered correspondence is stamped with the date of receipt in the Office (i.e., the "filing" date) unless the correspondence is filed by the "Express Mail" procedure provided in 37 CFR § 2.198. [Note 2.]

When correspondence intended for the Board is filed by the "Express Mail Post Office to Addressee" service of the United States Postal Service the document will be stamped with the "date in" as the date of receipt (unless the "date in" is a Saturday, Sunday, or Federal holiday

within the District of Columbia). 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 3.]

If correspondence which is permitted to be filed by fax transmission to the Board is filed by that method with a certificate of transmission in accordance with 37 CFR § 2.197(a), the transmission date specified in the certificate of transmission is used for purposes of determining the timeliness of the correspondence. [Note 4.] *See* TBMP § 107. The date of receipt of the transmission, as described in 37 CFR § 2.195(a)(3), is used for all other purposes. [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 CFR § 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 CFR § 2.195(a)(2); *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* http://estta.uspto.gov for instructions for filing via ESTTA.

2. 37 CFR § 2.195(a).

3. 37 CFR § 2.195 and 37 CFR § 2.198. *See* 37 CFR § 2.198(d), regarding procedures for petitioning the Director to correct a filing date discrepancy.

4. 37 CFR § 2.197(a). The only correspondence which may be filed by fax is a notice of ex parte appeal to the Board. 37 CFR § 2.195(d)(3).

5. *See* 37 CFR § 2.197(a).

6. *See* 37 CFR § 2.195(a) and 37 CFR § 2.197(a). For information concerning the date stamped by the USPTO on correspondence when interruptions or emergencies occur in the United States Postal Service, *see* 37 CFR § 2.195(e).

110 Certificate of Mailing Procedure and Electronic Filing Using ESTTA

110.01 Certificate of Mailing – In General

***37 CFR § 2.197* Certificate of mailing or transmission.**

(a) *Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.*

(1) *Correspondence will be considered as being timely filed if:*

(i) *The correspondence is mailed or transmitted prior to expiration of the set period of time by being:*

(A) *Addressed as set out in § 2.190 and deposited with the U.S. Postal Service with sufficient postage as first class mail; or*

(B) *Transmitted by facsimile to the Office in accordance with § 2.195(c); and*

(ii) *The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.*

(2) *The procedure described in paragraph (a)(1) of this section does not apply to:*

(i) *Applications for the registration of marks under 15 U.S.C. 1051 or 1126; and*

(ii) *Madrid-related correspondence filed under § 7.11, § 7.21, § 7.14, § 7.23, § 7.24 or § 7.31.*

(b) *In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Office, and an application is abandoned, a registration is cancelled or expired, or a proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:*

(1) *Informs the Office of the previous mailing or transmission of the correspondence within two months after becoming aware that the Office has no evidence of receipt of the correspondence;*

(2) *Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and*

(3) *Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.*

(c) *The Office may require additional evidence to determine whether the correspondence was timely filed.*

The certificate of mailing procedure discussed below applies only to submissions filed in paper form. For information regarding the filing of submissions via the Internet using ESTTA, *see* TBMP § 110.09.

Except in certain instances, specified in 37 CFR § 2.197(a), as amplified by 37 CFR § 2.195(c),

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, or (for correspondence which is permitted to be filed by fax) is transmitted to the Office by fax, in accordance with 37 CFR § 2.195(c), and (2) includes a certificate of mailing or transmission which meets the requirements specified in 37 CFR § 2.197(a). [Note 1.]

In effect, the certificate of mailing or transmission procedure permits certain types of correspondence, as specified in 37 CFR § 2.197(a) and 37 CFR § 2.195(c), to be sent to the Office by first-class mail, or by fax transmission, 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, or that the fax transmission may not, because of USPTO equipment failure or maintenance requirements, be completed until the next day. [Note 2.]

However, the Office, 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 all types of correspondence in Board proceedings.

The certificate of transmission procedure is available in Board proceedings only for the filing of a notice of ex parte appeal to the Board. [Note 4.] *See* TBMP § 107 (How and Where to File Papers and Fees).

NOTES:

1. 37 CFR § 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. 37 CFR § 2.197(c); *S. Indus. 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); and *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. 37 CFR § 2.195(d)(3).

110.02 Requirements for Certificate

<u>37 CFR § 2.190</u> Addresses for trademark correspondence with the United States Patent and Trademark Office.

(a) Trademark correspondence -- in general. *All trademark-related documents filed on paper, except documents sent to the Assignment Services Division for recordation; requests for copies of trademark documents; and certain documents filed under the Madrid Protocol as specified in paragraph (e) of this section, should be addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451. All trademark-related documents may be delivered by hand, 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. *An applicant may transmit a trademark document through TEAS, at http://www.uspto.gov.*

(c) Trademark Assignments. *Requests to record documents in the Assignment Services Division may be filed through the Office's web site, at http://www.uspto.gov . Paper documents and cover sheets to be recorded in the Assignment Services Division should be addressed to: Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. See § 3.27 of this chapter.*

(d) Requests for copies of trademark documents. *Copies of trademark documents can be ordered through the Office's web site at www.uspto.gov. Paper requests for certified or uncertified copies of trademark documents should 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, and petitions to the Director to review an action of the Office's Madrid Processing Unit, when filed by mail, must be mailed to: Madrid Processing Unit, 600 Dulany Street, MDE-7B87, Alexandria, VA 22314-5793.*

The requirements for filing trademark-related documents (except for trademark-related documents sent to the Assignment Services Division for recordation and requests for certified copies of trademark application and registration documents) by the certificate of mailing or transmission procedure are as follows:

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

ATTN: Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451,

or (ii) (for correspondence which is permitted to be filed by fax) transmitted to the Office by fax, in the manner described in 37 CFR § 2.195(c); and

(2). Each piece of correspondence must include a certificate which states the date of deposit or transmission, 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 or transmitted on or before the date indicated. [Note 1.]

Trademark-related documents sent to the Assignment Services Division for recordation should be addressed to: Mail Stop Assignment Recordation 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 copies (certified or uncertified) of trademark documents pertaining to applications and registrations are handled by the USPTO Patent and Trademark Copy Fulfillment Branch, Public Records Division. The address for all such requests mailed to the Office is: Mail Stop Document Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. [Note 3.] *See* TBMP § 121 for further information on obtaining file copies.

The Assignment Services Division of the Public Records Division also has an electronic trademark assignment recording form on the Office web site. The system is called ETAS (Electronic Trademark Assignment System) and allows customers to create and submit a Trademark Assignment Recordation Coversheet by completing on-line 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 or a certificate of transmission should be clearly labeled as such and should include a reference to the proceeding number to which it pertains, the date of transmission, and the signature of the person attesting that the document is being transmitted on a certain date. When possible, the certificate should appear on the paper being transmitted, rather than on a separate sheet of paper.

NOTES:

1. 37 CFR § 2.197(a).

2. 37 CFR § 2.190(c).

3. 37 CFR § 2.190(d).

4. 37 CFR § 2.190(c).

110.03 Suggested Format

Shown below is a suggested format for a certificate of mailing, under 37 CFR § 2.197, for trademark-related mail (except for trademark-related documents sent to the Assignment Services Division 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

Shown below is a suggested format for a certificate of transmission under 37 CFR § 2.197:

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office

on _____ _____
Date *Signature*

_____
Typed or printed name of person signing certificate

110.04 Location of Certificate

If one of the simple certificate of mailing or certificate of transmission formats shown in TBMP § 110.03 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 or certificate of transmission 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 or a certificate of transmission 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, the simple certificate formats shown in TBMP § 110.03 are not appropriate for use on a separate sheet of paper. Rather, a certificate placed on a separate sheet of paper 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 or certificate of transmission on a separate sheet pertains, the certificate will not be accepted.

110.05 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.

110.06 No receipt of Correspondence Bearing Certificate

In the event that correspondence intended for the USPTO is timely filed with an appropriate certificate of mailing or certificate of transmission, pursuant to 37 CFR § 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 or facsimile transmission 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 or transmitted 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 or transmission. The

statement must be verified if it is made by a person other than a practitioner, as that term is defined in 37 CFR § 11.1. If the correspondence was appropriate for filing by fax transmission, a copy of the sending fax machine's report confirming transmission may be used to support the statement. *See also* TBMP § 107 (How and Where to File Papers and Fees). [Note 1.] If the document is not one authorized to be filed by facsimile transmission, the document will not be accepted. [Note 2.]

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

NOTES:

1. 37 CFR § 2.197(b).

2. A notice of ex parte appeal to the Board is the only document that may be filed by fax. 37 CFR § 2.195(d)(3).

110.07 Excluded Filings

The certificate of mailing procedure is **not** applicable to the filing of an extension of time to oppose, or a notice of opposition involving an application under Trademark Act § 66(a), 15 U.S.C. § 1141f(a). [Note 1.] The certificate of mailing procedure is applicable to all other types of paper filings in Board proceedings, including a notice of opposition; a petition to cancel; a request for an extension of time to oppose; 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.

The certificate of transmission procedure is not applicable to any correspondence intended for the Board, except for the notice of appeal in an ex parte appeal to the Board, if sent by facsimile. [Note 2.] Neither a certificate of mailing nor a certificate of transmission is necessary or appropriate for documents filed via 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 CFR § 2.102(a)(2) ("A written request to extend the time for filing an opposition to an application filed under section 66(a) of the Act must be filed through ESTTA."); 37 CFR § 2.101(b)(2) ("An opposition to an application based on section 66(a) of the Act must be filed through ESTTA."). In addition, the certificate of mailing procedure may not be used in connection with the filing of trademark applications, 37 CFR § 2.197(a)(2)(i), and certain other Madrid-related correspondence, 37 CFR § 2.197(a)(2)(ii). *See* TMEP § 305.02(a).

2. 37 CFR § 2.195(d).

110.08 A Certificate of Mailing or Transmission is Not ...

As is evident from the requirements for a certificate of mailing, specified in 37 CFR § 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 CFR § 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 or certificate of transmission is not the equivalent of a certificate of service. A certificate of mailing or certificate of transmission indicates when correspondence was sent to the Office pursuant to the provisions of 37 CFR § 2.197(a). The mailing date recited in a certificate of mailing, or the transmission date recited in a certificate of transmission, 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 CFR § 2.195 and 37 CFR § 2.197.

110.09 Electronic Filing Using ESTTA

37 CFR § 2.2(g) *The acronym ESTTA means the Electronic System for Trademark Trials and Appeals, available at http://www.uspto.gov/.*

37 CFR § 2.126(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.*

37 CFR § 2.101(b)(2) *An opposition to an application based on section 66(a) of the Act must be filed through ESTTA.*

37 CFR § 2.102(a)(2) *A written request to extend the time for filing an opposition to an application filed under section 66(a) of the Act must be filed through ESTTA.*

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. Likewise, users need not open an account or obtain a password, and there is no additional fee for use of ESTTA.

The Board strongly encourages 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 en 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 e-mail 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. Eastern time controls the filing date, not the local date from where the document was sent. [Note 1.] ESTTA filers should not send hard copies of electronically-filed documents to the Board.

Filers outside of the United States generally cannot receive the benefit of a certificate of mailing, 37 CFR § 2.197, or filing by Express Mail, 37 CFR § 2.198, because both provisions require deposit of the correspondence with the U.S. Postal Service. However, ESTTA provides proof of timely filing from anywhere in the world.

The ESTTA user manual, ESTTA forms, and instructions for their use can be found at http://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.

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 CFR § 2.195(a)(2); http://estta.uspto.gov (instructions for filing via ESTTA).

110.09(a) 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 § 110.09(e) (Questions about ESTTA Filing), but cannot guarantee that any problem will be resolved prior to a deadline. Except when filing extensions of time to oppose or oppositions to Madrid Protocol applications, ESTTA filing is optional. *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 Express Mail procedures). See* TBMP § 110 (Certificate of Mailing), and TBMP § 111 ("Express Mail" procedure). Note, however, that an extension of time to oppose, or a notice of opposition involving an application under

Trademark Act § 66(a) **must** be filed through ESTTA. [Note 2.] Users should not anticipate that the Board will extend a deadline because it was not possible to file a paper by ESTTA on the due date.

NOTES:

1. *Vibe Records Inc. v. Vibe Media Group LLC,* 88 USPQ2d 1280 (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 CFR § 2.102(a)(2) (extension of time to oppose) and 37 CFR § 2.101(b)(2) (notice of opposition).

110.09(b) ESTTA is Mandatory for Some Filings

Use of ESTTA is optional for most papers, but is mandatory 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 1.] 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. [Note 2.] Similarly, a notice of opposition not filed through ESTTA against such an application will not be instituted. [Note 3.] Once a notice of opposition is filed, subsequent submissions may be filed either on paper, or through ESTTA, although use of ESTTA is strongly encouraged for all filings.

For a further discussion of filing notices of opposition against Madrid Protocol applications via ESTTA, *see* TBMP § 306.01.

NOTES:

1. 37 CFR § 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 CFR § 2.101(b)(2) (notice of opposition against Trademark Act § 66(a), 15 U.S.C. § 1141f(a) application must be filed through ESTTA). *See e.g.*, *O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.,* 95 USPQ2d 1327, 1328 n.2 (TTAB 2010) (opposition to § 66(a) application must be filed via ESTTA).

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

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

110.09(c) Attachments to ESTTA Filings

110.09(c)(1) 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, ESTTA will display its pages in "thumbnail" form, so that the user may determine whether all of the relevant pages of the selected file or files have been designated for filing.

110.09(c)(2) 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.

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 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. Original paper documents are usually sent to the warehouse, and the Board works from the scanned images, rather than the originals. It will almost always be easier for the filer – who is familiar with the documents being submitted – to see that the images are suitable to the purpose for which they are being filed.

In addition, electronically submitted pleadings, motions, briefs, and the like must be formatted for at least 11-point type and be double-spaced. [Note 3.] 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. All paper submissions are scanned by the Board upon receipt. Even when making large filings, ESTTA is preferred over paper filing.

3. 37 CFR § 2.126(b).

110.09(c)(3) Size Limitations

ESTTA is suitable (and is recommended) even 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.

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 10 MB, and the aggregate of all attached files for a single ESTTA transmission may not exceed 1 GB. However, because very large flies 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) of approximately 300 pages*. If a single submission, e.g., a single testimonial transcript or notice of reliance, is greater than 300 pages, it should be broken into two or more submissions, such that each is less than 300 pages.

110.09(d) Service of ESTTA Filings

All papers 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.] Many of the ESTTA forms assist the filer by including a certificate of service as part of the ESTTA submission. In all other forms, the filer must include a certificate of service as an attachment (or as part of an attachment) to the ESTTA filing.

In addition to the requirement for a certificate of service, ESTTA papers, like all other Board filings, must actually be served upon the other parties to the proceeding in the manner designated. [Note 2.] *See* TBMP § 2.113 (Service of Papers). ESTTA does not automatically serve papers upon opposing parties or provide notice of their filing. [Note 3.]

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

NOTES:

1. 37 CFR § 2.119(a).

2. *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 CFR § 2.119(b) (acceptable means of service).

3. *Equine Touch Foundation Inc. v. Equinology Inc.,* 91 USPQ2d 1943, 1944 n.5 (TTAB 2009) ("[a]ny plaintiff who files a complaint through ESTTA is viewed by the Board as having included proof of service with its pleading. 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). *See e.g.*, *Chocoladefabriken Lindt & Sprungli AG v. Flores,* 91 USPQ 2d 1698, 1699 n.2 (TTAB 2009) (opposer filed notice of opposition via ESTTA and served copy thereof on applicant by first-class mail).

110.09(e) 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 e-mail 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 e-mail inquiries within two business days. The e-mail address is for technical ESTTA questions only. **Papers will not be accepted for filing by e-mail.** *See* TBMP § 107 ("The Board does not accept any filings by e-mail.").

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 "Express Mail" Procedure

111.01 In General

***37 CFR § 2.198* Filing of correspondence by "Express Mail."**

(a)(1) *Except for documents listed in paragraphs (a)(1)(i) and vii) of this section, any correspondence received by the Office that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed with the Office on the date of deposit with the USPS. The Express Mail procedure does not apply to:*

(i) *Applications for registration of marks;*

(ii) *Amendments to allege use under section 1(c) of the Act;*

(iii) *Statements of use under section 1(d) of the Act;*

(iv) *Requests for extension of time to file a statement of use under section 1(d) of the Act;*

(v) *Affidavits of continued use under section 8 of the Act;*

(vi) *Renewal requests under section 9 of the Act; and*

(vii) *Requests to change or correct addresses.*

(2) *The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the date of receipt in the Office as the filing date.*

(b) *Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.*

(c) *Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:*

(1) *The petition is filed within two months after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;*

(2) *The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing; and*

(3) *The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.*

(d) *Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:*

(1) *The petition is filed within two months after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;*

(2) *The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing; and*

(3) *The petition includes a showing that establishes, to the satisfaction of the Director, that the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup on the requested filing date. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or evidence that came into being within one business day of the deposit after the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.*

(e) *If correspondence is properly addressed to the Office pursuant to § 2.190 and deposited with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but not received by the Office, the party who mailed the correspondence may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:*

(1) *The petition is filed within two months after the person becomes aware that the Office has no evidence of receipt of the correspondence*

(2) *The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) prior to the original mailing;*

(3) *The petition includes a copy of the originally deposited paper(s) or fee(s) showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the correspondence was deposited in the "Express Mail Post Office to addressee" service prior to the last scheduled pickup on the requested filing date; and*

(4) *The petition includes a statement that establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.*

(f) *The Office may require additional evidence to determine whether the correspondence was deposited as "Express Mail" with the USPS on the date in question.*

Certain papers or fees to be filed in the Office, including any paper or fee intended for the Board, can be filed utilizing the "Express Mail Post Office to Addressee" service (not the "Express Mail Post Office to Post Office" 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 1.]

In effect, the "Express Mail" procedure permits all types of correspondence intended for the Board to be sent by the "Express Mail 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 "Express Mail" service of the United States Postal Service, not any third-party carrier that offers overnight delivery. [Note 2.]

NOTES:

1. *See* 37 CFR § 2.198(a)(1). *See also* TMEP § 305.03 for "Express Mail" procedures for the Trademark Examining Operation.

2. *See 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).

111.02 Requirements for "Express Mail"

As 37 CFR § 2.198(b) provides, prior to the original mailing, the "Express Mail" 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 that wishes to send mail to the Board by the "Express Mail" service of the U.S. Postal Service should be careful to use the "Express Mail Post Office to Addressee" service, rather than the "Express Mail Post Office to Post Office" service.

111.03 Questionable Date of Mailing

If the "date-in" appearing on the "Express Mail" label is illegible, the filing date will be the actual receipt date by the USPTO. 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-in" date by providing the evidence set forth in 37 CFR § 2.198(c), 37 CFR § 2.198(d), and 37 CFR § 2.198(e). [Note 1.]

NOTES:

1. *See* TMEP § 305.03 for further information on petition procedures.

112 Times for Taking Action

***37 CFR § 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, written requests for discovery (i.e., interrogatories, requests for production of documents, and requests for admission) 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, 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 web site 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.

NOTES:

1. *See e.g.*, *Nat'l 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); *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).

2. *See "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 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.

113 Service of Papers

<u>37 CFR § 2.119</u> Service and signing of papers.

(a) *Every paper filed in the United States Patent and Trademark Office in inter partes cases, including notice of appeal, must be served upon the other parties. Proof of such service must be made before the paper 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 papers 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 may be made in any of the following ways:*

(1) *By delivering a copy of the paper 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 a member of the person's family over 14 years of age and of discretion;*

(4) *Transmission by the "Express Mail 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.*

(6) *Electronic transmission when mutually agreed upon by the parties.*

Whenever it shall be satisfactorily shown to the Director that none of the above modes of obtaining service or serving the paper is practicable, service may be by notice published in the Official Gazette.

(c) *When service is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier will be considered the date of service. Whenever a party is required to take some action within a prescribed period after the service of a paper upon the party by another party and the paper is served by first-class mail, "Express Mail," or overnight courier, 5 days shall be added to the prescribed period.*

* * * *

113.01 Requirement for Service of Papers

Every document 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 applies not only to documents filed in an inter partes proceeding before the Board, but also to documents filed in an application or registration which is the subject of such a proceeding, if the documents could have an effect on the inter partes proceeding. For example, a request to amend or correct an application or registration which is the subject of an inter partes proceeding; an abandonment of the application; or a voluntary surrender of the registration, must all be served by the defendant upon every other party to the proceeding.

NOTES:

1. 37 CFR § 2.119(a).

113.02 Requirement for Proof of Service

When a party to an inter partes proceeding before the Board files a document required by 37 CFR § 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 document 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 itself mails a copy of the abandonment to the opposer, or 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 CFR § 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.]

NOTES:

1. *See e.g.*, *Central Mfg. 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).

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. 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 CFR § 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 mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: (set out name and address of opposing counsel or party).

_____
Signature

113.04 Manner of Service

Service of papers filed in inter partes cases may be made in any of the ways specified in 37 CFR § 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 a member of the person's family over 14 years of age and of discretion; (4) transmission by the "Express Mail 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) electronic transmission when mutually agreed upon by the parties. In addition, whenever it is satisfactorily shown to the Director that none of the specified modes of service is practicable, service may be made by notice published in the Official Gazette of the USPTO. [Note 1.]

When service is made by mail, pursuant to 37 CFR § 2.119(b)(4), the Board considers the mailing date of the paper 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 CFR § 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.

When agreed upon by the parties, service may be made by electronic means, such as e-mail or fax. [Note 2.] The best practice is to reduce such an agreement to writing, although the agreement should not be filed with the Board unless necessary to resolve a motion.

NOTES:

1. 37 CFR § 2.119(b).

2. 37 CFR § 2.119(b)(6).

113.05 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 paper upon that party by another party to the proceeding, and the paper is served by first-class mail, "Express Mail, or overnight courier, the time for taking action is enlarged by 5 days. [Note 1.] The 5-day enlargement is not applicable to agreed use by parties of service by electronic transmission (i.e. e-mail or fax). [Note 2.] In addition, Fed. R. Civ. P. 6(d) is not applicable to Board proceedings.

For example, if one party to a proceeding serves, upon another party to the proceeding, a motion to compel discovery, and service of the motion is made by first-class mail, "Express Mail," or overnight courier, the served party's time for filing a response to the motion will be 20 days from the date of service of the motion, that is, from the date of mailing or of delivery to the overnight courier. Because the service was made by first-class mail, "Express Mail," or overnight courier, 5 days are added to the 15-day period prescribed in 37 CFR § 2.127(a) for filing a response to a motion. The additional 5 days are added to the response period before applying 37 CFR § 2.196, which addresses the response time when the last day for taking action falls on a Saturday, Sunday, or Federal holiday.

37 CFR § 2.119(c) applies only when a party has to take some action within a prescribed period after the service of a paper upon it by another party, and service of the paper was made in one of three specified ways. It does not apply to an action that must be taken by a party within a time set in a communication from the Board. Thus, for example, when a Board action notifying a defendant of the filing of an opposition or petition to cancel allows the defendant 40 days from the date of the notification in which to file an answer to the complaint, the answer is due on or before the 40th day, not on the 45th day. Similarly, the 5-day enlargement is not applicable to 37 CFR § 2.128 which sets the time for filing the briefs on the case.

NOTES:

1. 37 CFR § 2.119(c).

2. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42250 (August 1, 2007) ("As for agreed use by parties of email or fax for forwarding of service copies, the Office confirms that § 2.119(c) would not apply to service by electronic transmission

(e-mail or fax) under § 2.119(b)(6).”).

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. *Cf.* TBMP § 110.08.

114 Representation of a Party

***37 CFR § 11.14* Individuals who may practice before the Office in trademark and other non-patent cases.**

(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 cases. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent cases. 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 Jan. 1, 1957, will be recognized as agents to continue practice before the Office in trademark matters.*

(c) Foreigners. *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 registered or in good standing before the patent or trademark office of the country in which he or she resides and practices and is possessed of 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 patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark matters before the Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.*

(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) *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. Any individual may appear in a trademark or other non-patent matter in his or her own behalf. Any individual may appear in a trademark matter for*

(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, if such firm, partnership, corporation, or association is a party to a trademark proceeding pending before the Office.*

(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 may represent itself in an ex parte or inter partes proceeding before the Board, or the party may be represented by an attorney or other authorized representative. [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.]

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 familiar with trademark law represent a party.

NOTES:

1. *See* 37 CFR § 11.14(e).

2. 37 CFR § 11.14(e).

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 CFR § 2.11.

114.03 Representation by Attorney

The term "attorney" is defined in 37 CFR § 11.1 as "an individual who is a member in good standing of the highest court of any State, including an individual who is in good standing of the highest court of one State and not under an order of any court or federal agency suspending, enjoining, restraining, disbarring or otherwise restricting the attorney from practice before the bar of another State or Federal agency." 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, as defined in 37 CFR § 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, [Note 2] (2) appears in person, or (3) files a written power of attorney signed by the party the attorney represents. [Note 3.]

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 CFR § 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, inter alia, a representation to the Office that, under the provisions of 37 CFR § 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 4.]

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 5.] 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 6.] *See* TBMP § 117 (Correspondence – With Whom Held).

NOTES:

1. *See* 37 CFR § 11.1, 37 CFR § 11.14(a); *Weiffenbach v. Klempay*, 29 USPQ2d 2027, 2030 (Dep't 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. *See Djeredjian v. Kashi Co*., 21 USPQ2d 1613, 1613 n.1 (TTAB 1991) (appearance made by filing motion on behalf of respondent).

3. 37 CFR § 2.17(c).

4. 37 CFR § 2.17(a).

5. *HKG Indus. 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).

6. 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 CFR § 11.14(b); *Weiffenbach v. Klempay*, 29 USPQ2d 2027, 2031 (Dep't Comm. 1993) (patent agent, admitted to practice before the Office in patent cases after January 1, 1957, was excluded from 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 CFR § 11.14(c) and (e).

2. 37 CFR § 2.17(b).

114.05 Representation by Foreign Attorney or Agent

***37 CFR § 11.14(c)* Foreigners.** *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 registered or in good standing before the patent or trademark office of the country in which he or she resides and practices and is possessed of 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 patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark matters before the Office. Recognition under this paragraph shall continue only during the period that*

the conditions specified in this paragraph obtain.

***37 CFR § 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 CFR § 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 CFR § 11.14(c) must apply in writing to the Director of the Office of Enrollment and Discipline, and pay the appropriate fee. [Note 1.] For information on how to meet the specified conditions, contact the USPTO's Office of Enrollment and Discipline by telephone at (571) 272-4097 or by mail at Mail Stop OED, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. When a foreign attorney is recognized to practice before the Office, the parties are reminded that the certificate of mailing procedure is not available for use on mail that originates in a foreign country

Currently, only Canada provides substantial reciprocal privileges to attorneys in the United States to practice before its trademark office. Therefore, the USPTO's Office of Enrollment and Discipline recognizes Canada as qualifying for the limited exception provided in 37 CFR § 11.14(c), permitting the Canadian attorney to represent a Canadian party before the Office. The Office of Enrollment and Discipline maintains a list of attorneys who are registered or in good standing with the Canadian Intellectual Property Office. [Note 2.]

However, 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 CFR § 11.14(f).

2. *See* TMEP § 602.03 (Foreign Attorneys and Agents).

114.06 Individual Not Entitled to Represent Others

An individual who is not entitled, under 37 CFR § 11.14(a), 37 CFR § 11.14 (b), 37 CFR § 11.14(c), or 37 CFR § 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 entitlement to practice before the USPTO in trademark matters.

If it comes to the attention of the Board that an individual who is not entitled, under 37 CFR § 11.14(a), 37 CFR § 11.14 (b), 37 CFR § 11.14 (c) or 37 CFR § 11.14 (d), 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.

Moreover, 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 other authorized representative entitled to practice before the Office in trademark cases. [Note 1.] *See* TBMP § 117 (Correspondence – With Whom Held).

NOTES:

1. 37 CFR § 2.18(d).

114.07 Designation of Domestic Representative

***37 CFR § 2.24* Designation of representative by foreign applicant.** *If an applicant is not domiciled in the United States, the applicant may designate by a document filed in the United States Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. If the applicant does not file a document designating the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director. The mere designation of a domestic representative does not authorize the person designated to prosecute the application unless qualified under paragraph (a), (b) or (c) of § 11.14 of this subchapter and authorized under § 2.17(b).*

37 CFR § 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, the party may designate by document filed in the United States Patent and Trademark 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 United States Patent and Trademark 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 subchapter. 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(b).*

Shown below is a suggested format for the designation of a domestic representative (the suggested format should appear below information identifying the proceeding in connection with which it is filed):

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)

Once a party has appointed a domestic representative, all correspondence in the case will be sent to the domestic representative, unless the party is represented by an attorney or other authorized representative located in the United States, or by a foreign attorney or agent duly qualified under 37 CFR § 11.14(c). *See* TBMP § 117.06 (Correspondence with Foreign Party).

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.]

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. [Note 3.]

NOTES:

1. *See* TMEP § 610.

2. *See* TMEP § 610.

3. 37 CFR § 2.119(d).

114.08 Adverse Parties Represented by Same Practitioner

37 CFR § 10.66 Refusing to accept or continue employment if the interests of another client may impair the independent professional judgment of the practitioner.

(a) *A practitioner shall decline proffered employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely*

affected by the acceptance of the proffered employment, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.

(b) *A practitioner shall not continue multiple employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the practitioner's representation of another client, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.*

(c) *In the situations covered by paragraphs (a) and (b) of this section a practitioner may represent multiple clients if it is obvious that the practitioner can adequately represent the interest of each and if each consents to the representation after full disclosure of the possible effect of such representation on the exercise of the practitioner's independent professional judgment on behalf of each.*

(d) *If a practitioner is required to decline employment or to withdraw from employment under a Disciplinary Rule, no partner, or associate, or any other practitioner affiliated with the practitioner or the practitioner's firm, may accept or continue such employment unless otherwise ordered by the Director or Commissioner.*

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 CFR § 10.66(c).

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. [Note 2.]

NOTES:

1. 37 CFR § 10.66(a); 37 CFR § 10.66(b); *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 Indus., 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). *See also* Am. Bar Ass'n, MODEL RULES OF PROFESSIONAL CONDUCT, R. 1.7 (Conflict of Interest: Current Clients), 1.9 (Duties to Former Clients).

2. 37 CFR § 10.20(b).

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 Parts 10 and 11 of 37 CFR. Part 10 contains both Canons and Disciplinary Rules. Canons are "statements of axiomatic norms, expressing in general terms the standards of professional conduct expected of practitioners in their relationships with the public, with the legal system, and with the legal profession," while Disciplinary Rules are "mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action." [Note 1.]

Part 11 of 37 CFR 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 CFR §§ 11.4-11.18), and investigations and disciplinary proceedings (37 CFR §§ 11.19-11.61).

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 2.]

NOTES:

1. 37 CFR § 10.20.

2. 37 CFR § 2.192; *MySpace Inc. v. Mitchell*, 91 USPQ2d 1060, 1062 n.4 (TTAB 2009).

115.02 Disciplinary Proceedings

***37 CFR § 2.193* Trademark correspondence and signature requirements.**

* * * *

(c)(2) *The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by a party, whether a practitioner or non-practitioner, constitutes a*

certification under § 11.18(b) of this chapter. Violations of § 11.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, 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 11.23(c)(15).

***37 CFR § 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 § 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 CFR § 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. The order shall establish procedures for the supervision of probation. Violation of any condition of probation shall be cause for the probation to be revoked, and the disciplinary sanction to be imposed for the remainder of the probation period. Revocation of probation shall occur only after an order to show cause why probation should not be revoked is resolved adversely to the practitioner.*

(b) *Conditions imposed with discipline. When the USPTO Director imposes discipline, the practitioner may be required to make restitution either to persons financially injured by the practitioner's conduct or to an appropriate client's security trust fund, or both, as a condition of probation or of reinstatement. Such restitution shall be limited to the return of unearned practitioner fees or misappropriated client funds. Any other reasonable condition may also be imposed, including a requirement that the practitioner take and pass a professional responsibility examination.*

(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 CFR § 11.18(b), and is subject to sanctions under 37 CFR § 11.18(c) for violation of 37 CFR § 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 CFR §§ 11.19-11.61. Such a proceeding is instituted only under the circumstances specified in 37 CFR § 11.19.

NOTES:

1. For examples of cases involving disciplined practitioners, *see Bender v. Dudas,* 490 F.3d 1361, 83 USPQ2d 1065 (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 (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 (Dir. USPTO 2003) (reciprocal discipline); *In re Ryznic,* 67 USPQ2d 1115 (Dir. USPTO 2003) (agent suspended for, *inter alia,* prosecuting patent application while employed by USPTO); *In re Cohen,* 66 USPQ2d 1782 (Dir. USPTO 2003) (practitioner suspended for neglecting client matter and other sanctionable conduct); *Moatz v. Kersey*, 67 USPQ2d 1291 (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 CFR § 11.19(c) *Petitions to disqualify a practitioner in ex parte or inter partes cases 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 cases before the Board are not disciplinary proceedings and hence are not governed by 37 CFR §§ 11.19-11.60. 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 CFR § 2.19 Revocation of power of attorney; withdrawal.

(a) *Authority to represent an applicant, registrant or a party to a proceeding may be revoked at any stage in the proceedings of a case upon written notification to the Director; and when it 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 one has been appointed. The Office will notify the person affected of the revocation of his or her authorization.*

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 CFR § 2.19(b) *If the requirements of § 10.40 of this chapter are met, an attorney authorized under § 11.14 to represent an applicant, registrant or party in a trademark case may withdraw upon application to and approval by the Director.*

37 CFR § 10.40 Withdrawal from employment.

(a) *A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§ 1.36 and 2.19 of this subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.*

(b) Mandatory withdrawal. *A practitioner representing a client before the Office shall withdraw from employment if:*

(1) *The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;*

(2) *The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;*

(3) *The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or*

(4) *The practitioner is discharged by the client.*

(c) Permissive withdrawal. *If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:*

(1) *The petitioner's client:*

(i) *Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;*

(ii) *Personally seeks to pursue an illegal course of conduct;*

(iii) *Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;*

(iv) *By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;*

(v) *Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or*

(vi) *Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services*

(2) *The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;*

(3) *The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;*

(4) *The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;*

(5) *The practitioner's client knowingly and freely assents to termination of the employment; or*

(6) *The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.*

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 withdraw until he or she has complied with the conditions specified in 37 CFR § 10.40(a).

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 CFR § 10.40(b).

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 CFR § 10.40(c).

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 CFR § 10.40(b) and 37 CFR § 10.40(c). Moreover, the practitioner must comply with the requirements of 37 CFR § 10.40(a). [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.

NOTES:

1. *See* 37 CFR § 2.19(b) and 37 CFR § 10.40; *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 (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 CFR § 2.18* Correspondence, with whom held.**

(a) *If an attorney transmits documents, or a written power of attorney is filed, the Office will send correspondence to the attorney transmitting the documents, or to the attorney designated in the power of attorney, provided that the attorney is an attorney as defined in § 11.1 of this chapter.*

(b) *The Office will not undertake double correspondence. If two or more attorneys appear or sign a document, the Office's reply will be sent to the address already established in the record until the applicant, registrant or party, or its duly appointed attorney, requests in writing that correspondence be sent to another address.*

(c) *If an application, registration or proceeding is not being prosecuted by an attorney but a domestic representative has been appointed, the Office will send correspondence to the domestic representative, unless the applicant, registrant or party designates in writing another correspondence address.*

(d) *If the application, registration or proceeding is not being prosecuted by an attorney and no domestic representative has been appointed, the Office will send correspondence directly to the applicant, registrant or party, unless the applicant, registrant or party designates in writing another correspondence address.*

37 CFR § 2.24 ***Designation of representative by foreign applicant.***
If an applicant is not domiciled in the United States, the applicant may designate by a document filed in the United States Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. If the applicant does not file a document designating the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director. The mere designation of a domestic representative does not authorize the person designated to prosecute the application unless qualified under paragraph (a), (b) or (c) of § 11.14 of this subchapter and authorized under § 2.17(b).

37 CFR § 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, the party may designate by document filed in the United States Patent and Trademark 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 United States Patent and Trademark 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 subchapter. 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(b).*

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 or other authorized representative. Such correspondence will be sent to the party at the party's address of record in the proceeding, unless an appearance is made on behalf of the party by an attorney (as defined in 37 CFR § 11.1), or a written power of attorney is filed, or written authorization of some other person entitled to be recognized is filed, or the party designates in writing another address to which correspondence is to be sent. If one of these events occurs, correspondence will be sent not to the party's address of record, but rather to the attorney who makes the appearance, or to the attorney designated in the power of attorney, or to the other person designated in the written authorization, or to the address designated by the party for correspondence. [Note 1.] If there is no attorney of record, but a domestic representative has been appointed, correspondence will be sent to the domestic

representative, unless the party designates in writing another correspondence address. If there is no attorney of record and no domestic representative has been appointed, correspondence will be sent directly to the party. Correspondence will continue to be sent to such address until the party, or the party's attorney or other representative, indicates in writing that correspondence is to be sent to another address. [Note 2.]

If the Board has an e-mail address for Board correspondence with a party, notice of all Board actions will be sent by e-mail. A "hard copy" may not be sent by postal mail. An e-mail 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 e-mail address in connection with the prosecution of the subject application and had authorized the Office to communicate with applicant by e-mail. In all other cases, the Board will obtain an e-mail address for a party when that party files correspondence with the Board using ESTTA, or files a change of correspondence address specifying an e-mail address. The Board considers the submission of papers using ESTTA as consent to the Board's sending notice of Board actions by e-mail. [Note 3.] Unlike the case with paper correspondence, a party may designate more than one e-mail address (separated by commas, up to a limit of 150 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 e-mail "spam" filters to always accept messages from the USPTO domain (uspto.gov).

If the Board does not have an e-mail 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.

The mailing of correspondence in accordance with standard Office mailing procedures creates a presumption of receipt of correspondence. [Note 4.]

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 CFR § 2.18(b). *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. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243-44 (August 1, 2007).

4. *See 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 Authorized Representative

If a party has supplied a list of e-mail addresses for correspondence with the Board, notice of any Board action will be sent to each of the e-mail addresses supplied (regardless of whether the listed e-mail recipients are the party's attorney(s)). *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 authorized representative makes an appearance on behalf of a party, the papers filed by the additional attorney(s) or other authorized representative(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 or other authorized representative ("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 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, 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 Board, in its discretion, may request that the plaintiffs appoint one lead counsel, to whom the Board may send correspondence intended for the plaintiffs. [Note 4.] After the lead counsel has been appointed, the Board will send one copy of any forthcoming Board order, decision, or other communication to the applicant or its attorney or other authorized representative, and one copy to plaintiffs' lead counsel. Lead counsel in turn will be responsible for making and distributing copies of such Board correspondence to each plaintiff or its attorney or other authorized representative. 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. A Board action requesting the appointment of lead counsel normally includes a detailed explanation of the anticipated duties and responsibilities of lead counsel.

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

NOTES:

1. *See* 37 CFR § 2.18.

2. *See* TMEP § 604.03.

3. *See* TMEP § 604.03.

4. *Cf. Internet Inc. v. Corp. for Nat'l 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 authorized representative) 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 e-mail address, if electronic communication with the Office has been authorized. 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 written authorization of some other person entitled to be recognized is filed in the proceeding by the registrant, or the registrant designates in writing another address to which correspondence is to be sent. [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 address is 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. A single TEAS [Note 3] 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 4.]

NOTES:

1. 37 CFR § 2.105(c).

2. *See* 37 CFR § 2.113(c), 37 CFR § 2.18(d).

3. TEAS is the acronym for the Trademark Electronic Application System. 37 CFR § 2.2(f).

4. *See* TMEP § 605.01.

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 or other authorized representative located in the United States, or by a foreign attorney or agent duly qualified under 37 CFR § 11.14(c), correspondence will be sent to the party's domestic representative, if one has been appointed. Note, however, that a domestic representative cannot represent a party in Board proceedings. [Note 1.] If the party has not appointed a domestic representative and the proceeding is not being prosecuted by an attorney 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. [Note 2.]

NOTES:

1. *See* TMEP § 610.

2. *See* 37 CFR § 2.119(d).

117.07 Change of Address

If a party to a Board proceeding or its attorney or other authorized representative moves or changes its e-mail address, a separate written notice of the change of address or e-mail address should be filed with the Board and should reference the proceeding number. 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 e-mail address, if applicable. 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 e-mail 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, the Board rarely sees 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 papers 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 e-mail address, for any party to a Board proceeding changes. Parties are encouraged to file a change of address online using ESTTA, where they are able to enter the new address.

117.08 Individual Not Entitled to Represent Others

An individual who is not entitled, under 37 CFR § 11.14(a), 37 CFR § 11.14(b), 37 CFR § 11.14(c) or 37 CFR § 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 or other authorized representative entitled to practice before the USPTO in trademark cases. [Note 2.]

NOTES:

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

2. *See* 37 CFR § 2.18.

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 CFR § 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 CFR § 1.21, as well as on the USPTO web site.

A list of fees and charges for processing correspondence relating to international applications and registrations under the Madrid Protocol may be found in 37 CFR § 7.6 as well as on the USPTO web site. 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 CFR § 7.7 as well as on the WIPO web site, www.wipo.int.

118.02 Fees Payable in Advance

***37 CFR § 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.*

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

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

* * * *

(d)(1) *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).*

(2) *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.*

(3) *If an otherwise timely opposition is submitted on paper, the following is applicable if less than all required fees are submitted:*

(i) *If the opposition is accompanied by no fee or a fee insufficient to pay for one person to*

oppose the registration of a mark in at least one class, the opposition will be refused.

(ii) *If the opposition is accompanied by fees sufficient to pay for one person to oppose registration in at least one class, but fees are insufficient to oppose registration in all the classes in the application, and the particular class or classes against which the opposition is filed is not specified, the opposition will be presumed to be against the class or classes in ascending numerical order, including only the number of classes in the application for which sufficient fees have been submitted.*

(iii) *If persons are joined as party opposers, each must submit a fee for each class for which opposition is sought. If the fees submitted are sufficient to pay for one person to oppose registration in at least one class, but are insufficient for each named party opposer, the first-named party will be presumed to be the party opposer. Additional parties will be deemed to be party opposers only to the extent that the fees submitted are sufficient to pay the fee due for each party opposer. If persons are joined as party opposers against a multiple class application, the fees submitted are insufficient, and no specification of opposers and classes is made at the time the party is joined, the fees submitted will be applied first on behalf of the first-named opposer against as many of the classes in the application as the submitted fees are sufficient to pay. Any excess will be applied on behalf of the second-named party to the opposition against the classes in the application in ascending numerical order.*

(4) *The filing date of an opposition is the date of receipt in the Office of the notice of opposition, with proof of service on the applicant, or its attorney or domestic representative of record, if one has been appointed, at the correspondence address of record in the Office, and the required fee, unless the notice is filed in accordance with § 2.198.*

37 CFR § 2.111 Filing petition for cancellation.

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

* * * *

(c)(1) *The petition for cancellation must be accompanied by the required fee for each party joined as petitioner for each class in the registration for which cancellation is sought (see § 2.6).*

(2) *An otherwise timely petition for cancellation will not be accepted via ESTTA unless the petition for cancellation 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.*

(3) *If an otherwise timely petition for cancellation is submitted on paper, the following is applicable if less than all required fees are submitted:*

(i) *If the petition for cancellation is accompanied by no fee or a fee insufficient to pay for one person to petition for cancellation against at least one class in the registration, the petition for*

cancellation will be refused.

(ii) *If the petition for cancellation is accompanied by fees sufficient to pay for one person to petition for cancellation against at least one class in the registration, but fees are insufficient for a petition for cancellation against all the classes in the registration, and the particular class or classes against which the petition for cancellation is filed is not specified, the petition for cancellation will be presumed to be against the class or classes in ascending numerical order, including only the number of classes in the registration for which sufficient fees have been submitted.*

(iii) *If persons are joined as party petitioners, each must submit a fee for each class for which cancellation is sought. If the fees submitted are sufficient to pay for one person to petition for cancellation of the registration in at least one class but are insufficient for each named party petitioner, the first-named party will be presumed to be the party petitioner. Additional parties will be deemed to be party petitioners only to the extent that the fees submitted are sufficient to pay the fee due for each party petitioner. If persons are joined as party petitioners against a multiple class registration, the fees submitted are insufficient, and no specification of parties and classes is made at the time the party is joined, the fees submitted will be applied first on behalf of the first-named petitioner against as many of the classes in the registration as the submitted fees are sufficient to pay. Any excess will be applied on behalf of the second-named party to the cancellation against the classes in the registration in ascending numerical order.*

(4) *The filing date of a petition for cancellation is the date of receipt in the Office of the petition for cancellation, with proof of service on the owner of record, or on the owner's domestic representative, if one has been appointed, at the correspondence address of record in the Office, and with the required fee, unless the petition is filed in accordance with § 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 transmitted to the USPTO. 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, it will not be refused a filing date provided that the fee paid is sufficient for at least one opposer or petitioner to proceed against at least one class. If the classes to be opposed are not specified, the fee tendered will be applied to the classes of the subject application or registration, in ascending order, on behalf of the opposers or petitioners in the order they were named. [Note 3.]

NOTES:

1. 37 CFR § 2.101(d)(4) and 37 CFR § 2.111(c)(4).

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. *See* 37 CFR § 2.111(c)(3).

118.03 Method of Payment--In General

***37 CFR § 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.*

It is the practice of the Office to routinely 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.

Filers using ESTTA to file papers 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.

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, the Revenue Accounting and Management (RAM) system, that allows transactions to occur over the Internet through the Office web site 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 filing paper documents.

The fees for filing an ex parte appeal to the Board, an opposition, and a petition for cancellation, may all be charged to a deposit account, provided that the requirements of 37 CFR § 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 a $100 fee 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 CFR § 2.208 (Deposit accounts).

2. 37 CFR § 2.208(c).

3. *See* 37 CFR § 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 CFR § 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 CFR 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 Papers and Fees--Ex Parte Cases

After an application has received a filing date, papers filed in connection therewith, including ex parte appeal papers, will not be returned. [Note 1.]

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, or, 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 CFR § 2.25 (Documents not returnable).

119.03 Papers and Fees--Inter Partes Cases

After an inter partes proceeding before the Board has been filed, papers and other materials filed in connection therewith, normally will not be returned. Following the conclusion of a proceeding, including any appeal period, a party which filed confidential paper materials pursuant to a protective order will be given the choice to have those materials returned, or to have them destroyed by the Board. *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.

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 CFR § 2.102(b), that it is in privity with the person who obtained the extension, or that the person in whose name the extension was requested was misidentified by 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).

Electronic fillings will not be accepted if any of the above-identified conditions exist.

Proceedings will be instituted, and the filing fee charged 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.

120 Access to Files

37 CFR § 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 CFR § 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 web site 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://tarr.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 that are located at the Board or one of the

USPTO Warehouses may place a request for access to a particular Board file with the Trademark Assistance Center, located at 600 Dulany Street, Madison East Concourse Level, Room C55, Alexandria, Virginia. Requests for access may be made using the self-service electronic File Ordering System or by logging such in the Public Access Log Book located in the Trademark Assistance Center public access area. A Trademark Assistance Center employee is available to assist customers desiring to place requests for access to Board files.

An individual who wishes to inspect or copy a paper file located at the Board may also contact a Board Customer Service Representative at (571) 272-8500 or (800) 786-9199 (toll free), and ask that the file be located. When the file has been located, the Board will deliver the file to the Trademark Assistance Center and will notify the customer that the file has been delivered and is available for access at the Trademark Assistance Center, 600 Dulany Street, Madison East Concourse Level, Room C55, Alexandria, Virginia.

Paper files which have been ordered and received for customers will be held at the Trademark Assistance Center customer service window for a period of two weeks to enable the customer to return to inspect or copy the ordered files. Customers may copy pages from the files using the photocopier designated for public use which is located in the Trademark Assistance Center public access area by using a magnetic card to charge the fees for the copies. The magnetic card, known as a "copy card" may be purchased from the cashier at the USPTO Public Search Facility, located at 600 Dulany Street, Madison East, 1st Floor, Alexandria, Virginia.

Paper files or portions thereof may not be taken from the premises of the Trademark Assistance Center and a person who removes papers from a file for copying must return the papers to the file in their proper order.

For information concerning access to the paper files of cases that are on appeal from a decision of the Board, *see* TBMP § 904.

NOTES:

1. *See* 37 CFR § 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. Paper or electronic submissions in Board proceedings which are not properly designated as confidential

will be placed in the Board's public records, available on the Internet.

Electronic filing using ESTTA is preferred for submissions containing confidential material. 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.

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.

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 4.] 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 papers. [Note 5.]

NOTES:

1. *See* 37 CFR § 2.120(g) ("The Trademark Trial and Appeal Board's standard protective order is applicable during disclosure, discovery and at trial in all opposition, cancellation, interference and concurrent use registration 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, or upon request, a copy will be provided.").

2. *See* 37 CFR § 2.27(e); 37 CFR § 2.120(f); 37 CFR § 2.125(e).

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* 37 CFR § 2.126(c); *Duke University v. Haggar Clothing Co*., 54 USPQ2d 1443, 1445 (TTAB 2000).

5. *See* 37 CFR § 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).

Beginning in 2001, the Board began to create and maintain electronic files for Board proceedings. 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 paper inter partes proceeding files that result in a final decision by the Board, e.g., a granted motion for summary judgment or motion to dismiss, or a final decision on the merits, are transferred to a USPTO warehouse for 3 years, then to the Washington National Records Center in Suitland, Maryland for 27 years, and then to the National Archives for permanent retention. All other terminated paper proceedings are transferred to a USPTO warehouse for 3 years and then transferred to the Washington National Records Center in Suitland, Maryland, where they remain for 27 years before destruction. The paper files of existing registrations are also stored at the warehouse for as long as they remain registered. The paper files of cancelled and expired registrations are destroyed three years after the date of cancellation or expiration; the paper files of abandoned applications are 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 stored by the Office in a USPTO warehouse may place a request for access to a particular file with the Trademark Assistance Center, located at 600 Dulany Street, Madison East Concourse Level, Room C55, Alexandria, Virginia. Requests for access may be made using the self-service electronic File Ordering System or by logging them in the Public Access Log Book located in the Trademark Assistance Center public access area. A Trademark Assistance Center employee is available to assist customers desiring to place requests for access to Board files.

Paper files which have been ordered and received for customers will be held at the Trademark Assistance Center customer service window for a period of two weeks to enable the customer to return to inspect or copy the ordered files. Customers may copy pages from the files using the

photocopier designated for public use which is located in the Trademark Assistance Center public access area by using a prepaid magnetic card to charge the fees for the copies. The magnetic card, known as a "copy card" may be purchased from the cashier at the USPTO Public Search Facility, which is located at 600 Dulany Street, Madison East, 1st Floor, Alexandria, Virginia. The file may not be removed from the premises of the Trademark Assistance Center, and a person who removes papers from a file for copying must return the papers to the file in their proper order. [Note 1.]

NOTES:

1. *See* TMEP § 109.02.

121 Copying of Files

Most records filed in Board proceedings since 2001 are kept electronically. Non-electronic records are kept in paper files pursuant to the relevant retention schedule. When used, paper files are kept at the Board during the pendency of the Board proceeding, then stored at a warehouse pursuant to the relevant retention schedule. *See* TBMP § 120.03.

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 TDR (Trademark Document Retrieval). [Note 2.] Both TTABVUE and TDR permit users to view, download, and print non-confidential portions of applications, registrations, and Board proceedings.

Copies of Board non-electronic (i.e., paper) files may be obtained by requesting the file, *see* TBMP § 120, and utilizing the photocopier designated for public use in the Trademark Assistance Center public access area by using a magnetic card to charge the fees for the copies. [Note 3.] The magnetic card, known as a "copy card" may be purchased from the cashier at the USPTO Public Search Facility, which is located at 600 Dulany Street, Madison East, 1st Floor, Alexandria, Virginia.

Paper files or portions thereof may not be taken from the premises of the Trademark Assistance Center and a person who removes papers from a file for copying must return the papers to the file in their proper order.

Alternatively, the Patent and Trademark Copy Fulfillment Branch, Public Records Division will furnish photocopies (either certified or uncertified) 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 CFR § 2.6. The Office will also furnish, upon written request and payment of the fee prescribed in 37 CFR § 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 and uncertified 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 Patent and Trademark Copy Fulfillment Branch, Public Records Division. Copies can be ordered online from the Office of Public Records at http://ebiz1.uspto.gov/oems25p/index.html, by e-mail to dsd@uspto.gov, and by telephone at (571) 272-3150 or (toll free) (800) 972-6382. A request (with the required fee) made by postal mail for copies should be addressed to Mail Stop Document Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. The written request, with fee, may also be hand delivered to the Public Service Window at 2800 South Randolph Street, Randolph Square Building, 3rd Floor, Arlington, Virginia 22206-2217. Finally, if the written request includes an authorization to charge the required fee to a deposit account, the request may be sent by facsimile transmission to (571) 273-3250. [Note 4.]

NOTES:

1. http://ttabvue.uspto.gov/.

2. http://tmportal.uspto.gov/external/portal/tow.

3. *See* 37 CFR § 2.6(b)(9) (current charge for self-service copies is $.25 per page).

4. *See Notice of a Change in Procedure Regarding Requests for Certification Services*, 1165 TMOG 13 (Aug. 2, 1994).

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 from the Patent and Trademark Copy Fulfillment Branch, Public Records Division, upon written request and payment of the required fee. *See* TBMP § 121 for 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 TARR database at http://tarr.uspto.gov. Information on any recorded documents affecting the title to applications or registrations can be obtained from the Trademark Assignments database at http://assignments.uspto.gov/assignments/.

The Trademark Assistance Center provides general information about the registration process and can also answer status questions. The Center can be reached at (800) 786-9199 (toll free) or (571) 272-9250. Trademark application and registration information can also be obtained through the Trademark Applications and Registrations Retrieval (TARR) database at http://tarr.uspto.gov. [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. 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).

NOTES:

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

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

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

3. *See* TMEP § 1906.01(a)(i).

4. 37 CFR § 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 CFR § 2.101 ***Filing an opposition.***

(a) *An opposition proceeding is commenced by the filing in the Office a timely notice of opposition with the required fee. The notice must include proof of service on the applicant, or its attorney or domestic representative of record, at the correspondence address of record in the Office, as detailed in §§ 2.101(b) and 2.119.*

(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 and must serve a copy of the opposition, including any exhibits, on the attorney of record for the applicant or, if there is no attorney, on the applicant or on the applicant's domestic representative, if one has been appointed, at the correspondence address of record in the Office. The opposer must include with the opposition proof of service pursuant to § 2.119 at the correspondence address of record in the Office. If any service copy of the opposition is returned to the opposer as undeliverable, the opposer must notify the Board within ten days of receipt of the returned copy. 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 based on section 1 or 44 of the Act must be filed either on paper or through ESTTA.*

(2) *An opposition to an application based on section 66(a) of the Act must be filed through ESTTA.*

(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.*

(d)(1) *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).*

(2) *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.*

(3) *If an otherwise timely opposition is submitted on paper, the following is applicable if less than all required fees are submitted:*

(i) *If the opposition is accompanied by no fee or a fee insufficient to pay for one person to oppose the registration of a mark in at least one class, the opposition will be refused.*

(ii) *If the opposition is accompanied by fees sufficient to pay for one person to oppose registration in at least one class, but fees are insufficient to oppose registration in all the classes in the application, and the particular class or classes against which the opposition is filed is not specified, the opposition will be presumed to be against the class or classes in ascending numerical order, including only the number of classes in the application for which sufficient fees have been submitted.*

(iii) *If persons are joined as party opposers, each must submit a fee for each class for which opposition is sought. If the fees submitted are sufficient to pay for one person to oppose registration in at least one class, but are insufficient for each named party opposer, the first-named party will be presumed to be the party opposer. Additional parties will be deemed to be party opposers only to the extent that the fees submitted are sufficient to pay the fee due for each party opposer. If persons are joined as party opposers against a multiple class application, the fees submitted are insufficient, and no specification of opposers and classes is made at the time the party is joined, the fees submitted will be applied first on behalf of the first-named opposer against as many of the classes in the application as the submitted fees are sufficient to pay. Any excess will be applied on behalf of the second-named party to the opposition against the classes in the application in ascending numerical order.*

(4) *The filing date of an opposition is the date of receipt in the Office of the notice of opposition, with proof of service on the applicant, or its attorney or domestic representative of record, if one has been appointed, at the correspondence address of record in the Office, and the required fee, unless the notice is filed in accordance with § 2.198.*

<u>37 CFR § 2.102</u> 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 in the Office a written request, addressed to the Trademark Trial and Appeal Board, to extend the time for filing an opposition. The written 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 written request to extend the time for filing an opposition to an application filed under*

section 1 or 44 of the Act must be filed either on paper or through ESTTA.

(2) *A written request to extend the time for filing an opposition to an application filed under section 66(a) of the Act must be filed through ESTTA.*

(b) *A written 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 should be in the name of the person to whom the extension was granted. 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 either a thirty-day extension of time, which will be granted upon request, or a ninety-day extension of time, which will be granted only for good cause shown.*

(2) *If a person was granted a 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. 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.*

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* TBMP § 303.02.

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 upon the Principal Register may file a written request to extend the time for filing an opposition. [Note 2.] Requests for extensions of time to oppose are determined by the Board. [Note 3.]

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 CFR § 2.102(c). Other requirements for a request for extension of time to oppose are set forth in 37 CFR § 2.102(a) and 37 CFR § 2.102(b). Moreover, an extension of time to oppose must also meet the general requirements for submissions to the Board specified in 37 CFR § 2.126. Each of these requirements is discussed in the sections that follow.

NOTES:

1. Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 CFR § 2.101.

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

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

202 Time for Filing Request

202.01 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) [§ 43(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 [§ 12] 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 CFR § 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 either a thirty-day extension of time, which will be granted upon request, or a ninety-day extension of time, which will be granted only for good cause shown.*

(2) *If a person was granted a 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. 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.

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), for purposes of opposition. Any request for a further extension of time to oppose must be filed prior to the expiration of an extension granted to the requesting party or its privy. [Note 1.]

The timely filing of documents in the Office requires that the documents actually be received in the Office within the set time period unless such documents are filed in accordance with 37 CFR § 2.197 and 37 CFR § 2.198, which provide for filing of papers by certificate of mailing and Express Mail, respectively. *See* TBMP § 110 and TBMP § 111. Documents filed in accordance with these rules are considered as having been filed on the date of deposit as first class U.S. mail or Express Mail even if the mailed correspondence is not received in the Office until after the due date. [Note 2.] *See* TBMP § 110.01. The Express Mail filing procedure applies only to the "Express Mail" of the United States Postal Service, not any third-party carrier that offers overnight delivery. [Note 3.] *See* TBMP § 110.01. For extension requests filed electronically through the Board's Electronic System for Trademark Trials and Appeals (ESTTA), all time periods are calculated electronically and the filer is immediately informed of the timeliness of the filing. *See* TBMP § 109 and TBMP § 110.09.

In the event that a particular extension request submitted on paper is timely filed with an appropriate certificate of mailing, pursuant to 37 CFR § 2.197, but is not received in the Office, the correspondence will be considered timely if the party that submitted it supplies an additional copy of the previously mailed extension request and certificate, and includes a statement attesting to the previous timely mailing. The statement must be verified if it is made by a person other than a practitioner, as defined in 37 CFR § 10.1(r). [Note 4.] TBMP § 110.01. The only evidence accepted by the Office to prove deposit of the missing extension request is an exact copy of the disputed document including a copy of the executed original certificate of mailing. A reconstructed request and certificate of mailing will not suffice. [Note 5.] *See generally* TBMP § 110.

A potential opposer that has filed an extension request on paper should not wait until it has received notification from the Board of the grant or denial of the request before filing an opposition or a request for a further extension of time to oppose. If a request for an extension of time to oppose is granted, the length of the granted extension may be less than that sought in the extension request. A first extension runs from the expiration of the thirty-day opposition period after publication. In the case of a subsequent extension, it will run from the date of expiration of the previously granted extension. [Note 6.] While the Board attempts to notify a potential opposer of the grant of an extension request filed on paper before a granted extension expires, particularly when the length of the granted extension is less than that requested, the Board is

under no obligation to do so, and in some cases cannot. [Note 7.] Note that filing extension requests electronically using ESTTA will usually eliminate this problem, since almost all ESTTA extension requests are processed automatically and granted within minutes of filing.

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 8.] 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 9.] Alternatively, the potential opposer may file a single first request for a ninety-day extension of time for good cause. [Note 10.] 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 11.]

The final request (120-180 days after publication) can only be granted for sixty days and not any other period of time. [Note 12.] For example, after 120 days 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 based on consent, the request will be denied unless the reasons stated for the granting of the request are extraordinary, in which case the request will be granted for sixty days instead of the thirty days requested. This is because a thirty-day extension of time is not permissible under 37 CFR § 2.102(c)(3). However, the citing of extraordinary circumstances would allow the granting of a sixty-day extension of time.

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 CFR § 2.102(c)</td><td>First 30 days – no reason necessary
37 CFR § 102(c)(1)</td><td>Next 60 days – for good cause or consent
37 CFR § 102(c)(2)</td><td rowspan="2">Final 60 days – with consent or under extraordinary circumstances
37 CFR § 102(c)(3)</td></tr>
<tr><td colspan="2">First 90 Days – for good cause or consent
37 CFR § 102(c)(1)</td></tr>
</table>

NOTES:

1. Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 CFR § 2.102(c). *See In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (timeliness of extension requests is statutory and cannot be waived).

2. *See In re Pacesetter Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm’r 1994).

3. *See In re Pacesetter Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm’r 1994) (papers filed using overnight courier not entitled to benefit of Express Mail procedure). Because the certificate of mailing and Express Mail procedures both require use of the United States Postal Service,

correspondence mailed from outside of the United States is not eligible to receive the benefit of either provision. Accordingly, papers posted from outside of the United States will be accorded a filing date as of the date of their actual receipt in the USPTO. *See* 37 CFR § 2.195(a). Note, however, that electronic filing using ESTTA is available to all filers, from wherever transmitted. ESTTA papers are accorded the filing date (Eastern time -- USA) upon which the Office receives the complete transmission. 37 CFR § 2.195(a)(2); http://estta.uspto.gov (instructions for filing via ESTTA).

4. *See* 37 CFR § 2.197(b).

5. *In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1512 (Comm'r 1995) (a declaration attesting to the filing and to the certificate of mailing is not acceptable as evidence of timely filing).

6. *See In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990).

7. *See Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) (where misdirection of initial extension prevented Board from addressing calculation error in the request); *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990) (potential opposer was not notified of partial grant of extension request until after date had passed). *Cf. In re Holland Amercian Wafer Co.*, 737 F.2d 1015, 222 USPQ 273, 275 (Fed. Cir. 1984) (no statute or regulation imposes obligation on Office to notify parties of defects in sufficient time to allow correction); *In re L.R. Sport Inc.*, 25 USPQ2d 1533, 1534 (Comm'r 1992) (no obligation to notify of defective statement of use); and *In re Application Papers Filed November 12, 1965*, 152 USPQ 194, 195 (Comm'r 1966) (no obligation to discover deficiencies within a specified time).

8. 37 CFR § 2.102(c).

9. 37 CFR §§ 2.102(c)(1)-(2).

10. 37 CFR § 2.102(c)(1).

11. 37 CFR § 2.102(c)(3).

12. 37 CFR § 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 for opposition, pursuant to 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 this time for filing an opposition under certain conditions. Thus, any opposition, and any request for an extension of time to oppose, filed before the 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 privy. 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.] Accordingly, a first request filed after the expiration of the thirty-day period following publication of the subject mark, or a request for a further extension filed after the expiration of the previous extension granted to the requesting party or its privy, must 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 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.

NOTES:

1. Trademark Act § 13(a), 15 U.S.C. § 1063(a); 37 CFR § 2.102(c). *See In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980).

2. *See In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1512 (Comm'r 1995) (waiver of 37 CFR § 1.8 (now 37 CFR § 2.197) would effectively waive Trademark Act § 13, 15 U.S.C. § 1063(a), and, in any event, fact that potential opposer did not retain executed hard copies of documents filed with Office and cannot prove document was timely is not an extraordinary circumstance justifying a waiver of 37 CFR § 1.8); *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477, 1478 (Comm'r 1994); and *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980).

203 Form of Request

203.01 General Considerations

203.01(a) Paper or Electronic Filings

***37 CFR § 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 in the Office a written request, addressed to the Trademark Trial and Appeal Board, to extend the time for filing an opposition. The written 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 written request to extend the time for filing an opposition to an application filed under section 1 or 44 of the Act must be filed either on paper or through ESTTA.*

(2) *A written request to extend the time for filing an opposition to an application filed under section 66(a) of the Act must be filed through ESTTA.*

(b) *A written 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 should be in the name of the person to whom the extension was granted. 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 either a thirty-day extension of time, which will be granted upon request, or a ninety-day extension of time, which will be granted only for good cause shown.*

(2) *If a person was granted a 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. 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.*

<u>37 CFR § 2.126</u> 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 the 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.*

A request for an extension of time to oppose must be made in writing and must specify the period of extension desired. [Note 1.]

A request for extension of time to oppose a Trademark Act § 1 or Trademark Act § 44, 15 U.S.C. § 1051 or 15 U.S.C. § 1126 application may either be filed on paper or through ESTTA. [Note 2.] *See* TBMP § 106.03 and TBMP § 107. However, a request for extension of time to oppose a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) (Madrid Protocol), application must be filed through ESTTA. [Note 3.] *See* TBMP § 106.03. The requirements for paper and electronic submissions to the Board are specified in 37 CFR § 2.126(a) and 37 CFR § 2.126(c), respectively. Available forms and instructions for electronic filing can be found at http://estta.uspto.gov.

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.] 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.] Alternatively, the potential opposer may file a single first request for a ninety-day extension of time for good cause. [Note 6.] 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 7.]

The final request (120–180 days after publication) can only be granted for sixty days and not any other period of time. [Note 8.] For example, at 120 days after 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 based on consent, the request will be denied unless the reasons stated for the granting of the request are extraordinary, in which case the request will be granted for sixty days instead of the thirty days requested. This is because a thirty day extension of time is not permissible under 37 CFR § 2.102(c)(3). However, the citation of extraordinary circumstances would allow the grant of a sixty day extension of time.

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
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37 CFR § 102(c)(1)</td></tr>
</table>

NOTES:

1. 37 CFR § 2.102(a).

2. 37 CFR § 2.102(a)(1).

3. 37 CFR § 2.102(a)(2).

4. 37 CFR § 2.102(c)(3).

5. 37 CFR § 2.102(c).

6. 37 CFR § 2.102(c)(1).

7. 37 CFR § 2.102(c)(3).

8. 37 CFR § 2.101(c)(3).

203.01(b) Note on Electronic Filing With ESTTA

Electronic filing of extensions of time to oppose using ESTTA is optional, except in the case of extensions of time to oppose applications under Trademark Act § 66(a), 15 U.S.C. § 1141f(a) (Madrid Protocol). [Note 1.] It should be noted, however, that nearly all extensions of time to oppose are now filed electronically using ESTTA. Electronic filing is strongly encouraged by the Board. Use of ESTTA for filing extensions of time to oppose provides users with instant proof of timely filing, even when use of a certificate of mailing or the Express Mail procedure is unavailable. *See* TBMP § 202.01. Moreover, because ESTTA prompts the user to supply and verify all required information, use of ESTTA for filing extensions of time to oppose will usually avoid common pitfalls in filing. Most extensions of time to oppose filed via ESTTA are automatically processed, providing a nearly instantaneous order (via e-mail) granting the requested extension (if appropriate).

ESTTA forms, including a request for extension of time to oppose, and filing instructions can be found at http://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 e-mail to ESTTA@uspto.gov. [Note 2.] The e-mail address is for technical ESTTA questions only. Questions of a general nature regarding Board proceedings should be directed to the phone numbers listed above. *Papers will not be accepted for filing by e-mail*.

See TBMP § 106.03 and TBMP § 110.09 for general information on ESTTA filing.

NOTES:

1. 37 CFR § 2.102(a)(2). *See In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (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).

2. When sending an e-mail 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 telephone number for contact. The Board will respond to e-mail inquiries within two business days. E-mail should not be used for more urgent inquiries.

203.02 Identifying Information

203.02(a) In General

An extension request filed on paper 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. Any attachments to ESTTA forms should be separately captioned and identified for clarity.

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 CFR §§ 2.194(b)(1)-(2) ("A letter about a trademark application should identify the serial number, the name of the applicant, and the mark." "A letter about a registered trademark should identify the registration number, the name of the registrant, and the mark.").

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.] If a request for extension of time to oppose fails to identify the potential opposer with reasonable certainty, 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, 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. [Note 2.]

If a 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.

Tip for ESTTA filers: 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 CFR § 2.102(b).

2. *See In re Spang Industries, Inc.*, 225 USPQ 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 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; one potential opposer was accordingly not considered to be a party).

203.03 Signature

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

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 CFR § 11.1 or other authorized representative, as specified in 37 CFR § 11.14(b). [Note 1.] A paper 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 business address (to which correspondence relating to the request will be sent); and telephone number. This information is required on the electronic form as well.

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.

While a request for an extension of time to oppose must be signed, an 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 3.] TBMP § 106.02. An extension request filed through ESTTA cannot be electronically transmitted to the Office unless all required fields, including the signature field, are completed.

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 (after submission of a signed copy of the request) 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 CFR § 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 CFR § 2.193(c). *See* TMEP § 611.01(b) (Requirements for Signature), TMEP § 611.01(c) (Signature of Documents Filed Electronically).

3. 37 CFR § 2.119(e).

203.04 Service

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.] The timely filing of a notice of opposition in the Office with proof of service and the required fee commences an opposition proceeding. [Note 2.] 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 3.] 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 extension request together with the Board's action thereon. [Note 4.]

NOTES:

1. 37 CFR § 2.119(a).

2. 37 CFR § 2.101(a).

3. *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).

4. 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.

When duplicate paper requests have been filed and the first request has been granted, the second request is given no consideration, and the attorneys are notified in writing of the duplicate filings and are requested to take appropriate action to avoid filing duplicate requests in the future. [Note 1.] If requests filed by different attorneys on behalf of the same party are duplicates but for the fact that the second request seeks a longer extension than the first, the second request will be granted, if otherwise appropriate, but the attorneys will be requested in writing to avoid the filing of further duplicate requests.

NOTES:

1. 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. However filed, counsel should avoid duplicate filings by checking the application status in TTABVUE prior to filing an extension request (or any other paper).

204 Fee

There is no fee for filing a request for an extension of time to oppose. [Note 1.]

NOTES:

1. *See* 37 CFR § 2.6.

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 registration's issuance. [Note 3.]

Accordingly, the Board must deny any request for an extension of time to oppose the mark in an application for registration on the Supplemental Register. 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 CFR § 2.82.

2. Trademark Act § 23(b) and Trademark Act § 24; 15 U.S.C. § 1091(b) and 15 U.S.C. § 1092; 37 CFR § 2.82.

3. Trademark Act § 24, 15 U.S.C. § 1092; 37 CFR § 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 CFR § 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 in the Office a written request, addressed to the Trademark Trial and Appeal Board, to extend the time for filing an opposition. ...*

(b) *A written 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 should be in the name of the person to whom the extension was granted. 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 written 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) 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. The Board may question a potential opposer's standing in appropriate cases, either upon motion or sua sponte. But 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 standing 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 CFR § 2.101.

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

3. 37 CFR § 2.102(b).

4. *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.").

5. *See* 37 CFR § 2.102(b); TMEP § 1503.04; *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994); *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980).

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").

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, and must be submitted either with the request or opposition, or during the time allowed by the Board in its action 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.

Tip for ESTTA filers: 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 CFR § 2.102(b); TMEP § 1503.04; *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); *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). *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); and *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 (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 "misidentification by mistake," as used in 37 CFR § 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 by mistake should be in the form of a recitation of the facts upon which the claim of misidentification by mistake is based, and must be submitted either with the request or opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy.

NOTES:

1. *See* 37 CFR § 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); *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) and TMEP § 1503.04. *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); *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); and *Raker Paint Factory v. United Lacquer Mfg. 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 & Company 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 providing for right to apply; since distributor had no right to apply, subsequent assignment to proper applicant 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); and *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 CFR § 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 either a thirty-day extension of time, which will be granted upon request, or a ninety-day extension of time, which will be granted only for good cause shown.*

(2) *If a person was granted a 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. 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. 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 2.] Alternatively, the potential opposer may file a single first request for a ninety-day extension of time for good cause. [Note 3.] 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 4.]

The final request (120-180 days after publication) can only be granted for sixty days and not any other period of time. [Note 5.] For example, 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 based on consent, the request will be denied unless the reasons stated for the granting of the request are extraordinary, in which case the request will be granted for sixty days instead of the thirty days requested. This is because a thirty day extension of time is not permissible under 37 CFR § 2.102(c)(3). However, the citation 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 CFR § 2.102(c)</td><td>First 30 days – no reason necessary
37 CFR § 102(c)(1)</td><td>Next 60 days – for good cause or consent
37 CFR § 102(c)(2)</td><td rowspan="2">Final 60 days – with consent or under extraordinary circumstances
37 CFR § 102(c)(3)</td></tr>
<tr><td colspan="2">First 90 Days – for good cause or consent
37 CFR § 102(c)(1)</td></tr>
</table>

NOTES:

1. 37 CFR § 2.102(c)(3).

2. 37 CFR § 2.102(c).

3. 37 CFR § 2.102(c)(1).

4. 37 CFR § 2.102(c)(3).

5. 37 CFR § 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.]

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 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 CFR § 2.102(c).

2. 37 CFR § 2.102(c).

3. 37 CFR § 2.102(c)(1).

4. *See Lotus Dev. Corp. v. Narada Prods., 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 (120-180 days after publication) can only be granted for sixty days and not any other period of time. [Note 2.] For example, 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 based on consent, the request will be denied unless the reasons stated for the granting of the request are extraordinary, in which case the request will be granted for sixty days instead of the thirty days requested. This is because a thirty day extension of time is not permissible under 37 CFR § 2.102(c)(3). However, the citation 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 authorized representative, or (2) 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 (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.]

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 request that the parties are discussing settlement; the request must expressly state that applicant has consented to the extension. [Note 6.] In addition, the statement of consent should appear in the body of the request, not merely in the title (e.g. "Consented Request to Extend") of the 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.]

NOTES:

1. 37 CFR § 2.102(c)(3).

2. 37 CFR § 2.102(c)(3).

3. 37 CFR § 2.102(c)(3).

4. 37 CFR § 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) (applicant's silence in response to potential opposer's inquiries about extension requests does not amount to consent).

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 Indus., Inc.* 225 USPQ 888 (Comm'r 1985) (potential opposer not identified with reasonable certainty; defect not curable after time for filing extension expired).

208 Essential Element Omitted

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.]

While a request for an extension of time to oppose must be signed, an 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. Extension requests filed through ESTTA cannot be electronically transmitted to the Office unless all required fields, including the signature field, are completed. 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.

NOTES:

1. *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 Indus., 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 CFR § 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 decision on 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

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 CFR § 2.102(c). If a first request for an extension of time to oppose asks for a time 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, the extension, if granted, will be set to expire in ninety days. [Note 7.] *See* TBMP § 207.02. If good cause for a first extension beyond thirty days has not been shown, the time will be set to expire on the thirtieth day. [Note 8.] *See* TBMP § 207.02 (Extensions Up to 120 Days From Date of Publication).

If a further request for extension of time to oppose (that is, beyond a first thirty-day request) 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), and shows good cause, the extension, if granted, will be set to expire in sixty days.

After receiving a first thirty-day and a sixty-day extension of time, or a first ninety-day extension of time, if a potential opposer requests an extension of time for any other period other than a sixty-day request, the request will be denied unless the party has cited extraordinary circumstances. [Note 9.] *See* TBMP § 207.03.

Note for ESTTA filers: ESTTA automatically calculates extension dates, preventing many pitfalls associated with calculation of extension dates. Further, ESTTA only allows requests to be made in permissible intervals, avoiding mistakes and unexpected results.

NOTES:

1. *See* 37 CFR § 2.195 (Receipt of trademark correspondence); 37 CFR § 2.196 (Times for taking action: Expiration on Saturday, Sunday or federal holiday); *Lotus Dev. Corp. v. Narada Prods., 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 CFR § 2.102(c)(1).

4. *See* 37 CFR § 2.102(c)(2).

5. *See* 37 CFR § 2.102(c)(1).

6. *See* 37 CFR § 2.102(c)(3).

7. *See* 37 CFR § 2.102(c); *Kimberly-Clark Corp. v. Paper Converting Indus., 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 CFR § 2.102(c).

9. *See* 37 CFR § 2.102(c)(3).

210 Objections 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 will provide notice to the applicant of the extension request, which may be viewed at http://ttabvue.uspto.gov.

An applicant may learn of the filing of an extension request, and file objections thereto, before applicant receives anything from the Board about the request. This may happen, for example, when potential opposer serves a courtesy copy of the request upon applicant. If the Board receives objections before it acts upon the request, the Board will consider them. If the objections are received after action on the request, and the request has been granted, the objections will be treated as a request for reconsideration.

However, nearly all requests for extension of time to oppose are now filed electronically, and most of those will be automatically processed within minutes, so 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).

Further, an applicant who receives notification from the Board that a request for extension of time to oppose has been granted may submit objections to the granting of any further extensions of time to the potential opposer. In such a case, the objections will be considered by the Board in determining any subsequent request filed by the potential opposer, for an extension of time to oppose. If the Board does not receive objections until after it has granted a subsequent extension request, they will be treated as a request for reconsideration of the Board's action.

Any document 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 document 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 document together with the Board's action on the extension request, or, if the document is treated by the Board as a request for reconsideration, with the Board's action on the request for reconsideration.

211 Relief From Action of Board

211.01 Request for Reconsideration

If an applicant or potential opposer is dissatisfied with an action 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 receives the Board's action.

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 action granting or denying the request. One copy of the action is entered in the record of the subject application, one copy is sent to the applicant, and one copy is 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 together with that party's copy of the Board's action 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.

NOTES:

1. *Cf.* 37 CFR § 2.89(g).

211.02 Relief after Institution of Opposition

If an applicant is dissatisfied with an action 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 Mfg. 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 action 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 action 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 CFR § 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 affidavits or declarations in accordance with 37 CFR § 2.20, and these affidavits or declarations, 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 within 15 days from the mailing 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 or other authorized representative of the applicant, if any, or on the applicant. [Note 4.] A petition from the grant of a request must be served on the attorney or other authorized representative of the opposer, if any, or on the opposer. [Note 5.] Proof of service of the petition must be made as provided in 37 CFR § 2.119. [Note 6.] *See* TBMP §§ 113.03 (Elements of Certificate), and 113.04 (Manner of Service). The potential opposer or the applicant, as the case may be, may file a response within 15 days from 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 CFR § 2.119(a). 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 action will be sent to both parties.

If the decision on the petition is unfavorable to opposer, the opposition will be dismissed.

NOTES:

1. 37 CFR § 2.146 (Petitions to the Director). *See* TMEP § 1704 (Petitionable Subject Matter).

2. 37 CFR § 2.146(c).

3. 37 CFR § 2.146(e)(1).

4. 37 CFR § 2.146(e)(1).

5. 37 CFR § 2.146(e)(1).

6. 37 CFR § 2.146(e)(1).

7. 37 CFR § 2.146(e)(1).

8. 37 CFR § 2.146(e)(1).

9. *See* 37 CFR § 2.146(g); *In re Docrite Inc.*, 40 USPQ2d 1636, 1637 n.1 (Comm'r 1996) (citing 37 CFR § 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 extension of time to oppose, 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 paper (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, and the application is not 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 paper. [Note 2.] Unless an inter partes proceeding (i.e., an opposition or concurrent use proceeding) is pending, all post-publication amendments must be filed with the Trademark Examining Operation. [Note 3.]

However, the Board does determine the propriety of a request filed by an attorney or other authorized representative 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 in 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.

Any amendment 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 or by faxing it to the USPTO at (571) 270-9007. Any inquiry about the status of the amendment should be directed by e-mail to TMPostPubQuery@uspto.gov.

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 papers with the Board will only delay consideration of the amendment. 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 CFR §§ 2.102(c)(1) or (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 CFR § 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 CFR § 2.84 (examining attorney may exercise jurisdiction over application prior to publication, and with the permission of the Director, after publication) *with* 37 CFR § 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 CFR § 2.84; *In re MCI Communications Corp.*, 21 USPQ2d 1534 (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.

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 printing 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, provided that the amendment does not necessitate issuance of a refusal or requirement by the

examining attorney. If a refusal or requirement by the examining attorney would be needed, 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 1.]

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 2.]

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. *E.g.*, 37 CFR § 2.84(b); TMEP § 1504 (Jurisdiction over Application); TMEP § 1505 *et seq*. (Amendments filed by Applicants After Publication).

2. *See In re MCI Communications Corp.*, 21 USPQ2d 1534, 1539 (Comm'r 1991) (disclaimer). *Cf. In re Little Caesar Enters., Inc.*, 48 USPQ2d 1222 (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 paper 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 document relating to an application. Such amendments should be filed with the Trademark Examining Operation electronically through TEAS or by faxing it to the USPTO at (571) 270-9007.

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 should be filed either electronically through TEAS or by faxing the amendment to (571) 270-9007. Filing such amendments with the Board serves only to delay consideration of the paper. If an amendment is received by the Board, the amendment will be forwarded to the Trademark Examining Operation.

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 CFR § 2.102(c)(1) or 37 CFR § 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 CFR § 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.

In situations where the potential opposer files the notice of opposition electronically using ESTTA, the potential opposer should file the notice of opposition first and wait to receive an opposition number. (Most ESTTA-filed oppositions are instituted automatically within minutes of successful filing.) After the opposition number has been received and a proceeding number assigned, the potential opposer should then file a separate motion to suspend the opposition, citing the pendency of an amendment as grounds for seeking a suspension of proceedings.

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; and 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. If the amendment is not approved, the parties will be so advised, and proceedings will be resumed with appropriate dates set.

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 CFR § 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 request 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 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, a Board administrative staff member will prepare an order advising potential opposer and applicant thereof, and take further appropriate action. Examples are described below.

If the restoration of jurisdiction occurs during the running of an extension of time to oppose, the order will inform the potential opposer and applicant that jurisdiction over the application has been restored to the examining attorney; 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); 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 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, along with the notice of opposition, 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.

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.

If registration is ultimately denied by the examining attorney, any timely-filed opposition will be dismissed as a nullity.

NOTES:

1. *See* 37 CFR § 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 CFR § 2.130 (new matter suggested by the trademark examining attorney); TMEP § 1504.02.

3. *See* TMEP § 1504.05(a).

4. *See* TMEP § 1904.02(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 go to issue, 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, listing examples of amendments for which republication is necessary, TMEP § 1505.03(a), and those for which republication is not necessary, TMEP § 1505.03(b).

2. *See* Trademark Act § 68(c), Trademark Act § 69(a), 15 U.S.C. § 1141h(c); *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 knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information 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 is, a letter that recites the facts and is accompanied by supporting evidence. [Note 1.] The Deputy Commissioner will determine whether the letter of protest should be "granted," that is, whether the information or evidence should be given to the examining attorney for consideration. [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 ordinarily must be filed within thirty days after publication in order to be considered timely, and will usually be denied as untimely if filed more than thirty days after publication. [Note 3.] If the application is the subject of an opposition, the request for restoration of jurisdiction must be directed to the Board. [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 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 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 granted 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 submitted with the letter of protest. [Note 7.] Sometimes, a letter of protest is filed *before* the mark has been published for opposition but the Deputy Commissioner does not grant the letter of protest until after the mark has been published. In such case, if the mark has not been opposed, it is discretionary with the examining attorney whether to request that the Deputy Commissioner restore jurisdiction for further consideration of the registrability of the mark. [Note 8.] If the mark has been opposed, jurisdiction rests with the Board, and therefore the examining attorney must request that the Board remand the application for the purpose of making a refusal or requirement based on the relevant evidence submitted with the letter of protest. [Note 9.] On the other hand, if a letter of protest is filed *after* the mark has been published, and the Deputy Commissioner grants the letter of protest, then regardless of whether an extension of time request to oppose the application is pending, the Deputy Commissioner will restore jurisdiction to the examining attorney for the purpose of making a refusal or requirement based on the relevant evidence submitted with the letter of protest. [Note 10.] If the mark is the subject of an opposition when the Deputy Commissioner grants a letter of protest, jurisdiction rests with the Board, and therefore the examining attorney must request that the Board remand the application for the purpose of making a refusal or requirement based on the relevant evidence submitted with the letter of protest. [Note 11.]

If the Deputy Commissioner grants a letter of protest filed with respect to 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 grant in any order on any further request to extend, or when instituting an opposition.

Examples are described below:

Grant of Letter of Protest During Extension of Time:

Sometimes, when the Board considers an extension of time to oppose, the letter of protest has been granted, but jurisdiction over the application may or may not have been restored to the examining attorney, as discussed above. If jurisdiction has *not* been restored, then the question of registrability is not before the examining attorney and the opposition period, and any request for extension of time to oppose or notice of opposition which may be filed, will be processed as usual. 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 approving the extension request and notifying the potential opposer and applicant that the letter of protest has been granted, and jurisdiction over the application restored to the examining attorney who has issued an Office Action; 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 a letter of protest has been granted, jurisdiction has been restored, and an office action has issued, if the Board fails to do so, the potential opposer is not excused from the noted responsibilities.

Grant of Letter of Protest During Opposition:

If a party files a timely opposition while a letter of protest is pending, but not yet determined by the Deputy Commissioner, the Board will institute the opposition as it normally would. If the letter of protest (filed before or after publication of the subject mark) subsequently is granted, the examining attorney may seek remand of the application from the Board. [Note 12.] 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.

If a party files a timely opposition after a letter of protest has been granted 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, then the Board may resume the suspended opposition and dismiss it as moot.

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. *See In re Urbano*, 51 USPQ2d 1776, 1778-79 n.5 (TTAB 1999) (letter of protest provided additional information to the examining attorney to support a refusal); *In re BPJ Enterprises Ltd*., 7 USPQ2d 1375, 1379 (Comm'r 1988) (if examining attorney did not consider issue raised in letter of protest and letter is supported by evidence that would support a refusal, it should be granted; letter reviewed under former standard asking whether letter presented "prima facie" evidence for refusal); *In re Pohn*, 3 USPQ2d 1700, 1703 (Comm'r 1987) (guidelines for

timeliness of letter of protest).

2. *See* TMEP § 1715. For information concerning the standard applied by the Deputy Commissioner in determining whether a letter of protest should be granted, *see* TMEP § 1715.02 (letter of protest filed before publication), and TMEP § 1715.03 (letter of protest filed after publication).

3. TMEP § 1715.03(b) ("Letters of protest filed more than 30 days after publication are generally denied as untimely."). *See In re G. Heileman Brewing Co., Inc*., 34 USPQ2d 1476, 1478 (Comm'r 1994) (letter of protest, filed more than a year after publication and accompanied by evidence of descriptiveness which was available 2 months prior to publication, was untimely); *In re BPJ Enters. Ltd*., 7 USPQ2d 1375, 1379 (Comm'r 1988); *In re Pohn*, 3 USPQ2d 1700, 1703 (Comm'r 1987).

4. TMEP § 1715.03(c) ("However, if an opposition has been instituted, the Board has jurisdiction over the application. TMEP § 1504.02. Therefore, upon request, the Board will generally restore jurisdiction and remand the application to the examining attorney"). *See* 37 CFR § 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 Enters. Ltd*., 7 USPQ2d 1375, 1377 (Comm'r 1988).

7. *See* TMEP § 1504.01.

8. TMEP § 1715.03(c).

9. TMEP § 1715.03(c).

10. *See* TMEP § 1715.03(c).

11. *See* TMEP § 1715.03(c).

12. *See* 37 CFR § 2.130; TMEP § 1517.03(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. Such a registration is called an "inadvertently issued" registration.

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 inadvertently overlooked by the Board. [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 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 be returned, and any submitted opposition fee will be refunded. The potential opposer's substantive remedy will, under the statute, 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 a timely opposition, 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. *Mc Lachlan Touch Inc*., 6 USPQ2d 1395, 1396 (Comm'r 1987).

2. *Quality S. Mfg. Inc. v. Tork Lift Central Welding of Kent, Inc.*, 60 USPQ2d 1703, 1704 (Comm'r 2000).

3. *Quality S. Mfg. Inc. v. Tork Lift Central Welding of Kent, Inc.*, 60 USPQ2d 1703, 1704 (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 thereafter agrees 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).

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 in the Office a written statement of abandonment or withdrawal of the application, signed by the applicant or by the applicant's attorney or someone with legal authority to bind the applicant. [Note 6.] It is recommended that an express abandonment (filed prior to commencement of an opposition) be filed using TEAS in order to minimize the possibility that a paper-filed abandonment may not be associated with the file and acted upon prior to the institution of any opposition. 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, a Board administrative staff member will prepare an order notifying potential opposer that the application is no longer subject to the filing of a notice of opposition.

NOTES:

1. If an international registration is cancelled by the International Bureau 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 CFR § 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 CFR § 7.31. Although the transformed application retains the filing and priority date of the abandoned Trademark Act § 66(a) application, 37 CFR § 7.31(b), it is reexamined under 37 CFR Part 2, and will be published for opposition, even if it had been published prior to transformation. 37 CFR § 7.31(c). *See* TMEP § 1904.09, *et seq.*, for information on transformation.

2. *See 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 CFR § 2.68.

4. *See* 37 CFR § 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. 37 CFR § 2.68.

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 [Note 5] as any other timely filed amendment to allege use that is not associated with the application file until after publication. 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 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 CFR § 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), Trademark Act § 13(b)(2), 15 U.S.C. § 1051(d)(1), 15 U.S.C. § 1063(b)(2); 37 CFR § 2.81(b).

3. Trademark Act § 13(b)(2), 15 U.S.C. § 1063(b)(2); 37 CFR § 2.81(b).

4. 37 CFR § 2.76(a); 37 CFR § 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. TMEP § 1104.04.

220 Inadvertent Issuance of a Notice of Allowance

Sometimes 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. Additionally, 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. In that case, 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 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. The proceeding 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.]

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(2)(a) (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 § 18**,** 15 U.S.C. § 1068.

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

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

301.02 Mark on Supplemental Register Not Subject to Opposition

15 U.S.C. § 1092 [Trademark Act § 24] *Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office.*

Although the mark in an application for registration on the Principal Register is published for, and subject to, opposition, the mark in an application for registration on the Supplemental Register is not. [Note 1.] *See also* TBMP § 205.

Accordingly, the Board must reject any opposition filed with respect to the mark in an application for registration on the Supplemental Register. If the opposition is filed in paper form, the opposition papers will not be returned to the person who filed them. Any opposition fee submitted will be refunded. 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 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(2)(a).

302 Commencement of Proceeding

37 CFR § 2.101(a) *An opposition proceeding is commenced by filing in the Office a timely notice of opposition, with the required fee. The notice must include proof of service on the applicant, or its attorney or domestic representative of record, at the correspondence address of record in the Office, as detailed in §§ 2.101(b) and 2.119.*

37 CFR § 2.111(a) *A cancellation proceeding is commenced by filing in the Office a timely petition for cancellation with the required fee. The petition must include proof of service on the owner of record for the registration, or the owner's domestic representative of record, at the correspondence address of record in the Office, as detailed in §§ 2.111(b) and 2.119.*

37 CFR § 2.116(b) *The opposer in an opposition proceeding or the petitioner in a cancellation proceeding shall be in the position of plaintiff, and the applicant in an opposition proceeding or the respondent in a cancellation proceeding shall be in the position of defendant. A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.*

37 CFR § 2.116(c) *The 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.] The notice of opposition must include proof of service on the owner of the application, or its attorney or domestic representative of record, at the correspondence address of record in the Office. [Note 2.] *See* TBMP § 309.02(c). If any service copy of the opposition is returned to the opposer as undeliverable, the opposer must notify the Board within ten days of receipt of the returned copy. [Note 3.] *See* TBMP § 309.02(c)(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 4.] The petition to cancel must include proof of service on the record owner of the registration, or its domestic representative. *See* TBMP § 309.02(d). If any service copy of the petition to cancel is returned to the petitioner as undeliverable, the petitioner must notify the Board within ten days of receipt of the returned copy. [Note 5.] *See* TBMP § 309.02(c)(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 6.] 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 7.]

An interference proceeding commences when the Board mails a notice of interference to each of the parties to the proceeding, as described in 37 CFR § 2.93. For further information concerning interference proceedings, *see* TBMP Chapter 1000.

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

NOTES:

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

Civ. P. 3.

2. *See* 37 CFR § 2.101(a).

3. 37 CFR § 2.101(b).

4. 37 CFR § 2.111(a).

5. 37 CFR § 2.111(b).

6. 37 CFR § 2.116(c).

7. 37 CFR § 2.116(b). *See Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988).

303 Who May Oppose or Petition to Cancel

303.01 In General

15 U.S.C. § 1063(a) [Trademark Act § 13(a)] *Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered.*

15 U.S.C. § 1064 [Trademark Act § 14] *A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905.*

15 U.S.C. § 1092 [Trademark Act § 24] *Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that such person is or will be damaged by the registration of a mark on the supplemental register--*

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

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

15 U.S.C. § 1127 [Trademark Act § 45] *In the construction of this chapter, unless the contrary is plainly apparent from the context--*

* * * *

Person, Juristic Person. *The term "person" and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act includes a juristic person as well as a natural person. The term "juristic person" includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.*

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

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

* * * *

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

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

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

303.02 Meaning of the Term "Person"

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

If an operating division of a corporation is not itself incorporated or is not otherwise a legal entity which can sue and be sued, it does not have legal standing to own a mark or to file an application for registration, an opposition, or a petition for cancellation. [Note 3.] *See* TMEP § 1201.02(d) ("An operating division's use is considered to be use by the applicant…."). In such a case, the application, opposition, or petition for cancellation should be filed in the name

of the corporation of which the division is a part. If an opposition or a petition for cancellation is filed in the name of a division, and there is no indication that the division is incorporated, where the issue is presented in connection with a discovery conference or a motion, the Board may inquire as to whether the division is incorporated or is otherwise a legal entity that can sue and be sued. If the opposer or petitioner responds in the negative, the opposition or petition for cancellation will go forward in the name of the corporation of which the division is a part. [Note 4.] *See* TMEP § 1201.02(d).

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

NOTES:

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

2. Trademark Act § 45, 15 U.S.C. § 1127. *See Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1475 (Fed. Cir. 1992) (a "person" may be a corporation or other entity); *Morehouse Manufacturing Corp. v. J. Strickland and Co.*, 407 F.2d 881, 160 USPQ 715, 720-21 (CCPA 1969) (a corporation is a "person" within the meaning of Trademark Act § 45, 15 U.S.C. § 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)); and *In re Mohawk Air Services Inc.*, 196 USPQ 851, 855 (TTAB 1977) (a government agency is a juristic person and as such may file an application for registration, an opposition, or a petition for cancellation).

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

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

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

303.03 Meaning of the Term "Damage"

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

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

NOTES:

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

2. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-6 (Fed. Cir. 1999).

3. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999).

4. *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 (Fed. Cir. 1987); *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); *International Order of Job's Daughters v. Lindeburg and Company*, 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984); *Rosso & Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 219 USPQ 1050 (Fed. Cir. 1983); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 27 (CCPA 1976); and *Universal Oil Products Co. v. Rexall Drug & Chemical Co.*, 463 F.2d 1122, 174 USPQ 458, 459-60 (CCPA 1972).

See also Montecash LLC v. Anzar Enterprises Inc., 95 USPQ2d 1060, 1062 (TTAB 2010);

Enbridge, Inc. v. Excelerate Energy Limited Partnership, 92 USPQ2d 1537, 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 (TTAB 1992); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991); *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990); *Ipco Corp. v. Blessings Corp.*, 5 USPQ2d 1974 (TTAB 1988); *Aruba v. Excelsior Inc.*, 5 USPQ2d 1685 (TTAB 1987); *Bankamerica Corp. v. Invest America*, 5 USPQ2d 1076 (TTAB 1987); *BRT Holdings Inc. v. Homeway, Inc.*, 4 USPQ2d 1952 (TTAB 1987); *American Speech-Language-Hearing Ass'n v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984); and *Davco Inc. v. Chicago Rawhide Mfg. Co.*, 224 USPQ 245 (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 (TTAB 2006), *aff'd unpub'd*, 240 Fed. Appx. 865 (Fed. Cir. July 11, 2007), *cert. den'd*, 552 U.S. 1109 (2008).

303.04 Federal Trade Commission

15 U.S.C. § 1064 [Trademark Act § 14] *Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this chapter, and the prescribed fee shall not be required.*

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

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

NOTES:

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

303.05 Opposition Filed During Extension of Time to Oppose

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

37 CFR § 2.102(b) *A written 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 should be in the name of the person to whom the extension was granted. 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 CFR § 2.102(b); TMEP § 1503.04; *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994); *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (fact that two entities share same objection is not a basis for finding privity).

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

303.05(b) Opposition Filed by Privy

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

The "showing" of privity should be in the form of a recitation of the facts on which the claim of privity is based, and must be submitted either with the opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy. If the opposition is filed both in the name of the party granted the previous extension and in the name of one or more differing parties, an explanation will be requested as to each differing party, and the opposition will not be accepted as to any differing party that fails to make a satisfactory showing of privity.

Once a timely notice of opposition has been filed, and the time for opposing has expired, the right to pursue the filed case is a right individual to the timely filer. While this right may be

transferred to another party, as by an assignment of the mark with the associated goodwill, it may not be shared. [Note 3.]

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

NOTES:

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

2. *See* 37 CFR § 2.102(b); *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); TMEP § 1503.04. *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 (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 (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 MFG. Corp.,* 141 USPQ 407 (TTAB 1964) (motion to amend complaint to substitute sole owner of company as real party in interest for opposer company granted); and *Pyco, Inc. v. Pico Corp.,* 165 USPQ 221, 222 (TTAB 1969) (substitution of opposer allowed where notice of opposition named non-existing entity that had transferred rights to opposer prior to filing of opposition). *Cf. also, Chien Ming Huang v. Tzu Wei Chen Food Co.,* 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988) (trademark application was fatally defective because applicant was not the owner of the mark, having transferred it from himself to a corporation between the time that he executed the application and the date it was received in the Office).

303.05(c) Misidentification of Opposer

If the name of the opposer, in an opposition filed during an extension of time to oppose, differs from the name of the party to which the extension was granted, the opposition will not be

rejected on that ground if it is shown to the satisfaction of the Board that the party in whose name the extension was requested was "misidentified through mistake." [Note 1.]

The phrase "misidentified through mistake," as used in 37 CFR § 2.102(b), means a mistake in the form of the opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named. [Note 2.] *See* TBMP § 512.04.

The "showing" submitted in support of a claim of misidentification through mistake should be in the form of a recitation of the facts on which the claim of misidentification through mistake is based, and must be submitted either with the opposition or during the time allowed by the Board in its letter requesting an explanation of the discrepancy.

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

NOTES:

1. 37 CFR § 2.102(b). *See Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (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); *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). *See also* TMEP § 1503.04. *Cf. William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870 (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 (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 (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 (TTAB 1988) (foreign manufacturer, not exclusive United States distributor, owns mark in absence of agreement between them providing otherwise); and *Argo & Company v. Springer*, 189 USPQ 581 (TTAB 1976) (substitution allowed where, after opposition instituted, court determined that attempted incorporation of applicant was legally defective; three individuals who owned mark as tenants in common substituted for corporation initially named as owner of mark).

303.05(d) Misidentification of Applicant or Respondent

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

NOTES:

1. *See* Fed. R. Civ. P. 17(a); 37 CFR § 2.116. *See also Argo & Company v. Springer,* 189 USPQ 581 (TTAB 1976) (three individuals who owned mark as tenants in common substituted for corporation initially named as owner of mark where, after opposition instituted, court in related civil proceeding determined that attempted incorporation of applicant was legally defective). *Cf. In re Tong Yang Cement Corp.,* 19 USPQ2d 1689 (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 (TTAB 1988) (foreign manufacturer, not exclusive United States distributor, owns mark in absence of agreement between them providing otherwise).

303.06 Joint Opposers or Petitioners

Two or more parties may file a notice of opposition or a petition for cancellation jointly. However, the required fee must be submitted for each party joined as opposer or petitioner for each class in the application for which registration is opposed or for each class in the registration for which cancellation is sought. *See* TBMP § 308. [Note 1.] For information concerning the filing of an opposition by two or more parties jointly where the notice of opposition is filed during an extension of time obtained by only one of the parties, *see* TBMP § 303.05.

When parties file jointly, the notice of opposition or petition for cancellation must name each party joined as plaintiff. In addition, the notice of opposition or petition for cancellation should include allegations concerning the standing of each party plaintiff and the ground or grounds for opposition or cancellation. *See* TBMP § 309.03(b) and Trademark Act § 309.03(c) for a discussion of standing and grounds for oppositions and cancellations. If the case is ultimately determined on the merits, rather than by default, withdrawal, stipulation, etc., any joint plaintiff whose standing has not been proved cannot prevail, even though a ground for opposition or cancellation has been proved. [Note 2.]

On the other hand, the fact that two or more parties may have an interest in a mark to be pleaded in a notice of opposition, or a petition for cancellation does not mean that each such party must be joined as opposer, or petitioner. Joint filing is elective, not mandatory. [Note 3.]

NOTES:

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

2. *See Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1142 (TTAB 1986) (of three joint opposers, owner of registration and its licensee as user of marks had real interest in proceeding, but opposer who only held software copyright had no standing and was given no further consideration). *See also Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1605 (TTAB 1999) (Board found that one of the two opposers did not prove standing).

3. *See Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625, 1627 (TTAB 1992) (respondent's motion to dismiss and its alternative motion to join petitioner's parent as owner of pleaded registrations and real party in interest denied since issue concerned what rights petitioner has in pleaded marks vis a 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 oppose or cancel registration in at least one class, the proceeding will not be instituted. If there are sufficient fees to pay for one or more of the designated classes, but less than sufficient to pay for all the designated classes, or to pay for all party opposers or petitioners, the proceeding will be instituted and the fee(s) submitted will be applied in the manner set forth in 37 CFR § 2.101(d)(3)(ii)-(iii). The institution notice will identify the parties and classes for which the required fees were submitted. *See* TBMP § 308 for information on filing fees.

NOTES:

1. *See* 37 CFR § 2.86.

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

305 Consolidated and Combined Complaints

37 CFR § 2.104(b) *Oppositions to different applications owned by the same party may be joined in a consolidated opposition when appropriate, but the required fee must be included for each party joined as opposer for each class in which registration is opposed in each application against which the opposition is filed.*

37 CFR § 2.112(b) *When appropriate, petitions for cancellation of different registrations owned by the same party may be joined in a consolidated petition for cancellation. The required fee must be included for each party joined as a petitioner for each class sought to be cancelled in each registration against which the petition to cancel is 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 sets 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. 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 § 308.05. When such a pleading is filed, the Board sets up a single cancellation file, identified by a single cancellation proceeding number, but bearing the number of each registration sought to be cancelled in the consolidated petition to cancel.

A consolidated notice of opposition, or consolidated petition to cancel, is appropriate if the plaintiff's claims against each of the defendant's subject applications, and/or registrations, involve common (i.e., similar) questions of law or fact. [Note 3.]

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

NOTES:

1. *See* 37 CFR § 2.104(b).

2. *See* 37 CFR § 2.112(b).

3. *See* Fed. R. Civ. P. 42(a); *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246, 248 (TTAB 1975) (oppositions involving similar marks and similar issues consolidated); *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440, 441 (TTAB 1973) (applicant's motion to consolidate denied in view of extent of differences in the involved issues); *Bigfoot 4x4 Inc. v.*

Bear Foot Inc., 5 USPQ2d 1444, 1445 (TTAB 1987) (joint motion to consolidate granted in view of identity of parties and issues), and *Federated Department Stores, Inc. v. Gold Circle Insurance Co.*, 226 USPQ 262, 263 (TTAB 1985) (consolidation permitted; issues of fact and law substantially similar).

305.02 Combined Complaint

A party may file, when appropriate, a single pleading combining a notice of opposition to one or more applications, and a petition to cancel one or more registrations, provided that each subject application and registration is owned by the same defendant. [Note 1.] Such single pleading is referred to as a "combined" opposition and petition to cancel. However, the required fee must be submitted for each party joined as plaintiff, for each class sought to be opposed or cancelled, in each application or registration against which the pleading is filed. [Note 2.] *See* TBMP § 308.05. Further, a combined complaint must be filed on paper; it may not be filed electronically because the Board's Electronic System for Trademark Trials and Appeals ("ESTTA") currently is not designed to accept a combined complaint. When such a pleading is filed, the Board sets up both an opposition and a cancellation proceeding file, each with its own identifying number, and each marked "Combined with _____" followed by the number of the other proceeding. 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.

A combined notice of opposition and 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.] *See* TBMP § 511.

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

NOTES:

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

2. *Cf.* 37 CFR § 2.104(b) and 37 CFR § 2.112(b).

3. *See Nabisco Brands Inc. v. Keebler Co.,* 28 USPQ2d 1237, 1238 n.2 (TTAB 1993) (defendant who believes marks and issues are sufficiently different such that combined proceeding is not appropriate may file motion to separate proceedings).

306 Time for Filing Opposition

306.01 In General

15 U.S.C. § 1062(a) [Section 12(a) of the Trademark Act] *Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be*

made and, if on such examination it shall appear that the applicant is entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1051(d) of this title, the Director shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office....

15 U.S.C. § 1063(a) [Section 13(a) of the Trademark Act] *Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. ...*

37 CFR § 2.101 Filing an opposition.

(a) *An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee. The notice must include proof of service on the applicant, or its attorney or domestic representative of record, at the correspondence address of record in the Office, as detailed in §§ 2.101(b) and 2.119.*

* * * *

(b)(1) *An opposition to an application based on section 1 or 44 of the Act must be filed either on paper or through ESTTA.*

(2) *An opposition to an application based on section 66(a) of the Act must be filed through ESTTA.*

(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.*

* * * *

(d)(4) *The filing date of an opposition is the date of receipt in the Office of the notice of opposition, with proof of service on the applicant, or its attorney or domestic representative of record, if one has been appointed, at the correspondence address of record in the Office, and the required fee, unless the notice is filed in accordance with § 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 Gazett*e for opposition, or within an extension of time to oppose granted to the opposer or its privy. [Note 1.] S*ee* 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 may be filed on paper or electronically via the Board's Electronic System for Trademark Trials and Appeals ("ESTTA"). If filed on paper, the certificate of mailing by first-class mail procedure described in 37 CFR § 2.197 and the "Express Mail" procedure described in 37 CFR § 2.198 are both available. The certificate of facsimile transmission procedure, described in 37 CFR § 2.197, is not available. [Note 2.] *See* TBMP § 110 and Trademark Act § 111.

An opposition to an application based on Trademark Act § 66(a), 15 U.S.C. § 1141f(a) must be filed electronically via ESTTA. [Note 3.] *See* TBMP § 203.01.

The filing date of an opposition is the date of receipt in the Office of the opposition and the required fee, with proof of service on the applicant, or its attorney or domestic representative of record, if one has been appointed, at the correspondence address of record in the Office, unless the notice is filed in accordance with 37 CFR § 2.198 (Filing of correspondence by "Express Mail). [Note 4.] If the notice is filed in accordance with 37 CFR § 2.198, the filing date of an opposition will be the date of deposit with the United States Postal Service ("USPS"), i.e., the date shown by the "date in" date on the "Express Mail" 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 5.]

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. [Note 6.] Nor may an opposition, once instituted, be amended to correct a misidentified serial number associated with the application sought to be opposed. [Note 7.] The Board may, however, be able to correct serial number misidentification errors that are brought to its attention by the opposer, if the opposition has not yet been instituted and time remains in the opposition period. Also, for oppositions *that are not filed electronically*, if there is a discrepancy in the notice of opposition regarding the identification of the mark to be opposed, but the Board can determine the correct serial number against which the opposition is intended to be filed by a reading of the notice of opposition in its entirety, the Board will ascertain the correct serial number and institute the proceeding against the correct serial number. Otherwise, a would-be opposer's remedy is to seek to cancel the mark once the application has matured to registration, or (if time remains in the opposition period) to file a new opposition, including payment of an additional 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.

Utilizing ESTTA to file a notice of opposition offers several advantages over paper filing. Parties which use 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 and that the notice of opposition will contain a certificate of service attesting to service. [Note 8.] The certificate of service appears on the ESTTA-generated filing form, and the filing form is considered part of the plaintiff's initial pleading. Of course, the mere appearance of the certificate of service on the notice of opposition is insufficient to prove actual service; the potential opposer must also make actual service of the complaint on the defendant. [Note 9.]

For information on opposition filing fees, *see* TBMP § 308. For information on how to file an opposition, *see* TBMP § 309.

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

NOTES:

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

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

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

4. 37 CFR § 2.101(d)(4). *See Vibe Records Inc. v. Vibe Media Group LLC,* 88 USPQ2d 1280 (TTAB 2008) (untimely opposition dismissed as a nullity).

5. *See* 37 CFR § 2.198(a)(2).

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

7. *See Yahoo! Inc. v. Loufrani,* 70 USPQ2d 1735 (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 (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 (Comm'r 1992) (application misidentified in request for extension of time).

8. *Schott AG v. L'Wren Scott,* 88 USPQ2d 1862, 1863 n.3 (TTAB 2008) (opposer failed to include a certificate of service with the notices of opposition, filed via first class mail, and did not dispute its failure to actually forward service copies to applicant; case dismissed as nullity);

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).

9. *The Equine Touch Foundation, Inc. v. Equinology, Inc.*, 91 USPQ2d 1943, 1944 n.5 (TTAB 2009).

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/news/og/tindex.jsp.

306.03 Premature Opposition

Trademark Act § 13(a), 15 U.S.C. § 1063(a), requires that an opposition to the registration of a mark on the Principal Register be filed within a specified time after the publication of the mark in the *Official Gazette*.

Thus, any opposition filed prior to the publication of the mark sought to be opposed is premature, and will be rejected by the Board, even if the mark has been published by the time of the Board's action. No proceeding will be instituted, and any submitted opposition fee will be refunded. *Cf.* TBMP § 119.03 and Trademark Act § 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.]

Accordingly, an opposition 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 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.]

Parties which use the ESSTA 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.

For information concerning the effect of fee and signature requirements on the timing of an opposition, *see* TBMP § 308.02(b) and Trademark Act § 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, 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); and *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980). **Please Note:** Trademark Rule 1.8 was replaced by 37 CFR § 2.197, which is now the applicable rule regarding certificates of mailing.

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

307 Time for Filing Petition to Cancel

15 U.S.C. § 1064 [Trademark Act § 14] *A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of confusion of dilution by blurring or dilution by tarnishment under section 43(c), by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905:*

(1) *Within five years from the date of the registration of the mark under this Act.*

(2) *Within five years from the date of publication under section 12(c) hereof of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.*

(3) *At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 or of subsection (a), (b), or (c) of section 2 for a registration under this Act, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.*

(4) *At any time if the mark is registered under the Act of March 3, 1881, or the Act of*

February 20, 1905, and has not been published under the provisions of subsection (c) of section 12 of this Act.

(5) *At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies:*

Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this Act, and the prescribed fee shall not be required.

15 U.S.C. § 1092 [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 43(c); or*

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

The Director shall refer such application to the Trademark Trial and Appeal Board which shall give notice thereof to the registrant. If it is found after a hearing before the Board that the registrant is not entitled to registration, or that the mark has been abandoned, the registration shall be cancelled by the Director. However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).

37 CFR § 2.111 Filing petition for cancellation.

(a) *A cancellation proceeding is commenced by filing in the Office a timely petition for cancellation with the required fee. The petition must include proof of service on the owner of record for the registration, or the owner's domestic representative of record, at the correspondence address of record in the Office, as detailed in §§ 2.111(b) and 2.119.*

(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. Petitioner must serve a copy of the petition, including any exhibits, on the owner of record for the registration, or on the owner's domestic representative of record, if one has been appointed, at the correspondence address of record in the Office.*

The petitioner must include with the petition for cancellation proof of service, pursuant to § 2.119, on the owner of record, or on the owner's domestic representative of record, if one has been appointed, at the correspondence address of record in the Office. If any service copy of the petition for cancellation is returned to the petitioner as undeliverable, the petitioner must notify the Board within ten days of receipt of the returned copy. 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)(1)(iii) 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)(4) *The filing date of a petition for cancellation is the date of receipt in the Office of the petition for cancellation, with proof of service on the owner of record, or on the owner's domestic representative, if one has been appointed, at the correspondence address of record in the Office, and with the required fee, unless the petition is filed in accordance with § 2.198.*

307.01 Petition That May Be Filed At Any Time After Registration

A petition to cancel a registration may be filed at any time in the case of a registration issued on the Supplemental Register under the Act of 1946, 15 U.S.C. § 1051 *et. seq*., or under the Act of 1920. A petition to cancel may also be filed at any time in the case of a registration issued under the Act of 1881 or the Act of 1905 which has not been published under Trademark Act § 12(c), 15 U.S.C. § 1062(c). [Note 1.]

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

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

The filing date of the petition is the date of receipt in the Office of the petition, with proof of service and the required fee. [Note 8.] However, if the petition is filed by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) in accordance

with 37 CFR § 2.198, then the filing date of the petition is the date the petition was deposited with the USPS. [Note 9.]

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 requirements, *see* TBMP § 309.02(c).

NOTES:

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

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

3. *See* Trademark Act § 2(a), 15 U.S.C. § 1052(a). *Cf. Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990) (registration over five years old may not be challenged on ground that mark is geographically descriptive under Trademark Act § 2(e)(2), 15 U.S.C. § 1052(e)(2)).

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

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

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

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

8. 37 CFR § 2.111(c)(4).

9. *See* 37 CFR § 2.198.

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], all of the grounds specified in Trademark Act § 2(e), 15 U.S.C. § 1052(e) (including a claim that respondent's mark is merely descriptive or deceptively misdescriptive, that respondent's mark is geographically descriptive or geographically deceptively misdescriptive, or that respondent's mark is primarily merely a surname) [Note 5]; the ground that respondent is not the owner of the registered mark; and the ground that there was no bona fide use of respondent's mark in commerce to support the original registration.

For additional information on selected grounds for opposition and cancellation, *see* TBMP § 309.03. 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 § 1605.05 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, 1 881, 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 receipt in the Office of the petition, with proof of service and the required fee. [Note 10.] However, if the petition is filed by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) in accordance

with 37 CFR § 2.198, then the filing date of the petition is the date the petition was deposited with the USPS. [Note 11.] For information on filing fees, *see* TBMP § 308. The Certificate of Mailing procedure described in 37 CFR § 2.197 and the "Express Mail" procedure described in 37 CFR § 2.198 are available for the filing of a petition to cancel. [Note 12.] Where a timely filed petition to cancel is served on the registrant's attorney instead of the registrant directly, the Board may not dismiss the petition to cancel and the petitioner may be granted a new petition filing date if the petitioner makes subsequent service on the registrant within five years of the issuance date of the challenged registration and amends the proof of service to show such subsequent service on the registrant. [Note 13].

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 (TTAB 2000) (Trademark Act § 14, 15 U.S.C. § 1064 does not limit Board's authority to entertain an action under Article 8 of the Pan American Convention against a registration over five years old).

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

3. *See Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990); *International Mobile Machines Corp. v. International Telephone and Telegraph Corp*., 800 F.2d 1118, 231 USPQ 142, 142 (Fed. Cir. 1986); *International Order of Job's Daughters v. Lindeburg and Company*, 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 (TTAB 2009) (petition to cancel a registration on the Principal Register on a claim that the mark is descriptive may be filed at any time within five years of the date of registration). *Cf. Montecash LLC v. Anzar Enterprises Inc.,* 95 USPQ2d 1060 (TTAB 2010) (registration more than five years old may not be cancelled based on claim that a portion of the mark is generic term); *Finanz St. Honore B.V. v. Johnson & Johnson,* 85 USPQ2d 1478, 1480 (TTAB 2007)

(same; motion to strike claim granted).
6. *See Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862-63 (TTAB 2007).

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

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

9. *Cf. Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309, 1310 (TTAB 1990); TMEP § 1605.05 and TMEP § 1606.03.

10. *See* 37 CFR § 2.111(c)(4).

11. *See* 37 CFR § 2.198.

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

13. *The Equine Touch Foundation Inc. v. Equinology, Inc.*, 91 USPQ2d 1943 (TTAB 2009) (since petitioner acted promptly to cure its failure of service well within the five year period for filing petition to cancel, Board will not dismiss the petition as a nullity but rather grant a new filing date as of the date petitioner filed its amendment of proof of service).

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 Company*, 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 Company 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); and *Sunbeam Corp. v. Duro Metal Products Co.*, 106 USPQ 385, 386 (Comm'r 1955). *See also* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 20:67 (4th ed. 2010). *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 Company, Inc.*, 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).

307.03 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, if a petition to cancel a registration is filed prior to the issuance of the registration, it is premature, and will be rejected by the Board, even if the registration has issued by the time of the Board's action. The petition to cancel will not be instituted, and any submitted petition fee will be refunded. Petitioner's remedy lies in the 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 and including proof of service) 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 petition to cancel one of these Principal Register registrations is filed after the expiration of the five-year period and does not plead one or more of the grounds specified in Trademark Act § 14(3) or Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5) the petition is late, and will be rejected by the Board. The petition to cancel will not be instituted, and any submitted petition fee will be refunded. However, the rejection of the petition is without prejudice to petitioner's right to 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 Trademark Act § 309.02(b).

NOTES:

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

308 Filing Fees

308.01 Fee for Filing Opposition

308.01(a) 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....*

37 CFR § 2.101 Filing an opposition.

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

* * * *

(d)(1) *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).*

(2) *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.*

(3) *If an otherwise timely opposition is submitted on paper, the following is applicable if less than all required fees are submitted:*

(i) *If the opposition is accompanied by no fee or a fee insufficient to pay for one person to oppose the registration of a mark in at least one class, the opposition will be refused.*

(ii) *If the opposition is accompanied by fees sufficient to pay for one person to oppose registration in at least one class, but fees are insufficient to oppose a registration in all the classes in the application, and the particular class or classes against which the opposition is*

filed is not specified, the opposition will be presumed to be against the class or classes in ascending numerical order, including only the number of classes in the application for which sufficient fees have been submitted.

(iii) *If persons are joined as party opposers, each must submit a fee for each class for which opposition is sought. If the fees submitted are sufficient to pay for one person to oppose registration in at least one class, but are insufficient for each named party opposer, the first-named party will be presumed to be the party opposer. Additional parties will be deemed to be party opposers only to the extent that the fees submitted are sufficient to pay the fee due for each party opposer. If persons are joined as party opposers against a multiple class application, the fees submitted are insufficient, and no specification of opposers and classes is made at the time the party is joined, the fees submitted will be applied first on behalf of the first-named opposer against as many of the classes in the application as the submitted fees are sufficient to pay. Any excess will be applied on behalf of the second-named party to the opposition against the classes in the application in ascending numerical order.*

The rules governing opposition fees are specified in 37 CFR § 2.101(d)(1)-37 CFR § 2.101 (d)(4). The amount of the required filing fee is specified in 37 CFR § 2.6(a)(17). The required fee must be submitted with the opposition; the filing date of an opposition (and, hence, the date of commencement of the opposition proceeding) is the date of receipt in the Office of both the opposition with proof of service and the required fee. [Note 1.] *See* TBMP § 309.

The required fee must be submitted for each party joined as opposer for each class opposed, [Note 2] and if fewer than the total number of classes in the application are opposed, the classes opposed should be specified. *See* TBMP § 304. [Note 3.]

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

NOTES:

1. *See* 37 CFR § 2.101(a). *See also 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 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).

3. *See* 37 CFR § 2.101(d).

308.01(b) Insufficient Fee

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. [Note 1.] *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 either through ESTTA or on paper. [Note 2.] *See* TBMP § 309.

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 3.]

If an otherwise timely opposition is submitted on paper, and if the opposition is not accompanied by any fee or a sufficient fee to pay for one person to oppose the registration of a mark in at least one class, the opposition will be rejected. [Note 4.] If the opposition is accompanied by fees sufficient to pay for one person to oppose registration in at least one class, but less than sufficient to pay for all the opposed classes in the application and/or all party opposers, the opposition will be instituted and the fee(s) submitted will be applied in the manner set forth in 37 CFR § 2.101(d)(3)(ii)-(iii). The institution notice will identify the parties and classes for which the required fees were submitted. *See* TBMP § 310.

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

NOTES:

1. *See* 37 CFR § 2.101(b)(2).

2. *See* 37 CFR § 2.101(b)(1).

3. *See* 37 CFR § 2.101(d)(2); *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).

4. *See* 37 CFR § 2.101(d)(3)(i).

308.02 Fee for Filing Petition to Cancel

308.02(a) In General

15 U.S.C. § 1064 [Trademark Act § 14] *A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any*

person who believes that he is or will be damaged, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905....

15 U.S.C. § 1092 [Trademark Act § 24] *Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by the registration of a mark on the supplemental register--*

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

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

37 CFR § 2.111(c)(1) *The petition for cancellation must be accompanied by the required fee for each party joined as petitioner for each class in the registration for which cancellation is sought (see § 2.6).*

(2) *An otherwise timely petition for cancellation will not be accepted via ESTTA unless the petition for cancellation 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.*

(3) *If an otherwise timely petition for cancellation is submitted on paper, the following is applicable if less than all required fees are submitted:*

(i) *If the petition for cancellation is accompanied by no fee or a fee insufficient to pay for one person to petition for cancellation against at least one class in the registration, the petition for cancellation will be refused.*

(ii) *If the petition for cancellation is accompanied by fees sufficient to pay for one person to petition for cancellation against at least one class in the registration, but fees are insufficient for a petition for cancellation against all the classes in the registration, and the particular class or classes against which the petition for cancellation is filed is not specified, the petition for cancellation will be presumed to be against the class or classes in ascending numerical order, including only the number of classes in the registration for which sufficient fees have been submitted.*

(iii) *If persons are joined as party petitioners, each must submit a fee for each class for which cancellation is sought. If the fees submitted are sufficient to pay for one person to petition for cancellation of the registration in at least one class but are insufficient for each named party petitioner, the first-named party will be presumed to be the party petitioner. Additional parties*

will be deemed to be party petitioners only to the extent that the fees submitted are sufficient to pay the fee due for each party petitioner. If persons are joined as party petitioners against a multiple class registration, the fees submitted are insufficient, and no specification of parties and classes is made at the time the party is joined, the fees submitted will be applied first on behalf of the first-named petitioner against as many of the classes in the registration as the submitted fees are sufficient to pay. Any excess will be applied on behalf of the second-named party to the cancellation against the classes in the registration in ascending numerical order

(4) *The filing date of a petition for cancellation is the date of receipt in the Office of the petition for cancellation, with proof of service on the owner of record, or on the owner's domestic representative, if one has been appointed, at the correspondence address of record in the Office, and with the required fee, unless the petition is filed in accordance with § 2.198.*

The rules governing cancellation fees are specified in 37 CFR § 2.111(c)(1)-37 CFR § 2.111 (c)(4). The amount of the required fee is specified in 37 CFR § 2.6(a)(16). The required fee for a petition to cancel must be submitted with the petition; the effective filing date of a petition to cancel (and, hence, the date of commencement of the cancellation proceeding) is the date of receipt in the Office of both the petition to cancel showing proof of service and the required fee. [Note 1.] *See* TBMP § 308.02(b).

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 2.] *See* TBMP § 304.

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

NOTES:

1. *See* 37 CFR § 2.111(a), 37 CFR § 2.111(c)(1), and 37 CFR § 2.111(c)(4); *Williamson-Dickie Manufacturing Co. v. Mann Overall Company,* 359 F.2d 450, 149 USPQ 518, 520 (CCPA 1966). *Cf. Fred Beverages, Inc. v. Fred's Capital Management Company,* 605 F.3d 968, 94 USPQ2d 1958 (Fed. Cir. 2010) (Board's decision denying petitioner's motion for leave to amend cancellation petition, for failure to submit fee for amendment at time of filing the motion, reversed; case remanded to Board for further consideration of motion to amend).

2. *See* 37 CFR § 2.111(c).

308.02(b) Insufficient Fee

A petition for cancellation must be filed either through ESTTA or on paper. [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.]

If an otherwise timely petition for cancellation is submitted on paper, and if the petition is not accompanied by any fee, or a sufficient fee to pay for one person to petition to cancel the registration in at least one class, the petition will be rejected. [Note 3.] If the petition to cancel is accompanied by fees sufficient to pay for one person to petition to cancel the registration in at least one class, but less than the required amount because multiple party petitioners and/or multiple classes in the registration are involved, the cancellation proceeding will be instituted, and the fee(s) submitted will be applied in the manner set forth in 37 CFR §§ 2.111(c)(3)(ii)-(iii). [Note 4.] The institution notice will identify the parties and classes for which the required fees were submitted. *See* TBMP § 310.

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 for one person to petition to cancel the registration in at least one class, the rejection of the petition is without prejudice to petitioner's right to file, at any time thereafter, a new petition to cancel provided that the five-year period, if applicable, has not expired, or, if expired, that the petition recites a ground permitted after the expiration of the five-year period. [Note 5.]

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

NOTES:

1. Board practice does not permit the filing of a petition for cancellation on CD-ROM. *See* 37 CFR § 2.126; Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42247 (August 1, 2007).

2. *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 (TTAB 2008) (where ESTTA filing process not completed because no fee was paid, date appearing on the ESTTA "Validate" screen is inoperative; opposition dismissed as a nullity).

3. *See* 37 CFR § 2.111(c)(3)(i).

4. *See, e.g., 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).

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

6. *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.]

NOTES:

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

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

3. *See 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 (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).

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).

NOTES:

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

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

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 ("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.

In addition, a party may file, when appropriate, a single pleading combining a notice of opposition to one or more applications, and a petition to cancel one or more registrations, provided that each subject application and registration is owned by the same defendant. [Note 3.] *See* TBMP § 305.02. However, the required fee must be submitted for each party joined as plaintiff, for each class sought to be opposed or cancelled, in each application or registration against which the complaint is filed. [Note 4.] *See* TBMP § 305.

NOTES:

1. *See* 37 CFR § 2.104(b).

2. *See* 37 CFR § 2.112(b).

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

4. *Cf*. 37 CFR § 2.104(b) and 37 CFR § 2.112(b).

309 Form and Content of Oppositions and Petitions to Cancel

309.01 In General

37 CFR § 2.101(b) *Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file an opposition addressed to the Trademark Trial and Appeal Board and must serve a copy of the opposition, including any exhibits, on the attorney of record for the applicant or, if there is no attorney, on the applicant or on the applicant's domestic representative, if one has been appointed, at the correspondence address of record in the Office. The opposer must include with the opposition proof of service pursuant to § 2.119 at the correspondence address of record in the Office. If any service copy of the opposition is returned to the opposer as undeliverable, the opposer must notify the Board within ten days of receipt of the returned copy. 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)(1)(iii) are required for oppositions filed through ESTTA under paragraphs (b)(1) or (2) of this section.*

(1) *An opposition to an application based on section 1 or 44 of the Act must be filed either on paper or through ESTTA.*

(2) *An opposition to an application based on section 66(a) of the Act must be filed through ESTTA.*

37 CFR § 2.111(b) *Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part. Petitioner must serve a copy of the petition, including any exhibits, on the owner of record for the registration, or on the owner's domestic representative of record, if one has been appointed, at the correspondence address of record in the Office. The petitioner must include with the petition for cancellation proof of service, pursuant to § 2.119, on the owner of record, or on the owner's domestic representative of record, if one has been appointed, at the correspondence address of record in the Office. If any service copy of the petition for cancellation is returned to the petitioner as undeliverable, the petitioner must notify the Board within ten days of receipt of the returned copy. 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)(1)(iii) are required for petitions submitted electronically via ESTTA….*

37 CFR § 2.116(c) *The opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.*

37 CFR § 2.119(e) *Every paper 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 paper will not be refused consideration if a signed copy is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.

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

* * * *

37 CFR § 2.126(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.*

* * * *

Submissions may be made to the Board on paper or filed electronically via ESTTA, as permitted by the rules or Board practice. Submissions made by CD-ROM are no longer accepted. [Note 1.] As required by 37 CFR § 2.101(b), an opposition to an application based on Trademark Act § 66(a), 15 U.S.C. § 1141f(a), must be filed electronically through ESTTA, and 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 either on paper or through ESTTA. [Note 2.] A petition for cancellation must be filed either on paper or through ESTTA. [Note 3.]

The notice of opposition, or petition to cancel, corresponds to the complaint in a court proceeding. [Note 4.] For purposes of simplicity, the term "complaint" is often used hereafter in this section to refer to a notice of opposition or a petition to cancel.

NOTES:

1. *See* 37 CFR § 2.126(a) and 37 CFR § 2.126(b); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42247 (August 1, 2007).

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

3. *See* 37 CFR § 2.111(a) and 37 CFR § 2.111(b).

4. 37 CFR § 2.116(c).

309.02 Form of Complaint

The form of a complaint must meet the general requirements for submissions to the Board as set forth in 37 CFR § 2.126. *See* TBMP § 106.03. If a 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. [Note 1.]

While an opposition against a Trademark Act § 66(a), 15 U.S.C. § 1141f(a), application must be filed through ESTTA, a petition for cancellation, or an opposition against a Trademark Act § 1 or Trademark Act § 44, 15 U.S.C. § 1051 or 15 U.S.C. § 1126, application, may be filed either through ESTTA or on paper. [Note 2.] If the complaint is filed on paper, the submission, including any exhibits, may not be stapled or bound or have any extruding tabs or other such devices, and must otherwise comply with the requirements of 37 CFR § 2.126(a).

NOTES:

1. *See* 37 CFR § 2.126(b).

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

309.02(a) Format for Complaint

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. Alternatively, the notice of opposition or petition to cancel ESTTA form (docket) "cover sheet" may be created using ESTTA and the completed form may then be printed out for mailing to the Board with the notice of opposition or petition to cancel. The Board views the ESTTA filing form and the attached pleading as comprising a single document or paper being filed with the Board. [Note 1.] Parties are encouraged to use ESTTA to commence the proceeding and for general filing purposes. Upon filing, the filer will

receive an e-mail 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.

A complaint filed on paper need not follow a particular format, as long as it meets the requirements of 37 CFR § 2.126(a) for paper submissions and includes the necessary information. The complaint 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 of the current owner of record of the registration. [Note 2.] To determine the correspondence address of the owner of the registration, the petitioner may consult the Office's Trademark Applications and Registrations Retrieval (TARR) system, accessible through http://tarr.uspto.gov. [Note 3.] The TARR 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(c)(2).

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

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

NOTES:

1. *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 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").

2. *See* 37 CFR § 2.112(a) and 37 CFR § 2.112(b). *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).

3. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

309.02(b) Signature of Complaint

The complaint need not be verified, but it must be signed by the plaintiff or by the plaintiff's attorney, as specified in 37 CFR § 10.1(c), or other authorized representative, as specified in 37 CFR § 11.14(b). [Note 1.] *See* TBMP § 106.02. Electronic signatures pursuant to 37 CFR § 2.193(c) are required for complaints submitted electronically via ESTTA. [Note 2.] The Board views the electronic signature on the ESTTA filing form as pertaining to all attachments thereto. [Note 3.] Thus, a plaintiff's electronic signature on the ESTTA filing form serves as its signature for the entire complaint being filed, including in the absence of a signature on any attachment to the filing form. [Note 4.]

If an attorney signs the complaint, it need not be accompanied by a written power of attorney, but if a written power of attorney is filed, the plaintiff must sign it. If a plaintiff signing for itself is a partnership, the signature must be made by a partner. If a plaintiff signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the plaintiff who has authority to sign for the plaintiff and whose title is given. The signature should be accompanied by a description of the capacity in which the signing individual signs (i.e., as plaintiff, if plaintiff is an individual; as counsel for plaintiff; as a partner of plaintiff, if plaintiff is a partnership; as an officer of plaintiff identified by title, if plaintiff is a corporation; etc.).

Although a complaint must be signed, an unsigned complaint 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.

However, Trademark Act § 14, 15 U.S.C. § 1064, limits, after a specified five-year period, the grounds on which certain Principal Register registrations may be cancelled. [Note 6.] *See*

TBMP § 307.02(a). If an unsigned petition to cancel such a registration is filed prior to the expiration of the five-year period, but a signed copy thereof is not filed until after the expiration of the period, the petition can be entertained by the Board only to the extent that it pleads a ground for cancellation permitted after the expiration of the five-year period. [Note 7.] *Cf.* TBMP § 308.02(b). Although whenever it comes to the Board's attention, the Board makes every effort to notify petitioners of unsigned complaints before the expiration of any applicable statutory deadline, so that the informality may be corrected prior to the deadline, the Board has no obligation to do so, and cannot assume the burden of discovering filing errors within any specified time. [Note 8.]

NOTES:

1. *See* 37 CFR § 2.101(b) and 37 CFR § 2.111(b). *See also Media Online Inc. v. El Clasificado, Inc.* 88 USPQ2d 1285, 1286 n.3 (TTAB 2008).

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

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

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

5. *See* 37 CFR § 2.119(e).

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

7. *Cf. e.g.*, cases involving former requirement for verification, *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 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 and proof of service, and has concurrently served a copy of its complaint (notice of opposition or petition to cancel), including any exhibits, on the owner of record (or, when applicable, on the attorney or domestic representative) designated in the involved application or registration, or in assignment records regarding the application or registration, at the correspondence address of record in the Office. [Note 1.] The requirement that an opposer or petitioner serve the complaint on the defendant directly recognizes that plaintiffs and defendants often are in contact before the plaintiff files its complaint or claims, and also recognizes that continuation of direct communication is vital both for promoting possible settlement of claims and for ensuring cooperation and procedural efficiency in the early stages of a proceeding. [Note 2.]

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

NOTES:

1. *See* 37 CFR § 2.101(a) and 37 CFR § 2.111(a). *See also* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (August 1, 2007).

2. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (August 1, 2007).

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

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

(a) *An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee. The notice must include proof of service on the applicant, or its attorney or domestic representative of record, at the correspondence address of record in the Office, as detailed in §§ 2.101(b) and 2.119.*

(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 and must serve a copy of the opposition, including any exhibits, on the attorney of record for the applicant or, if there is no attorney, on the applicant or on the applicant's domestic representative, if one has been appointed, at the correspondence address of record in the Office. The opposer must include with the opposition proof of service pursuant to § 2.119 at the correspondence address of record in the Office. If any service copy of the opposition is returned to the opposer as undeliverable, the opposer must notify the Board within ten days of receipt of the returned copy. 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)(1)(iii) are required for oppositions filed through ESTTA under paragraphs (b)(1) or (2) of this section.*

(d)(4) *The filing date of an opposition is the date of receipt in the Office of the notice of opposition, with proof of service on the applicant, or its attorney or domestic representative of record, if one has been appointed, at the correspondence address of record in the Office, and the required fee, unless the notice is filed in accordance with § 2.198.*

An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee. The notice must include proof of service of a copy of the opposition "on the attorney of record for the applicant or, if there is no attorney, on the applicant or on the applicant's domestic representative, if one has been appointed, at the correspondence address of record in the Office." [Note 1.]

When an opposer files its notice of opposition with the Board, the opposer must concurrently serve a copy of the opposition, including any exhibits, on the attorney of record for the applicant at the attorney's correspondence address of record in the Office. [Note 2.] If there is no attorney, then service must be made on the applicant at its address of record, unless applicant has appointed a domestic representative in the involved application, in which case service must be made on the domestic representative. The requirement that an opposer serve the notice of opposition on the applicant directly recognizes that plaintiffs and defendants often are in contact before the plaintiff files its complaint or claims, and also recognizes that continuation of direct communication is vital both for promoting possible settlement of claims and for ensuring cooperation and procedural efficiency in the early stages of a proceeding. [Note 3.]

To determine the correspondence address of record for an applicant or registrant, the potential opposer must check the Trademark Applications and Registrations Retrieval (TARR) system at the following web address: http://tarr.uspto.gov. [Note 4.] The TARR display of information includes an active link to assignment information, and this link should also be checked. [Note 5.] The complaint need only be served at the address shown as applicant's correspondence address of record, that is, applicant's attorney's, or its designated domestic representative's record address or applicant's own record address.

It is in opposer's interest to have the real party in interest apprised of the existence of the Board proceeding, so that any judgment eventually obtained will be binding on the correct party. If opposer has any doubt as to the identity or address of the real party in interest, opposer may serve additional copies of the notice of opposition on any address opposer may have reason to believe is more current than the address for applicant that is listed in Office records, or on any person who may have an ownership interest in the relevant application.

The manner of service is provided for in 37 CFR § 2.119. The parties may agree to use electronic transmission (e.g., facsimile or e-mail) to communicate with each other and to meet their service obligations. When such an agreement is made, the best practice is to reduce the agreement to writing. If the parties have communicated prior to the filing of the notice of opposition, and the applicant has agreed to accept service of the complaint by electronic transmission, opposer may serve the notice of opposition by the agreed upon means. [Note 6.] Authorization by an applicant, given to the Office during prosecution, to allow the Office to communicate with applicant by e-mail, does not by itself enable opposer to serve the notice of

opposition by e-mail.

Where an applicant is represented by an attorney in the Office records, if opposer makes sufficient efforts to timely serve and file the notice of opposition but improperly serves applicant directly, the opposition will not be dismissed as a nullity if (1) the notice of opposition is timely filed and includes a certificate of service and (2) the notice of opposition was timely served on applicant. [Note 7.] The Board may, however, require that opposer re-serve the applicant at its attorney's address, if the attorney has not received notice of the proceeding through other means. [Note 8.] On the other hand, the Board will not institute a proceeding where there is no proof of service, even though there may have been actual service [Note 9], or where there is no actual service even though there may have been proof of service. [Note 10.] Proof of service assumes actual service on applicant or its attorney or domestic representative and is meaningless in the absence of actual service in accordance with the statements contained in the proof of service. [Note 11.]

The notice of opposition may be filed using ESTTA, the Board's Electronic System for Trademark Trials and Appeals. By utilizing ESTTA to file its notice of opposition, a potential opposer is assured that the notice of opposition will contain a certificate of service attesting to service, because a plaintiff cannot complete the ESTTA filing process unless it confirms that it has forwarded a service copy of its complaint to all parties at their addresses of record. [Note 12.] "Such confirmation then appears on the ESTTA generated filing form for the attached complaint, and the filing form is considered part of the plaintiff's initial pleading." [Note 13.] Of course, a potential opposer must complete the ESTTA filing process to be accorded a valid filing date, and must make actual service. The mere appearance of the certificate of service on the notice of opposition does not by itself effect service, however; opposer must still make actual service of the complaint on applicant to comply with its service obligation. [Note 14.]

If a service copy is returned to opposer as undeliverable, opposer must notify the Board within ten (10) days of receipt of the returned service copy, or of any notice indicating that the service copy could not be delivered. [Note 15.] Notification to the Board of failure of service may be provided by any means available for filing pleadings and motions or other papers with the Board. *See* TBMP § 104 (Business to Be Conducted in Writing). Therefore, notice of failure of service may be provided, for example, by written notice mailed to the Board or by appropriate filing through ESTTA. [Note 16.] While opposer is under no obligation to search for current correspondence address information for, or investigate the whereabouts of, any applicant the opposer is unable to serve, if opposer knows of any new address information for the applicant, opposer must report the address to the Board. In any case in which opposer notifies the Board that a service copy sent to an applicant was returned or not delivered, including any case in which the notification includes a new address for the applicant discovered by or reported to opposer, the Board will effect service. [Note 17.]

The filing date of the notice of opposition is the date of receipt in the Office of the notice, with proof of service and the required fee. [Note 18.] However, if the notice of opposition is filed by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) in accordance with 37 CFR § 2.198, then the filing date is the date the notice of opposition was deposited with the USPS [Note 19], 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 20.] The Certificate of Mailing procedure described in 37 CFR § 2.197 and the "Express Mail" procedure described in 37 CFR § 2.198 are available for the filing of a notice of opposition. [Note 21.] Facsimile transmission of the notice of opposition is not permitted, and if submitted, will not be accorded a date of receipt. [Note 22.]

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

NOTES:

1. 37 CFR § 2.201(b).

2. 37 CFR § 2.101(b).

3. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (August 1, 2007).

4. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

5. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

6. *See* 37 CFR § 2.119(b)(6); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42248 (August 1, 2007).

7. *See Chocoladefabriken Lindt & Sprungli AG v. Karlo Flores*, 91 USPQ2d 1698 (TTAB 2009) (timely service of notice of opposition on applicant directly, rather than at applicant's correspondence address of record, which was his attorney's address, was sufficient to commence opposition proceeding; motion to dismiss denied).

8. *See Chocoladefabriken Lindt & Sprungli AG v. Karlo Flores*, 91 USPQ2d 1698, 1700 (TTAB 2009).

9. *See Schott AG v. L'Wren Scott*, 88 USPQ2d 1862 (TTAB 2008) (opposer filed notices of opposition via first class mail that failed to include certificates of service and opposer did not dispute its failure to actually forward service copies to applicant upon filing; opposer cannot cure its failure to properly serve the original notices of opposition by filing amended notices and actually serving the amended notices; cases dismissed as nullities).

10. *See Springfield Inc. v XD*, 86 USPQ2d 1063 (TTAB 2008) (notice of opposition filed through ESTTA on the last day of the opposition period included a proof of service, but inasmuch as there was no actual service on applicant, opposer failed to comply with service requirement of 37 CFR §§ 2.101(a) and 2.101(d)(4); notice of opposition should not have received a filing date and proceeding should not have been instituted; case dismissed as nullity); *Schott AG v. L'Wren Scott*, 88 USPQ2d 1862 (TTAB 2008) (opposer filed notices of

opposition via first class mail that failed to include certificates of service and opposer did not dispute its failure to actually forward service copies to applicant upon filing; cases dismissed as nullities). *Cf. Chocoladefabriken Lindt & Sprungli AG v. Karlo Flores*, 91 USPQ2d 1698 (TTAB 2009) (timely service of notice of opposition on applicant directly, rather than at applicant's correspondence address of record, which was his attorney's address, was sufficient to commence opposition proceeding; motion to dismiss denied).

11. *See Springfield Inc. v XD,* 86 USPQ2d 1063 (TTAB 2008) (notice of opposition filed through ESTTA on the last day of the opposition period included a proof of service, but inasmuch as there was no actual service on applicant, opposer failed to comply with service requirement of 37 CFR §§ 2.101(a) and 2.101(d)(4); notice of opposition should not have received a filing date and proceeding should not have been instituted; case dismissed as nullity).

12. *See Schott AG v. Scott,* 88 USPQ2d 1862, n.3 (TTAB 2008).

13. *The Equine Touch Foundation Inc. v. Equinology, Inc.*, 91 USPQ2d 1943, 1944, n.5 (TTAB 2009).

14. *See Schott AG v. L'Wren Scott,* 88 USPQ2d 1862, 1863 (TTAB 2008); *Vibe Records, Inc. v. Vibe Media Group LLC,* 88 USPQ2d 1280 (TTAB 2008).

15. *See* 37 CFR § 2.101(b).

16. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

17. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

18. *See* 37 CFR § 2.101(d)(4).

19. *See* 37 CFR § 2.198 (a)(1).

20. *See* 37 CFR § 2.198(a)(2).

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

22. 37 CFR § 2.195(d)(3); *Vibe Records Inc. v. Vibe Media Group LLC,* 88 USPQ2d 1280 (TTAB 2008) (untimely opposition dismissed as a nullity).

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

<u>37 CFR § 2.111</u> Filing petition for cancellation.

(a) *A cancellation proceeding is commenced by filing in the Office a timely petition for cancellation with the required fee. The petition must include proof of service on the owner of record for the registration, or the owner's domestic representative of record, at the correspondence address of record in the Office, as detailed in §§ 2.111(b) and 2.119.*

(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. Petitioner must serve a copy of the petition, including any exhibits, on the owner of record for the registration, or on the owner's domestic representative of record, if one has been appointed, at the correspondence address of record in the Office. The petitioner must include with the petition for cancellation proof of service, pursuant to § 2.119, on the owner of record, or on the owner's domestic representative of record, if one has been appointed, at the correspondence address of record in the Office. If any service copy of the petition for cancellation is returned to the petitioner as undeliverable, the petitioner must notify the Board within ten days of receipt of the returned copy.*

A cancellation proceeding is commenced by filing in the Office a timely petition to cancel with the required fee. [Note 1.] The petition must include proof of service of a copy of the petition, including any exhibits, on the owner of record for the registration, [Note 2] or, if the owner has designated a domestic representative which is of record, the petition to cancel must be served on the domestic representative, at the correspondence address of record in the Office. [Note 3.]

When petitioner files its petition to cancel with the Board, the petitioner must concurrently serve a copy of the petition, including any exhibits, on the owner of record for the registration at the correspondence address of record in the Office, unless a domestic representative has been designated in the involved registration or in assignment records regarding the registration, in which case, the domestic representative should be served. The requirement that a petitioner serve the petition to cancel on a respondent recognizes that plaintiffs and defendants often are in contact before the plaintiff files its complaint or claims, and also recognizes that continuation of direct communication is vital both for promoting possible settlement of claims and for ensuring cooperation and procedural efficiency in the early stages of a proceeding. [Note 4.]

The Board does not serve a copy of the petition to cancel on the owner of the registration. Instead, the petitioner is responsible for serving a copy of the petition to cancel on the owner of record for the registration, or the owner's domestic representative, if one has been appointed, at the correspondence address of record in the Office. [Note 5.] To determine the correspondence address of the owner of record of the registration, the petitioner may consult the Office's Trademark Applications and Registrations Retrieval (TARR) system, accessible through <u>http://tarr.uspto.gov</u>. [Note 6.] The TARR display of information includes an active link to assignment information [Note 7]; 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 must be served on the correspondence address of the assignee. The complaint need only be served at the address shown as the owner of record's correspondence address of record displayed on the TARR website, including any relevant information from the assignment link. [Note 8.] Although petitioner is not required to serve a copy of the petition to cancel on any address other than the address listed in the TARR system, if the petitioner has any doubt as to the identity or address of the real party in interest, the petitioner may serve a copy of the petition to cancel on any party believed to have an ownership interest in the relevant registration (e.g., an assignee or survivor of merger that had not recorded the document of transfer in the Office's Assignment Branch but was known to the petitioner) at the correspondence address known to the petitioner. It is generally in a plaintiff's interest to have the real party in interest apprised of the existence of the Board proceeding, so that any judgment eventually obtained will be binding on the correct party. [Note 9.]

The petitioner need not, and should not, serve any attorney who may have represented the respondent before the Office in the prosecution of the application that resulted in issuance of the registration. [Note 10.] Moreover, if petitioner serves only said attorney, it has not effected proper service of the petition to cancel. However, if respondent has appointed an attorney to represent it in post-registration trademark matters, and petitioner serves the petition on the attorney appointed for post-registration matters instead of on respondent, petitioner may be excused if its failure to serve a copy of the petition on respondent was due to excusable error, and if petitioner thereafter sends a service copy to respondent and files a motion to amend the proof of service accordingly. In that case, the proceeding will not be dismissed as a nullity, but will be accorded a filing date as of the date of the amended proof of service and will proceed on whatever grounds are then available. [Note 11.] It should be noted that even if the petition to cancel was originally served within 5 years from the date of the registration of the mark, the grounds for cancellation may be affected if the amended filing date is after the five-year anniversary date of the registration. [Note 12.] Therefore, even where petitioner may believe respondent is represented by counsel, the better practice is to serve respondent or any appointed domestic representative directly (with an optional copy to respondent's attorney), to avoid a potential time bar and since 37 CFR § 2.111(a) requires the petition to be served on the owner of the registration or its domestic representative, if one has been appointed. [Note 13.]

The manner of service is provided for in 37 CFR § 2.119. The parties may agree to use electronic transmission (e.g., facsimile or e-mail) to communicate with each other and to meet their service obligations. When such an agreement is made, the best practice is to reduce the agreement to writing. If the parties have communicated prior to the filing of the petition to cancel, and respondent has agreed to accept service of the complaint by electronic transmission, petitioner may serve the petition to cancel by electronic transmission, e.g., facsimile or e-mail. [Note 14.]

The petition to cancel may be filed using ESTTA, the Board's Electronic System for Trademark Trials and Appeals. By using ESTTA, a petitioner affirmatively represents to the Board that it has served a copy of the petition to cancel on respondent; thus any petitioner who files its petition to cancel through ESTTA will be viewed by the Board as having included proof of service with the pleading [Note 15], because a statement confirming service appears

on the ESTTA-generated filing form as part of the complaint. [Note 16.] The appearance of the proof of service on the complaint does not by itself effect service however; petitioner must still make actual service of the complaint on respondent to comply with its service obligation.

If a service copy is returned to petitioner as undeliverable, petitioner must notify the Board within ten (10) days of receipt of the returned service copy, or of any notice indicating that the service copy could not be delivered. [Note 17.] Notification to the Board of failure of service may be provided by any means available for filing pleadings and motions or other papers with the Board. *See* TBMP § 104 (Business to Be Conducted in Writing). Therefore, notice of failure of service may be provided, for example, by written notice mailed to the Board or by appropriate filing through ESTTA. [Note 18.] While petitioner is under no obligation to search for current correspondence address information for, or investigate the whereabouts of, any respondent the petitioner is unable to serve, if petitioner knows of any new address information for the respondent, petitioner must report the address to the Board. In any case in which petitioner notifies the Board that a service copy sent to a respondent was returned or not delivered, including any case in which the notification includes a new address for the respondent discovered by or reported to petitioner, the Board will effect service. [Note 19.]

The filing date of the petition is the date of receipt in the Office of the petition, with proof of service and the required fee. However, if the petition is filed by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) in accordance with 37 CFR § 2.198, then the filing date is the date the petition to cancel was deposited with the USPS. [Note 20], 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 21.] The Certificate of Mailing procedure described in 37 CFR § 2.197 and the "Express Mail" procedure described in 37 CFR § 2.198 are available for the filing of a petition to cancel. [Note 22.]

NOTES:

1. *See* 37 CFR § 2.111(a).

2. *See* 37 CFR § 2.111(a).

3. *See* 37 CFR § 2.111(b).

4. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (August 1, 2007).

5. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (August 1, 2007).

6. Miscellaneous Changes to Trademark Trial and Appeal Board Rules 72 Fed. Reg. 42242, 42243 (August 1, 2007).

7. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242,

42243 (August 1, 2007).

8. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

9. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

10. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

11. *See The Equine Touch Foundation Inc. v. Equinology, Inc.*, 91 USPQ2d 1943 (TTAB 2009) (petitioner allowed to remedy its failure to comply with the service requirements of 37 CFR §§ 2.111(a), 2.111(b) and 2.111(c)(4) by proof of subsequent service of the petition to cancel on respondent; since counsel for respondent filed an answer and was clearly representing respondent, petitioner need not send additional copy of petition to respondent.).

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

13. *The Equine Touch Foundation Inc. v. Equinology, Inc.*, 91 USPQ2d 1943, 1944 n.3 (TTAB 2009) (although service of petition to cancel on counsel for registrant was improper, since counsel for registrant filed an answer and was representing registrant, petitioner did not have to reserve registrant at its address of record.)

14. *See* 37 CFR § 2.119(b)(6); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42248 (August 1, 2007).

15. *See Schott AG v. Scott*, 88 USPQ2d 1862 n.3 (TTAB 2008) (where opposer filed notice of opposition by mail, its only opportunity to show proof of service at the time of filing was to include a certificate of service with the notice; having failed to include proof of service with its complaint, opposer could not meet the requirement set forth in 37 CFR § 2.101(b), but use of the Board's ESTTA online filing system prevents the process from being completed unless opposer confirms that it has forwarded a service copy of its complaint to all parties at their addresses of record).

16. *The Equine Touch Foundation Inc. v. Equinology, Inc.*, 91 USPQ2d 1943, 1944 n.5 (TTAB 2009) ("Such confirmation then appears on the ESTTA generated filing form for the attached complaint, and the filing form is considered part of the plaintiff's initial pleading.").

17. *See* 37 CFR § 2.101(b).

18. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

19. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

20. *See* 37 CFR § 2.198(a)(1).

21. *See* 37 CFR § 198(a)(2).

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

309.03 Substance of Complaint

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

37 CFR § 2.99(h) *The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.*

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

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

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

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

37 CFR § 2.133(c) *Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.*

309.03(a) In General

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

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

The Board is an administrative tribunal that is empowered to determine only the right to

register; it may not determine the right to use, or broader questions of infringement or unfair competition. *See* TBMP § 102.01.

NOTES:

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

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

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

A notice of opposition must include (1) a short and plain statement of the reason(s) why opposer believes it would be damaged by the registration of the opposed mark (i.e., opposer's standing to maintain the proceeding -- *see* TBMP § 303.03 and TBMP § 309.03(b)), and (2) a short and plain statement of one or more grounds for opposition. [Note 1.]

Similarly, a petition to cancel must include (1) a short and plain statement of the reason(s) why petitioner believes it is or will be damaged by the registration sought to be cancelled (i.e., petitioner's standing to maintain the proceeding -- *see* TBMP § 303.03 and TBMP § 309.03(b)) and (2) a short and plain statement of the ground(s) for cancellation. [Note 2.]

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

All averments should be made in numbered paragraphs, the contents of each of which should be limited as far as practicable to a statement of a single set of circumstances. [Note 5.] Each claim founded upon a separate transaction or occurrence should be stated in a separate count whenever a separation would facilitate the clear presentation of the matters pleaded. [Note 6.] A paragraph may be referred to by number in all succeeding paragraphs, and statements in the complaint may be adopted by reference in a different part of the complaint. [Note 7.]

A plaintiff may state as many separate claims as it has, regardless of consistency; a plaintiff may also set forth two or more statements of a claim alternatively or hypothetically, either in one count or in separate counts. [Note 8.]

When two or more statements are made in the alternative, the sufficiency of each is determined independently; the fact that one of them may be insufficient does not mean that the other(s) is (are) also insufficient. [Note 9.]

Evidentiary matters (such as, for example, lists of publications or articles in which a term sought to be registered by an applicant is alleged to be used descriptively) should not be pleaded in a complaint. They are matters for proof, not for pleading. [Note 10.]

Factual allegations made in the pleadings are not evidence of the matters alleged except insofar

as they might be deemed to be admissions against interest. [Note 11.]

In inter partes proceedings before the Board, as in civil cases before the United States district courts, all pleadings are so construed as to do substantial justice. [Note 12.]

For a discussion of the grounds for opposition and cancellation, *see* TBMP § 309.03(c) and J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 20:13 et. seq. (4th ed. 2010). 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 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 20:52 et. seq. (4th ed. 2010).

NOTES:

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

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

3. *See Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007). *See also 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. *Ashcroft v. Iqbal*, 556 U.S. ___, 129 S.Ct. 1937 (2009), *quoting Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007); Fed. R. Civ. P. 8(a)(2).

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

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

309.03(b) Standing

Any person who believes it is or will be damaged by registration of a mark has standing to file a complaint. [Note 1.] *See* TBMP § 303. At the pleading stage, all that is required is that a

plaintiff allege facts sufficient to show a “real interest” in the proceeding, and a “reasonable basis” for its belief that it would suffer some kind of damage if the mark is registered. [Note 2.] *See also*, TBMP § 303.06 regarding pleading of standing by joint plaintiffs. To plead a “real interest,” plaintiff must allege a “direct and personal stake” in the outcome of the proceeding. [Note 3.] The allegations in support of plaintiff's belief of damage must have a reasonable basis “in fact.” [Note 4.]

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

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

A claim of likelihood of confusion that is not wholly without merit [Note 7], including claims based upon current ownership of a valid and subsisting registration [Note 8] or prior use of a confusingly similar mark [Note 9];

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 10];

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 11];

Plaintiff belongs to class of potential purchasers it alleges are disparaged or brought into contempt or disrepute by defendant’s mark [Note 12];

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 13].

A counterclaimant's standing to cancel a pleaded registration is inherent in its position as defendant in the original proceeding. [Note 14.] *See also* TBMP § 313.03.

A plaintiff need not assert proprietary rights in a term in order to have standing. [Note 15.] For example, when descriptiveness or genericness of the mark is in issue, plaintiff may plead (and later prove) its standing by alleging that it is engaged in the sale of the same or related products or services (or that the product or service in question is within the normal expansion of plaintiff's business) and that the plaintiff has an interest in using the term descriptively in its business. [Note 16.]

If a plaintiff can show standing on one ground, it has the right to assert any other grounds in an opposition or cancellation proceeding. [Note 17.]

NOTES:

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

2. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). *See also Herbko International Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987) *on remand*, 5 USPQ2d 1622 (TTAB 1987), *rev'd*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988) (trade association has standing to maintain opposition); *International Order of Job's Daughters v. Lindeburg and Co.*, 727 F.2d 1087, 220 USPQ 1017, 1020 (Fed. Cir. 1984); *Enbridge, Inc. v. Excelerate Energy Limited Partnership*, 92 USPQ2d 1537, 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).

3. *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); *Corporacion Habanos S.A. v. Anncas Inc.*, 88 USPQ2d 1785 (TTAB 2008) (Cuban entity has standing although it does not and cannot engage in any business in the United States due to the embargo on Cuban goods).

4. *Ritchie v. Simpson*, 170 F.3d 1092, 50 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).

5. *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., 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 (TTAB 2008) (failure to prove standing); and *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1605 (TTAB 1999) (at final decision, inquiry is not whether pleading of standing is sufficient but

whether allegations have been proven).

6. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1027 (Fed. Cir. 1999) ("The crux of the matter is not how many others share one's belief that one will be damaged by the registration, but whether that belief is reasonable and reflects a real interest in the issue"). *See also, Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co*., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007) (plaintiff has shown that it is not a mere intermeddler).

7. *See Cunningham v. Laser Golf Corp*., 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 648 (Fed. Cir. 1983); *Lipton Industries Inc. v. Ralston Purina Co.*,670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982)*; Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (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 (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 Company Inc. v. Nash-Finch Co.*, 4 USPQ2d 1085, 1087 (TTAB 1987); and *Liberty Trouser Co. v. Liberty & Co.*, 222 USPQ 357, 358 (TTAB 1983) (allegation of likelihood of confusion accepted as proper allegation of petitioner's standing with respect to pleaded grounds of fraud and abandonment).

8. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*,670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974) (prior registration but not priority in use); *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752 (TTAB 2009) (pleaded registration made of record); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1849 (TTAB 2008) (pleaded registrations properly made of record); *Corporacion Habanos S.A. v. Anncas Inc.*, 88 USPQ2d 1785 (TTAB

2008) (pleaded registration made of record); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1586 (TTAB 2008) (standing established by making of record copies of its pleaded registrations showing the current status of the registrations and their ownership in opposer); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1721 (TTAB 2008) (opposer alleged ownership of application that issued during proceeding and introduced a certified copy of subsequent registration at trial showing current status and title in opposer's name); *Apple Computer v. TVNET.net Inc.*, 90 USPQ2d 1393 (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 (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 Mfg. Co.*, 77 USPQ2d 1220, 1225 (TTAB 2005); and *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005) (status and title copies of pleaded registrations made of record).

9. *See First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 476 F.3d 867, 81 USPQ2d 1375 (Fed. Cir. 2007) (intrastate use by foreign opposer); *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 (TTAB 2008) (prior use); *General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179, 1181 (TTAB 2008) (past use and present licensing); and *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1106 (TTAB 2007) (prior use).

10. *See 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); *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); and *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).

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

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

13. *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 Corporation v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984).

14. *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 (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); and *General Mills, Inc. v. Natures 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).

15. *See International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1496 (Fed. Cir. 2000); *Books on Tape Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301 (Fed. Cir. 1987); and *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").

16. *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., Inc. 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); *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 (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); and *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).

17. *See Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009), *citing Liberty Trouser Co., Inc. v. Liberty & Co., Ltd.*, 222 USPQ 357, 358 (TTAB 1983) (averments of priority, likelihood of confusion and damage resulting therefrom accepted to show petitioner's standing with respect to pleaded grounds of fraud and abandonment despite unavailability of likelihood of confusion claim under Trademark Act § 2(d), 15 U.S.C. § 1052(d) because registration more than five years old).

309.03(c) Grounds

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

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

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

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, and 12 through 14 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 *de jure* functional; or if not *de jure* functional, that the product design has not acquired distinctiveness. [Note 11.]

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

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

(5) That defendant did not have a bona fide intent to use the mark in connection with the identified goods/services as of the filing date of the application under Trademark Act § 1(b), 15 U.S.C. § 1052(b). [Note 18.]

(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 19.]

(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 20.]

(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 21] or that defendant's mark, consisting of a particular sound applied to its goods, is not inherently distinctive and has not acquired distinctiveness. [Note 22.]

(9) That the term for which registration is sought or for which registration has been obtained has not been used as a trademark or service mark. [Note 23.]

(10) That defendant's mark represents multiple marks in a single application (or registration) ("phantom mark"). [Note 24.]

(11) That defendant's mark has been abandoned due to nonuse with intent not to resume use, and nonuse for three consecutive years shall be prima facie evidence of abandonment, [Note 25]; or due to a course of conduct that has caused the mark to lose significance as an indication of source. [Note 26.]

(12) That defendant's mark consists of or comprises the name of a particular living individual without the individual's consent. [Note 27.]

(13) That defendant's product design is generic. [Note 28.]

(14) That defendant's mark would dilute the distinctive quality of plaintiff's famous mark. [Note 29.]

(15) That defendant has used its mark so as to misrepresent the source of its goods or services. [Note 30.]

(16) That defendant has misused the federal registration symbol with intent to deceive the purchasing public or others in the trade into believing that the mark is registered. [Note 31.]

(17) That defendant committed fraud in the procurement of its registration or during the prosecution of its application for registration. [Note 32.]

(18) That defendant's registered mark interferes with the registration of a foreign owner's mark under Article 8 of the General Inter-American Convention for Trademark and Commercial Protection of Washington, 1929 ("Pan American Convention"), 46 Stat. 2907. [Note 33.]

(19) That defendant's application is barred from registration by claim or issue preclusion. [Note 34.] *See also* TBMP § 311.02(b).

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 35.] 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 36.] 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 37] prior trademark or service mark use; [Note 38] or prior use analogous to trademark or service mark use. [Note 39.]

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 40] 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 41.]

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 42.]

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 43.] 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 44.]

Direct or Hypothetical Pleading of Likelihood of Confusion: A plaintiff may plead likelihood of confusion directly or hypothetically. [Note 45.] 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 46.] 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 47.]

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 Womens Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006), *aff'd unpub'd*, 240 Fed. Appx. 865 (Fed. Cir. 2007), *cert. den'd*, 552 U.S. 1109 (2008) (Board does not have authority to determine whether a party has engaged in criminal or civil wrongdoings); *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); and *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 (TTAB 2009) (Paris Convention does not provide independent cause of action); *Franpovi SA v. Wessin*, 89 USPQ2d 1637 (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 (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 (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 (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); and *Century 21 Real Estate Corp. v. Century Life of America*, 11 USPQ2d 1355, 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); *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); *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); and *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000).

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., 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 (Fed. Cir. 2005); *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992); and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002). *See also First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 476 F.3d 867, 81 USPQ2d 1375, 1378 (Fed. Cir. 2007) (claim of prior intrastate use); *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 (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 (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 Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720 (Fed. Cir. 2001) (deceptive misdescriptiveness) and *Callaway Vineyard & Winery v. Endsley Capital Group, Inc.*, 63 USPQ2d 1919 (TTAB 2002) (mere descriptiveness). Regarding claims under Trademark Act § 2(f), 15 U.S.C. § 1052(f), *see Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (in cancellation proceeding, presumption of validity of registration under Trademark Act § 2(f) includes presumption of acquired distinctiveness, and party seeking cancellation must overcome this presumption by preponderance of evidence; "burden" to prove that mark has acquired distinctiveness shifts to registrant only after plaintiff establishes prima facie case that mark has not acquired distinctiveness); *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 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); *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1680 (TTAB 2007) (ultimate burden of persuasion under Trademark Act § 2(f) rests with applicant); and *Kellogg Co. v. General Mills Inc.*, 82 USPQ2d 1766, 1768 (TTAB 2007) (mere descriptiveness; whether claim under Trademark Act § 2(f) is sufficient).

8. *See* Trademark Act § 2(e)(2), 15 U.S.C. § 1052(e)(2). *See also, e.g., Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1504 (TTAB 2008) (whether mark is descriptive and/or primarily geographically descriptive, applicant has shown acquired distinctiveness); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994).

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 (Fed. Cir. 2001); *Corporacion Habanos S.A. v. Anncas Inc.*, 88 USPQ2d 1785 (TTAB 2008) (primarily geographically deceptively misdescriptive and deceptive claims); *United States Playing Card Co., v. Harbro, LLC*, 81 USPQ2d 1537 (TTAB 2006) (addressing deceptiveness of a geographic term); and *In re Wada*, 48 USPQ2d 1689 (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., Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132 (TTAB 2000); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 391-92 (TTAB 1979); and *Food Specialty Co. v. Carnation Co.*, 170 USPQ

522, 523 (TTAB 1971). *Cf. In re Rath*, 402 F.3d 1207, 74 USPQ2d 1174 (Fed. Cir. 2005); and *In re Piano Factory Group Inc.*, 85 USPQ2d 1522 (TTAB 2007).

11. *See* Trademark Act § 2(e)(5), 15 U.S.C. § 1052(e)(5); *TrafFix Devices Inc. v. Marketing Displays Inc.*, 523 U.S. 23, 58 USPQ2d 1001, 1006 (2001); and *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161 (1995). *See also, e.g., Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, (TTAB 2009) (product configuration); and *M-5 Steel Mfg, Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001). *Cf. Duramax Marine, LLC v. R.W. Fernstrum & Company*, 80 USPQ2d 1780 (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 (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 (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 (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), *citing In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853, 1856 (Fed. Cir. 2003) ("The amended Lanham Act gives geographically deceptively misdescriptive marks the same treatment as geographically deceptive marks under § 1052(a)."); *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., In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010) (religious affiliation); *In re Heeb Media, LLC*, 89 USPQ2d 1071 (TTAB 2008) (religious affiliation); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) (disparagement); *In re Squaw Valley Development Co.*, 80 USPQ2d 1264 (TTAB 2006) (disparagement); *McDermott v. San Francisco Womens Motorcycle Contingent*, 81 USPQ2d 1212 (TTAB 2006); *aff'd unpub'd*, 240 Fed.Appx. 865 (Fed. Cir. 2007), *cert. denied*, 552 U.S.1109 (2008) (while individual male citizen sufficiently alleged a "real interest" in the proceedings, he failed to properly allege "belief of damage," as he does not inherently possess an immutable trait directly implicated by the mark or allege that others share his belief of damage); *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600 (TTAB 1999) (women in general and African American women in particular); *Order Sons of Italy in America v. Memphis Mafia Inc.*, 52 USPQ2d 1364 (TTAB 1999) (members of plaintiff's Order and Italian-Americans in general); and *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1740-48 (TTAB 1999), *rev'd*, 284 F. Supp. 2d 96, 125, 68 USPQ2d 1225, 1248 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), and *aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009) (cancellation action brought by Native Americans on grounds of disparagement barred by laches).

14. *See, e.g., Corporacion Habanos S.A. v. Anncas Inc.*, 88 USPQ2d 1785 (TTAB 2008)

(deceptiveness); *Boston Red Sox Baseball Club Limited Partnership v. Sherman*, 88 USPQ2d 1581, 1588 (TTAB 2008); *In re Boulevard Entertainment, Inc.*, 334 F.3d 1336, 67 USPQ2d 1475 (Fed. Cir. 2003) (use of dictionary evidence to determine whether mark is scandalous); and *In re Mavety Media Group, Ltd.*, 33 F.3d 1367, 31 USPQ2d 1923 (Fed. Cir. 1994) (analyzing mark in terms of "vulgarity"). *See also Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) (standing to oppose on Trademark Act § 2(a), 15 U.S.C. § 1052(a) grounds); *In re South Park Cigar, Inc.*, 82 USPQ2d 1507 (TTAB 2007) (deception involving geographical mark); *In re Red Bull GmbH*, 78 USPQ2d 1375 (TTAB 2006) (scandalous mark); *In re Wilcher Corp.*, 40 USPQ2d 1929 (TTAB 1996) (design mark scandalous); and *In re Old Glory Condom Corp.*, 26 USPQ2d 1216, 1220 (TTAB 1993) (design mark not scandalous). *Cf. McDermott v. San Francisco Womens Motorcycle Contingent*, 81 USPQ2d 1212, 1214 (TTAB 2006), *aff'd unpub'd*, 240 Fed.Appx. 865 (Fed. Cir. 2007), *cert. denied*, 552 U.S. 1109 (2008) (authority of Trademark Act § 2(a), 15 U.S.C. § 1052(a) does not extend to goods or services that may be viewed as scandalous or immoral in nature).

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

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

17. *See, e.g., International Mobile Machines Corp. v. International Telephone and Telegraph Corp.*, 800 F.2d 1118, 231 USPQ 142 (Fed. Cir. 1986); *Avakoff v. Southern Pacific Co.*, 765 F.2d 1097, 226 USPQ 435 (Fed. Cir. 1985); *Paramount Pictures Corp. v. White*, 31 USPQ 1768 (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); *Nutrasweet Company v. K & S Foods Inc.*, 4 USPQ2d 1964 (TTAB 1987); *Pennwalt Corp. v. Sentry Chemical Co.*, 219 USPQ 542, 558 (TTAB 1983); and *Bonaventure Associates v. Westin Hotel Co.*, 218 USPQ 537, 543 (TTAB 1983). *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)); and *CarX Service Systems, Inc. v. Exxon Corp.*, 215 USPQ 345, 351 (TTAB 1982) (plaintiff must plead and prove that there was no use prior to filing date; mere claim that dates of use are incorrect does not state a claim of action).

18. *See, e.g., Honda Motor Co., Ltd. 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); and *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1504 (TTAB 1993). *Cf. Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1643 (TTAB 2007) (capacity to market and /or manufacture goods, having produced them in the past under different marks, rebuts claim that applicant lacked bona fide intent to use).

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

20. *See, e.g., Ballet Tech Foundation, Inc. v. The Joyce Theater Foundation, Inc.*, 89 USPQ2d 1262 (TTAB 2008); *Anheuser-Busch Inc. v. The Florists Association of Greater Cleveland Inc.*, 29 USPQ2d 1146 (TTAB 1993); *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318, 1320 (TTAB 1990); and *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) *recon. den.*, 36 USPQ2d 1328 (TTAB 1994) (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).

21. *See, e.g., Qualitex Co. v. Jacobson Prods. 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); and *Kassnar Imports v. Plastilite Corp.*, 180 USPQ 156, 157 (TTAB 1973), *aff'd*, 508 F.2d 824, 184 USPQ 348, 350 (CCPA 1975).

22. *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).

23. *See, e.g., 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); and *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.SC. § 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); and *Auburn Farms, Inc. v. McKee Foods Corp.*, 51 USPQ2d 1439 (TTAB 1998). *Cf. General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179 (TTAB 2008) (plaintiff could not prove priority because it abandoned mark with no intent to resume use prior to use by defendant); and *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007) (plaintiff must allege ultimate facts pertaining to the alleged abandonment).

26. Trademark Act § 45, 15 U.S.C. § 1127. *See, e.g., Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, (TTAB 2009) (failure to police third party use of marks); *Ballet Tech Foundation, Inc. v. The Joyce Theater Foundation, Inc.*, 89 USPQ2d 1262 (TTAB 2008) (use of marks pursuant to implied license inures to benefit of licensor); *Tea Board of India v. The Republic of Tea, Inc.* 80 USPQ2d 1881 (TTAB 2006); and *Woodstock's Enterprises Inc. v. Woodstock's Enterprises Inc.*, 43 USPQ2d 1440 (TTAB 1997), *aff'd*, 152 F.3d 942 (Fed. Cir. Mar. 5, 1998).

27. *See* Trademark Act § 2(c), 15 U.S.C. § 1052(c). *See also Chester L. Krause v. Krause Publications, Inc.*, 76 USPQ2d 1904 (TTAB 2005), *aff'd* slip. op. 2007-1364 (Fed. Cir. Dec. 7, 2007); *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"); and *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (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 (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 (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); *National Pork Board and National Pork Producers Council v. Supreme Lobster and Seafood Company*, 96 USPQ2d 1479 (TTAB 2010) (commodity promotion slogan dilution by blurring); *Coach Services, Inc. v. Triumph Learning LLC*; 96 USPQ2d 1479 (TTAB 2010) (dilution by blurring and tarnishment); *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); *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); *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); and *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000); and, *e.g.*, *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 (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); *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); and *The E.E. Dickinson Co. v. The T.N. Dickinson Company*, 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 (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); and *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844 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); *DaimlerChrysler Corp. v. American Motors Corp*., 94 USPQ2d 1086 (TTAB 2010) (summary judgment on fraud claim denied); *Enbridge, Inc. v. Excelerate Energy Limited Partnership*, 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), *citing Kowal v. MCI Communications Corp*., 16 F.3d 1271, 1279 n.3 (D.C. Cir. 1994) ("[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"); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986); *King Auto., Inc. v. Speedy Muffler King, Inc*., 667 F.2d 1008, 212 USPQ 801, 803 (CCPA 1981) (fraud must be pleaded with particularity); *Smith Int'l, 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); and *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 (TTAB 2008) (rebuttable presumption that opposer lacked willful intent to deceive Office arises when registrant amended identification of goods during ex parte prosecution); and *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); and *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").

35. 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); *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); and *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1108 (TTAB 2007) (priority established by proof of prior use).

36. *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 (TTAB 1987), *rev'd*, 853 F.2d 888, 7 USPQ2d 1628, 1632 (Fed. Cir. 1988); *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Golomb v. Wadsworth*, 592 F.2d 1184, 201 USPQ 200, 201 (CCPA 1979); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009) (applicant may rely without further proof upon the filing date of its application as a "constructive use" date for purposes of priority); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1852 (TTAB 2008) (priority based on acquisition of acquired distinctiveness of merely descriptive mark); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1722 (TTAB 2008) (underlying application for registration predates filing date of applicant's application); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285 (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 Corporation 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); and *Rolex Watch U.S.A., Inc. v. Madison Watch Co., Inc*., 211 USPQ 352 (TTAB 1981) (proprietary right is a right residing in owner of mark and those in privity). *Cf. 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).

37. *See 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 (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 (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); and *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991).

38. *See Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009) (insufficient record evidence of prior use); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1023 (TTAB 2009) (in absence of pleaded registration, petitioner must show prior common law use); *Mattel Inc. v. Funline Merchandise Co.*, 81 USPQ2d 1372, 1374 (TTAB 2006) (petitioner's use of mark prior to respondent's first use); *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.*, 86 USPQ2d 1283, 1284 (TTAB 2008) (opposer's use, while not large, was sufficient to constitute more than token use); *General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179 (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); and *Jimlar Corporation 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 (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).

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

40. *See King Candy Co., Inc. 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 * * *'...”); *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) *aff'd unpub*, 208 Fed. Appx. 886, 887 (Fed. Cir. Dec. 6, 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); *DC Comics v. Pan American Grain Mfg. 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 (TTAB 1998). *Cf.* regarding cancellation proceedings, *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 USPQ 840, 841 (TTAB 1980) (priority must be proven in cancellation proceeding).

41. *See, e.g., Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, 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., Inc. v. The Englander Company, Inc.*, 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 (Comm'r Pat. 1998) (“prior use need not be shown by an opposer relying on a registration of its pleaded mark for its pleaded goods or services unless the applicant counterclaims for cancellation”). *See also* 37 CFR § 2.106(b)(2)(ii) (attack on registration must be made by counterclaim or separate claim); *Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989) (better practice is to raise defense as a counterclaim); and *Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624, 1626 n.1 (TTAB 2007) (applicant’s arguments in its brief that opposer’s marks are functional, non-distinctive, and lack source-indicating significance constitute an impermissible collateral attack on opposer’s pleaded registrations, which arguments cannot be considered in the absence of a counterclaim for cancellation). *Cf. Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (petition or counterclaim to restrict the scope of goods in registration under Trademark Act § 18, 15 U.S.C. § 1068 was not a collateral attack on the validity of that registration). **Please Note:** In cases where a plaintiff has relied on its ownership of a pleaded registration, any counterclaim or petition to cancel that registration is normally decided before the issues in the underlying

opposition. *See, e.g., Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1328 (TTAB 1992); and *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1272 (TTAB 1992).

42. *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 (TTAB 2007) (petitioner committee's right derived through inheritance found sufficient); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435 (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 (TTAB 1995) (fraternal organization has standing); and *Holmes Products Corp. v. Duracraft Corp.*, 30 USPQ2d 1549, 1552 (TTAB 1994) (no legitimate interest in preventing confusion alleged).

43. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See e.g., Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En* 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (to determine whether the marks are similar for purposes of assessing the likelihood of confusion, the Board will consider the appearance, sound, connotation and commercial impression of each mark); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (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); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *see also 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 (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 Mfg. 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); and *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1052-1053 (TTAB 1992) (family-of-marks).

44. *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 *du Pont* factor"); *Kellogg Co. v. Pack'em Enterprises Inc*., 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992). *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).

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

46. *See John T. Clark Company v. Colgate-Palmolive Company*, 176 USPQ 93 (TTAB 1972); and *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 (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).

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

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

15 U.S.C. § 1068 [Trademark Act § 18] *In such proceedings the Director may refuse to register opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties under this chapter may be established in the proceedings....*

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

37 CFR § 2.133(b) *If, in an inter partes proceeding, the Trademark Trial and Appeal Board finds that a party whose application or registration is the subject of the proceeding is not entitled to registration in the absence of a specified restriction to the involved application or registration, the Board will allow the party time in which to file a motion that the application or registration be amended to conform to the findings of the Board, failing which judgment will be entered against the party.*

37 CFR § 2.99(h) *The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.*

37 CFR § 2.133(c) *Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.*

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

Relief under Trademark Act § 18, 15 U.S.C. § 1068, may be sought separately and apart from, or in addition to, any other ground. [Note 3.] A claim under Trademark Act § 18, 15 U.S.C. § 1068, is in the nature of an equitable remedy and does not require pleading and proof of specific grounds for cancellation or opposition, such as abandonment. [Note 4.] A claim in which the plaintiff seeks to delete specific items on the grounds that the defendant is no longer using, and has no intent to resume use of its mark on those goods or services, is not a claim under Trademark Act § 18, 15 U.S.C § 1068 but is essentially a "straightforward" pleading of abandonment. [Note 5.]

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

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

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

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

A claim to restrict or rectify with respect to the register the registration. A petition to restrict or clarify the description of a mark in a registration would fall under the provision giving the Board authority to “restrict or rectify” the register. [Note 12.] As in the case of a petition to restrict goods or services, a proper pleading to restrict the description of a mark could include allegations that, for example, the description of the mark in the registration is ambiguous or overly broad and not specific to the mark actually used by the defendant, and that the limitation would avoid a finding of a likelihood of confusion. [Note 13.]

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

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

As in the case of any other claim, a claim for partial opposition or partial cancellation

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

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

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

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

NOTES:

1. Trademark Act § 18, 15 U.S.C. § 1068. *See also*, 37 CFR § 2.111(b) and 37 CFR § 2.133(b); *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 (TTAB 2007) (proposed amendment denied); *Seculus Da Amazonia S/A v. Toyota Jidosha Kabushiki Kaisha*, 66 USPQ2d 1154 (TTAB 2003) (opposition based on applicant's alleged misconduct and unclean hands in its dealing with the U.S. Customs Service fails to constitute a claim that is cognizable under Trademark Act § 18, 15 U.S.C. § 1068).

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

3. *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); and *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. *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 (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 for which counterclaimant sought to have deleted from registration).

6. *See 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 (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). **Please Note:** To the extent that cases decided prior to *Eurostar* permitted a restriction petition 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).

14. *See 8440 LLC v. Midnight Oil Company*, 59 USPQ2d 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 (TTAB 1990).

15. *See Montecash LLC v. Anzar Enterprises, Inc.*, 95 USPQ2d 1060, 1063 (TTAB 2010) (petitioner, seeking entry of a disclaimer of a purportedly generic term that formed a portion of a mark that is not generic in its entirety, and that resided on the Principal Register for more than five years, failed to state a claim upon which relief may be granted); *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545 (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 (TTAB 1998) (restriction proposed for first time in reply brief untimely); *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266 (TTAB 1994); and *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).

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 (TTAB 1990) (counterclaim that opposer's registration should be amended "to accurately describe the services" was vague); and *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 1272 (TTAB 1994); and *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125 (TTAB 1990) (petitioner's

request to restrict channels of trade for respondent's goods denied when raised at end of rebuttal period).

19. 37 CFR § 2.106(b)(2)(ii).

309.04 Defects in Complaint That May Affect Institution of Proceeding

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 CFR § 2.102(b), that it is in privity with the person who obtained the extension, or that the person in whose name the extension was requested was misidentified through mistake. *See* TBMP § 303.05.

(2) If an opposition or a petition for cancellation *in paper form* 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). *See* TBMP § 306.03 and TBMP § 307.03. **Please Note:** ESTTA, the Board's electronic filing system, 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) If an opposition is filed *in paper form* 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, the U.S. Patent and Trademark Office's electronic filing system, 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 1.]

(4) If a party files an opposition *in paper form* but 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) Where an opposition is filed through ESTTA and the applicant has not supplied its e-mail address in the application; the Board will then attempt to manually institute the opposition, and should the Board note the issuance of the notice of allowance or registration, the proceeding will not be instituted and the filing fee will be refunded.

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

(1) If a party files a petition for cancellation *in paper form* 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; they 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 2.] 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. §§ 14(3) and (5), and will not allow a party to select other (unavailable) grounds.

(2) If a petition for cancellation is filed *in paper form* 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. 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) If a party files an opposition or a petition for cancellation *in paper form*, 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, the proceeding will be instituted, and no refund will be made. However, if there is a defect in the opposition or petition for cancellation which precludes institution, no proceeding will be instituted, and any submitted fee 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 3.] *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 retain all papers. If the proceeding was instituted through ESTTA, the electronic file record for the erroneous opposition or cancellation will be retained in TTABVUE.

NOTES:

1. *See 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 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").

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

310 Notification to Parties of Proceeding and Setting Time to Answer

310.01 Notification to Parties of Proceeding

***37 CFR § 2.105* Notification to parties of opposition proceeding[s].**

(a) *When an opposition in proper form (see §§ 2.101 and 2.104), with proof of service in accordance with § 2.101(b), has been filed and the correct fee has been submitted, the Trademark Trial and Appeal Board shall prepare a notification, which shall identify the title and number of the proceeding and the application involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. If a party has provided the Office with an e-mail address, the notification may be transmitted via e-mail.*

(b) *The Board shall forward a copy of the notification 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 notification 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.*

(2) *If opposer is not represented by an attorney in the opposition, but opposer has appointed a domestic representative, the Board will send the notification to 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 notification directly to opposer, unless opposer designates in writing another correspondence address.*

(c) *The Board shall forward a copy of the notification 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 documents described in this section to applicant's 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 documents described in this section to 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 documents described in this section directly to applicant, unless applicant designates in writing another correspondence address.*

37 CFR § 2.113 Notification of cancellation proceeding.

(a) *When a petition for cancellation in proper form (see §§ 2.111 and 2.112), with proof of service in accordance with § 2.111(b), has been filed and the correct fee has been submitted, the Trademark Trial and Appeal Board shall prepare a notification which shall identify the title and 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 notification, within which an answer must be filed. If a party has provided the Office with an e-mail address, the notification may be transmitted via e-mail.*

(b) *The Board shall forward a copy of the notification 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 notification 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.*

(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 notification to 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 notification directly to petitioner, unless petitioner designates in writing another correspondence address.*

(c) *The Board shall forward a copy of the notification to the respondent (see § 2.118). The respondent shall be the party shown by the records of the Office to be the current owner of the registration(s) sought to be cancelled, 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).*

(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 petition for cancellation shall be forwarded with a copy of the notification to the alleged current owner. The alleged current owner may file a motion to be joined or substituted as respondent.*

When a timely opposition in proper form (*see* 37 CFR § 2.101 and 37 CFR § 2.104), with proof of service in accordance with 37 CFR § 2.101(b) has been filed, and the required fee has been submitted, the opposition will be instituted. [Note 1.] The defendant in the opposition is the party shown by the records of the U.S. Patent and Trademark Office to be the current owner of the opposed application, except that the Board, in its discretion, may join or substitute as defendant a party that makes a showing of a current ownership interest in the application.

[Note 2.] *See* TBMP § 512.

When a timely petition to cancel in proper form (*see* 37 CFR § 2.111(a) and 37 CFR § 2.112), together with proof of service in accordance with 37 CFR § 2.111(b), 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.

When a timely petition to cancel in proper form is submitted *on paper*, 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 and correspondence address of the current owner of record of the registration. [Note 5.] To determine the correspondence address of the owner of the registration, the petitioner may consult the Office's Trademark Applications and Registrations Retrieval (TARR) system, accessible through http://tarr.uspto.gov. [Note 6.] The TARR 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).

Next, the Board prepares an institution order wherein it notifies the parties of the formal institution of the proceeding. The institution order includes the identification information described in 37 CFR § 2.105(a), for an opposition, or in 37 CFR § 2.113(a), for a cancellation; states that proceedings in the case will be conducted in accordance with the Trademark Rules of Practice, 37 CFR Part 2, and specifies the due date for the filing of defendant's answer to the complaint. The institution order also sets forth the remaining schedule for the case – deadline for the required discovery conference and for initial and expert disclosures, the opening and closing dates for the discovery period, and assigning each party's time for pretrial disclosures and for taking testimony. [Note 7.] Notification from the Board may be sent by e-mail when a party has provided an e-mail address. [Note 8.]

In any proceeding, when a notice from the Board of the commencement of a proceeding, sent to any respondent or applicant, is returned to the Office undelivered, additional notice may be given by publication in the *Official Gazette*, available via the Office's Web site (http://www.uspto.gov). [Note 9.]

One copy of the institution order is sent to the attorney representing the plaintiff [Note 10], or, if the plaintiff is representing itself, to the plaintiff itself, unless the plaintiff has designated in writing another correspondence address. [Note 11.] 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 12.]

In an opposition, a second copy of the institution order, together with instructions and an electronic link for viewing the opposition and any exhibits thereto in the electronic file for the proceeding via the Board's TTABVUE system, is sent 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 13.] In a cancellation, a second copy of the institution order is sent, together with instructions and an electronic link 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 14.]

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 complaint, 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 15.] The Board may also contact petitioner in an attempt to obtain a better address for registrant.

In a cancellation proceeding, if the party identified by the petitioner pursuant to 37 CFR § 2.112(a) as the current owner of the registration sought to be cancelled is not the record owner thereof, the Board will send to the alleged current owner a courtesy copy of the institution order, together with instructions and an electronic link 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 16.] *See* TBMP § 512.

NOTES:

1. *See* 37 CFR § 2.105.

2. *Cf*. 37 CFR § 2.113(c).

3. 37 CFR § 2.113.

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

5. *See* 37 CFR § 2.112(a) and 37 CFR § 2.112(b).

6. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

7. *See* 37 CFR § 2.120(a); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007). An example of a trial order can be found in the Appendix of Forms.

8. 37 CFR § 2.105(a).

9. *See* 37 CFR § 2.118; Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243-4 (August 1, 2007).

10. 37 CFR § 2.105(b)(1); 37 CFR § 2.113(b)(1).

11. 37 CFR § 2.105(b)(3); 37 CFR § 2.113(b)(3).

12. 37 CFR § 2.105(b)(2) and 37 CFR § 2.113(b)(2). *See* 37 CFR § 2.119(d).

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

14. *See* 37 CFR § 2.113(c).

15. *See* Notice of Final Rulemaking, 54 Fed. Reg. 34886, 34891 (August 22, 1989). *Cf.* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007) ("A plaintiff filing a petition for cancellation is not expected to serve any attorney who may have represented the registrant before the Office in the prosecution of the application that resulted in issuance of the registration").

16. *See* 37 CFR § 2.113(d).

310.02 Defendant's Copy of Institution Order Returned as Undeliverable

***37 CFR § 2.118* Undelivered Office notices.** *When a notice sent by the Office to any registrant or applicant is returned to the Office undelivered, additional notice may be given by publication in the Official Gazette for the period of time prescribed by the Director.*

If an applicant in an opposition is not represented by an attorney or other authorized representative, and the applicant's copy of the notification is returned to the Board as undeliverable, 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 or opposition proceeding, the defendant's copy of the institution order is returned to the Board as undeliverable, or the plaintiff advises the Board that the service copy was returned undeliverable, the Board will make all reasonable efforts to locate the defendant, including inquiring of the plaintiff as to the defendant's current address. If the Board is unable to locate the defendant after reasonable investigation, or if the plaintiff is unable to furnish respondent's current address or notifies the Board that the defendant is no longer in business, notice of the filing of the petition to cancel or notice of opposition will be published in the *Official Gazette,* pursuant to 37 CFR § 2.118. [Note 2.]

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

For information concerning the procedure followed by the Board in a concurrent use proceeding when a communication sent by the Board to a specified excepted user is returned as undeliverable, *see* TBMP § 1106.05.

NOTES:

1. 37 CFR § 2.118.

2. *See* 37 CFR § 2.118; Miscellaneous Changes to Trademark Trial and Appeal Board Rules 72 Fed. Reg. 42242, 42244 (August 1, 2007); Notice of Final Rulemaking, 54 Fed. Reg. 34886, 34891 (August 22, 1989).

310.03 Setting Time for Filing Answer

310.03(a) In General

***37 CFR § 2.105* Notification to parties of opposition proceeding[s].**

(a) *When an opposition in proper form (see §§ 2.101 and 2.104), with proof of service in accordance with § 2.101(b), has been filed and the correct fee has been submitted, the Trademark Trial and Appeal Board shall prepare a notification, which shall identify the title and number of the proceeding and the application involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. If a party has provided the Office with an e-mail address, the notification may be transmitted via e-mail.*

37 CFR § 2.113 Notification to parties of cancellation proceeding.
(a) *When a petition for cancellation in proper form (see §§ 2.111 and 2.112), with proof of service in accordance with § 2.111(b), has been filed and the correct fee has been submitted, the Trademark Trial and Appeal Board shall prepare a notification which shall identify the title and 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 notification, within which an answer must be filed. If a party has provided the Office with an e-mail address, the notification may be transmitted via e-mail.*

As provided by 37 CFR § 2.105(a) and 37 CFR § 2.113(a), in part, the Board's notification 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 notification, 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 notification 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 notification 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) Five-Day Addition Under 37 CFR § 2.119(c) Not Applicable to Deadlines Set by Board

As provided by 37 CFR § 2.119(c), in part, "[w]henever a party is required to take some action within a prescribed period after the service of a paper upon the party by another party and the paper is served by first-class mail, 'Express Mail' or overnight courier, 5 days shall be added to the prescribed period." This provision, by its very terms, applies only when a party has to take some action within a prescribed period after the service of a paper on it by another party (and service of the paper was made in one of three specified ways). It does not apply to an action that must be taken by a party within a time set in a communication from the Board [Note 1] or when service is effected in other than the three specified ways, such as when the parties have agreed to accept service by e-mail or by facsimile transmission. [Note 2.]

Thus, when a Board notification allows the defendant 40 days from the mailing date of the notification in which to file an answer to the complaint, the answer is due on or before the 40th day, not on the 45th day. Similarly, when the Board allows a counterclaim defendant 30 days from the mailing date of the Board's notification in which to file an answer to the counterclaim, the answer is due on or before the 30th day, not on the 35th day.

NOTES:

1. *See Amazon Technologies, Inc. v. Wax*, 95 USPQ2d 1865, 1867 n.4 (TTAB 2010) (where due date for opposer's responses to discovery was set by Board order to fall on a Sunday, the responses were timely served on the following Monday).

2. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42250 (August 1, 2007).

310.03(c) Extension of Time to File Answer

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.

For cases commenced on or after November 1, 2007, the discovery period does not open until after an answer has been filed, and concurrently with the deadline for the mandatory discovery conference. However, for cases filed before November 1, 2007, the discovery period opens before the answer is due. Regardless, due dates for answers to complaints may not be extended beyond the close of the discovery period. Any motion to extend the time to answer beyond the close of discovery, even if consented, will be denied. Thus, any extension request, which would reset the time to answer beyond the date presently set for the close of discovery, must also include a request for an extension of the discovery period.

Please Note: By using ESTTA to file requests for extension of time to file an answer, parties are ensured that any date selected will not be beyond the close of the discovery period. The ESTTA system will prompt the filer to enter new deadlines in a manner that will generate an appropriate schedule in the proper form and will not allow a party to request an extension date that is later than the close of the discovery period.

NOTES:

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

311 Form and Content of Answer

311.01 Form of Answer

***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.*

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

The form of an answer must meet the general requirements for submissions to the Board set forth in 37 CFR § 2.126. *See* TBMP § 106.03. If an answer is filed electronically through ESTTA, the text in the electronic submission must be in at least 11-point type and double-spaced and any exhibits pertaining to the electronic submission must be made electronically as an attachment to the answer. [Note 2.] If the answer is submitted on paper, the submission, including any exhibits, may not be stapled or bound or have any extruding tabs, and must otherwise comply with the requirements of 37 CFR § 2.126(a) in order to permit efficient scanning.

A party may no longer make submissions in CD-ROM format that could otherwise be

submitted on paper or filed electronically as a digital image through ESTTA. The Board will not return an inappropriately filed CD-ROM to the party which filed it. [Note 3.]

NOTES:

1. *See* 37 CFR § 2.116(c).

2. *See* 37 CFR § 2.126(b).

3. *See* 37 CFR § 2.126(a) and 37 CFR § 2.126(b).

311.01(a) Format for Answer

An answer need not follow a particular format, as long as the answer meets the requirements for the particular type of submission to the Board (37 CFR § 2.126(a) for paper and 37 CFR § 2.126(b) for electronic filings through ESTTA), 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

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

The Board views the electronic signature on the ESTTA filing form as pertaining to all attachments thereto. [Note 2.] 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 signature on any attachment to the filing form. [Note 3.]

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 4.] 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.).

Although an answer must be signed, an unsigned answer will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board. [Note 5.] *See* TBMP § 106.02.

NOTES:

1. *See* 37 CFR § 2.119(e).

2. *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 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").

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

4. *Cf.* TMEP § 712 (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).

5. *See* 37 CFR § 2.119(e).

311.01(c) Filing and Service of Answer

One copy of the answer, and any exhibits thereto, must be filed with the Board. 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. 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 paper will be considered by the Board. [Note 1.] *See* TBMP § 113.

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

NOTES:

1. *See* 37 CFR § 2.119(a).

311.02 Substance of Answer

37 CFR § 2.106(b)(1) *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 need 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 and date of issuance in an original notice of opposition or in any amendment thereto made under Rule 15, Federal Rules of Civil Procedure.*

37 CFR § 2.106(b)(2)(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 it is the subject of another proceeding between the same parties or anyone in privity therewith.*

(ii) *An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.*

37 CFR § 2.114(b)(1) *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 need not be filed. When a defense attacks the validity of a registration pleaded in the petition, paragraph (b)(2) of this section shall govern. A pleaded registration is a registration identified by number and date of issuance in an original petition for cancellation or in any amendment thereto made under Rule 15, Federal Rules of Civil Procedure.*

(2)(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 it is the subject of another proceeding between the same parties or anyone in privity therewith.*

(ii) *An attack on the validity of a registration pleaded by a petitioner for cancellation will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.*

37 CFR § 2.133(d) *A plaintiff's pleaded registration will not be restricted in the absence of a counterclaim to cancel the registration in whole or in part, except that a counterclaim need not be filed if the registration is the subject of another proceeding between the same parties or anyone in privity therewith.*

311.02(a) Admissions and Denials

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

A denial of an allegation should fairly meet the substance of the allegation denied, and may take any of the forms described in Fed. R. Civ. P. 8(b). [Note 2.] An answer that fails to deny a portion of an allegation may be deemed admitted as to that portion. *See* Fed. R. Civ. P. 8(d). Thus, if a defendant intends in good faith to deny only a part or a qualification of an allegation, the defendant should admit so much of the allegation as is true and material and should deny only the remainder. If a defendant intends in good faith to controvert all of the allegations contained in a complaint, including the jurisdictional grounds, the defendant may do so by general denial, subject to the obligations set forth in Fed. R. Civ. P. 11 (for a discussion of Fed. R. Civ. P. 11 in relation to pleadings, *see* TBMP § 318). If a defendant does not intend in good faith to controvert all of the allegations contained in a complaint, the defendant may make its denials as specific denials of designated allegations or paragraphs, or may generally deny all the allegations except those designated allegations or paragraphs which are expressly admitted. [Note 3.]

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

NOTES:

1. *See* 37 CFR § 2.106(b)(1) and 37 CFR § 2.114(b)(1); 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 (TTAB 1996) (applicant's answers were argumentative and nonresponsive and Board was ultimately forced to interpret the answer); *National Football League v. Jasper Alliance Corporation*, 16 USPQ2d 1212 (TTAB 1990) (applicant's answer was more in the nature of argument than answer); and *Thrifty Corp. v. Bomax Enterprises*, 228 USPQ 62, 63 (TTAB 1985).

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

311.02(b) Affirmative Defenses

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

Equitable defenses may not be available against certain grounds for opposition or cancellation or under certain circumstances. For example, the availability of laches and acquiescence is severely limited in opposition and cancellation proceedings. In Board opposition proceedings, these defenses start to run from the time of knowledge of the application for registration (that is, from the time the mark is published for opposition), not from the time of knowledge of use. In Board cancellation proceedings, these defenses start to run from the date of registration, in

the absence of actual knowledge before the close of the opposition period. [Note 6.] Moreover, for public policy reasons, the defenses of laches and acquiescence may not be available against claims such as genericness, descriptiveness, fraud, abandonment and functionality, and further, may not apply in a case of likelihood of confusion if it is determined in the case that confusion is inevitable. [Note 7.]

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

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

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

A defendant may state as many separate defenses as it has, regardless of consistency; a defendant may also set forth two or more statements of a defense alternately or hypothetically, either in one count or in separate counts. [Note 17.] For example, an applicant whose application for registration has been opposed under Trademark Act § 2(d), 15 U.S.C. § 1052(d), on the ground of opposer's alleged prior use of its mark, coupled with an allegation of likelihood of confusion, might deny that there is any likelihood of confusion with respect to its mark and goods as set forth in the application. At the same time, the applicant might plead alternatively that it actually uses its mark only on a specific type (identified in the pleading) of the goods covered by the broad identification in its application; that there is no likelihood of confusion with respect to applicant's actual goods; and that even if the Board ultimately finds that opposer is entitled to judgment with respect to applicant's goods as broadly identified, applicant would be entitled to a registration of its mark with a restricted identification reflecting the actual nature of its goods. [Note 18.] *See* TBMP § 309.03(d) and TBMP § 514.

When two or more statements are made in the alternative, the sufficiency of each is determined independently; the fact that one of them may be insufficient does not mean that the other(s) is (are) also insufficient. [Note 19.]

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

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

Although 37 CFR § 2.106(b)(2)(ii) and 37 CFR § 2.114(b)(2)(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 covering 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.]

NOTES:

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

2. *See* 37 CFR § 2.106(b)(1) and 37 CFR § 2.114(b)(1). *See, e.g., Giersch v. Scripps Networks Inc.,* 90 USPQ2d 1020, 1021 n.4 (TTAB 2009) (affirmative defenses waived if not maintained in party's trial brief); *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.,* 86 USPQ2d 1283 (TTAB 2008) (comparison of marks for purposes of determining whether marks are essentially the same under the *Morehouse* doctrine); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1222 (TTAB 1995) (Fed. R. Civ. P. 12(b) permits a defendant to assert in the answer the "defense" of failure to state a claim upon which relief can be granted).

See, e.g., with respect to estoppel, *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG,* 87 USPQ2d 1526, 1530 (TTAB 2008) (contractual and equitable estoppel); *Tea Board of India v. Republic of Tea Inc.,* 80 USPQ2d 1881, 1884 n.6 (TTAB 2006) (licensee estoppel); *Freeman v. National Association of Realtors,* 64 USPQ2d 1700 (TTAB 2002) (licensee estoppel); *Leatherwood Scopes International Inc. v. Leatherwood,* 63 USPQ2d 1699, 1702 (TTAB 2002) (licensee estoppel); and *M-5 Steel Mfg. Inc. v. O'Hagin's Inc.,* 61 USPQ2d 1086 (TTAB 2001)

(contractual estoppel). *Cf. Textron, Inc. v. The Gillette Company*, 180 USPQ 152, 154 (TTAB 1973) (defense of file wrapper estoppel not available in trademark cases, but since statement in ex parte proceeding may be admitted as possible admission against interest, statement not stricken from answer).

See, e.g., with respect to "*Morehouse*" defense, *Morehouse Manufacturing Corp. v. J. Strickland and Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969) (that defendant already owns a substantially similar registered mark for substantially similar goods and/or services such that the second registration (or second registration sought) causes no added injury to the plaintiff). *See also O-M Bread Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995) (*Morehouse* defense). *Cf. Land O' Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1958 (TTAB 2008) (cannot rely upon expired registration for *Morehouse* defense); *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.*, 86 USPQ2d 1283 (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) *aff'd unpub*, 208 Fed. Appx. 886, 887 (Fed. Cir. Dec. 6, 2006) (*Morehouse* defense fails where goods in the involved registration are clearly different from those in prior registrations).

See, e.g., with respect to prior judgment, *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 86 USPQ2d 1369 (Fed. Cir. 2008) (claim of trademark invalidity, made before Board in cancellation proceeding, amounted to collateral attack on court's judgment rendered in first action); *International Nutrition Co. v. Horphag Research Ltd*., 220 F.3d 1325, 55 USPQ2d 1492 (Fed. Cir. 2000) (res judicata); *Jet Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854 (Fed. Cir. 2000), (res judicata, claim preclusion); *Boston Chicken Inc. v. Boston Pizza International, Inc.*, 53 USPQ2d 1053 (TTAB 1999) (judicial estoppel); and *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318 (TTAB 1990) (claim preclusion, issue preclusion). *Cf. Mayer/Berkshire Corp. v. Berkshire Fashions Inc.*, 424 F.3d 1229, 76 USPQ2d 1310 (Fed. Cir. 2005) (Board erred in dismissing opposition on res judicata and collateral estoppel grounds where issues and transactional facts arising from prior district court infringement litigation differed from those in opposition proceeding); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008) (res judicata argument fails because marks at issue in prior proceedings were different); *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500 (TTAB 2007) (neither claim nor issue preclusion apply where parties are not the same).

See, e.g., with respect to laches, *Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460 (Fed. Cir. 2001). *See also National Cable Television Association, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991) (laches runs from the time action could be taken against the acquisition of trademark rights which flow from registration of mark); *Land O' Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1959 (TTAB 2008) (where laches defense based on failure to object to an expired registration, asserted period of delay begins on issue date of prior registration and ends with its expiration); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008) (no evidence that opposer knew of applicant's use of its mark in the U.S.); *Herbaceuticals Inc. v. Xel Herbaceuticals Inc.*, 86 USPQ2d 1572, 1575 n.3

(TTAB 2008) (laches is unavailable as an affirmative defense against a claim of fraud); *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) *aff'd unpub'd*, 208 Fed. Appx. 886, 887 (Fed. Cir. Dec. 6, 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); *Chester L. Krause v. Krause Publications, Inc.*, 76 USPQ2d 1904 (TTAB 2005) (same); and *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004).

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

3. *See* 37 CFR § 2.133(a). *Cf.* 37 CFR § 2.133(b) and 37 CFR § 2.133(c).

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

5. *See* 37 CFR § 2.133(a) and 37 CFR § 2.133(b). *See also Montecash LLC v. Anzar Enterprises, Inc.*, 95 USPQ2d 1060 (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); *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); *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); and *Flow Technology Inc. v. Picciano,* 18 USPQ2d 1970, 1972 (TTAB 1991) (applicant's argument on summary judgment that parties' channels of trade were different not persuasive where applicant's claim of entitlement to narrower range of goods was not put in issue by motion or amendment to its pleading). *Cf. Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1846 (TTAB 2008) (amendment in Trademark Act § 8, 15 U.S.C. § 1058 affidavit filed during pendency of cancellation proceeding granted as unconsented motion to amend).

6. *See National Cable Television Association v. American Cinema Editors Inc*., 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.,* 934 F.2d 1551, 19 USPQ2d 1401, 1404-05 (11th Cir. 1991); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG,* 87 USPQ2d 1526, 1531 (TTAB 2008) (conduct which occurs prior to publication of application for opposition generally cannot support a finding of equitable estoppel); *Jansen Enterprises Inc. v. Rind,* 85 USPQ2d 1104, 1114 (TTAB 2007) (in the absence of actual notice prior to the close of the opposition period, the date of registration is the operative date for calculating laches); *Barbara's Bakery Inc. v. Landesman,* 82 USPQ2d 1283, 1292 n.14 (TTAB 2007) (defenses of laches, acquiescence or estoppel generally not available in opposition proceeding); *Turner v. Hops Grill & Bar Inc.,* 52 USPQ2d 1310, 1312 (TTAB 1999); and *University Book Store v. University of Wisconsin Board of Regents,* 33 USPQ2d 1385, 1401 n.39 (TTAB 1994) (equitable defenses are not grounds for opposition). *But see, Fishking Processors Inc. v. Fisher King Seafoods Ltd.,* 83 USPQ2d 1762 (TTAB 2007) (defendant may assert laches defense in cancellation even though defendant's registration on which defense is based was cancelled during the pendency of the cancellation proceeding for failure to file affidavit under Trademark Act § 8, 15 U.S.C. § 1058); *Aquion Partners L.P. v. Envirogard Ltd*., 43 USPQ2d 1371, 1373 (TTAB 1991) (laches defense in an opposition may be based on opposer's failure to object to an earlier expired registration of substantially the same mark for substantially the same goods).

7. *See Herbaceuticals Inc. v. Xel Herbaceuticals Inc.,* 86 USPQ2d 1572, 1575 n.3 (TTAB 2008) (laches is unavailable as an affirmative defense against a claim of fraud); *Christian Broadcasting Network Inc. v. ABS-CBN International,* 84 USPQ2d 1560, 1572 (TTAB 2007) (equitable defenses such as laches and acquiescence would not preclude a judgment for plaintiff if confusion is inevitable); *Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003) (it is within the public interest to have certain registrations removed from the register and this interest, *quoting W. D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.,* 146 USPQ 313, 316 (TTAB 1965), *aff'd*, 377 F.2d 1001, 153 USPQ 749 (CCPA 1967), "cannot be waived by the inaction of any single person or concern no matter how long the delay persists."). *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); and *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1131 (TTAB 1990) (same). *Cf. 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); *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"); *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); and *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318 (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 (CCPA 1969); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989).

9. *See Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.*, 86 USPQ2d 1283, 1285 (TTAB 2008) (doctrine of foreign equivalents does not apply with respect to *Morehouse* analysis); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989) (*Morehouse* defense is unavailable where issue is abandonment, descriptiveness, or fraud); and *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 1 USPQ2d 1497 (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 (2004).

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

13. *American Express Marketing & Development Corp. v. Gilad Development Corp.*, 94 USPQ2d 1294, 1298 (TTAB 2010).

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); and *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); and *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 47 (TTAB 1985) (bald allegations in the language of the statute, did not provide fair notice of basis of petitioner's Trademark Act § 2(a), 15 U.S.C. § 1052(a) claim).

16. *See* 37 CFR § 2.106(b)(1) and 37 CFR § 2.114(b)(1); *In re Bose Corp*., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009); *Enbridge, Inc. v. Excelerate Energy Limited Partnership*, 92 USPQ2d 1537 (TTAB 2009); *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478 (TTAB 2009).

17. *See* Fed. R. Civ. P. 8(d)(2). *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); and *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48, 49 (TTAB 1971) (in seeking to cancel on ground of abandonment, plaintiff asserted proper hypothetical pleading of likelihood of confusion as its basis for standing).

18. *Cf*. 37 CFR § 2.133(b).

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

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

21. *See* 37 CFR § 2.106(b) and 37 CFR § 2.114(b); *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., Inc. v. The Englander Company, Inc.*, 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); and *Textron, Inc. v. The Gillette Company*, 180 USPQ 152, 153 (TTAB 1973) (defense attacking validity of pleaded registration must be raised by way of cancellation of registration). *Cf. Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1884 n.5 and 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 (TTAB 1977); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

22. *See* 37 CFR § 2.133(d); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1287 (TTAB 1998) (applicant's request raised in reply brief for a restriction of opposer's registration [beyond applicant's initial counterclaim to restrict] was untimely as it should have been raised by promptly moving to amend).

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

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 H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008) (the reason for requiring an affirmative defense to be pleaded is to give the plaintiff notice of the defense and an opportunity to respond; defense of tacking must be pleaded to put opposer on notice of new matter that applicant is placing at issue); *Diaz v. Servicios De Franquicia Pardo's S.A.C.*, 83 USPQ2d 1320, 1322 (TTAB 2007) (answer deemed amended to assert applicant's priority over opposer pursuant to Article 7 of the Pan American Convention); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1290 (TTAB 2007) (applicant's affirmative defense deemed to have been tried by the implied consent of the parties); *Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715, 1717 n.5 (TTAB 1991) (defense that opposer lacks proprietary rights in its common law mark raised for first time in final brief was neither pleaded nor tried); *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 341 (TTAB 1984) (laches is an affirmative defense which must be specifically pleaded); *Trans Union Corp. v. Trans Leasing International, Inc.*, 200 USPQ 748, 754 (TTAB 1978) (defense of laches, which was raised by applicant in its final brief, was not pleaded in answer but was tried by implied consent of opposer); *United States Mineral Products Co. v. GAF Corp.*, 197 USPQ 301, 304 n.5 (TTAB 1977) (the equitable defenses set forth in Trademark Act § 19, 15 U.S.C. § 1069 are affirmative defenses which must be affirmatively pleaded and in this case were neither pleaded nor tried); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585, 590 (TTAB 1977) (laches, while not affirmatively pleaded, was nevertheless tried and briefed by both parties without objection); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246, 251 (TTAB 1977) (laches and acquiescence were neither pleaded nor tried); and *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154 (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); *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) (objection to certain paragraphs of answer as verbose and argumentative not well taken); and *McCormick & Co. v.*

Hygrade Food Products Corp., 124 USPQ 16, 17 (TTAB 1959) (allegation that registered mark is weak does not constitute a collateral attack on validity of opposer's registrations). *Cf. Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1572 (TTAB 1988).

311.03 Reply to Answer Should Not be Filed

Although 37 CFR § 2.106(b) and 37 CFR § 2.114(b) require that an answer to a counterclaim be filed, within the time designated by the Board, they specifically provide that a reply to an affirmative defense need not be filed. [Note 1.] Similarly, Fed. R. Civ. P. 7(a) provides that there shall be a complaint and an answer and a reply to a counterclaim denominated as such; that certain other specified pleadings, not relevant to Board proceedings (and not including a reply to an answer), shall be allowed; but that "[o]nly these pleadings are allowed," except that the court may order a reply to an answer.

Thus, while a plaintiff must file an answer to a counterclaim, a reply to an answer need not, and should not, be filed.

NOTES:

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

312 Default

312.01 In General

37 CFR § 2.106(a) *If no answer is filed within the time set, the opposition may be decided as in case of default.*

37 CFR § 2.114(a) *If no answer is filed within the time set, the petition may be decided as in case of default.*

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, which would be served on defendant by plaintiff, 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.

Please Note: In instances where the defendant is in default, the parties' obligations to conference and, subsequently, to make initial disclosures is effectively stayed. [Note 5.] If default is set aside, the Board will reset the deadline for the discovery conference as well as all subsequent dates. [Note 6.] For more information regarding the parties' obligations with respect to initial disclosures and the discovery conference, *see* TBMP § 401.01, TBMP § 404.02, TBMP § 408.01(a), and TBMP § 408.01(b).

NOTES:

1. *See* 37 CFR § 2.106(a) and 37 CFR § 2.114(a); Fed. R. Civ. P. 55(a), 55(b) and 55(c); *DeLorme Publishing Co v. Eartha's Inc*., 60 USPQ2d 1222, 1224 (TTAB 2000); *Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899, 1902-03 (Comm'r 1990); and *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 (TTAB 2000) (motion for default judgment); *Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899, 1902-03 (Comm'r 1990) (plaintiff's motion for default judgment and defendant's motion to accept late answer); and *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); and *Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899 (Comm'r 1990).

5. Miscellaneous Changes to Trademark Trial and Appeal Board Rules 72 Fed. Reg. 42242, 42245 (August 1, 2007).

6. Miscellaneous Changes to Trademark Trial and Appeal Board Rules 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 Limited Partnership v. Paolo 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); and *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556, 1557 (TTAB 1991) (failure to answer due to inadvertence on part of applicant's counsel; answer had been prepared and reviewed by applicant but counsel inadvertently failed to file it; nine-day delay would cause minimal prejudice; by submission of answer which was not frivolous meritorious defense was shown). *Cf.* regarding a motion to set aside judgment under Fed. R. Civ. P. 60(b), *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991) (the two other factors having been shown, applicant was allowed time to show meritorious defense by submission of answer).

3. *See DeLorme Publishing Co v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2000).

4. *See, e.g., Identicon Corp. v. Williams*, 195 USPQ 447, 449 (Comm'r 1977) (fact that in response to order to show cause applicant filed answer but no response to show cause order does not mandate entry of default judgment; applicant allowed time to show cause).

5. *See DeLorme Publishing Co v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2000) (although no specific prejudice to opposer, and while meritorious defense was shown, Board found applicant's conduct amounted to gross neglect and granted motion for default judgment where applicant filed its answer six months late, viewing the notice of opposition as "incomplete," instead of filing appropriate motion or taking other appropriate action).

312.03 Setting Aside Default Judgment

The standard for setting aside default judgment is stricter than the standard for setting aside a notice of default.

A notice of default may be set aside on a showing of good cause. [Note 1.] *See* TBMP § 312.02. However, once default judgment has actually been entered against a defendant pursuant to Fed. R. Civ. P. 55(b), the judgment may be set aside only in accordance with Fed. R. Civ. P. 60(b), which governs motions for relief from final judgment. The stricter standard reflects public policy favoring finality of judgments and termination of litigation. [Note 2.]

The factors considered in determining a motion to set aside notice of default are also considered in determining a motion for relief from a default judgment entered pursuant to Fed. R. Civ. P. 55. [Note 3.] Among the factors to be considered in determining a motion to vacate a default judgment for failure to answer the complaint are (1) whether the plaintiff will be prejudiced, (2) whether the default was willful, and (3) whether the defendant has a meritorious defense to the action. [Note 4.]

However, the showing submitted by the defendant is likely to be viewed with less leniency when defendant seeks relief from default judgment than when defendant seeks to show cause why default judgment should not be entered against it. [Note 5.]

Nevertheless, because default judgments for failure to timely answer the complaint are not favored by the law, a motion under Fed. R. Civ. P. 55(c) or 60(b) seeking relief from such a

judgment is generally treated with more liberality by the Board than are other motions under Fed. R. Civ. P. 60(b) for relief from other types of judgments such as default judgments entered against plaintiffs for failure to prosecute the case. [Note 6.]

For information concerning motions under Fed. R. Civ. P. 60(b) for relief from final judgment, *see* TBMP § 544.

NOTES:

1. *See* Fed. R. Civ. P. 55(c).

2. *See Waifersong Ltd. Inc. 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. *Cf. Paolo's Associates Limited Partnership v. Paolo 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 3d § 2692 (2009); and *Waifersong Ltd. Inc. 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); and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (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. Inc. 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); and 10A C.WRIGHT, A. MILLER & M. KANE, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2692 (2009).

6. *Cf. Djeredjian v. Kashi Co.*, 21 USPQ2d 1613 (TTAB 1991) and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (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); and *Williams v. Five Platters, Inc.*, 181 USPQ 409, 410 (TTAB 1974), *aff'd*, 510 F.2d 963, 184 USPQ 744 (CCPA 1975) (motion to set aside default judgment for failure to respond to motion for summary judgment denied; carelessness and inattention of counsel). *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 3d § 2693 (2009).

313 Counterclaims

313.01 In General

37 CFR § 2.106(b)(2)(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 it is the subject of another proceeding between the same parties or anyone in privity therewith.*

(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 within which an answer to the counterclaim must be filed.*

(iv) *The times for pleading, discovery, testimony, briefs or oral argument will be reset or extended when necessary, upon motion by a party, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.*

37 CFR § 2.114(b)(2)(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 it is the subject of another proceeding between the same parties or anyone in privity therewith.*

(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 within which an answer to the counterclaim must be filed.*

(iv) *The times for pleading, discovery, testimony, briefs, or oral argument will be reset or extended when necessary, upon motion by a party, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.*

The Board cannot entertain an attack upon the validity of a registration pleaded by a plaintiff unless the defendant timely files a counterclaim or a separate petition to cancel the registration. [Note 1.]

Although 37 CFR § 2.106(b)(2)(ii) and 37 CFR § 2.114(b)(2)(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 covering 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(b). The counterclaimant must allege that the partial cancellation will avoid a likelihood of confusion and that the registrant does not use the mark on the goods or services for which deletion is being sought. [Note 9.] On the other hand, a counterclaim to delete goods or services from the registration on the ground that registrant

does not use the mark on those goods or services and has no intent to resume use, without regard to likelihood of confusion, is a straightforward abandonment claim and not a claim under Trademark Act § 18, 15 U.S.C. § 1068 and in such case, counterclaimant need not allege that a likelihood of confusion will be avoided through the restriction. [Note 10.]

A counterclaim is the legal equivalent of a petition to cancel. Thus, the provisions of 37 CFR § 2.111-37 CFR § 2.115, governing petitions to cancel, are applicable to counterclaims. [Note 11.]

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 § 401.03. 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. [Note 13.] *See also* TBMP § 509, regarding motions to extend.

NOTES:

1. *See* 37 CFR § 2.106(b)(2)(ii) and 37 CFR § 2.114(b)(2)(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 Company, Inc.*, 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); *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 n.5 and n.12 (TTAB 2006) (a showing of descriptiveness or genericness of part of a mark does not constitute a collateral attack on the registration; however arguments directed to show opposer failed to exercise control over logo mark, where only word mark registration was challenged, constitutes impermissible attack on logo mark).

2. *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989).

3. *See Vitaline Corp. v. General Mills Inc*., 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989).

4. *See Pyttronic Industries Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 n.2 (TTAB 1990) (counterclaim to cancel "any registration which might issue in the future from pleaded application" stricken as improper); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983) (counterclaim to "refuse any application filed by petitioner" was improper).

5. *See* Trademark Act § 18, 15 U.S.C. § 1068; 37 CFR § 2.111(b) and 37 CFR § 2.133(b).

6. *See Montecash LLC v. Anzar Enterprises, Inc.* 95 USPQ2d 1060 (TTAB 2010) (partial cancellation on the ground that portion of the mark is a generic term unavailable where the registration sought to be cancelled is more than 5 years old); *Dak Industries, Inc. v. Daiichi Kosho Co*., 35 USPQ2d 1434, 1437 (TTAB 1995) ("a claim for cancellation by restriction or modification …is an equitable remedy …, not tied to a ground to cancel").

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

8. *See Dak Industries, Inc. v. Daiichi Kosho Co*., 35 USPQ2d 1434, 1437 (TTAB 1995) ("a claim for cancellation by restriction or modification …is an equitable remedy …, not tied to a ground to cancel")*; Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG,* 34 USPQ2d 1266, 1271 n.3 (TTAB 1995) ("[t]he restriction provisions of Section 18 are in the nature of an equitable remedy"). *See also, e.g., Penguin Books Ltd. v. Eberhard,* 48 USPQ2d 1280, 1286 (TTAB 1998) (counterclaim to partially cancel pleaded registration to restrict scope of goods therein did not preclude opposer's reliance on pleaded registration to establish priority in the opposition).

9. *See Eurostar Inc. v. "Euro-Star" Reitmoden Gmbh & Co.* 34 USPQ2d 1266, 1271 n.3 (TTAB 1995).

10. *See DAK Industries Inc. v. Daiichi Kosho Co*., 35 USPQ2d 1434, 1437 (TTAB 1995).

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

12. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42255 (August 1, 2007) ("In short, there are many potential triggers that will prompt the Board to reset discovery, disclosure and trial dates").

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

313.02 Fee For Counterclaim

37 CFR § 2.106(b)(2)(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 within which an answer to the counterclaim must be filed.*

37 CFR § 2.114(b)(2)(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 within which an answer to the counterclaim must be filed.*

A counterclaim for cancellation of a plaintiff's registration is the legal equivalent of a separate petition to cancel. The required filing fee must be paid when a petition to cancel takes the form of a counterclaim, just as it must be paid when a petition to cancel takes the form of a separate proceeding. [Note 1.] That is, the required fee (see 37 CFR § 2.6) must be paid for each party joined as counterclaimant for each class sought to be cancelled in each registration against which the counterclaim is filed. [Note 2.] *Cf.* TBMP § 308.02.

If no fee is submitted with the counterclaim, or the fee is insufficient to pay for one person to counterclaim to cancel the registration in at least one class, the counterclaim will be rejected. If the counterclaim is accompanied by fees sufficient to pay for one person to counterclaim to cancel the registration in at least one class, but less than the required amount because multiple party counterclaimants and/or multiple classes in the registration are involved, the fee(s) submitted will be applied in the manner set forth in 37 CFR § 2.111(c)(3)(ii)-37 CFR § 2.111(c)(3) (iii). The Board, in its notice acknowledging the counterclaim, will identify the parties and classes for which the required fees were submitted.

NOTES:

1. *See* 37 CFR § 2.106(b)(2)(iii) and 37 CFR § 2.114(b)(2)(iii); *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 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); and *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 (Fed. Cir. 2010) (Board's decision denying petitioner's motion for leave to amend cancellation petition because petitioner did not pay fee for amendment at time of filing the motion, reversed; case remanded to Board for further consideration of motion to amend.

2. *See* 37 CFR § 2.111(c) and 37 CFR § 2.112(b).

313.03 Form and Substance of Counterclaim; Service of Counterclaim

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.

Moreover, just as a plaintiff filing a separate petition to cancel must serve a copy thereof on the defendant(s), [Note 1], 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 2.]

The pleading of the substance of a counterclaim may also differ somewhat from the pleading of the substance of a separate petition to cancel. For example, a counterclaimant need not plead its standing to assert a counterclaim to cancel a registration pleaded by the plaintiff in its complaint. The counterclaimant's standing in such a case is inherent in its position as defendant to the complaint. [Note 3.]

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 4.]

NOTES:

1. *See* 37 CFR § 2.111(a) and 37 CFR § 2.119(a).

2. *See* 37 CFR § 2.119(a).

3. *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 (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 Corporation 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); and *General Mills, Inc. v. Natures Way Products*, 202 USPQ 840, 841 (TTAB 1979).

4. *See, e.g.*, *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 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 Company 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); and *Sunbeam Corp. v. Duro Metal Products Co*., 106 USPQ 385, 386 (Comm'r 1955). *See also* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 20:67 (4th ed. 2010). *Cf*. 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).

313.04 Compulsory Counterclaims

37 CFR § 2.106(b)(2)(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 it is the subject of another proceeding between the same parties or anyone in privity therewith.*

37 CFR § 2.114(b)(2)(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 it is the subject of another proceeding between the same parties or anyone in privity therewith.*

Counterclaims for cancellation of pleaded registrations in Board proceedings are governed by 37 CFR § 2.106(b)(2)(i) and 37 CFR § 2.114(b)(2)(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.]

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 4.]

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 5.]

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 6.]

NOTES:

1. *See* 37 CFR § 2.106(b)(2)(i) and 37 CFR § 2.114(b)(2)(i). *See also TBC Corp. v. Grand Prix Ltd*., 12 USPQ2d 1311, 1313 (TTAB 1989) (although parties referred to the "when justice requires" element of Fed. R. Civ. P. 13(f), counterclaims to cancel pleaded registrations in oppositions are governed by 37 CFR § 2.106(b)(2)(i)). *But see See's Candy Shops Inc. v. Campbell Soup Co.,* 12 USPQ2d 1395 (TTAB 1989) (Board applied Fed. R. Civ. P. 13(f) "when justice requires" standard where grounds for counterclaim filed as a separate petition to cancel were known at time of answer to opposition). **Please Note**: Effective December 1, 2009, Fed. R. Civ. P. 13(f) was abrogated as being redundant of Fed. R. Civ. P. 15(a)(2). That section still holds that leave should be freely given "when justice so requires."

2. *See Vitaline Corp. v. General Mills Inc*., 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989); *TBC Corp. v. Grand Prix Ltd.,* 12 USPQ2d 1311, 1314 (TTAB 1989) (since it was unclear from applicant's submissions to amend whether counterclaim was timely, i.e., whether grounds were known by applicant at time original answer was filed, applicant was allowed time to explain why it was not pleaded with answer); *S & L Acquisition Co. v. Helene Arpels Inc.,* 9 USPQ2d 1221, 1224 (TTAB 1987) (motion to amend answer to add additional ground to existing counterclaim denied since such ground was available at time of original answer); and *Consolidated Foods Corp. v. Big Red, Inc.*, 231 USPQ 744, 746 (TTAB 1986) (petitioner cannot avoid effect of its failure to timely assert counterclaim at time it filed its answer as defendant in prior opposition since grounds existed and were known to petitioner at that time). *But see See's Candy Shops Inc. v. Campbell Soup Co.,* 12 USPQ 1395, 1397 (TTAB 1989) (although counterclaim [filed as separate petition to cancel] was premised on facts known by applicant at time it filed its answer in the opposition, Board allowed the petition to go forward, notwithstanding that the petition was filed two weeks after answer was filed in the opposition).

3. *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989); *Zanella Ltd. v. Nordstrom Inc.*, 90 USPQ2d 1758 (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), *summ. judgment granted*, 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); and *M. Aron Corporation 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 (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); and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974) (same).

4. *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989); *Consolidated Foods Corp. v. Big Red, Inc.*, 231 USPQ 744, 746 (TTAB 1986).

5. *See Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd*, 22 USPQ2d 1594 (TTAB 1992) *summ. judgment granted*, 24 USPQ2d 1376 (TTAB 1992).

6. *See* 37 CFR § 2.106(b)(2)(i) and 37 CFR § 2.114(b)(2)(i); *M. Aron Corporation v. Remington Products, Inc*., 222 USPQ 93 (TTAB 1984). *See also* Notice of Final Rulemaking, 46 Fed. Reg. 6940 (January 22, 1981).

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 receipt in the Office of the counterclaim, with proof of service on the owner of record, or on the owner's domestic representative, if one has been appointed, at the correspondence address of record in the Office, and with the required fee, unless the counterclaim is filed by "Express Mail" in accordance with 37 CFR § 2.198. [Note 2.]

For information on fees for counterclaims, *see* TBMP § 308.02 and TBMP § 313.02. *See also* TBMP § 308.02(b).

NOTES:

1. *See* Fed. R. Civ. P. 13(b). *Cf.* 37 CFR § 2.106(b)(2)(i) and 37 CFR § 2.114(b)(2)(i).

2. 37 CFR § 2.111(c)(4).

313.06 Answer to Counterclaim

37 CFR § 2.106(b)(2)(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 within which an answer to the counterclaim must be filed.*

37 CFR § 2.114(b)(2)(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 within which an answer to the counterclaim must be filed.*

37 CFR § 2.114(a) *If no answer is filed within the time set, the petition may be decided as in case of default.*

When a counterclaim (together with proof of service and the required cancellation fee) is 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. *See* TBMP § 310.03(b) (five-day addition under 37 CFR § 2.119(c) does not apply to deadlines set by Board). A copy of the order is sent to each party to the proceeding, or to each party's attorney or other authorized representative. The order will also include a trial schedule and briefing dates to accommodate the counterclaim, which will reset or extend, as appropriate, the times for discovery (including conferencing and initial and expert disclosure dates), pretrial disclosures, testimony, briefs and/or oral argument. [Note 2.]

If no answer to the counterclaim is filed during the time allowed, the counterclaim may be decided as in case of default. [Note 3.] For information concerning default for failure to answer, *see* TBMP § 312.

An answer to a counterclaim should be in the same form as an answer to a complaint. For information on the proper form for an answer to a complaint, *see* TBMP § 311.01.

An answer to a counterclaim, like any other answer, may include a counterclaim for cancellation of a registration owned by the counterclaimant. A defense attacking the validity of any registration pleaded by the counterclaimant is a compulsory counterclaim if grounds for such counterclaim exist at the time the plaintiff's answer to the defendant's counterclaim is filed. If the plaintiff knows of grounds for a counterclaim when the plaintiff's answer to the defendant's counterclaim is filed, the counterclaim must be pleaded with or as part of the plaintiff's answer. If, during the course of the proceeding, the plaintiff learns, through discovery or otherwise, that grounds for a counterclaim exist, the counterclaim should be pleaded promptly after the grounds therefor are learned. [Note 4.] *Cf.* TBMP § 313.04.

A plaintiff's counterclaim to cancel a registration owned by the defendant, but not pleaded in the defendant's counterclaim, is a permissive counterclaim. [Note 5.] *Cf*. TBMP § 313.05.

For information on the fee for a counterclaim, *see* 37 CFR § 2.6(a)(16) and TBMP § 313.02. For information on the form for a counterclaim, *see* TBMP § 313.03.

NOTES:

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

2. An example of a trial order for a proceeding with a counterclaim can be found in the Appendix of Forms.

3. *See* 37 CFR § 2.114(a) and 37 CFR § 2.114(b)(2)(iii).

4. *Cf*. 37 CFR § 2.106(b)(2)(i) and 37 CFR § 2.114(b)(2)(i).

5. *Cf*. Fed. R. Civ. P. 13(b).

314 Unpleaded Matters

A plaintiff may not rely on an unpleaded claim. The plaintiff's pleading must be amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter. [Note 1.]

In the case of an opposition against an application under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), however, the opposition cannot be amended (or deemed amended) to assert any new claim. [Note 2.] *See* TBMP § 315 and TBMP § 507.

Except as provided in Fed. R. Civ. P. 12(b) and (h)(2) (which allow a defendant to raise certain specified defenses by motion), a defendant may not rely on an unpleaded defense unless the defendant's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or 15(b), to assert the matter. [Note 3.]

If, after the filing of its pleading, a party learns, through discovery or otherwise, of information which would serve as the basis for an additional claim (in the case of a plaintiff), or defense or counterclaim (in the case of a defendant), the party should move promptly to amend its pleading to assert the additional matter, to the extent such amendment would not be prohibited by 37 CFR § 2.107, which prohibits amendment of an opposition brought against applications filed under Trademark Act § 1 or Trademark Act § 44, 15 U.S.C. § 1051 or 15 U.S.C. § 1126, to add to the goods or services opposed (*see* 37 CFR § 2.107(a)) and prohibits amendment of an opposition brought against applications filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), to add to the grounds for opposition or to add to the goods or services subject to opposition (*see* 37 CFR § 2.107(b)). [Note 4.]

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 issues of

material fact as to an unpleaded claim or defense. [Note 5.] However, a party that seeks to obtain, or to defend against, summary judgment on the basis of an unpleaded claim or defense may, unless prohibited by 37 CFR § 2.107, move to amend its pleading to assert the matter. [Note 6.] *See* TBMP § 315 and TBMP § 528.07.

A plaintiff which pleads ownership of an application in its complaint does not have to amend its pleading to assert the resultant registration, so long as it issues before the plaintiff's testimony period closes. [Note 7.] The pleading of an application is viewed as providing sufficient notice to the defendant of the plaintiff's intention to rely on any registration that issues from the pleaded application. [Note 8.]

NOTES:

1. *See P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801, 804 (CCPA 1978) (registrant did not have fair notice that petitioner was attempting to establish a two-year period of nonuse extending beyond two-year period alleged in petition); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.3 (TTAB 2009) (unpleaded claim of dilution not considered); *Hornby v. TJX Companies Inc.*, 87 USPQ2d 1411, 1415 (TTAB 2008) (unpleaded claims were not tried by express or implied consent of the parties such that pleadings could be treated as amended pursuant to Fed. R. Civ. P. 15(b)); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103 n.3 (TTAB 2007) (raising claim for first time in plaintiff's brief is manifestly untimely; belated fraud claim given no further consideration); *Micro Motion, Inc. v. Danfoss A/S*, 49 USPQ2d 1628 (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); and *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).

2. *See* 37 CFR § 2.107(b); *O.C. Seacrets, Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327 (TTAB 2010) (in opposition involving a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) application, motion to amend notice of opposition to add an additional ground denied).

3. *See* Fed. R. Civ. P. 8(b), 8(c), and 12(b); *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840 (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), 15 U.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); and *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984).

4. *See* 37 CFR § 2.107(a) and 37 CFR § 2.107 (b); Fed. R. Civ. P. 15(a); *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); *Trans Union Corp. v. Trans Leasing International, Inc.*, 200 USPQ 748, 754 (TTAB 1978); *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975); and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974). *See also* 37 CFR § 2.106(b)(2)(i) and 37 CFR § 2.114(b)(2)(i).

5. *See, e.g., American Express Marketing & Development Corp. v. Gilad Development Corp.*, 94 USPQ2d 1294, 1296 (TTAB 2010) ("defendant may not obtain summary judgment on an unasserted defense . . . summary judgment is not appropriate on an unpleaded issue."); *Consolidated Foods Corporation v. Berkshire Handkerchief Co., Inc*., 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, 1785-1786 (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 (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); and *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 UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009).

8. *See 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 Mfg. Co.*, 77 USPQ2d 1220, 1223 n. 6 (TTAB 2005); and *M & T Chemicals Inc. v. Stepan Chemical Co.*, 150 USPQ 570, 571 (TTAB 1966).

315 Amendment of Pleadings

***37 CFR § 2.107* Amendment of pleadings in an opposition proceeding**.

(a) *Pleadings in an opposition proceeding against an application filed under section 1 or 44 of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, after the close of the time period for filing an opposition including any extension of time for filing an opposition, an opposition may not be amended to add to the goods or services opposed.*

(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 to the grounds for opposition or to add to the goods or services subject to opposition.*

***37 CFR § 2.115* Amendment of pleadings in a cancellation proceeding**. *Pleadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court.*

As a general rule, pleadings in inter partes proceedings before the Board may be amended in the same manner and to the same extent as pleadings in a civil action before a United States district court. [Note 1.] There is an exception to this rule, however. An opposition against a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) application may not be amended to add to the stated grounds for opposition. Thus, an opposition may not be amended to add an entirely new claim or to add an additional claimed registration to a previously stated Trademark Act § 2(d), 15 U.S.C. § 1052(d) ground. [Note 2.] Also, an opposition against an application filed under Trademark Act § 1, Trademark Act § 44 or Trademark Act § 66(a), 15 U.S.C. § 1051, 15 U.S.C. § 1126 or 15 U.S.C. § 1141f(a) may not be amended to add to the goods or services subject to opposition. [Note 3.] Other amendments, such as those that would amplify or clarify the grounds for opposition, are not prohibited by this rule. [Note 4.]

For further information concerning the amendment of pleadings, *see* Fed. R. Civ. P. 15, and

TBMP § 507.

NOTES:

1. *See* Fed. R. Civ. P. 15(a); 37 CFR § 2.107 and 37 CFR § 2.115.

2. *See* Trademark Act § 68(c)(3), 15 U.S.C. § 1141h; 37 CFR § 2.107(b); Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act; 68 Fed. Reg. 55748, specifically, summary of amendments at 55757 (September 26, 2003;. and *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* 37 CFR § 2.107(a) and 37 CFR § 2.107 (b); *Drive Trademark Holdings LP v. Inofin* , 83 USPQ2d 1433, 1436 (TTAB 2007).

4. *See, e.g.*, 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 motion under Fed. R. Civ. P. 12 directed to plaintiff's pleading, the Board will suspend the case for decision on the motion and (usually in the same order) reset the deadline for the discovery conference as well as all subsequent dates. [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, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

2. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42255 (August 1, 2007).

317 Exhibits to Pleadings

***37 CFR § 2.122(c)* Exhibits to pleadings.** *Except as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony.*

***37 CFR § 2.122(d)* Registrations.**

(1) *A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by an original or photocopy of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration, or by a current printout of information from the electronic database records of the USPTO 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 printout of information from the electronic database records of the USPTO showing the current status and title of the registration. When a plaintiff submits a printout 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 printout may be taken from (a) the TARR (Trademark Application and Registration Retrieval) electronic database of the Office showing the current status and title (owner) of the registration or, if the TARR printout does not reflect the current owner of the registration, a printout from the Office's Assignment database demonstrating an assignment to the current owner of the registration should be included with the TARR printout, 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 registration. [Note 5.] *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, including TARR, *see generally* TMEP § 504.

Exhibits submitted with a pleading must conform to the requirements of 37 CFR § 2.126. *See, generally,* TBMP § 106.03.

NOTES:

1. 37 CFR § 2.122(c). *See Republic Steel Co. v. M.P.H. Manufacturing Corp.*, 312 F.2d 940, 136 USPQ 447, 448 (CCPA 1963); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1846 n.6 (TTAB 2004); *Hard Rock Café Intl (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000); *Home Juice Co. v. Runglin Cos.*, 231 USPQ 897, 898 (TTAB 1986); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 155 n.3 (TTAB 1985); *Syosset Laboratories, Inc. v. TI Pharmaceuticals*, 216 USPQ 330, 332 (TTAB 1982); *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493, 495 n.5 (TTAB 1978); *A-1-A Corp. v. The Gillette Co.*, 199 USPQ 118, 119 n.2 (TTAB 1978); and *Permatex Co. v. California Tube Products, Inc.*, 175 USPQ 764, 765 n.2 (TTAB 1972). *Cf. Research in Motion Limited v. NBOR Corporation*, 92 USPQ2d 1926, (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 (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 sufficient under 37 CFR § 2.122(d)(1)).

3. *See* 37 CFR § 2.122(c) and 37 CFR § 2.122(d)(1).

4. *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 n.4 (TTAB 2008).

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."); and *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1485 n.4 (TTAB 2007).

318 Fed. R. Civ. P. 11 Applicable

Fed. R. Civ. P. 11 provides, in part, as follows:

(b) Representations to the Court. *By presenting to the court a pleading, written motion, or other paper -- whether by signing, filing, submitting, or later advocating it -- an attorney or*

unrepresented party certifies that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances:

(1) *it is not being presented for any improper purpose, such as to harass, cause unnecessary delay, or needless increase in the cost of litigation;*

(2) *the claims, defenses, and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law or for establishing new law;*

(3) *the factual contentions have evidentiary support or, if specifically so identified, will likely have evidentiary support after a reasonable opportunity for further investigation or discovery; and*

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

(c) Sanctions.

(1) In General. *If, after notice and a reasonable opportunity to respond, the court determines that Rule 11(b) has been violated, the court may impose an appropriate sanction on any attorney, law firm, or party that violated the rule or is responsible for the violation. Absent exceptional circumstances, a law firm must be held jointly responsible for a violation committed by its partner, associate, or employee.*

The quoted provisions are applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board. [Note 1.] *See* TBMP § 527.02.

NOTES:

1. *See* 37 CFR § 2.116(a). *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.

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401 Introduction to Disclosures and Discovery

37 CFR § 2.120(a)(1) *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 except as otherwise provided in this section. The provisions of Federal Rule of Civil Procedure 26 relating to required disclosures, the conference of the parties to discuss settlement and develop a disclosure and discovery plan, the scope, 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 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.*

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.

The conduct of discovery in Board inter partes proceedings is governed by 37 CFR § 2.120. Discovery before the Board under 37 CFR § 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 CFR § 2.120. The provisions of the Federal Rules relating to automatic disclosure and discovery conferences are not applicable in inter partes proceedings commenced prior to November 1, 2007. [Note 2.] However, for inter partes proceedings commenced on or after November 1, 2007, the Board has adopted a modified disclosure and conferencing regime. [Note 3.] For cases commenced on or after November 1, 2007, all involved parties are obliged to (1) conduct a discovery conference to discuss disclosure and discovery plans, and (2) make initial, expert, and pretrial disclosures. The Board adopted the disclosure regime of the Federal Rules 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 4.] 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 5.] 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 6.]

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.

For information regarding pretrial disclosures, *see* TBMP § 702.01.

For information regarding Accelerated Case Resolution (ACR), *see* TBMP § 528.05(a)(2) and TBMP § 702.04.

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 Corporation v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978). For a discussion of ACR, *see e.g., Eveready Battery Co., Inc. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009).

2. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (August 1, 2007).

3. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244-7 (August 1, 2007); 37 CFR § 2.120; Fed. R. Civ. P. 26(a)(1)(A); Fed. R. Civ. P. 26(a)(1)(B); Fed. R. Civ. P. 26(a)(2); Fed. R. Civ. P. 26(a)(3); Fed. R. Civ. P. 26(f).

4. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 and 42246 (August 1, 2007).

5. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 and 42246 (August 1, 2007).

6. *See Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767-8 (TTAB 2008).

401.01 Discovery Conferences

37 CFR § 2.120(a)(1) *... The provisions of Federal Rule of Civil Procedure relating to ... the conference of the parties to discuss settlement and 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 CFR § 2.120(a)(2) *The discovery conference shall occur no later than the opening of the discovery period, and the parties must discuss the subjects set forth in Federal Rule of Civil Procedure 26(f) 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. 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. ... 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) *... 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. ...*

For inter partes proceedings commenced on or after November 1, 2007, 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:

> *[T]he parties are required to have a conference to discuss: (1) the nature of and basis for their respective claims and defenses, (2) the possibility of settling the case or at least narrowing the scope of claims or defenses, and (3) arrangements relating to disclosures, discovery and introduction of evidence at trial, should the parties not agree to settle the case. See Trademark Rule 2.120(a)(2). Discussion of the first two of these three subjects should include a discussion of whether the parties wish to seek mediation, arbitration or some other means for resolving their dispute. Discussion of the third subject should include a discussion of whether the Board's Accelerated Case Resolution (ACR) process may be a more efficient and economical means of trying the involved claims and defenses. Information on the ACR process is available at the Board's main webpage. Finally, if the parties choose to proceed with the disclosure, discovery and trial procedures that govern this case and which are set out in the Trademark Rules and Federal Rules of Civil Procedure, then they must discuss whether to alter or amend any such procedures, and whether to alter or amend the Standard Protective Order (further discussed below). Discussion of alterations or amendments of otherwise prescribed procedures can include discussion of limitations on disclosures or discovery, willingness to enter into stipulations of fact, and willingness to enter into stipulations regarding more efficient options for introducing at trial information or material obtained through disclosures or discovery.*

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 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 or counterclaim has been filed, the parties' obligation to have a discovery conference is 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, motion or counterclaim. [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 call the Board attorney assigned to the case or file such request through ESTTA (Electronic System for Trademark Trials and Appeals), the Board's electronic filing system, 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.] Board participation is encouraged where pro se litigants are involved. [Note 10.] The participating attorney or judge has discretion to expand or reduce the number or nature of subjects to be discussed during the conference. [Note 11.] 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 12.] Participation by a Board professional will be by telephone. [Note 13.]

If neither party requests Board participation in the discovery conference, 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 amongst the parties does not substitute for a full discovery conference of subjects set forth in Fed. R. Civ. P. 26 and the Board's institution order. [Note 14.]

Unlike the Federal Rules, 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 15.]

The Board has the authority to order parties to hold a discovery conference, either sua sponte or upon motion. [Note 16.]

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).

NOTES:

1. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 and 42252 (August 1, 2007); 37 CFR § 2.120(a)(2); Fed. R. Civ. P. 26(f). *See e.g., Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (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).

2. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 and 42252 (August 1, 2007). *See Weatherford/Lamb Inc. v. C&J Energy Services, Inc.,* 96 USPQ2d 1834, 1836 n.4 (TTAB 2010) (parties encouraged to discuss ACR during discovery conference).

3. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

4. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

5. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

6. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

7. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007). *See Boston Red Sox Baseball Club LP v. Chaveriat,* 87 USPQ2d 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, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

9. *See* 37 CFR § 2.120(a)(2); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007). *But see Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (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, 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 CFR § 2.120(a)(2).

12. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42252 (August 1, 2007).

13. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

14. *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759 (TTAB 2009).

15. 37 CFR § 2.120(a)(2); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

16. *See e.g., Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759 (TTAB 2009).

401.02 Initial Disclosures

37 CFR § 2.120(a)(2) *. . . Initial disclosures must be made no later than thirty days after the opening of the discovery period. ...*

37 CFR § 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 Disclosures.

(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 may, at trial, 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.]

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 16.]

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 CFR §§ 2.120(a)(1)-(3).

2. 37 CFR § 2.120(a)(3). *See Amazon Technologies, Inc. v. Jeffrey S. Max,* 93 USPQ2d 1702 (TTAB 2009).

3. *See* 37 CFR § 2.120(a)(1). *See also* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 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, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

5. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007). *See 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."). *But see Byer California v. Clothing for Modern Times Ltd.,* 95 USPQ2d 1175 (TTAB 2010) (where opposer identifies trial witness in pretrial disclosures who was not identified in initial disclosures, opposer ordered to serve revised pretrial disclosure limiting testimony witness to subjects on which second trial witness that was identified in initial disclosures is expected to 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, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

9. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245-6 (August 1, 2007).

10. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

11. Fed. R. Civ. P. 26(a)(1)(E).

12. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42254 (August 1, 2007).

13. *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1861 n.4 (TTAB 2008).

14. 37 CFR § 2.127(e)(2) and 37 CFR § 2.120(i)(3)(i). *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

15. 37 CFR § 2.120(e); 37 CFR § 2.120(g)(1); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42256 (August 1, 2007).

16. 37 CFR § 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 yet to serve initial disclosures).

401.03 Expert Disclosures

37 CFR § 2.120(a)(2) *... Disclosure of expert testimony must occur in the manner and sequence provided in Federal Rule of Civil Procedure 26(a)(2), 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 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) *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 data or other information 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) *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), within 30 days after the other party's disclosure.*

(D) *Supplementing the Disclosure. The parties must supplement these disclosures when required under Rule 26(e).*

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. [Note 1.] Parties are not required to disclose consulting experts. [Note 2.] The extent of the expert disclosure obligation is governed by Fed. R. Civ. P. 26, specifically, Fed. R. Civ. P. 26(a)(2). [Note 3]. 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 4.] 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 5.] 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.

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 6.] The Board may then suspend proceedings to allow for discovery limited to experts. [Note 7.] 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. The Board recognizes that there may be cases in which a party may not decide that it needs to present an expert witness at trial until after the deadline for expert disclosure. 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 8.] 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 9.] The Board will decide on a case-by-case basis how to handle a party's late identification of experts. [Note 10.]

For further information regarding the duty to cooperate with regard to expert disclosures, *see* TBMP § 408.01(b).

NOTES:

1. *See* 37 CFR § 2.120(a). *See also* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 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 CFR § 2.120(a)(2)).

2. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42254 (August 1, 2007).

3. *See Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443 (TTAB 2009).

4. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

5. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

6. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

7. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

8. *See* 37 CFR § 2.120(a)(2).

9. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

10. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

401.04 Modification of Disclosure Obligations

37 CFR § 2.120(a)(2) *... 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. If a stipulation or motion for modification is denied, disclosure deadlines and obligations 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, or upon motion granted by the Board, or by order of the Board. [Note 1.] 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 2.] The parties may agree to waive or otherwise modify their obligation to make initial disclosures, but must inform the Board by written stipulation or by motion. [Note 3.] 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 4.] *See* TBMP § 411.01 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 effectively stayed. [Note 5.] 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 6.] For further information regarding the rescheduling of the discovery conference in these circumstances, *see* TBMP § 401.01.

Pretrial disclosures are not part of the disclosure and 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 CFR § 2.120(a)(2).

2. 37 CFR § 2.120(j)(8).

3. 37 CFR § 2.120(a)(2) and 37 CFR § 2.120(a)(3). *See e.g., Boston Red Sox Baseball Club LP v. Chaveriat,* 87 USPQ2d 1767-8 (TTAB 2008).

4. 37 CFR § 2.120(e)(1); 37 CFR § 2.120(g)(1) and 37 CFR § 2.120(2); *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 (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).

5. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

6. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 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.

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 ...*

(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, e-mail 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); Fed. R. Civ. P. 26(g).

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.

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 3.] Under these circumstances, the requirement of service of initial disclosures cannot be waived. [Note 4.] 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. [Note 5.]

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 CFR § 2.120(a)(2); Fed. R. Civ. P. 26(f); Miscellaneous Changes to Trademark Trial

and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007); *Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (TTAB 2009).

2. *See e.g., Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (TTAB 2009).

3. 37 CFR § 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.").

4. *Qualcomm, Inc. v. FLO Corp.,* 93 USPQ2d 1768, 1769-70 (TTAB 2010). *But see Boston Red Sox Baseball Club LP v. Chaveriat,* 87 USPQ2d 1767-8 (TTAB 2008) (Board approved parties' stipulation to waive their reciprocal obligation to make initial disclosures).

5. 37 CFR § 2.120(a)(3) ("a party must make its initial disclosures prior to seeking discovery ..."). *See Dating DNA, LLC v. Imagini Holdings, LLC,* 94 USPQ2d 1889 (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) *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 — including the existence, description, nature, custody, condition, and location of any documents or other tangible things and the identity and location of persons who know of any discoverable matter. For good cause, the court may order discovery of any matter relevant to the subject matter involved in the action. Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence. All discovery is subject to the limitations imposed by Rule 26(b)(2)(C).*

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.*

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), which provides, in part, as follows: [Note 1.]

> *Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense -- including the existence, description, nature, custody, condition, and location of any documents or other tangible things and the identity and location of persons having knowledge of any discoverable matter. ... Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence.*

A party may take discovery not only as to matters specifically raised in the pleadings, [Note 2] but also as to any matter which might serve as the basis for an additional claim, defense, or counterclaim. [Note 3.] While the scope of discovery is therefore somewhat broad, parties may not engage in "fishing expeditions" and must act reasonably in framing discovery requests. [Note 4.] The guidelines set forth in Fed. R. Civ. P. 26(a)(1) also apply to the discovery of information stored in digital or electronic form. 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 5.] However, parties are free to discuss agreed limits on discovery as a means of reducing the time and cost associated with discovery. [Note 6.]

Each party 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 specific issues involved in the proceeding. [Note 7.]

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 8.] 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 9.] 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. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) ("[d]uring discovery, a party may seek not only testimony and exhibits which would be admissible evidence but also information that would be inadmissible at trial if the information appears reasonably calculated to lead to the discovery of admissible evidence."). *See also Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975) (relevancy construed liberally).

2. *See Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 287 (TTAB 1974) (opposer must answer interrogatories concerning allegations in notice of opposition).

3. *See J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (information concerning possible abandonment, 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); and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974) ("applicant is entitled to take discovery not only as to the matters specifically raised in the pleadings but also as to any matters which might serve as the basis for an affirmative defense or for a counterclaim.").

4. Fed. R. Civ. P. 26(b). *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987).

5. *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).

6. 37 CFR § 2.120(a)(2) ("[t]he parties may stipulate to a shortening of the discovery period.").

7. Fed. R. Civ. P. 26(g). *See 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); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984).

8. *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); *Gastown Inc. of Delaware v. Gas City, Ltd.*, 180 USPQ 477, 477 (TTAB 1974). *Cf. Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572 (TTAB 1990) as cited in *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).

9. *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) *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) "the burden or expense of the proposed discovery outweighs its likely benefit, considering the needs of the case, the amount in controversy, the parties' resources, the importance of the issues at stake in the action, and the importance of the discovery in resolving the issues." [Note 10.]

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 nonparty); *Katz v. Batavia Marine & Sporting Supplies Inc.*, 984 F.2d 422, 25 USPQ2d 1547, 1549 (Fed. Cir. 1993) (in response to nonparty's prima facie showing that discovery was burdensome, party did not meet burden of showing need for information sought); and *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).

2. *See, e.g., British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), *cert. denied*, 514 U.S. 1050 (1995) (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); *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 Company*, 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); and *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 288 (TTAB 1974) (allowed to furnish representative samples of advertisements).

3. *See Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170 (TTAB 1980).

4. *See, e.g.*, Fed. R. Civ. P. 26(c); *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); and *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 Company*, 229 USPQ 147, 148 (TTAB 1985); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975); *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) *Ortho Pharmaceutical Corp. v. Schattner*, 184 USPQ 556 (TTAB 1975); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495 (TTAB 1975); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974). For proceedings pending or commenced on or after August 31, 2007 the Board's standard protective order automatically applies to all cases, absent agreement to, and Board approval of, a substitute. 37 CFR § 2.116(g).

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); *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 (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)).

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); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975); and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975). *See also Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432 (TTAB 1975); *Amerace Corp. v. USM Corp.*, 183 USPQ 506 (TTAB 1974); and *Goodyear Tire & Rubber Co. v. Uniroyal, Inc.*, 183 USPQ 372 (TTAB 1974).

7. Fed. R. Civ. P. 26(b)(2)(B).

8. Fed. R. Civ. P. 26(b)(2)(B).

9. Fed. R. Civ. P. 26(b)(2)(B).

10. Fed. R. Civ. P. 26(b)(2)(B) and (C).

403 Timing of Discovery

403.01 In General

37 CFR § 2.120(a)

(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) *… The discovery period will be set for a period of 180 days. … The parties may stipulate to a shortening of the discovery period. The discovery period may be extended 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 taken, and interrogatories, requests for production of documents and things, and requests for admission must be served, on or before the closing date of the discovery period as originally set or as reset.*

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 CFR § 2.92 for an interference and 37 CFR § 2.99(c) for a concurrent use proceeding), the Board sends out a notice advising the parties of the institution of the proceeding. [Note 1.] *See also* 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 for those cases commenced on or after November 1, 2007, the deadlines for the discovery conference and disclosures. [Note 2.] For such cases, 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 a shortening of the discovery period. [Note 5.]

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 6.] A party has no obligation to respond to an untimely request for discovery, nor is a party obliged to respond to discovery when initial disclosures have not been served, although a party should object on that basis. [Note 7.]

For further information regarding the timing of initial, expert and pretrial disclosures for inter partes proceedings commenced on or after November 1, 2007, *see* TBMP § 401 and TBMP § 702.01.

NOTES:

1. 37 CFR § 2.105 and 37 CFR § 2.113.

2. 37 CFR § 2.120(a)(1) and 37 CFR § 2.121(a); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

3. 37 CFR § 2.120(a)(2). *See Boston Red Sox Baseball Club LP v. Chaveriat,* 87 USPQ2d 1767-8 (TTAB 2008) (Board approved parties' stipulation to waive their reciprocal obligation to make initial disclosures).

4. 37 CFR § 2.120(a)(2). *See Boston Red Sox Baseball Club LP v. Chaveriat,* 87 USPQ2d 1767-8 (TTAB 2008).

5. 37 CFR § 2.120(a)(2). *See H.D. Lee Co. v. Maidenform, Inc.,* 87 USPQ2d 1715, 1720 n.55 (TTAB 2008).

6. *See 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).

7. *See Dating DNA, LLC v. Imagini Holdings, LLC,* 94 USPQ2d 1889 (TTAB 2010) (service of initial disclosures is a prerequisite to taking discovery); *Amazon Technologies v. Wax,* 93 USPQ2d 1702 (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 CFR § 2.120(a)(3) *… Discovery depositions must be taken, and interrogatories, requests for production of documents and things, and requests for admission must be served, on or before the closing date of the discovery period as originally set or as reset.*

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, for cases commenced on or after November 1, 2007, the serving party must have already made its initial disclosures, absent a stipulation or a granted motion or upon order of the Board to the contrary. [Note 1.] Written discovery may be served concurrently with initial disclosures. Additionally, for cases commenced on or after November 1, 2007, a party cannot notice depositions until it has served its initial disclosures, unless such disclosures are waived. [Note 2.] Discovery depositions must be not only noticed but also taken during the discovery period (unless the parties stipulate or the Board orders that the deposition may be taken outside of the period). [Note 3.]

NOTES:

1. 37 CFR § 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). For proceedings commenced prior to November 1, 2007, *see Luemme Inc. v. D.B. Plus, Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978); *Atwood Vacuum Machine Co. v. Automation Industries, Inc.*, 181 USPQ 606 (TTAB 1974); *AMP Inc. v. Raychem Corp.*, 179 USPQ 857 (TTAB 1973); and *Deere & Co. v. Deerfield Products Corp.*, 176 USPQ 422 (TTAB 1973).

2. 37 CFR § 2.120(a)(3).

3. 37 CFR § 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); and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978).

403.03 Time for Service of Discovery Responses

37 CFR § 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.*

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.] If service of the request for discovery is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the request. [Note 2.] *See* TBMP § 113.05. If the parties agree to electronic service (e.g., by e-mail, facsimile) the five extra day grace period does not apply. [Note 3.]

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. Rather, each party is under an obligation 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 4.] 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 may be served until the closing date of discovery, a responding party may not object to such discovery requests on the ground that responses would be due after the close of discovery. [Note 5.] However, a responding party may serve appropriate objections when timely responding to discovery requests served late in the discovery period, even though well-taken objections may result in the inquiring party not receiving responses. [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, 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 CFR § 2.120(a)(3); Fed. R. Civ. P. 33(b)(3), 34(b), and 36(a). S*ee 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 by that date).

2. 37 CFR § 2.119(c). *See also Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987).

3. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42250 (August 1, 2007).

4. Fed. R. Civ. P. 26(d); *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 632 (TTAB 1986).

5. 37 CFR § 2.120(a)(3).

6. *See Dating DNA, LLC v. Imagini Holdings, Ltd.*, 94 USPQ2d 1889 (TTAB 2010) (applicant was not required to inform opposer earlier that it would not be responding to discovery requests based on objection that opposer failed to serve initial disclosures as "this was a function of opposer choosing to serve discovery requests late in the discovery period;" opposer received applicant's objection two days after discovery closed). *See also H.D. Lee Co. v. Maidenform, Inc.*, 87 USPQ2d 1715, 1720 n.13 (TTAB 2008).

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); and *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 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 (TTAB 2007). *See also Hobie Designs, Inc. v. Fred Hayman Beverly Hills, Inc.*, 14 USPQ2d 2064 (TTAB 1990).

9. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000).

10. *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).

403.04 Extensions of Discovery Period, Time to Respond to Discovery Requests and Disclosures

37 CFR § 2.120(a)(2) *… The discovery period may be extended 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 CFR § 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. 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 CFR § 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.*

* * * *

37 CFR § 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.*

The closing date of the discovery period may be extended by 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. 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 1.] Also, 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, as a matter of course, 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 and should be presented in the form used in a trial order. [Note 2.] 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 3.] Thus, a party which waits until the waning days of 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, or after the close of the discovery period, that it needs an extension or reopening of the discovery

period in order to take “follow-up” discovery. [Note 4.]

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 5.]

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. However, 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 6.] 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 a request for 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 7.] 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 a motion granted by the Board, or by order of the Board. 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 may extend the closing date of discovery because expert disclosure generally and discovery activities related thereto are expected to occur within the discovery period.

For a discussion regarding modification of disclosure obligations, *see* TBMP § 401.04.

NOTES:

1. 37 CFR § 2.121(a)(1).

2. 37 CFR § 2.121(d).

3. *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852 (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); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (no reason given why discovery was not taken during the time allowed).

4. *See American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1316 n.4 (TTAB 1992).

5. *See Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067 (TTAB 1990); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975).

6. 37 CFR § 2.120(a) and 37 CFR § 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).

7. Fed. R. Civ. P. 29(b). *See Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, n.2 (TTAB 2008).

403.05 Need for Early Initiation of Discovery

403.05(a) To Allow Time for "Follow-up" 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 prior to the expiration of the discovery period. *See* TBMP § 403.04.

403.05(b) To Facilitate Introduction of Produced Documents

37 CFR § 2.120(j)(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).*

37 CFR § 2.122(e) ***Printed publications and official records.*** *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, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice 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 [United States] Patent and Trademark 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.

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 CFR § 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 CFR § 2.122(e) may be made of record. *See* TBMP § 704.09. 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 the discovery period has not yet expired, 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.] Then, during its testimony period, the propounding party may file a notice of reliance, pursuant to 37 CFR § 2.120(j)(3)(i), 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.

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, plus an extra five days if service of the request was made by first-class mail, “Express Mail,” or overnight courier. *See* TBMP § 403.03. Moreover, in proceedings before the Board, a discovery deposition must be both noticed and taken before the end of the discovery period. *See* TBMP § 403.02. Thus, a combined notice of deposition and request for production of documents normally must be served at least thirty-five days prior to the close of the discovery period.

For a full discussion of making evidence of record in a Board proceeding, *see* TBMP Chapter 700.

NOTES:

1. *See e.g.*, *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (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 (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).

404 Discovery Depositions

404.01 When Permitted and By Whom

Discovery depositions must be both noticed and taken prior to the expiration of 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 National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008). *See also 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) (it is clear from the language of Fed. R. Civ. P. 30 and 33 that while interrogatories need only be "served" during the discovery period, depositions must be "taken" during the discovery period).

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)*. Deposition 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)(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 the person to be examined is confined in prison; or

(2) If, without written stipulation of the parties, (i) a proposed deposition would result in more than ten discovery depositions being taken by the plaintiffs, or by the defendants, or (ii) the person to be examined already has been deposed in the case. [Note 1.]

Deposition of a nonparty witness residing in the United States may be taken by subpoena under Fed. R. Civ. P. 45 or, or on notice alone, if the nonparty witness agrees to appear voluntarily.

For information concerning limitations on the right to discovery, *see* TBMP § 402.02.

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 CFR § 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 by stipulation. ...

The discovery deposition of a 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 CFR § 2.124. [Note 2.]

For information on the taking of a discovery deposition on written questions, *see* TBMP § 404.07.

NOTES:

1. *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)(3) 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, *see* TBMP § 703.01(f)(2).

NOTES:

1. 37 CFR § 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 – Nonparty

***37 CFR § 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.

If a proposed deponent residing in the United States is not 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)(3) to testify on behalf of a party, the responsibility rests wholly with the deposing party to secure the attendance of the proposed deponent. [Note 1.] If the proposed deponent is not willing to appear voluntarily, the deposing party must secure the 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 non-party witness testimonial deposition, *see* TBMP § 703.01(f)(2).

NOTES:

1. 37 CFR § 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).

3. *See generally* cases cited in preceding Note 2.

4. *See, e.g., 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); *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 CFR § 2.120(c)* Discovery deposition in foreign countries**.

(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 or the parties stipulate, that the deposition be taken by oral examination.*

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)(3) 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 CFR § 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, a testimony deposition taken in a foreign country must be taken by deposition on written questions, as described in 37 CFR § 2.123(a)(2) unless the Board, on motion for good cause orders the deposition taken by oral examination, or the parties so stipulate. *See* TBMP § 703.01(b). 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 Citizens Consular Services, 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 nonparty 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 3.]

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 4.] 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 5.]

NOTES:

1. *See* 37 CFR § 2.120(c) and 37 CFR § 2.124.

2. 37 CFR § 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. Inc. v. Jonergin Vermont Inc.*, 222 USPQ 337, 340 (Comm'r 1983) (by stipulation).

3. *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 (E.D.N.Y. 1964); *Cf. Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises, Ltd*, 511 F.3d 437, 85 USPQ2d 1385 (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).

4. *Cf. Societe Internationale Pour Participations Industrielles et Commerciales, S.A. v. Rogers*, 357 U.S. 197 (1958) (Swiss government ordered Swiss plaintiff in U.S. court proceeding not to produce certain documents).

5. *Cf. Cochran Consulting Inc. v. Uwatec USA Inc.*, 102 F.3d 1224, 41 USPQ2d 1161 (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 – Nonparty

404.03(c)(1) Willing Nonparty

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)(3) 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 Citizens Consular Services, 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 CFR § 2.120(c) and 37 CFR § 2.123(a).

404.03(c)(2) Unwilling Nonparty – 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)(3) 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 nonparty 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 (8th edition 2004) 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 rule.

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 nonparty 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 paper submitted to 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 does submit 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; the signature will be authenticated in such a manner as to meet the requirements of the foreign country; and the original and one copy of the letter rogatory and accompanying questions will be forwarded 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 may be made by certified check or money order made payable to the American Embassy/Consulate [insert the name of the appropriate city, i.e., 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 letter rogatory process may be obtained from the Office of

Citizens Consular Services, U.S. Department of State, 2201 C Street N.W., Washington, D.C. 20520 or at the U.S. Department of State's web site at http//travel.state.gov/law/judicial/judicial_683.html.

Once the appropriate foreign judicial authority has received the letter rogatory, it may or may not be executed. As indicated above, the letter rogatory "rests entirely upon the comity of courts towards each other." 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 5.] 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 Citizens Consular Services, 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 6.]

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 7.]

The Hague 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 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 nonparty witness residing in a foreign country, if the

foreign country is a member of the Convention. [Note 8.]

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 9.] 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 Citizens Consular Services, 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 CFR § 2.119(a). *Cf.* 37 CFR § 2.124(b)(2).

4. *Cf.* 37 CFR § 2.124(d)(1).

5. *See* Fed. R. Civ. P. 28(b) Advisory Committee's notes, (1963 amendment) and 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2083 (2009)**.**

6. *See* Fed. R. Civ. P. 28; Fed. R. Civ. P. 28(b) Advisory Committee's notes, (1963 amendment); and 8A C.WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2083 (2009).

7. *Cf.* 37 CFR § 2.124(d)(2).

8. *See, e.g., Societe Nationale Industrielle Aerospatiale v. U.S. District Court for the Southern District of Iowa*, 482 U.S. 522 (1987) (although Hague Convention not exclusive discovery procedure, it may apply even if Federal Rules of Civil Procedure are available); *In re Anschuetz & Co., GmbH*, 838 F.2d 1362 (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 3d § 2005 (2009). For general information concerning the Hague Convention, *see Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609 (TTAB 1991) (applicant failed to establish necessity of using Hague procedures). [NOTE: This case involved the taking of discovery by interrogatories, requests for production of documents, and requests for admissions, rather than by deposition].

9. 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 (TTAB 1991).

404.03(d) Foreign Person Present Within the United States – Party

37 CFR § 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 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 CFR § 2.120(c)(2). Indeed, this option was available even before the adoption of 37 CFR § 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 CFR § 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.]

NOTES:

1. *See Rhone-Poulenc Industries v. Gulf Oil Corp*., 198 USPQ 372 (TTAB 1978); *Jonergin Co. Inc. v. Jonergin Vermont Inc*., 222 USPQ 337 (Comm'r 1983).

2. 37 CFR § 2.120(c)(2).

404.03(e) Foreign Person Present Within the United States – Nonparty

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 Within the United States. Within the United States or within a territory or insular possession subject to the jurisdiction of the United States, a deposition must be taken before:

(A) *an officer authorized to administer oaths by federal law or by the law in the place of examination; or*

(B) *a person so appointed by the court where the action is pending to administer oaths and take testimony.*

Fed. R. Civ. P. 28(a)(2) Definition of "Officer". *The term "officer" in Rules 30, 31 and 32 includes a person appointed by the court ... or designated by the parties under Rule 29(a).*

Fed. R. Civ. P. 28(b)(1) In a Foreign Country. In General*. Depositions 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.*

Fed. R. Civ. P. 28(b)(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.*

Fed. R. Civ. P. 28(b)(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 may designate the person before whom the deposition is to be taken either by name or descriptive title

Fed. R. Civ. P. 28(b)(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.*

Fed. R. Civ. P. 28(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 Board proceeding discovery deposition “shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the deposition is held, or before a person appointed by the court in which the action is pending.” [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 Board proceeding discovery deposition may be taken pursuant to Fed. R. Civ. P. 28(b). This means, for example, that a Board proceeding discovery deposition 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 Citizens Consular Services, 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 3d § 2083 (2009).

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 CFR § 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 him or the particular class or group to which he 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 CFR § 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)(3) 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 CFR § 2.124(b)(2) and 37 CFR § 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 (or 35 days if served by first-class mail "Express Mail," or overnight courier) 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 taken prior to the expiration of the discovery period (unless the parties stipulate that the deposition may be taken outside of the period). [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 § 521 and TBMP § 410.

NOTES:

1. Fed. R. Civ. P. 30(b)(1); 37 CFR § 2.124(b)(2); 37 CFR § 2.124(c). *See* Fed. R. Civ. P. 31(a)(3) and 37 CFR § 2.120(c). *Cf.* 37 CFR § 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), Advisory Committee's notes, (1970 amendment).

7. Fed. R. Civ. P. 34(b)(2)(A).

8. *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)(3).

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 very 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, 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); *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) Deposition 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.

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 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 1.]

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 2.]

For more information regarding depositions of natural persons, *see* TBMP § 404.03.

NOTES:

1. *See* 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2103 (2009) (discussing differences between a Fed. R. Civ. P. 30(b)(6) deposition and a "normal deposition")**.**

2. *See* Fed. R. Civ. P. 30(b)(6) ("This paragraph (6) does not preclude taking a deposition by any other procedure authorized under these rules"); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc*., 74 USPQ2d 1672 (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 is through a deposition under Fed. R. Civ. P. 30(b)(6). 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 1.] 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 2.] A party seeking to depose a Fed. R. Civ. P. 30(b)(6) witness in his or her individual capacity must provide notice under Fed. R. Civ. P. 30(b)(1).

When an organization is named by a party seeking discovery as a deponent, the subject matter of the deposition is to be described with reasonable particularity in the notice. [Note 3.] 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 that have knowledge of the subject matter identified in the notice [Note 4] 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 5.] 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 [Note 6], 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 7.] 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 8.] 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 9.]

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 representatives were uninformed. [Note 10.]

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 11]. 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 12.] The production of an unprepared witness is tantamount to a failure to appear. [Note 13.]

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), the Fed. R. Civ. P. 30(b)(6) deposition is treated as a single deposition. [Note 14.] 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 15.]
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 16.]

NOTES:

1. 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2103 (2009).

2. Fed. R. Civ. P. 30(b)(6); 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2103 (2009).

3. Fed. R. Civ. P. 30(b)(6).

4. *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.").

5. *A&E Products Group L.P. v. Mainetti USA Inc.*, 70 USPQ2d 1080, 1086 (S.D.N.Y. 2004) (and cases cited therein).

6. *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1605 (TTAB 2002).

7. *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1605 (TTAB 2002).

8. Fed. R. Civ. P. 30(b)(6).

9. *United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc.*, 50 USPQ2d 1060, 1062 (E.D. Mich. 1998).

10. *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 (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).

11. 37 CFR § 2.120(e). *See United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc*., 50 USPQ2d 1060 (E.D. Mich. 1998) (motion to compel due to unprepared 30(b)(6) witness); *S. Industries Inc. v. Lamb-Weston Inc*., 45 USPQ2d 1293 (TTAB 1997) (motion to compel appearance at Fed. R. Civ. P. 30(b)(6) deposition due to refusal to appear).

12. 37 CFR § 2.120(g).
13. *United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc*., 50 USPQ2d 1060, 1061 (E.D. Mich. 1998).

14. Fed. R. Civ. P. 30(b)(6) Advisory Committee's notes, (1993 amendment).

15. Fed. R. Civ. P. 30(d) Advisory Committee's notes, (2000 amendment).

16. *Cf. Foster-Miller Inc. v. Babcock & Wilcox Canada*, 210 F.3d 1, 54 USPQ2d 1193 (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)(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.

NOTES:

1. Fed. R. Civ. P. 30(d)(1).

2. Fed. R. Civ. P. 30(d) Advisory Committee's notes, (2000 amendment).

3. Fed. R. Civ. P. 30(d) Advisory Committee's notes, (2000 amendment).

4. Fed. R. Civ. P. 30(d) Advisory Committee's notes, (2000 amendment).

5. Fed. R. Civ. P. 30(d) Advisory Committee's notes, (2000 amendment).

6. Fed. R. Civ. P. 30(d) Advisory Committee's notes, (2000 amendment).

7. Fed. R. Civ. P. 30(d) Advisory Committee's notes, (2000 amendment).

8. Fed. R. Civ. P. 30(d) Advisory Committee's notes, (2000 amendment); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc*., 74 USPQ2d 1672 (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)(2)(A) With Leave. *A party must obtain leave of court, and the court must grant leave to the extent consistent with Rule 26(b)(2): 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)(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)(A)(ii).

3. Fed. R. Civ. P. 26(b)(2)(C)(i)-(iii); *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597 (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) Advisory Committee's notes, (1993 amendment). *Cf. Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672 (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) Advisory Committee's notes, (1993 amendment).

404.07 Discovery Depositions on Written Questions

Discovery depositions on written questions are taken in the manner prescribed by 37 CFR § 2.124.

404.07(a) Depositions on Written Questions: Before Whom Taken

37 CFR § 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 CFR § 2.124(a).

404.07(b) Depositions on Written Questions: When Taken

37 CFR § 2.120(a)(3) *... Discovery depositions must be taken, ...on or before the closing date of the discovery period as originally set or as reset*.

Discovery depositions must be both noticed and taken during the discovery period. [Note 1.] TBMP § 404.01. Thus, it is recommended that a party, which 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.

NOTES:

1. 37 CFR § 2.120(a)(3).

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 CFR § 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 him or the particular class or group to which he belongs shall be stated in the notice, and the party from whom the discovery disposition 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 CFR § 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 CFR § 2.124(d)(1) *Every notice served on any adverse party under the provisions of paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition.*

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 CFR § 2.124(b)(2).

2. 37 CFR § 2.124(b)(2) and 37 CFR § 2.124(c).

3. 37 CFR § 2.124(d)(1).

404.07(e) Depositions on Written Questions: Examination of Witness

37 CFR § 2.124(d)(1) *Every notice served on any adverse party under the provisions of paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Within twenty days from the date of service of the notice, any adverse party may serve cross questions upon the party who proposes to take the deposition; any party who serves cross questions 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 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; 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 CFR § 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 CFR § 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 (25 days, if service of the notice and accompanying questions was made by first-class mail, "Express Mail," or overnight courier [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 (15 days, if service of the cross questions was made by first-class mail, "Express Mail," or overnight courier), the deposing party may serve redirect questions on every adverse party. Within 10 days from the date of service of the redirect questions (15 days, if service of the redirect questions was made by first-class mail, "Express Mail," or overnight courier), 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 (15 days, if service of the objections was made by first-class mail, "Express Mail," or overnight courier). 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 CFR § 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.]

NOTES:

1. 37 CFR § 2.119(c).

2. 37 CFR § 2.124(d)(1). *See Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979).

3. 37 CFR § 2.124(d)(1). *See Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1410 (TTAB 1990).

4. *See* 37 CFR § 2.124(d)(2) regarding suspension of proceedings for testimonial depositions on written questions.

5. 37 CFR § 2.124(e).

404.07(f) Depositions on Written Questions: Objections

37 CFR § 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 CFR § 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 CFR § 2.124(d)(1).

2. 37 CFR § 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).

404.07(g) Depositions on Written Questions: Form of Deposition; Signature

37 CFR § 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 CFR § 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 CFR § 2.123(e)(5), and TBMP § 703.01(j).

NOTES:

1. 37 CFR § 2.124(e).

404.07(h) Depositions on Written Questions: Certification of Deposition

37 CFR § 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.

NOTES:

1. 37 CFR § 2.124(e). *See* 37 CFR § 2.123(f).

404.07(i) Depositions on Written Questions: Service, Correction, and Making the Deposition of Record

37 CFR § 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(b)). If the deposition is a discovery deposition, it may be made of record as provided by § 2.120(j). ...*

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) 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 CFR § 2.120(j) are to be followed. [Note 3.] With respect to making a discovery deposition of record, *see* TBMP § 704.09.

NOTES:

1. 37 CFR § 2.124(f).

2. 37 CFR § 2.124(f) and 37 CFR § 2.125(b).

3. 37 CFR § 2.124(f). *See also Fischer Gesellschaft M.b.H. v. Molnar and Co., Inc.*, 203 USPQ 861 (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 CFR § 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 Gesellschaft m.b.H. 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 § 521 and TBMP § 410.

NOTES:

1. *See* Fed. R. Civ. P. 32(d)(1). *Compare S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293 (TTAB 1997) (Board will not rule in advance of deposition as to whether information sought is confidential or otherwise objectionable); and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974) (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 CFR § 2.123(j); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648 (TTAB 2007) (overruling objections that notice of deposition was facially deficient and did not sufficiently identify the witness 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), different results reached on reh'g, 3 USPQ2d 1708 (TTAB 1984); and *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 CFR § 2.123(j).

404.08(c) Objections During Deposition

Fed. R. Civ. P. 30(c)(2) Objections. *... An objection must be stated concisely and 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)(3)(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.*

Fed. R. Civ. P. 32(d)(3)(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 CFR § 2.120(j)(1), 37 CFR § 2.120(j)(2), 37 CFR § 2.120(j) (3)(i), and 37 CFR § 2.120(j) (4), the propriety of the objection will be considered by the Board at final hearing when the objections are preserved in the final briefs; 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 CFR § 2.123(k).

2. Fed. R. Civ. P. 32(d)(3)(B). *Cf.* 37 CFR § 2.123(j).

3. Fed. R. Civ. P. 30(c)(2).

4. Fed. R. Civ. P. 30(d); Fed. R. Civ. P. 30(d) Advisory Committee's notes (1993 amendment).

5. *See* 37 CFR § 2.116(g) and 37 CFR § 2.123(e)(4); Fed. R. Civ. P. 26(b), 30(c)(2), and 37(a); Fed. R. Evid. 501; and 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2113 (2009)**.** *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 CFR § 2.120(j)(3)(i); *Fischer Gesellschaft m.b.H. 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 Cor*p., 183 USPQ 184, 189 (TTAB 1974). *Cf. Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629 (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 (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 very 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. 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 nonparty information that may be helpful to the deposing party's case. The discovery deposition is taken of the adversary or a nonparty, or an official or employee of the adversary or a nonparty. 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 2.]

The discovery deposition may only be taken during the discovery period, which is ongoing for all parties at the same time. *See also* TBMP § 403.02. [Note 3.] 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 therein. [Note 4.]

In a discovery deposition, a party may seek information that would be inadmissible at trial, provided that the information sought appears reasonably calculated to lead to the discovery of admissible evidence. [Note 5.] 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 6.]

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 7.] 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, 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 8.]

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 9.] 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 10.]

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's testimony. [Note 11.]

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 12.] TBMP § 704.09. That is, the offering of a discovery deposition in evidence is voluntary, not mandatory. [Note 13.] *See* TBMP § 704.09 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 14.] 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, may only be taken pursuant to a subpoena issued by a United States district court. [Note 15.] *See*

TBMP § 703.01(f) regarding securing attendance of an adverse party or nonparty and TBMP § 707.03(d) regarding the refusal of a party to answer testimony deposition question.

NOTES:

1. *See* Fed. R. Civ. P. 30 and Fed. R. Civ. P. 31.

2. *See Bison Corporation v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979); *Smith International, Inc. v. Olin Corp*., 201 USPQ 250 (TTAB 1978).
3. *See Smith International, Inc. v. Olin Corp.,* 201 USPQ 250 (TTAB 1978); *Rhone-Poulenc Industries v. Gulf Oil Corp*., 198 USPQ 372 (TTAB 1978).

4. 37 CFR § 2.121(a).

5. *See* Fed. R. Civ. P. 26(b)(1).

6. *See* 37 CFR § 2.122(a) and 37 CFR § 2.123(k).

7. *See* 37 CFR § 2.116(g); 37 CFR § 2.123(e)(4); Fed. R. Civ. P. 26(b)(5), 30(c), and 37(a)(3)(B); Fed. R. Evid. 501; 8A C.WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2113 (2009).

8. *See Ferro Corp. v. SCM Corp*., 219 USPQ 346, 351 (TTAB 1983); *Neville Chemical Co. v. Lubrizol Corp*., 183 USPQ 184, 189 (TTAB 1974).

9. 37 CFR § 2.120(e); *Neville Chemical Co. v. Lubrizol Corp*., 183 USPQ 184, 189 (TTAB 1974).

10. *See Jain v. Ramparts Inc*., 49 USPQ2d 1429 (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).

11. *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).

12. *See e.g., Galaxy Metal Gear Inc. v. Direct Access Technology Inc*., 91 USPQ2d 1859 (TTAB 2009) (motion granted allowing opposer to offer into evidence discovery deposition of nonparty witness residing in a foreign country via notice of reliance because witness unavailable during trial phase and not willing to appear voluntarily); *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); and *Parfums de Coeur Ltd. v. Lazarus,* 83 USPQ2d 1012 (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 (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).

13. *See, e.g., Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 867 (TTAB 1979); 37 CFR § 2.120(j)(1), 37 CFR § 2.120(j)(2), and 37 CFR § 2.120(j)(3)(i).

14. *See generally* 37 CFR § 2.123.

15. *See* 37 CFR § 2.120(b); Fed. R. Civ. P. 30(b); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583 (TTAB 1976). For further information concerning differences between discovery and testimony depositions, *see Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861 (TTAB 1979) (discovery deposition of nonparty 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); and *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978).

405 Interrogatories

405.01 When Permitted and By Whom

For inter partes proceedings commenced on or after November 1, 2007, 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 § 403.01. Interrogatories may be served on an adversary from the opening of the discovery period through the last day of the discovery period, even though the answers to later served interrogatories will not be served until after the discovery period has closed. TBMP § 403.02. Interrogatories may not be served on a non-party. [Note 2.]

NOTES:

1. 37 CFR § 2.120(a)(3).

2. *See* Fed. R. Civ. P. 33; 37 CFR § 2.120(d)(1).

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 (TTAB 1973).

405.03 Limit on Number

405.03(a) Description of Limit

37 CFR § 2.120(d)(1) *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. 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.

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.")

405.03(b) Application of Limit: Sets of Interrogatories

The numerical limit of 37 CFR § 2.120(d)(1) 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 CFR § 2.120(d)(1) 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, 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 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 of 37 CFR § 2.120(d)(1), 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 CFR § 2.120(d)(1) has been exceeded. On the other hand, 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); and *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990).

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).

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 Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625, 1626 (TTAB 1992).

405.03(e) Remedy for Excessive Interrogatories

37 CFR § 2.120(d)(1) *... If a party upon which interrogatories have been served believes that the number of interrogatories 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 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 (e) 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 CFR § 2.120(d)(1), 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 1.] A party should not answer what it considers to be the first 75 interrogatories and object to the rest as excessive. [Note 2.]

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 CFR § 2.120(e), including the requirement that a motion to compel 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 3.] It is further recommended that the moving party set out its counting method showing that the number of interrogatories does not exceed 75. 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 numerical limit. 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

4.]

However, if the revised set is not served until after the close of the discovery period, 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 5.]

Although there are no limitations on the number of document requests that may be served, 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 6.]

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 CFR § 2.120(d)(1). *Cf. Amazon Technologies v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009).

2. *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572, 1574 (TTAB 1990).

3. 37 CFR § 2.120(d)(1) and 37 CFR § 2.120(e).

4. *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 (TTAB 1990); *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).

5. *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636 (TTAB 1990); *Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc.*, 16 USPQ2d 1468, 1469 (TTAB 1990).

6. *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 CFR § 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. 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. If service of the interrogatories is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the interrogatories. [Note 1.] TBMP § 113.05 and TBMP § 403.03. In instances where the parties have agreed to electronic service, e.g. service by facsimile or e-mail, no additional time is allowed for responding to the interrogatories. [Note 2.] 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 3.] 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 4.] 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 5.] 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 6.]

NOTES:

1. 37 CFR § 2.119(c).

2. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42250 (August 1, 2007) ("As for agreed use by parties of email or fax for forwarding of service copies, the Office confirms that § 2.119(c) would not apply to service by electronic transmission (e-mail or fax) under § 2.119(b)(6).").

3. *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); and *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); and *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).

4. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000).

5. *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).

6. 37 CFR § 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 stated in lieu of an answer. [Note 1.] If a responding party believes that the number of interrogatories served exceeds the limit specified in 37 CFR § 2.120(d)(1), 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 2.] 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) and 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 3.] 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 4.] 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 5.]

A responding party cannot simultaneously invoke the option to produce business records and claim the protection of a privilege as to the documents. [Note 6.]

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. 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).

2. 37 CFR § 2.120(d)(1).

3. Fed. R. Civ. P. 33(d); *Johnson & Johnson v. Obschestvo s ogranitchennoy; otvetstvennostiu "WDS,"* 95 USPQ2d 1567 (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); and *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).

4. Fed. R. Civ. P. 33 Advisory Committee's notes, (2006 Amendment Rule 33(d)).

5. Fed. R. Civ. P. 33 Advisory Committee's notes, (2006 Amendment, Rule 33(d)).

6. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000); 8B C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2178 (2009).

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).

2. *See Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ2d 1663, 1665 (TTAB 1988).

3. *See* 37 CFR § 10.63; *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

For inter partes proceedings commenced on or after November 1, 2007, a party may serve discovery, including requests for the production of documents and things, on any other party only during the discovery period and provided that the serving party has either previously served or is serving concurrently therewith its initial disclosures, absent a stipulation or a granted motion or upon order of the Board to the contrary. [Note 1.] TBMP § 403.02. Requests for production may be served through the last day of the discovery period, even though the responses thereto may not be served until after the discovery period has closed. TBMP § 403.03 (Time for Service of Discovery Responses). 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 35 days prior to the scheduled date of the deposition if service of the requests for production is made by first-class mail, "Express Mail," or overnight courier, and at least 30 days prior to the deposition if service of the requests for production is made by one of the other methods specified in 37 CFR § 2.119(b). [Note 2.] TBMP § 113.04 (Manner of Service), TBMP § 113.05 (Additional Time for Service by Mail), and TBMP § 403.03 (Time for Service of Discovery Responses).

Requests for production may not be served on a non-party. [Note 3.] However, if a discovery deposition deponent is a nonparty 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 4.] *See* TBMP § 404.03(a)(2). A subpoena is unnecessary, however, if the nonparty 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 serve to preclude such discovery. [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* Fed. R. Civ. P. 34(a); *Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978).

2. 37 CFR § 2.119(c).

3. *See* Fed. R. Civ. P. 34(a).

4. 35 U.S.C. § 24; Fed. R. Civ. P. 45.

5. *Societe Internationale Pour Participations Industrielles et Commerciales, S.A. v. Rogers,* 357 U.S. 197 (1958) (Swiss government ordered Swiss plaintiff in U.S. court proceeding not to produce certain documents).

6. *Cochran Consulting Inc. v. Uwatec USA Inc.*, 102 F.3d 1224, 41 USPQ2d 1161 (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 to create or prepare documents that do not already exist in response to a discovery request. [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), *and aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (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 3d § 2210 (2009) ("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. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 and 42252 (August 1, 2007); 37 CFR § 2.120(a)(2); Fed. R. Civ. P. 26(f).

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.*

(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 an objection to the request, including the reasons.*

(C) Objections. *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. [Note 1.]

NOTES:

1. Fed. R. Civ. P. 34(b)(2)(e). *See e.g.*, *Amazon 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).

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 CFR § 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.*

Responses to requests for production must be served within 30 days after the date of service of the requests, unless otherwise stipulated by the parties or ordered by the Board. [Note 1.] TBMP § 403.03. If service of the requests is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the requests. [Note 2.] TBMP § 113.05. In instances where the parties have agreed to electronic service, e.g. facsimile or e-mail, no additional time is allowed for responding to the requests. [Note 3.] 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 4.] TBMP § 403.03 and TBMP § 405.04(a).

NOTES:

1. Fed. R. Civ. P. 34(b)(2)(A); 37 CFR § 2.120(a).

2. 37 CFR § 2.119(c).

3. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42250 (August 1, 2007) ("As for agreed use by parties of email or fax for forwarding of service copies, the Office confirms that § 2.119(c) would not apply to service by electronic transmission (e-mail or fax) under § 2.119(b)(6).").

4. *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 CFR § 2.120(d)(2) *The production of documents and things under the provisions of Rule 34 of the Federal Rules of Civil Procedure will be made at the place where the documents and things are usually kept, or where the parties agree, 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 CFR § 2.120(d)(2). [Note 1.] A party is only obliged to make documents and materials available for inspection and copying, where the documents are stored, and as they are kept in the ordinary course of business, [Note 2] or as organized and labeled to correspond to the requests. [Note 3.] However, in Board cases, parties often extend each other the courtesy of producing requested documents by copying the documents and forwarding them to the requesting party at the requesting party's expense. [Note 4.] Indeed, the Board believes this is more efficient and thus encourages this method of producing documents. [Note 5.] Parties are expected to discuss such arrangements 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 CFR § 2.120(d)(2), 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. *See Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1777 (TTAB 1998); *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013, 1015 (TTAB 1983); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 195 (TTAB 1976).

2. *No Fear Inc. v. Rule*, 54 USPQ2d 1551 (TTAB 2000).

3. Fed. R. Civ. P. 34(b)(2)(i).

4. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775 (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.)

6. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 and 42252 (August 1, 2007); 37 CFR § 2.120(a)(2); Fed. R. Civ. P. 26(f).

7. Fed. R. Civ. P. 34(b)(2)(E)(ii). *See* Fed. R. Civ. P. 34 Advisory Committee's notes, (2006 Amendment).

8. Fed. R. Civ. P. 34 Advisory Committee's notes, (2006 Amendment Rule 34, Subdivision (b)).

9. Fed. R. Civ. P. 34 Advisory Committee's notes, (2006 Amendment Rule 34, Subdivision (b)).

10. Fed. R. Civ. P. 34(b)(2)(E)(iii).

11. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (at the responding party's expense as a discovery sanction); *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013 (TTAB 1983) (at the requesting party's expense). *Cf. Electronic Industries Association v. Potega*, 50 USPQ2d 1775 (TTAB 1998).

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 an objection to the request, including the reasons.*

Fed. R. Civ. P. 34(b)(2)(C) Objections. *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.*

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, unless the request is objected to, in which case the reasons for objection must be stated. [Note 1.] For any item or category of documents which is not subject to a stated objection, a proper response should state whether or not there are responsive documents and, if there are responsive documents, whether they will be produced or withheld on a claim of privilege. [Note 2.] 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 3.] If objection is made to only part of an item or category, the part must be specified. A party may object to a requested form of data production for electronically stored information. [Note 4.] If no form for the electronically stored information is specified in the request, the party must state the form it intends to use. 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 5.] A party that produces electronically stored information must produce the information in the form specified by the request, if no objection is made. [Note 6.] It is contemplated that the parties will attempt to resolve such issues, i.e., the manner in which electronically stored information will be produced, during their discovery conference. If no specification is made as to form in the request, a party must produce the electronically stored information in the form in which it is ordinarily maintained, or in a reasonably usable form. [Note 7.]

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. 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).

2. *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

3. *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1679 (TTAB 2005).

4. Fed. R. Civ. P. 34(b)(2)(D).

5. Fed. R. Civ. P. 34(b)(2)(E)(i); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000), *citing* 8B C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2213 (2009) (party may not simply dump large quantities of documents containing responsive as well as unresponsive documents).

6. Fed. R. Civ. P. 26(f)(3)(c). *See also*, Fed. R. Civ. P. 34 Advisory Committee's note, (2006 Amendment Rule 34, Subdivision (b)).

7. Fed. R. Civ. P. 34(b)(2)(E)(ii).

407 Requests for Admissions

407.01 When Permitted and By Whom

For cases commenced on or after November 1, 2007, like interrogatories and requests for production of documents, absent a stipulation or granted motion or order of the Board to the contrary, requests for admission may be served on an adversary after service of or contemporaneously with initial disclosures, through the last day of the discovery period, even though the answers thereto will not be due until after the discovery period has closed. TBMP § 403.01 and TBMP § 403.02. 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.]

NOTES:

1. Fed. R. Civ. P. 36(a); 37 CFR § 2.120(a).

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.

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).

NOTES:

1. *See e.g.*, *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (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 (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).

407.03 Responses to Requests for Admission

407.03(a) Time for Service of Responses

37 CFR § 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) Requests for Admission.

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) Extending Time.

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. If service of the requests is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the requests. [Note 2.] TBMP § 113.05 and TBMP § 403.03. In instances where the parties have agreed to electronic service, e.g. service by facsimile or e-mail, no additional time is allowed for responding to the requests. [Note 3.] 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 4.]

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 5] unless the party is able to show that its failure to timely respond was the result of excusable neglect [Note 6] 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 7.] 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 CFR § 2.120(a)(3).

2. 37 CFR § 2.119(c).

3. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42250 (August 1, 2007) ("As for agreed use by parties of email or fax for forwarding of service copies, the Office confirms that § 2.119(c) would not apply to service by electronic transmission (e-mail or fax) under § 2.119(b)(6).").

4. Fed. R. Civ. P. 36(a)(3).

5. *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. Sandia Inc*., 11 USPQ2d 1227, 1228 n.5 (TTAB 1989).

6. 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).

7. 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 Ass'n (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; and *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); and *Questor Corp. v. Dan Robbins & Associates, Inc*., 199 USPQ 358, 361 n.2 (TTAB 1978), *aff'd*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979) (by failing to answer requests for admissions, opposer admitted that it abandoned use of certain registered marks).

407.03(b) Nature of Responses

Fed. R. Civ. P. 36(a) Requests for Admission.

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 so 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 stating its reasons for objection to those that it believes to be improper. *See* TBMP § 410. For information regarding a party's duty to supplement requests for admissions, *see* TBMP § 408.03.

For information regarding excessive requests for admissions requiring relief by protective order, *see* TBMP § 412.06(b).

NOTES:

1. Fed. R. Civ. P. 36(a).

2. Fed. R. Civ. P. 36(a).

3. Fed. R. Civ. P. 36(a).

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 CFR § 10.63. *Cf. Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ2d 1663 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.]

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 (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 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); *American Automobile Ass'n, 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); *Olin Corporation v. Hydrotreat, Inc.*, 210 USPQ 63, 65 n.4 (TTAB 1981) (anything not admitted is not established).

2. Fed. R. Civ. P. 36(b).

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 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 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., 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, 1305 (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 (TTAB 1974); and *Gastown Inc. of Delaware v. Gas City, Ltd.,* 180 USPQ 477 (TTAB 1974).

3. *Miss America Pageant v. Petite Productions, Inc.,* 17 USPQ2d 1067 (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 involved in inter partes proceedings commenced on or after November 1, 2007, 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. [Note 6.] In such instances, the Board professional will contact the non-cooperating party directly to schedule the conference. If the uncooperative party refuses 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 CFR § 2.120(g). 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 CFR § 2.120(g). 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 CFR § 2.120(g) 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.]

For a more detailed discussion of discovery conferences, *see* TBMP § 401.01.

NOTES:

1. *See* 37 CFR § 2.120(a)(2); Fed. R. Civ. P. 26(f). *See also* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007). *See e.g., Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (TTAB 2009).

2. *See e.g., Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (TTAB 2009).

3. *See e.g., Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (TTAB 2009).

4. *See e.g., Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (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 (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. Michael 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 (TTAB 2009).

7. 37 CFR § 2.120(g)(1).

8. *See e.g., Promgirl, Inc., v. JPC Co.,* 94 USPQ2d 1759 (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. Michael Boyd,* 88 USPQ2d 1701, 1704 (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).

408.01(b) Obligation to Make Initial and Expert Testimony Disclosures

As part of the discovery phase of each inter partes proceeding commenced on or after November 1, 2007, all involved parties are obliged to make initial and when necessary expert testimony disclosures. The Board adopted a disclosure regime in order 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 [to] increase the likelihood of fair disposition of the parties' claims and defenses." [Note 1.] In addition, the utilization 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.

In the event 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. [Note 6.] The expert disclosure requirement is intended to avoid any unfair surprise during the testimony period. 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 7.] 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 8.] 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. The parties should revisit these discussions whenever it appears that a testifying expert witness may become involved in the case.

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, 72 Fed. Reg. 42242, 42244 and 42246 (August 1, 2007).

2. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 and 42246 (August 1, 2007).

3. 37 CFR § 2.120(a)(1); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

4. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

5. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

6. 37 CFR § 2.120(a); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 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 CFR § 2.120(a)(2)). *See Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443 (TTAB 2009).

7. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

8. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

408.01(c) Duty to Cooperate With Regard to Written Discovery and Disclosures

Fed. R. Civ. P. 26(g)(1) *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 CFR § 2.120(e) (1) *A motion to compel initial disclosures, expert testimony disclosures, or discovery must be supported by a written statement 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 therefore the issues presented in the motion but the parties were unable to resolve their differences.*

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 lawyer 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 written statement showing that such a good faith effort was made. [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 (TTAB 1990). *Cf.* 37 CFR § 10.18(a); Fed. R. Civ. P. 11.

2. Fed. R. Civ. P. 26 Advisory Committee's notes, (1983 Amendment Rule 26, Subdivision (g)).

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 Advisory Committee's notes, (1983 Amendment Rule 26, Subdivision (g)).

5. 37 CFR § 2.120(e).

6. 37 CFR § 2.120(e).

7. 37 CFR § 2.120(e). *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 either they 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 which, 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 also* TBMP § 527.01(e) ("Estoppel Sanction").

NOTES:

1. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551 (TTAB 2000).

2. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000).

3. Fed. R. Civ. P. 34(b)(2).

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 (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.

Fed. R. Civ. P. 26(e)(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)(1) and (2). [Note 1.] Under that rule, a party that has made an initial or expert disclosure or has responded to a request for discovery with a response is under a duty to supplement or correct the response in a timely manner to include information under the particular circumstances specified in paragraphs (e)(1) and (2). [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, however, 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.] A party also will not be sanctioned for "failing to provide electronically stored information lost as a result of the routine, good-faith operation of an electronic information system." [Note 6.] Subsections (A) and (B) of Fed. R. Civ. P. 37(c)(1) 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.]

NOTES:

1. *See* 37 CFR § 2.116(a).

2. *See Vignette Corp. v. Marino*, 77 USPQ2d 1408 (TTAB 2005); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1284 (TTAB 1998).

3. *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 nonparty 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's 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) Advisory Committee Notes (1993 amendment to Rule 26(e)) ("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), *citing* 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2049.1 (2009).

5. *See Byer California v. Clothing for Modern Times Ltd.,* 95 USPQ2d 1175 (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 Galaxy Metal Gear Inc. v. Direct Access Technology Inc*., 91 USPQ2d 1859 (TTAB 2009) (because identity of nonparty 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. Fed. R. Civ. P. 37(e).

7. *See Byer California v. Clothing for Modern Times Ltd.,* 95 USPQ2d 1175 (TTAB 2010) (party ordered to serve revised pretrial disclosures). *Cf. Bison Corp. v. Perfecta Chemie B.V.,* 4 USPQ2d 1718 (TTAB 1987); *Andersen Corp. v. Therm-O-Shield Int'l, Inc.,* 226 USPQ 431 (TTAB 1985); *JSB International, Inc. v. Auto Sound North, Inc.,* 215 USPQ 60 (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 (CCPA 1978).

409 Filing Discovery Requests, Discovery Responses, and Disclosures With Board

37 CFR § 2.120(j) ***Use of discovery deposition, answer to interrogatory, admission, or written disclosure***.

* * * *

37 CFR § 2.120(j)(6) *Paragraph (j) 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 CFR § 2.120(j)(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 CFR § 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. 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 4.]

NOTES:

1. *Hiraga v. Arena*, 90 USPQ2d 1102 (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 CFR § 2.122(e) are printed publications and official records); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953 (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 CFR § 2.120(j)(3)(i); printed publications and official records, 37 CFR § 2.122(e)); *Ballet Tech Foundation Inc. v. Joyce Theater Foundation Inc.*, 89 USPQ2d 1262, 1265 n.2 (TTAB 2008) (documents produced in response to document production requests cannot normally be made of record by notice of reliance); *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912 (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 (TTAB 2007) (opposer filed a notice of reliance, pursuant to 37 CFR § 2.120(j)(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 (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 (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 (TTAB 2003) (if documents are offered in response to an interrogatory, they are admissible under 37 CFR § 2.120(j)(3)(i)).

2. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007); 37 CFR § 2.120(a)(2).

3. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

4. *See* 37 CFR § 2.120(j)(6) and 37 CFR § 2.120(j)(8). *See also 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 CFR § 2.120(j)(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), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (to be considered on summary judgment, responses to discovery requests must be submitted with motion or responsive brief); *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 CFR § 2.120(j)(8)); and *Fischer Gesellschaft m.b.H. 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).

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 § 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 for cases pending or commenced as of August 31, 2007. [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, for proceedings commenced on or after November 1, 2007, 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.]

Further, 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 CFR § 2.120(d)(1), 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).

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, for example, when a clearly unreasonable number of requests for production or requests for admission are served, or on which 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 9.]

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 10.] *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 11.] 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), (B) and (D). A motion to compel initial disclosures or expert testimony disclosures must be filed prior to the close of the discovery period. [Note 12.] 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 13.] For further information concerning disclosures and motions to compel disclosures, *see* TBMP § 401 and TBMP § 523.

NOTES:

1. *See No Fear, Inc. v. Rule,* 54 USPQ2d 1551 (TTAB 2000); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Luehrmann v. Kwick Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987); *Envirotech Corp. v. Compagnie Des Lampes,* 219 USPQ 448 (TTAB 1979); *McMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691 (TTAB 1975).

2. *See No Fear, Inc. v. Rule,* 54 USPQ2d 1551 (TTAB 2000).

3. *See* 37 CFR § 2.116(g).

4. *See No Fear, Inc. v. Rule,* 54 USPQ2d 1551 (TTAB 2000).

5. *Dating DNA, LLC v. Imagini Holdings, LLC,* 94 USPQ2d 1889 (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 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 (TTAB 1976) (a motion to strike interrogatories is improper; objections to interrogatories should be served upon the interrogating party); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.,* 188 USPQ 690 (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 (TTAB 1974); *Dow Corning Corp. v. Doric Corp.,*183 USPQ 126 (TTAB 1974); and *Atwood Vacuum Machine Co. v. Automation Industries, Inc.,* 181 USPQ 606 (TTAB 1974).

8**.** 37 CFR § 2.120(d)(1).

9. *See, e.g.,* Fed. R. Civ. P. 26(c); 37 CFR § 2.120(f); Fed. R. Civ. P. 36 Advisory Committee notes, (1970 amendment) ("requests to admit may be so voluminous and so 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)").

10. *See National Football League v. DNH Management LLC,* 85 USPQ2d 1852 (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).

11. 37 CFR § 2.120(e); *Influance v. Zuker,* 88 USPQ2d 1859 (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).

12. 37 CFR § 2.120(e).

13. *See Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC,* 88 USPQ2d 1541 (TTAB 2008).

411 Remedy for Failure to Provide Disclosures or Discovery

411.01 Initial and Expert Testimony Disclosures

In inter partes proceedings commenced on or after November 1, 2007, 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 or 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. [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 CFR § 2.120(e); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 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, Influance v. Zuker*, 88 USPQ2d 1859 (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 CFR § 2.120(e).

3. 37 CFR § 2.120(g)(1); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 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 CFR § 2.120(g)(1) denied as premature where no Board order in place compelling discovery). *But see* 37 CFR § 2.120(g)(2); *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541 (TTAB 2008) (discussing both 37 CFR §§ 2.120(g)(1) and (g)(2)).

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.] 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 3.]

For information concerning motions to compel, *see* TBMP § 523.

NOTES:

1. 37 CFR § 2.120(e).

2. 37 CFR § 2.120(e). *Cf.* Fed. R. Civ. P. 37(a)(2)(B).

3. 37 CFR § 2.120(g)(2). *Cf. Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC,* 88 USPQ2d 1541 (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.").

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 will stand admitted 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.] *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 (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 (TTAB 1990).

2. Fed. R. Civ. P. 36(a); 37 CFR § 2.120(h).

3. Fed. R. Civ. P. 36(a).

4. Fed. R. Civ. P. 36(a).

411.04 Discovery Depositions

If a party fails to designate a person pursuant to Fed. R. Civ. P. 30(b)(6) or Fed. R. Civ. P. 31(a),

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.] 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, 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 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.

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. However, if a witness being deposed objects to, and refuses to answer, or is instructed by counsel not 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 § 404.08(c). In the absence of a court order the propounding party's only alternative, if it wishes to compel a response, is to complete the deposition and then file a motion to compel with the Board. [Note 2.]

NOTES:

1. 37 CFR § 2.120(e). *Cf.* Fed. R. Civ. P. 37(a).

2. 37 CFR § 2.120(e). *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).

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 CFR § 2.120(g). [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 CFR § 2.116 (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. However, the Board will not hold any person in contempt, or award any expenses, including attorneys' fees, to any party. [Note 3.]

For further information concerning discovery sanctions and when they are available, *see* TBMP § 527.01.

For information regarding attorneys' fees in Board proceedings, *see* TBMP § 502.05.

NOTES:

1. *See e.g.*, *Amazon v. Wax*, 95 USPQ2d 1865 (TTAB 2010) (Board imposed sanctions pursuant to 37 CFR § 2.120(g)(1)); opposer ordered to serve index of produced documents, supplemental answers to certain interrogatories; discovery reopened for applicant only).

2. *Promgirl, Inc., v. JPC Co.*, 94 USPQ2d 1759 (TTAB 2009); *Guthy-Renker Corp. v. Michael Boyd*, 88 USPQ2d 1701, 1704 (TTAB 2008).

3. 37 CFR § 2.120(g)(1) and 37 CFR § 2.120(g)(2); 37 CFR § 2.127(f).

412 Protective Orders

37 CFR § 2.116(g) *The Trademark Trial and Appeal Board's standard protective order is applicable during disclosure, discovery and at trial in all opposition, cancellation, interference and concurrent use registration 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, or upon request, a copy will be provided. 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.*

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 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.

Highly Confidential -Material to be shielded by the Board from public access and subject to

agreed restrictions on access even as to the parties and/or their attorneys.

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 paragraph 4 and 5, by independent experts or consultants for the parties.

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 document; (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, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected 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, 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 otherwise employees of either the party or its attorneys.

-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 or highly confidential, subject to any agreed exceptions.

Outside counsel, but not in-house counsel, shall have access to information designated as 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 or highly confidential information in accordance with the terms that follow in paragraph 4. Further, independent experts or consultants may have access to 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 paragraph 4 and 5.

37 CFR § 2.120(f) *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 (1) through (8), inclusive, of Rule 26(c) 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 provide or permit discovery.*

Fed. R. Civ. P. 26(c)(1) *…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, 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) *. . . 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 CFR § 2.120(f) "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 web site 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. Cases commenced prior to August 31, 2007 in which a protective order has already been approved or imposed by the Board are not affected.

The Board's standard protective order provides for three tiers of protected information (1) confidential, (2) highly confidential, and (3) trade secret/commercially sensitive. Parties and their attorneys shall have access to information designated as confidential or highly confidential, subject to any agreed exceptions. Outside counsel, but not in-house counsel, shall have access to information designated as trade secret/commercially sensitive. Parties and those parties or individuals appearing pro se will not have access to information designated as 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 3.] The Board has the authority to sanction attorneys and individuals determined to be in breach during a proceeding. [Note 4.] *See also* TBMP § 527.

In Board proceedings, access to a party's confidential, highly confidential or trade secret/commercially sensitive information 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 5.] The Board's standard protective order does not automatically protect all information. [Note 6.] Parties must actively

utilize the provisions when seeking to designate protected information. [Note 7.] 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 8.] Nonetheless, when responding to discovery or filing submissions before the Board, the party seeking to designate information as confidential, highly confidential or trade secret has a duty to make a meaningful effort to designate only that information that warrants the designated level of protection. [Note 9.] For information regarding the designation of material as confidential and procedures regarding redaction at trial, *see* 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 10.] 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 11.]

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 12.] 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 CFR § 2.120(f), 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 13.] *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 14.] 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 15.] 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. [Note 16.] 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 17.] For further information on motions for protective orders, *see* TBMP § 410 (Motions Attacking Requests for Discovery), TBMP § 412.02 (Protective Order Regarding Confidential and Trade Secret Information) and TBMP § 526 (Motion for a Protective Order).

NOTES:

1. 37 CFR § 2.116(g); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 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, 72 Fed. Reg. 42242, 42244 (August 1, 2007). The standard protective order can viewed on the Board's home page of the USPTO web site at www.uspto.gov.

3. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42251 (August 1, 2007).

4. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42251 (August 1, 2007).

5. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42251 (August 1, 2007).

6. 37 CFR § 2.116(g). *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

7. *See* 37 CFR § 2.116(g); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

8. *See e.g., Wet Seal, Inc. v. FD Management, Inc.,* 82 USPQ2d 1629, 1633 n.6 (TTAB 2007).

9. *See e.g., 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).

10. *See e.g., Amazon Technologies, Inc. v. Wax,* 93 USPQ2d 1702, 1706 n.6 (TTAB 2009).

11. 37 CFR § 2.120(g).

12. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

13. *See* Fed. R. Civ. P. 26(c)(1); 37 CFR § 2.120(f). *See e.g., Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.,* 74 USPQ2d 1672 (TTAB 2005).

14. *FMR Corp. v. Alliant Partners,* 51 USPQ2d 1759, 1761 (TTAB 1999).

15. *A. Hirsh, Inc. v. United States,* 657 F. Supp. 1297, 1305 (C.I.T. 1987).

16. *See e.g., Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.,* 74 USPQ2d 1672 (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).

17. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

412.02 Modification of Board's Standard Protective Order Governing the Exchange of Confidential, Highly 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, highly confidential, and trade secret/commercially sensitive information. 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 1.]

NOTES:

1. 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2043 (2009).

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 CFR § 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 trade secret/commercially sensitive information. 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 trade secret/commercially sensitive information. [Note 1.] In instances where in-house counsel moves to amend the Board's protective order to permit access to trade secret/commercially sensitive information, the determining factor is whether in-house counsel is involved in its employer-litigant's "competitive decision making." [Note 2.]

NOTES:

1. *See A. Hirsh, Inc. v. United States,* 657 F. Supp. 1297, 1305 (C.I.T. 1987).

2. *See U.S. Steel Corp. v. United States,* 730 F.2d 1465 (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, after which the document will be returned to the party which submitted it. [Note 1.]

NOTES:

1. *Amazon 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 definition of the type of material to be considered confidential or trade secret information.

(2) The description of the manner in which confidential or trade secret information is to be handled.

(3) 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.

(4) 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.

(5) 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.

(6) 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.

(7) 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.

(8) 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).

(9) 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.

(10) 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.

(11) The means for resolving disputes over whether particular matter constitutes confidential or trade secret information.

(12) In order to 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" in ESTTA (Electronic System for Trademark Trials and Appeals), the Board's electronic filing system, or 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 trade secret submissions filed either via ESTTA or by paper, two versions are required – a confidential version as well as a redacted version available for public viewing. It is preferable for parties to file confidential and trade secret materials through ESTTA. For further information regarding the filing of confidential materials, *see* TBMP § 120.02, TBMP § 412.04 and TBMP § 412.05.

(13) 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.

The Board's standard protective order can be found on the USPTO web site at: www.uspto.gov.

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). Note that these cases were decided prior to automatic imposition of the Board's standard protective order.

412.03 Duration of Protective Order

Excerpt from Board's Standard Protective Order

15) 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 and briefs may be retained, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, the parties and their attorneys shall return to each disclosing party the protected information disclosed during the proceeding, and shall include any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

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. 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 1.] 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 2.] 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 3.]

NOTES:

1. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42251 (August 1, 2007).

2. *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); and *Fort Howard Paper Co. v. C.V. Gambina Inc.,* 4 USPQ2d 1552, 1555 (TTAB 1987). *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 (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).

3. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42251 (August 1, 2007).

412.04 Filing Confidential Materials With Board

37 CFR § 2.27(d) ***Pending trademark application index; access to applications***.
Except as provided in paragraph (e) of this section, after a mark has been registered, or published for opposition, the file of the application and all proceedings relating thereto are available for public inspection ..

37 CFR § 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 CFR § 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(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.*

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 brief that discusses such information, the protected information or portion of the brief discussing the same should be redacted from the remainder. A rule of reasonableness should dictate how redaction is effected.

Redaction can entail merely covering a portion of a page of material when it is copied 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 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 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. 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.

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. 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 1.] Paper or electronic submissions in Board proceedings 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 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 by paper under seal, the party must also submit for the public record a redacted version of said paper. [Note 2.]. Thus, for confidential submissions filed

either via ESTTA or by paper, two versions are required – a confidential version as well as a redacted version available for public view. A rule of reasonableness dictates what information should be redacted, and only in very rare instances should an entire submission be deemed confidential. [Note 3.] In cases where a redacted version has not been provided, the confidentiality of the information may be deemed waived. [Note 4.]

Electronic filing using ESTTA is preferred for submissions containing confidential material. When using ESTTA, the filer should select "CONFIDENTIAL Opposition, Cancellation or Concurrent Use" under "File Documents in a Board Proceeding." [Note 5.] 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.

For further information regarding the use of ESTTA for confidential filings, *see* TBMP § 120.02.

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 6.] 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 7], 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. *See* 37 CFR § 2.116(g).

2. *See* 37 CFR § 2.27(d) and 37 CFR § 2.27(e), and 37 CFR § 2.126(d); *Duke University v. Haggar Clothing Inc.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

3. *See e.g., 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).

4. *See e.g., Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1633 n.6 (TTAB 2007).

5. *See* http://estta.uspto.gov/filing-type.jsp.

6. *See* 37 CFR § 2.126(d).

7. *See* 37 CFR § 2.126(d).

412.05 Handling of Confidential Materials By the Board

A confidential filing submitted via ESTTA 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 filings. Confidential materials submitted in paper form (including trade secret information) 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 material, while given full consideration by the Board in its rulings, will not be disclosed in orders or decisions. [Note 1.] After the proceeding before the Board has been finally determined, the party(ies) will be contacted to arrange for the return or retrieval of all confidential materials submitted by them, or otherwise be required to consent to their disposal. If the Board does not hear from the party(ies) within a specified time period, the confidential materials will be destroyed. For further information regarding the handling of confidential information by the Board, *see* TBMP § 120.02. For information concerning access to protective order materials during an appeal from the decision of the Board, *see* TBMP § 904.

NOTES:

1. *See e.g., Schering Plough HealthCare Products Inc. v. Ing-Jing Huang,* 84 USPQ2d 1323, 1324 (TTAB 2007); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha,* 77 USPQ2d 1917, 1930 n.22 (TTAB 2006).

412.06 Protective Orders Limiting Discovery

37 CFR § 2.120(f) *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 (1) through (8), inclusive, of Rule 26(c) 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 provide or permit discovery.*

Fed. R. Civ. P. 26(c)(1) *. . . 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, 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.*

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 CFR § 2.120(f), 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.]

For additional information regarding motions for protective order, *see* TBMP § 412 and TBMP § 526.

NOTES:

1. *See e.g.*, *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 CFR § 2.120(f); Fed. R. Civ. P. 26(c)(1).

3. *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).

5. *See e.g.*, *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719 (TTAB 1989); and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974).

6. Fed. R. Civ. P. 26(c)(1).

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 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.]

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.]

NOTES:

1. Fed. R. Civ. P. 26(c)(1); 37 CFR § 2.120(f); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc*., 74 USPQ2d 1672, 1674 (TTAB 2005).

2. Fed. R. Civ. P. 26(c)(1); 37 CFR § 2.120(f).

3. *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999).

4. 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2037 (2009).

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 3d § 2037 (2009) and cases cited therein.

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 is service of a general objection, rather than a motion for protective order. [Note 3.] For more information regarding excessive interrogatories, *see* TBMP § 405.

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 and requests for production and 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 or whether the volume of improper requests for production or requests for admission renders them harassing and oppressive. [Note 5.] The parties are expected to take into account the principles of proportionality with regard to document requests and requests for admission such that the volume of requests does not render them harassing and oppressive and 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 CFR § 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. *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984).

2. *Fort Howard Paper Co. v. G.V. Gambina Inc.*, 4 USPQ2d 1552, 1553 (TTAB 1987).

3. 37 CFR § 2.120(d).

4. *See e.g.*, Fed. R. Civ. P. 36 Advisory Committee notes (1970 amendment) ("requests to admit may be so voluminous and so 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)").

5. *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609 (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 (TTAB 1987) (denying motion for protective order with respect to nineteen discovery requests which were suitably tailored to the issues in the opposition); and *C. H. Stuart Inc. v. S.S. Sarna, Inc*., 212 USPQ 386 (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).

413 Telephone and Pretrial Conferences

413.01 Telephone Conferences for Motions Relating to Discovery

37 CFR § 2.120(i)(1) *Whenever its appears to the Trademark Trial and Appeal Board that a stipulation or motion filed in an inter partes proceeding is of such nature that its approval or resolution by correspondence is not practical, the Board may, upon its own initiative or upon request made by one or both of the parties, address the stipulation or resolve the motion by telephone conference.*

37 CFR § 2.127(a) *. . . Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within fifteen 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. (emphasis added).*

When appropriate and necessary, 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.

The telephone conference procedure is not limited to motions or stipulations relating to discovery. For more information concerning the conduct and arrangement of telephone conferences, *see* TBMP § 502.06.

NOTES:

1. *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 USPQ2d 1174 (TTAB 2010) (motion to compel decided by teleconference).

2. *See* 37 CFR § 2.127(a). *See e.g., Byer California v. Clothing for Modern Times Ltd.,* 95 USPQ2d 1174 (TTAB 2010).

3. *See* 37 CFR § 2.120(i). *See also International Finance Corporation v. Bravo Co.,* 64 USPQ2d 1597, 1603 n.24 (TTAB 2002) (party prohibited from filing further motions to compel without first obtaining Board permission).

413.02 Pretrial Conferences

37 CFR § 2.120(i)(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 be likely to 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 or upon motion made by one or both of the parties, request that the parties or their attorneys, under circumstances which will not result in undue hardship for any party, meet with the Board at its offices for a disclosure, discovery or pre-trial conference.*

While rarely utilized, the Board has the discretion to order the parties to meet in person at the Board's offices to resolve complex disputes surrounding disclosures and discovery for a pretrial conference. [Note 1.] For further information concerning pretrial conferences, *see* TBMP § 502.06(b).

NOTES:

1. *Amazon 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.”).

414 Selected Discovery Guidelines

Listed below are a variety of discovery determinations, with case citations, relating to the discoverability of various matters. 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 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) For proceedings commenced on or after November 1, 2007, 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. For proceedings commenced prior to November 1, 2007, a party need not, in advance of trial, identify the witnesses it intends to call, except that the names of expert witnesses intended to be called are discoverable. [Note

13.] Regardless of when proceedings commenced (i.e., before or after November 1, 2007), 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.]

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); and *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., 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 Company*, 229 USPQ 147, 149 (TTAB 1985) (allowed to provide representative samples of invoices from each calendar quarter); *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 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); and *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) and *The Procter & Gamble Company 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 Company*, 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); and *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 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 (TTAB 1975); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495 (TTAB 1975); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120 (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); and *Volkswagenwerk Aktiengesellschaft 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); and *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); and *Amerace Corp. v. USM Corp.*, 183 USPQ 506, 507 (TTAB 1974) (attorney comments on search report or prosecution of application are privileged).

8. 37 CFR § 2.121(e).

9. 37 CFR § 2.121(e).

10. 37 CFR § 2.121(e).

11. *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175 (TTAB 2010) (in the event 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, 72 Fed. Reg. 42242, 42245-6 (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 nonparty 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's identity and subject matter of her testimony and was able to cross-examine the witness during the discovery phase).

13. *See Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002) (interrogatory requesting that opposer "identify each and every fact, document and witness in support of its pleaded allegations" was equivalent to a request for identification of fact witnesses and trial evidence prior to trial, and therefore improper); *Milliken & Co. v. Image Industries, Inc.*, 39 USPQ2d 1192, 1197 (TTAB 1996) (need only identify expert witnesses); *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); *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040, 2041 (TTAB 1989) (motion to exclude testimony of witness for failure to identify witness during discovery denied); *Polaroid Corp. v. Opto Specs, Ltd.*, 181 USPQ 542, 543 (TTAB 1974) (opposer need not describe evidence it will rely on to support allegations in opposition); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 124 (TTAB 1974).

14. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

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 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 (TTAB 1988) (need not investigate); and *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 (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 G.m.b.H.*, 188 USPQ 577, 580-81 (TTAB 1975) (identity of all civil and USPTO proceedings involving mark is not objectionable); and *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 Ass'n 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 (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 Company*, 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); and *Volkswagenwerk Aktiengesellschaft 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 (TTAB 1976), *rev'd on other grounds*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (although the goods are not the same, they are of the type often made by the same manufacturer); and *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 G.m.b.H.,* 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 Aktiengesellschaft v. MTD Products Inc.,* 181 USPQ 471, 473 (TTAB 1974); and *American Optical Corp. v. Exomet, Inc.,* 181 USPQ 120, 122 (TTAB 1974) (identification of vice-president as most familiar with use held sufficient).

21. *See, for general rule, Double J of Broward Inc. v. Skalony Sportswear GmbH,* 21 USPQ2d 1609, 1612-13 (TTAB 1991); and *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.7 (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). *See, re possible exceptions,* 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); and *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 (TTAB 1983); and *Johnson & Johnson v. Diaz,* 339 F. Supp. 60, 172 USPQ 35 (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 Aktiengesellschaft v. MTD Products Inc.,* 181 USPQ 471, 472 (TTAB 1974) (no bearing on right to register); and *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); and *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 G.m.b.H.,* 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); and *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.,* 181 USPQ 471, 473 (TTAB 1974).

25. *See J.B. Williams Co. v. Pepsodent G.m.b.H.,* 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 Company,* 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 G.m.b.H.,* 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 Aktiengesellschaft v. MTD Products Inc.,* 181 USPQ 471, 473 (TTAB 1974) (money expended in advertising to be confined to goods in application); and *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).

27. *See Volkswagenwerk Aktiengesellschaft 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); and *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); and *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); and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974).

CHAPTER 500
STIPULATIONS AND MOTIONS

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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 to extend or reopen times; that the total number of interrogatories which one party may serve upon another party in a proceeding may be reduced from or may exceed the limitation specified in 37 CFR § 2.120(d)(1); 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]; to protective agreements or provisions different from or in substitution for the Board's standard protective order; to the facts in the case of any party [Note 2]; that the testimony of witnesses may be submitted in affidavit form [Note 3]; that a deposition may be taken at a particular place, or in a certain manner [Note 4]; and that the proceeding shall be ended in a specified way. *See* TBMP § 403.04 (Extensions of Discovery Period, Time to Respond to Discovery Requests, and Disclosures), TBMP § 412.02(a) (Modification of Board's Standard Protective Order Upon Stipulation) and TBMP § 605.03 (Settlement Agreements).

NOTES:

1. 37 CFR § 2.120(d)(2).

2. 37 CFR § 2.123(b). *See 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 CFR § 2.123(b).

4. 37 CFR § 2.123(b).

501.02 Filing Stipulations

37 CFR § 2.120(a)(2)* [Discovery] …The parties may stipulate to a shortening of the discovery period. The discovery period may be extended 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. . . . 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 CFR § 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 CFR § 2.121(d) ***[Assignment of times for taking testimony]*** *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 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.*

Stipulations which require action or consideration by the Board, such as 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, and stipulations to end a proceeding in a specified way, must be filed with the Board. [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 CFR § 2.120(a)(2); 37 CFR § 2.120(a)(3); 37 CFR § 2.121(d).

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 which 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 (the Board's Electronic System for Trademark Trials and Appeals) "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.

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 CFR § 2.121(d).

2. 37 CFR § 2.120(a)(3); 37 CFR § 2.121(a).

502 Motions--In General

502.01 Available Motions

There is a wide range of motions which may be filed in inter partes proceedings before the Board. 37 CFR § 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 testimony. Instead, all 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 CFR § 2.132(a) and 37 CFR § 2.132(b) for failure of the plaintiff to take testimony, 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 which might be filed in an inter partes proceeding before the Board, this chapter discusses only the motions which most commonly arise in Board proceedings.

NOTES:

1. *See* 37 CFR § 2.123(a); 37 CFR § 2.125(c).

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); and *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, 61 (TTAB 1983), *aff'd,* 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (motion for involuntary dismissal under Fed. R. Civ. P. 41(b) unavailable).

502.02 Form of Motions and Briefs on Motions

***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 § 2.127(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 fifteen 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 15 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. 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 CFR § 2.127(e)(1)*... If no motion under Rule 56(f) 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 in written form and must meet the general requirements for submissions to the Board set forth in 37 CFR § 2.126. The requirements for paper submissions are specified in 37 CFR § 2.126(a), the requirements for electronic submissions over the Internet can be found in 37 CFR § 2.126(b), and the requirements for confidential submissions are in 37 CFR § 2.126(c). Additional information regarding electronic submissions made through ESTTA (Electronic System for Trademark Trials and Appeals) 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).

The certificate of mailing by first-class mail procedure provided under 37 CFR § 2.197, and the "Express Mail" procedure provided under 37 CFR § 2.198, are both available for the filing of motions. [Note 3.] *See* TBMP § 110 and TBMP § 111. Parties are not permitted to file motions via e-mail except at the request of the Board attorney or judge. ESTTA is the only available procedure for electronic filing. In fact, the ESTTA system is the most efficient way to file motions.

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 e-mail confirmation. Once the electronic filing is submitted, the Board immediately transmits an e-mail filing receipt. If the filing party does not receive the e-mail 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 e-mail 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.

Except when filing extensions of time to oppose or oppositions to Madrid Protocol applications, ESTTA filing is optional. If ESTTA filing is not possible prior to a deadline for any reason, parties should timely submit their filings on paper. *See* TBMP § 107, TBMP § 110 and TBMP § 111.

A party should file only one copy of a motion with 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 4.] *See* TBMP § 113 (Service of Papers). The parties may stipulate to service by e-mail or fax. [Note 5.] If the parties stipulate to service by e-mail or fax, 37 CFR § 2.119(c) allowing an additional 5 days to take an action, does not apply because 37 CFR § 2.119(c) does not address service by e-mail or fax. *See* TBMP § 113.05.

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 CFR § 2.119(e).

3. 37 CFR § 2.197; 37 CFR § 2.198.

4. 37 CFR § 2.119(a); 37 CFR § 2.119(b).

5. 37 CFR § 2.119(b)(6).

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 CFR § 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 CFR § 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 15 days from the date of service of the motion (20 days if service of the motion was made by first class mail, "Express Mail," or overnight courier). [Note 5.] When a motion for summary judgment is filed, a brief in response, or a motion for Fed. R. Civ. P. 56(f) discovery under the Federal Rules of Civil Procedure, must be filed within 30 days from the date of service of the summary judgment motion (35 days if 37 CFR. § 2.119(c) applies). [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(f) discovery will not be extended. *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 7.] *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 CFR § 2.127(a), unless otherwise ordered. [Note 8.]

A reply brief, if filed, including a reply brief for a summary judgment motion, shall be filed within 15 days from the date of service of the brief in response to the motion (20 days if 37 CFR § 2.119(c) applies). The time for filing a reply brief will not be extended, even upon the parties' consent. [Note 9.] No further papers (including surreply briefs) will be considered by the Board. [Note 10.] 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 11.]

NOTES:

1. 37 CFR § 2.127(a).

2. 37 CFR § 2.127.

3. 37 CFR § 2.127(a). *See also 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 CFR § 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).

5. 37 CFR § 2.119(c).

6. 37 CFR § 2.127(e)(1).

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

8. 37 CFR § 2.127(a).

9. 37 CFR § 2.127(a). *See 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).

10. 37 CFR § 2.127(a); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies,* 73 USPQ2d 1672, 1677 (TTAB 2005) (because 37 CFR § 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).

11. *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000); and *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").

502.02(c) Confidential Information

For inter partes proceedings pending or commenced on August 31, 2007, the Board's standard protective order is automatically in place (with the exception of pending cases with a protective order already in place). [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 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, 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 filed by paper under seal pursuant to a protective order. 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 3.]

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 and will not be kept confidential by the Board and will be placed in the Board's public records available on the Internet. [Note 4.] To be handled as confidential, and kept out of the public record, submissions to the Board must be filed under a separate cover or designated as confidential in ESTTA. 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 public view. [Note 5.]

When filing confidential documents electronically through the Board's ESTTA system, 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 a separate redacted version of the confidential filing.

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 and confidential materials, *see* TBMP § 120.02 and TBMP § 412.

NOTES:

1. 37 CFR § 2.116(g).

2. 37 CFR § 2.27(d); 37 CFR § 2.27 (e), and 37 CFR § 2.126(c); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

3. 37 CFR § 2.27(e) and 37 CFR § 2.126(c); *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000).

4. *Cf. 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).

5. 37 CFR § 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 issue or 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 CFR § 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). *Compare 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 CFR § 2.127(a). *See e.g., Byer California v. Clothing for Modern Times,* 95 USPQ2d 1175 (TTAB 2010).

502.04 Determination of Motions

37 CFR § 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 CFR § 2.127(c) *Interlocutory motions, requests, 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 of the Board to whom authority so to act has been delegated.*

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 CFR § 2.106(c), 37 CFR § 2.114(c), 37 CFR § 2.134(a), or 37 CFR § 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 opposition brief or presenting a responsive argument in a telephone conference, the Board will decide the motion on its merits.

Interlocutory motions that are not actually or potentially dispositive of a proceeding may be acted upon by a single Board judge, or by a single attorney to whom such authority has been delegated. [Note 3.] *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 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 4.] 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.

NOTES:

1. 37 CFR § 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); *Central Manufacturing Inc. v. Third Millennium Technology, Inc.*, 61 USPQ2d 1210, 1211 (TTAB 2001) (motion to dismiss treated as conceded); and *Boston Chicken Inc. v. Boston Pizza International Inc.*, 53 USPQ2d 1053, 1054 (TTAB 1999).

2. *See, e.g.*, *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 Mfg. 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) and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990).

3. 37 CFR § 2.127(c).

4. 37 CFR § 2.120(a)(3).

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 CFR § 2.127(f); *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"); and *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443, 1445 n.3 (TTAB 2000). *See also* 37 CFR § 2.120(f) and 37 CFR § 2.120(g)(1). Note, however, that conduct in violation of the Canons and Disciplinary Rules set forth in 37 CFR parts 10 and 11 may be referred to the Office of Enrollment and Discipline (OED) for appropriate action. *See* 37 CFR § 10.20 *et. seq.* and 37 CFR § 11.19 *et. seq*.

502.06 Telephone and Pretrial Conferences

502.06(a) Telephone Conferences

37 CFR § 2.120(i)(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 its approval or resolution by correspondence is not practical, the Board may, upon its own initiative or upon request made by one or both of the parties, address the stipulation or resolve the motion by telephone conference.*

37 CFR § 2.127(a) *. . . Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within fifteen 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 which 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 and TBMP § 413.01 regarding telephone conferences for motions relating to discovery. The telephone conference procedure may also be useful 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.

Telephone conferences are not a substitute for written consented motions or stipulations. Parties are encouraged to file consented motions or stipulations through ESTTA rather than call the Board for an order that can be agreed upon without the Board's 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 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 e-mail 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 4.] If a response to a pending motion has not yet been filed, the non-moving 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 file its motion through ESTTA and call the Board attorney to request a telephone conference. This procedure is useful when time is of the essence. Filing a motion through ESTTA followed by a telephone call to the Board attorney is the most efficient way to get a motion to the attention of the Board attorney. ESTTA is more efficient than hand delivery. Filing by facsimile is prohibited. [Note 5.]

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 papers.

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 the 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 contents of the telephone conference. 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 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 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 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).

The filing of a request for reconsideration under 37 CFR § 2.127(b) or the filing of a petition under 37 CFR § 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 CFR § 2.120(i)(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); and the Official Gazette Notice entitled Teleconferencing on Cases Before the TTAB (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., 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) (motion to quash and motion for discovery sanctions); *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1552 (TTAB 1991) (motion to attend testimony deposition by telephone); and *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.*, *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. 37 CFR § 2.127(a). *See e.g.*, *Byer California v. Clothing for Modern Times Ltd.,* 95 USPQ2d 1175 (TTAB 2010).

5. 37 CFR § 2.195(d)(3).

502.06(b) Pretrial Conferences

37 CFR § 2.120(i)(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 be likely to 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 or upon motion made by one or both of the parties, request that the parties or their attorneys, under circumstances which will not result in undue hardship for any party, meet with the Board at its offices for a disclosure, discovery or pre-trial conference.*

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 attorneys or parties are unable to work out a resolution of any of their differences. [Note 1.]

For information concerning discovery conferences, *see* TBMP § 401.01 and TBMP § 408.01(a).

NOTES:

1. 37 CFR § 2.120(i)(2).

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. 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). *Compare 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. *Hollowform, Inc. v. Delma Aeh*, 180 USPQ 284, 286 (TTAB 1973), *aff'd,* 515 F.2d 1174, 185 USPQ 790 (CCPA 1975) (motion for default judgment for failure to answer denied).

4. *Cf.* 37 CFR § 2.120(a)(2) and 37 CFR § 2.127(d). *See also* 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, 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); C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL 3d § 1357 (2009). *Compare, 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 "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).

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 standing to maintain the proceeding, 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.]

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 4.]

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 5.]

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 6.]

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); *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); and *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 (CCPA 1982); *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); and *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.--, 129 S.Ct. 1937 (2009) (plausibility standard applies to all federal civil claims).

4. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

5. *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.

6. *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 (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); and *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. 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 the amended complaint corrects the defects noted by the defendant in its motion to dismiss, and states a claim upon which relief can be granted, the 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 pleading).

NOTES:

1. *See* Fed. R. Civ. P. 15(a)(1)(B).

2. *Fair Indigo LLC v. Style Conscience,* 85 USPQ2d 1536, 1537 (TTAB 2007).

3. *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"); and *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), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984) ("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").

4. Fed. R. Civ. P. 15(a)(2); *Bayer Consumer Care AG v. Belmora LLC,* 90 USPQ2d 1587, 1590-1591 (TTAB 2009) (because petitioner twice failed to properly allege prior use, petitioner's Trademark Act § 2(d) claim was dismissed with prejudice, however, its misrepresentation of source claim was sufficient); *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); and *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) (amendment would serve no useful purpose). *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); and *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

For inter partes proceedings commenced on or after November 1, 2007, the Board adopted a modified disclosure and conferencing regime. As a result of the interplay of certain amended rules, 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. More specifically, 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, in cases subject to the 2007 rules, 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.]

NOTES:

1. 37 CFR § 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 yet to serve initial disclosures).

2. 37 CFR § 2.127(e)(1); *Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009) (proceeding involved two related oppositions, one of which was subject to the 2007 amended rules; motion to dismiss not converted to motion for summary judgment in opposition subject to the 2007 amended rules).

3. With respect to inter partes proceedings commenced prior to November 1, 2007, if, on a motion to dismiss for failure to state a claim upon which relief can be granted, matters outside the pleading are submitted and not excluded by the Board, the motion may be treated as a motion for summary judgment under Fed. R. Civ. P. 56. *See* Fed. R. Civ. P. 12(d); *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ 1478, 1479 n.2 (TTAB 1998) (matters excluded); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1436 (TTAB 1996) (matters excluded); and *Missouri Silver Pages Directory Publishing Corp., Inc. v. Southwestern Bell Media, Inc.,* 6 USPQ2d 1028, 1029 (TTAB 1988) (because applicant's motion to dismiss contains matter outside the pleading, it has been treated as a motion for summary judgment). 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 non-movant 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); and *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).

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 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.] Thus, to be timely, a motion for

judgment on the pleadings must be filed after the pleadings are closed, but prior to the opening of the first testimony period, as originally set or as reset. [Note 3.]

When a motion to dismiss for failure to state a claim upon which relief can be granted is filed after the answer, but prior to trial, the Board may construe the motion as a motion for judgment on the pleadings. [Note 4.] *Cf.* TBMP § 503.01 (Time for Filing Motion to Dismiss).

NOTES:

1. Fed. R. Civ. P. 12(c).

2. 37 CFR § 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. *Cf.* 37 CFR § 2.127(e)(1)*; 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 (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); and *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 182 USPQ 572 (Comm'r 1974).

4. 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); and *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 which have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(d), 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); *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); and *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); *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); and C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 1367 *et seq*. (2009).

3. *Kraft Group LLC v. Harpole,* 90 USPQ2d 1837, 1840 (TTAB 2009); *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); and C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 1367 *et seq.* (2009).

4. *Kraft Group LLC v. Harpole,* 90 USPQ2d 1837, 1840 (TTAB 2009); *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); and C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE Civil 3d
§ 1367 *et seq*. (2009).

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); and C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 1368 (2009).

504.03 Matters Outside the Pleadings Submitted on Motion for Judgment on Pleadings

For inter partes proceedings commenced on or after November 1, 2007, the Board adopted a modified disclosure and conferencing regime. As a result of the interplay of certain amended rules, 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 CFR § 2.127(e)(1). *Cf. Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009) (proceeding involved two related oppositions with one subject to the 2007 amended rules; motion to dismiss not converted to motion for summary judgment in opposition subject to the 2007 amended rules).

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); and *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); *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); and *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); C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 1377 (2009). *Cf. 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); C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 1378 (2009).

3. *See* C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE Civil 3d §§ 1376-1377

(2009).

4. *See* C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 1376 (2009).

5. *See* C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE Civil 3d §§ 1376-1377 (2009).

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).

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 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); *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. *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); and C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 1380 (2009).

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 (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); and *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988) (reasonable latitude permitted in statement of claims).

6. C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 1381 (2009).

7. *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 and 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 Vitamin Products, 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, 1571-1572 (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); and *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.] However, a motion to strike matter from a pleading will not relieve the defendant from filing its responsive pleading. The issues raised in the motion to strike may be discussed in the discovery conference in the event the parties request Board participation therein. Accordingly, the plaintiff need not file a responsive brief in such a case. A Board attorney will participate in the discovery conference when so 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 thereupon.
If no responsive pleading is required, the motion should be filed within 20 days after service upon the moving party of the pleading that is the subject of the motion (25 days, if service of the pleading was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.119(c)). [Note 2.]

However, the Board, upon its own initiative, and at any time, including during a discovery conference, may order stricken from a pleading any insufficient 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, then it will be decided like any other pretrial motion.

NOTES:

1. Fed. R. Civ. P. 12(f)*; 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); and *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); and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990); C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 1380 (2009).

506.03 Exhibits Attached to Pleadings

The Board will not strike exhibits submitted with pleadings since they are clearly contemplated by 37 CFR § 2.105(c), 37 CFR § 2.113(c), and 37 CFR § 2.122(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 CFR § 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.] TBMP § 317 (Exhibits to Pleadings).

NOTES:

1. 37 CFR § 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 to the evidence and to raise an unpleaded issue. But failure so to amend does not affect the result of the trial of that issue.*

<u>37 CFR § 2.107</u> 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.*

(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 to the grounds for opposition or to add to the goods or services subject to opposition.*

<u>37 CFR 2.115</u> 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 two 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; and (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. [Note 3.] Thus, an opposition against a Trademark Act § 66(a) application may not be amended to add an entirely new claim or a claim based on an additional registration in support of an existing Trademark Act § 2(d), 15 U.S.C. § 1052(d) claim. [Note 4.] Other amendments, such as those that would amplify or clarify the grounds for opposition, are not prohibited by this rule. [Note 5.]

A signed copy of the proposed amended pleading should accompany a motion for leave to amend a 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 CFR § 2.107, 37 CFR § 2.115, and 37 CFR § 2.116(a).

3. 37 CFR § 2.107.

4. 37 CFR § 2.107(b).

5. Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act (Final Rule), 68 Fed. Reg. 55748, 55757 (September 26, 2003).

507.02 Amendments--General Rule--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 no responsive pleading is permitted, it may be amended once as a matter of course at any time within 21 days after it is served, or 21 days after service of a motion under Rule 12(b), (e), or (f), whichever is earlier. [Note 1.] An amendment filed as a matter of course need not be accompanied by a motion for leave to amend. [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) 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 goods or services to the proceeding. [Note 7.]

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 non-moving party should not argue against granting the moving party leave to amend merely because the non-moving 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 supercede any prior pleadings, particularly an amended pleading which 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).

4. *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 1789 (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 (TTAB 1990); *Marmark Ltd. v. Nutrexpa S.A*., 12 USPQ2d 1843 (TTAB 1989); *See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ2d 1395 (TTAB 1989); *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989); and *Fioravanti v. Fioravanti Corrado S.R.L*., 230 USPQ 36 (TTAB 1986), *recon. denied*, 1 USPQ2d 1304 (TTAB 1986).

5. *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, 1785-1786 (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, 858-859 (TTAB 1986); *Pegasus Petroleum Corp. v. Mobil Oil Corp*., 227 USPQ 1040, 1044 (TTAB 1985); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428, 430-431 (TTAB 1985); and *Gemini Engine Co. v. Solar Turbines Inc.*, 225 USPQ 620 (TTAB 1985).

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 (TTAB 1979); and *Huffy Corp. v. Geoffrey, Inc.*, 18 USPQ2d 1240 (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 CFR § 2.107(b).

8. *Avedis Zildjian Co. v. D. H. Baldwin Co.*, 180 USPQ 539 (TTAB 1973) (allegations amplified).

9. *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990) (motion to amend to restrict goods would serve no purpose); *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 (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 1789, 1799 (TTAB 2001) (where proposed pleading of dilution was legally insufficient, leave to re-plead allowed); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540 (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 (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); and *CBS Inc. v. Mercandante,* 23 USPQ2d 1784 (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 non-moving 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 non-moving party.

NOTES:

1. *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 Corporation 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 (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 (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 (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 (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*, 17 USPQ2d 1652 (TTAB 1990) ("concept of 'undue delay' is inextricably linked with the concept of prejudice to the non-moving party"); *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732 (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 Corporation 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); and *M. Aron Corporation 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 (TTAB 2000) (reopened for limited purpose of conducting discovery on new claim); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (reopened solely for applicant's benefit); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985) (applicant to advise whether it would need additional discovery).

507.02(b) Timing of Motion to Amend to Add Counterclaim

The timing of a motion for leave to amend is particularly important in the case of a motion for leave to amend to assert a counterclaim for cancellation of one or more of the plaintiff's pleaded registrations. Counterclaims to cancel pleaded registrations in Board proceedings are governed by 37 CFR § 2.106(b)(2)(i) and 37 CFR § 2.114(b)(2)(i). [Note 1.] As provided therein, if grounds for the counterclaim are known to the defendant when its answer to the complaint is filed, the counterclaim should be pleaded with or as part of the answer. 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 2.] TBMP § 313.04 (Compulsory Counterclaims).

NOTES:

1. 37 CFR § 2.106(b)(2)(i) and 37 CFR § 2.114(b)(2)(i); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989) (although parties referred to the "when justice requires" element of Fed. R. Civ. P. 13(f), counterclaims to cancel pleaded registrations in oppositions are governed by 37 CFR § 2.106(b)(2)(i)). *Compare See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ2d 1395, 1397 (TTAB 1989) (applied Fed. R. Civ. P. 13(f) "when justice requires" standard where grounds for counterclaim were known at time of answer).

2. 37 CFR § 2.106(b)(2)(i) and 37 CFR § 2.114(b)(2)(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 CFR § 2.114(b)(2)(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 CFR § 2.106(b)(2)(i) where grounds are learned during course of proceeding), *summary judgment granted*, 24

USPQ2d 1376 (TTAB 1992); and *Marshall Field & Co. v. Mrs. Field's Cookies*, 11 USPQ2d 1355 (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 CFR § 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) and TBMP § 507.01 regarding amendment of pleadings in an opposition against a Trademark Act § 66(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 which 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 (TTAB 1974).

2. Fed. R. Civ. P. 15(b). *Cf. Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985); *Anheuser-Busch, Inc. v. Martinez*, 185 USPQ 434 (TTAB 1975); *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (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 CFR § 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) 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 non-moving party is be 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. *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 (TTAB 2010) (Board deemed unpleaded registrations to have been tried by implied consent pursuant to Fed. R. Civ. P. 15(b)); *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 Mfg. 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. *Morgan Creek Productions Inc. v. Foria International Inc.,* 91 USPQ2d 1134, 1138 (TTAB 2009); *H.D. Lee Co. v. Maidenform Inc.,* 87 USPQ2d 1715, 1720-1721 (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); *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 (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. *Safer Inc. v. OMS Investments Inc.,* 94 USPQ2d 1031 (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 USPQ 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 (TTAB 1981); *New York State Office of Parks and Recreation v. Atlas Souvenir & Gift Co.*, 207 USPQ 954 (TTAB 1980); *Plus Products v. Redken Laboratories, Inc.*, 199 USPQ 111 (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 late-filed 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, defendant's entry into default stays 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 CFR § 2.106(a) and 37 CFR § 2.114(a); Fed. R. Civ. P. 55(a) and 55(b); *DeLorme Publishing Co., Inc. 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 CFR § 2.127(a) (the Board may treat the motion as conceded).

3. 37 CFR § 2.127(a).

4. 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, 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.").

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), 59(b), (d), and (e), and 60(b), except as those rules allow.*

37 CFR § 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 with the notice of institution of the proceeding.*

(2) *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. Initial disclosures must be made no later than thirty days after the opening of the discovery period. Disclosure of expert testimony must occur in the manner and sequence provided in the Federal Rules of Civil Procedure 26(a)(2), 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 may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert. The parties may stipulate to a shortening of the discovery period. The discovery period may be extended 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. 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 taken, and interrogatories, requests for production of documents and things, and requests for admission must be served, on*

or before the closing date of the discovery period as originally set or reset. 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. 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 CFR § 2.121* Assignment of times for taking testimony.**

(a) *The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's pretrial disclosures and assigning to each party its time for taking testimony. No testimony shall be taken 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. 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.*

* * * *

(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 extended by stipulation of the parties approved by the Trademark Trial and Appeal Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the testimony periods 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.*

(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 CFR § 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 fifteen days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal 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 fifteen 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.*

509.01 Nature of Motions

Pursuant to Fed. R. Civ. P. 6(b), made applicable to Board proceedings by 37 CFR § 2.116(a), a party may file a motion for an enlargement of the time in which an act is required or allowed to 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 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 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*, however, 37 CFR § 2.127(a) ("The time for filing a reply brief [on a motion] will not be extended.") and 37 CFR § 2.127(e)(1) ("The time for filing a motion under [Fed. R. Civ. P.] 56(f) will not be extended").

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

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 defendant's motion to extend its time to file an answer is granted, the order granting the motion will include a resetting of all subsequent deadlines or dates, including the deadline for the discovery conference, disclosures, discovery and trial.

After an answer has been filed, the Board is unlikely to find good cause for a 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, even upon consent or stipulation. [Note 6.]

The time for filing a reply brief on a motion will not be extended, even upon the parties' consent. [Note 7.] 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(f) will not be extended. *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, (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 (TTAB 1999) (sparse motion contained insufficient facts on which to find good cause); and *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); and *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. 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); *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. and Shoppers Food Warehouse Corp. v. Di Pardo Packing Limited*, 60 USPQ2d 1372 (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 Mfg. 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); and *Luemme, Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1760-1761 (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 CFR § 2.120(a)(2) (discovery period); 37 CFR § 2.121(a) (testimony period); 37 CFR § 2.127(a) (time for responding to a motion); and 37 CFR § 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 Mfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000); *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1760-1761 (TTAB 1999). *Compare 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. *Boston Red Sox Baseball Club LP v. Chaveriat,* 87 USPQ2d 1767, 1767 n.1 (TTAB 2008),

citing Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007) ("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.").

7. 37 CFR § 2.127(a).

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 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). *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 Company v. Brunswick Associates Ltd. Partnership*, 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 CFR § 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 which 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 which 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 the party's 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 Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380, 395 (1993); and *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, 1892-3 (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 Ltd. Partnership v. Bodo*, 21 USPQ2d 1899, 1904 (Comm'r 1990).

3. *See 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, 1307-1308 (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 Mfg. 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); and *Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858 (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 and at 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 (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., Inc.*, 229 USPQ 619 (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); and *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 (1997) (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 Company v. Brunswick Associates Ltd. Partnership*, 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 (TTAB 1999); and *Pumpkin Ltd. v. The Seed Corps.*, 43 USPQ2d 1582, 1586 (TTAB 1997). *Cf. General Motors Corp. v. Cadillac Club Fashions Inc.,* 22 USPQ2d 1933, 1936 (TTAB 1992) (motion for relief from judgment under Fed. R. Civ. P. 60(b) for failure to take testimony was granted because petitioner's counsel was grossly negligent and misled petitioner).

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 (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. Roladex Corp.*, 204 USPQ 249 (TTAB 1979); *Tektronix, Inc. v. Daktronix, Inc.*, 187 USPQ 588 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Wilson Sporting Goods Co. v. Northwestern Golf Co.*, 169 USPQ 510 (TTAB 1971);

Chemetron Corp. v. Self-Organizing Systems, Inc., 166 USPQ 495 (TTAB 1970); and *United States Plywood Corp. v. Modiglass Fibers, Inc.*, 125 USPQ 144 (TTAB 1960).

2. *L.C. Licensing Inc. v. Berman,* 86 USPQ2d 1883, 1886-1887 (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), *citing Canadian Tire Corp. Ltd. v. Cooper Tire & Rubber Co.,* 40 USPQ2d 1537, 1539 (Comm'r 1996) (newly discovered evidence was hearsay in nature and pertained to unpleaded defense).

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 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.]

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 which 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 and should be submitted in the form used in a trial order, specifying the closing date for each period to be reset. [Note 2.] 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 3.] However, receipt by the parties of the Board's action on the motion will be delayed, because the Board will have to prepare an action 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 Board's Electronic System for Trademark Trials and Appeals ("ESTTA"), 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.

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 4.]

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 5.] 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 6.] 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 7.] *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 8.]

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 9.]

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 include a request to reset the dates in its pending motion, further specifying the deadlines or periods which it wishes to have reset. [Note 10.]

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 11.] TBMP § 902.02 (Time for Filing Notice of Appeal) and TBMP § 903.04 (Time for Filing Civil Action).

NOTES:

1. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007) ("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.").

2. 37 CFR § 2.121(d).

3. 37 CFR § 2.121(a).

4. *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.")

5. 37 CFR § 2.127(a).

6. *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888 (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).

7. *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888, 891 (CCPA 1980); *Luemme, Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758 (TTAB 1999) (waiting for Board approval of previous extension request insufficient to justify resetting of dates). *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984); and *In re L.R. Sport Inc.*, 25 USPQ2d 1533 (Comm'r 1992).

8. *See* 37 CFR § 2.120(a), 37 CFR § 2.121(a)(1), 37 CFR § 2.121(c), 37 CFR § 2.127(a) and 37 CFR § 2.127(e)(1). *See also Luemme, Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1760 (TTAB 1999).

9. 37 CFR § 2.121(a).

10. *See, e.g.*, 37 CFR § 2.120(a)(3).

11. 37 CFR § 2.145(e).

510 Motion to Suspend; Motion to Resume

***37 CFR § 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, for good cause, upon motion or a stipulation of the parties approved by the Board.*

37 CFR § 2.120(e)(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 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.*

37 CFR § 2.127(d) *When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be 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 specified in the 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 CFR § 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 CFR § 2.124(d)(2)* Depositions upon written questions ...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 CFR § 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 Ass'n of America v. Independent Opticians of America Inc.,* 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990), *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 which 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. To the extent that a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court. [Note 2.]

Further, pursuant to 37 CFR § 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 even another proceeding in which only one of the parties is involved. [Note 6.]

Ordinarily, 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 7.]

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 8], nor do parties or their attorneys. [Note 9.] 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.

When a motion to suspend pending the outcome of a civil action is filed, the Board normally will require that a copy of the 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 10.] This requirement ordinarily is waived if all parties consent to the suspension. *See* TBMP § 502. Many of these types of suspension requests are filed electronically via ESTTA. If filing via ESTTA and the suspension is consented to by all parties, use the "consent motion" form provided, which requires that the filer certify that the adverse party has consented to the suspension. If an adverse party has not consented, the filing may still be made via ESTTA, but the filer should select the "general filings" category from the drop-down menu instead of the "consent motions" option. *See* TBMP § 110.09 and http://estta.uspto.gov for information regarding filing via ESTTA.

The Board does not usually require that an issue be joined (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 11.] 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 which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered. [Note 12.] 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 CFR § 2.117(a). *See General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689 (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 (TTAB 1974); *petition denied*, 181 USPQ 779 (Comm'r 1974); *Tokaido v. Honda Associates Inc.,* 179 USPQ 861 (TTAB 1973); and *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971).

2. *See*, *e.g.*, *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2nd 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 (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); and *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. 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 (Fed. Cir. 1983) (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); and *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366 (TTAB 1975) (state court action to determine ownership of applicant's mark and authority of applicant to file application).

5. *See Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792 (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 Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366 (TTAB 1975) (state court action between applicant and third party to determine ownership of applicant's mark).

7. 37 CFR § 2.117(a). *See*, *e.g.*, *General Motors Corp v. Cadillac Club Fashions, Inc.*, 22 USPQ2d 1933 (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 (TTAB 1974) (decision in civil action for infringement and unfair competition would have bearing on outcome of Trademark Act § 2(d) claim before Board), *petition denied*, 181 USPQ 779 (Comm'r 1974). *See also Tokaido v. Honda Associates Inc.*, 179 USPQ 861 (TTAB 1973); and *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971); and *Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568 (TTAB 1971).

But see Boyds Collection Ltd. v. Herrington & Co., 65 USPQ2d 2017 (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); and *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp.*, 178 USPQ 429 (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).

8. *See Opticians Ass'n 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).

9. *See Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568 (TTAB 1971).

10. *See Forest Laboratories Inc. v. G.D. Searle & Co*. 52 USPQ2d 1058 (TTAB 1999); and *SCOA Industries Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411 (TTAB 1975), *appeal dismissed*, 189 USPQ 15 (CCPA 1976).

11. *See Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974).

12. *See* 37 CFR § 2.117(b). *See also Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017 (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. 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 which have been suspended pending civil action will 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 a decision on the merits of the case (i.e., a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom, or all appeals filed have been decided.

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 upon stipulation of the parties approved by the Board. [Note 1.] For example, proceedings may be suspended, upon motion or stipulation under 37 CFR § 2.117(c), for purposes of settlement negotiations, subject to the right of either party to request resumption at any time. [Note 2.] However, for proceedings commenced on or after November 1, 2007, 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 activities. After a period of time, the Board may require the parties to file a detailed report from time to time on the progress of their settlement negotiations; and periodically thereafter. Further, the Board may, in its discretion, deny further suspension when the parties have already been granted a reasonable time to settle the case and it does not appear that further suspension is likely to result in resolution of the dispute. While parties are encouraged to settle their cases, 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 process 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 other authorized representative (and inform the Board thereof), or 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. *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 files a motion which is potentially dispositive of the proceeding, such as a motion to dismiss, [Note 7] a motion for

judgment on the pleadings, or a motion for summary judgment, the case will be suspended by the Board with respect to all matters not germane to the motion. [Note 8.]

The filing of such a potentially dispositive motion does not, in and of itself, operate to suspend a case; until the Board issues its suspension order, all times continue to run. [Note 9.] However, when issuing its suspension order, the Board ordinarily treats the proceeding as if it had been suspended as of the filing date of the potentially dispositive motion. [Note 10.] On a case-by-case basis, the Board may find that the filing of a potentially dispositive motion provides a party with good cause for not complying with an otherwise outstanding obligation, for example, responding to discovery requests. [Note 11.] For information on suspension after filing a motion for summary judgment, *see* TBMP § 528.03.

Once the Board has suspended proceedings in a case, pending determination of a potentially dispositive motion, no party should file any paper that is not germane to the motion. [Note 12.]

Motion to compel. Pursuant to 37 CFR § 2.120(e)(2) 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 which 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 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, nor does it excuse a party from making any required disclosures. When the motion to compel is filed after discovery has closed, but prior to the opening of 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 14.] *See* TBMP § 523 regarding motions to compel.

Motion to divide. A registration or application which 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. 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. Until and unless 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 CFR § 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 CFR § 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).

NOTES:

1. 37 CFR § 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 (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 Company, Ltd. v. Hudson Valley Brewing Company, Inc.*, 65 USPQ2d 1701 (TTAB 2002) (proceedings are not suspended automatically when parties are discussing settlement and a party which 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). *See also* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

4. *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.").

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 (Comm'r 1992) (suspended where petitioner's pleaded registration was the subject of a counterclaim) *aff'd sub nom.*, *Checkers Drive-In Restaurants, Inc. v. Commissioners of Patents and Trademarks*, 51 F.3d 1078, 34 USPQ2d 1574 (D.C. Cir. 1995).

7. 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); *Hollowform Inc. v. Delma Aeh,* 180 USPQ 284 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975).

8. 37 CFR § 2.127(d); *Elec. Indus. Ass'n. v. Potega,* 50 USPQ2d 1775, 1776 n.4 (TTAB 1999) (suspended pending disposition of motion for discovery sanctions which included request for entry of judgment); *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434 (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); and *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 (TTAB 1994) (motion for leave to amend a notice of opposition is not a potentially dispositive motion which would warrant suspension under 37 CFR § 2.127(d)).

9. *See Super Bakery Inc. v. Benedict,* 96 USPQ2d 1134, 1136 (TTAB 2010) (mere filing of motion for summary judgment or other motion which is potentially dispositive of a case does not automatically suspend proceedings; only an order of the Board formally suspending proceedings has such effect); *Elec. Indus. Ass'n v. Potega,* 50 USPQ2d 1775, 1776 n.4 (TTAB 1999); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707 (TTAB 1994); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 965 (TTAB 1986).

10. *See Leeds Technologies Ltd. v. Topaz Communications Ltd*., 65 USPQ2d 1303 (TTAB 2002); *Elec. Indus. Ass'n. v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999). *But see Super Bakery Inc. v. Benedict,* 96 USPQ2d 1134, 1135-6 (TTAB 2010) (where an outstanding Board order granting discovery sanctions required respondent to serve full and complete discovery responses, Board did not treat case as suspended as of filing date of respondent's "clearly meritless" motion for summary judgment; default judgment entered against respondent).

11. *See Leeds Technologies Ltd v. Topaz Communications Ltd.*, 65 USPQ2d 1303 (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, and prior to issuance of Board suspension order, does not establish good cause for failure to comply with discovery obligations under Board order granting discovery sanctions).

12. 37 CFR § 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); and *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 (TTAB 1998) (proceedings deemed suspended as of the filing of the motion).

14. 37 CFR § 2.120(e)(2).

15. 37 CFR § 2.146(g).

16. 37 CFR § 2.124(d)(2).

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 when 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 or other authorized representative has withdrawn, a period of time in which to either appoint new counsel (and inform the Board thereof) or file a paper stating that it desires to represent itself (i.e., proceed "pro se"), 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 or other authorized representative at 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 MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979).

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 (TTAB 1993).

4. *See* 37 CFR § 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.

For proceedings commenced on or after November 1, 2007, which may be consolidated with cases filed prior thereto, consolidation will occur after initial disclosures have been made in the case commenced on or after November 1, 2007 and a new case schedule will be set under the rules as amended in 2007.

NOTES:

1. *See* Fed. R. Civ. P. 42(a); *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 (TTAB 1996), *rev'd on other grounds*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) (cases consolidated despite variations in marks and goods); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993) (opposition and cancellation consolidated); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1384 n.3 (TTAB 1991). *See also Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989); *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444 (TTAB 1987); *Federated Department Stores, Inc. v. Gold Circle Insurance Co.*, 226 USPQ 262 (TTAB 1985); and *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199 (TTAB 1981), *set aside on other grounds and new decision entered*, 217 USPQ 464 (TTAB 1983).

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 (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 (TTAB 1981) (consolidation denied as possibly prejudicial to defendant where defendant's involved marks were not all the same); *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246 (TTAB 1975) (consolidation ordered where issues were substantially the same and consolidation would be advantageous to both parties); and *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440 (TTAB 1973) (consolidation denied where issues differed).

3. *See Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444 (TTAB 1987).

4. *See* C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2383, 2384 (2009).

5. *See, e.g., Dating DNA LLC v. Imagini Holdings Ltd.,* 94 USPQ2d 1889, 1893 (TTAB 2010) (motion to consolidate granted); *Venture Out Properties LLC v. Wynn Resorts Holdings LLC,* 81 USPQ2d 1887, 1889 (TTAB 2007) (consolidation ordered sua sponte); *8440 LLC v. Midnight Oil Company,* 59 USPQ2d 1541 (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 (TTAB 1993) (stipulation); *Regatta Sport Ltd. v. Telux-Pioneer Inc.,* 20 USPQ2d 1154 (TTAB 1991) (Board's initiative); and *Helene Curtis Industries Inc. v. Suave Shoe Corp.,* 13 USPQ2d 1618 (TTAB 1989) (stipulation).

6. *Cf.* 37 CFR § 2.104(b); 37 CFR § 2.114(b).

7. *See 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 (TTAB 1993).

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 (TTAB 2010).

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 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 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 CFR 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 Trademark Act § 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 in the International Register. [Note 6.]

If the mark in an application or registration which 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 Services Division 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] or the assignor is no longer in existence, or 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 Services Division 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 (which 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., 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 CFR § 3.71; 37 CFR § 3.73(b).

3. *See* 37 CFR § 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 CFR § 7.23; 37 CFR § 7.24.

5. *See* Trademark Act § 72, 15 U.S.C. 1141; and 37 CFR § 7.22. *See also* TMEP § 1904.06, Assignment of Extension of Protection to the United States.

6. *See* TMEP § 1904.06.

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.

8. *See 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 CFR § 2.113(c); 37 CFR § 2.113(d), 37 CFR § 3.71 and 37 CFR § 3.73(b); Fed. R. Civ. P. 17 and 25; *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 (TTAB 1993); *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); and *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 (Comm'r 1990); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221 (TTAB 1987); *Mason Engineering & Design Corp. v. Mateson Chemical Corp*., 225 USPQ 956 (TTAB 1985); *E.E. Dickinson Co. v. T.N. Dickinson Co*., 221 USPQ 713 (TTAB 1984); and *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802 (TTAB 1982).

10. *See*, *e.g.*, 37 CFR § 2.113(c); 37 CFR § 2.113 (d); 37 CFR § 3.71; and 37 CFR § 3.73(b); Fed. R. Civ. P. 17 and 25; 37 CFR § 2.102(b); *William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870 (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 (TTAB 1992) (opposer's motion to substitute granted where copy of assignment was filed and applicant did not object); and *Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034 (TTAB 1988) (survivor of merger substituted at final decision).
See also Binney & Smith Inc. v. Magic Marker Industries, Inc., 222 USPQ 1003 (TTAB 1984);

Electronic Realty Associates, Inc. v. Extra Risk Associates, Inc., 217 USPQ 810 (TTAB 1982*); Liberty & Co. v. Liberty Trouser Co*., 216 USPQ 65 (TTAB 1982); *Gold Eagle Products Co. v. National Dynamics Corp*., 193 USPQ 109 (TTAB 1976); and *Aloe Creme Laboratories, Inc. v. Aloe 99, Inc*., 188 USPQ 316 (TTAB 1975). *Compare SDT Inc. v. Patterson Dental Co*., 30 USPQ2d 1707 (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 (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.

12. *See Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1225 (TTAB 1993); *Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133 (TTAB 1982).

13. *See* Fed. R. Civ. P. 25(c); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, n.1 (TTAB 1982) (decision will be binding upon the assignee).

14. *See Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625 (TTAB 1992) (respondent's motion to join petitioner's licensor as party plaintiff denied).

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 Services Division 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 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 CFR § 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.*, *WMA Group Inc. v. Western International Media Corp.*, 29 USPQ2d 1478 (TTAB 1993); *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 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); and *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984). *Cf. In re Brittains Tullis Russell Inc.*, 23 USPQ2d 1457 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 (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 (TTAB 1983). *Cf*. Fed. R. Civ. P. 25(c).

3. *See* TMEP § 1906.01(a) and TMEP § 1906.01(c).

512.03 Issuance of Registration to Assignee, or in New Name

***37 CFR § 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 which 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 CFR § 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 Services Division 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 CFR § 3.85. [Note 2.]

If an assignment or change of name document is recorded in the Assignment Services Division 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 CFR § 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 CFR 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 Trademark Act § 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 CFR § 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 CFR § 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 CFR § 7.23; 37 CFR § 7.24.

6. *See* Trademark Act § 72, 15 U.S.C. § 1141; 37 CFR § 7.22 and TMEP § 501.07.

7. *See* TMEP § 501.07.

512.04 Misidentification

Fed. R. Civ. P. 15(a) Amendments Before Trial.

(1) Amendment 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 which 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); *Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap*, 184 USPQ 505 (TTAB 1974); *Lone Star Manufacturing Co. v. Bill Beasley, Inc.*, 176 USPQ 426 (TTAB 1972), *rev'd on other grounds*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974); *Davidson v. Instantype,*

Inc., 165 USPQ 269 (TTAB 1970); *Pyco, Inc. v. Pico Corp.*, 165 USPQ 221 (TTAB 1969); *Raker Paint Factory v. United Lacquer Mfg. Corp.*, 141 USPQ 407 (TTAB 1964); and *Textron, Inc. v. Gillette Co.*, 177 USPQ 530 (Comm'r 1973). *Cf.* 37 CFR § 2.102(b); and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993) (amendment to correct misidentification and substitute proper party in interest not permitted).

2. *See Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ 1443, 1445-46 (TTAB 1996) (applicant's misidentification of itself as a corporation was harmless mistake); *Argo & Co. v. Springer*, 198 USPQ 626 (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 & Company, Inc. v. Springer, et al.*, 189 USPQ 581 (TTAB 1976); and *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.,* 183 USPQ 613 (Comm'r 1974) (deletion of "company" was correctable mistake). *Cf.* TMEP § 803.06, TMEP § 1201.02(b), and TMEP § 1201.2(c); *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (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 (Comm'r 1990); *Huang v. Tzu Wei Chen Food Co. Ltd.,* 7 USPQ2d 1335 (Fed. Cir. 1988) (application filed by individual void where owner was corporation, even though individual was affiliated with corporation); *In re Techsonic Industries, Inc.*, 216 USPQ 619 (TTAB 1982); and *In re Eucryl Ltd.*, 193 USPQ 377 (TTAB 1976).

3. *Yahoo! Inc. v. Loufrani,* 70 USPQ2d 1735 (TTAB 2004).

4. *Accu Personnel Inc. v. Accustaff Inc.,* 38 USPQ2d 1443 (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 (TTAB 1996).

513 Motion to Withdraw as Representative; Petition to Disqualify

513.01 Motion to Withdraw as Representative

37 CFR § 2.19(b) *If the requirements of § 10.40 of this chapter are met, an attorney authorized under § 11.14 to represent an applicant, registrant or party in a trademark case may withdraw upon application to and approval by the Director.*

37 CFR § 10.40 ***Withdrawal from employment. (a)*** *A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (See §§ 1.36 and 2.19 of this subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is*

entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.

***(b) Mandatory withdrawal**. A practitioner representing a client before the Office shall withdraw from employment if:*

***(1)** The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;*

***(2)** The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;*

***(3)** The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or*

***(4)** The practitioner is discharged by the client.*

***(c) Permissive withdrawal**. If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:*

***(1)** The petitioner's client:*

***(i)** Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;*

***(ii)** Personally seeks to pursue an illegal course of conduct;*

***(iii)** Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule*

***(iv)** By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;*

***(v)** Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or*

***(vi)** Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.*

(2) *The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;*

(3) *The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;*

(4) *The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;*

(5) *The practitioner's client knowingly and freely assents to termination of the employment; or*

(6) *The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.*

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 CFR § 10.40(b) and 37 CFR § 10.40(c).

Moreover, the practitioner must comply with the requirements of 37 CFR § 10.40(a). [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 his or her 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) if any part of a fee paid in advance has not been earned, a statement that the unearned part has been refunded; and (5) proof of service of the request upon the client 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 or other authorized representative (and inform the Board thereof), or to file a paper stating that it desires to represent itself. 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 5.]

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 Examining 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 § 116.05. *Cf.* TMEP § 607.

NOTES:

1. *See* 37 CFR § 2.19(b) and 37 CFR § 10.40; *SFW Licensing Corp. and Shoppers Food Warehouse Corp. v. Di Pardo Packing Limited*, 60 USPQ2d 1372 (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 CFR § 10.40(a) were satisfied and attorney filed the request within a reasonable time after notifying applicant of his intent to withdraw).

2. 37 CFR § 10.40.

3. *See SFW Licensing Corp. and Shoppers Food Warehouse Corp. v. Di Pardo Packing Limited*, 60 USPQ2d 1372 (TTAB 2001).

4. *See SFW Licensing Corp. and Shoppers Food Warehouse Corp. v. Di Pardo Packing Limited*, 60 USPQ2d 1372 (TTAB 2001).

5. *See CTRL Systems Inc. v. Ultraphonics of North America Inc.,* 52 USPQ2d 1300 (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); and *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993).

513.02 Petition to Disqualify

37 CFR § 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.

Petitions to disqualify are not disciplinary proceedings and hence are not governed by 37 CFR § 11.19–37 CFR § 11.60. Rather, petitions to disqualify are governed by 37 CFR § 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. [Note 1.] The Chief Administrative Trademark Judge may further delegate his/her responsibility to a Board judge or Board attorney for signature by the Chief Administrative Judge.

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 CFR § 10.63; *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha,* 22 USPQ2d 1316 (TTAB 1992); *Allstate Insurance Co. v. Healthy America Inc*., 9 USPQ 2d 1663 (TTAB 1988); and *Little Caesar Enterprises Inc. v. Domino's Pizza Inc.*, 11 USPQ2d 1233 (Comm'r 1989). *Cf. In re Gray*, 3 USPQ2d 1558 (TTAB 1987).

514 Motion to Amend Application or Registration

37 CFR § 2.133(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.*

514.01 In General

The amendment of any application or registration which is the subject of an inter partes proceeding before the Board is governed by 37 CFR § 2.133. Thus, an application which 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 question of, for example, a likelihood of confusion with the goods or services to be deleted, it may be approved, even where an opposer objects. [Note 3.]

A registration which 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.]

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 involved in an inter partes proceeding, *see* TBMP § 602.01.

A proposed amendment to any application or registration which is the subject of an inter partes proceeding must also comply with all other applicable rules and statutory provisions. [Note 5.] These include 37 CFR § 2.71-37 CFR § 2.75, in the case of a proposed amendment to an application; 37 CFR § 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 which involves an addition to the identification of goods or services, or which 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. Republication may not be available for applications filed under Trademark Act § 66(a) due to the time requirements of the Madrid Protocol. [Note 6.]

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 which 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 7.] *See* TBMP § 113. A request to amend an application involved in a Board proceeding must be filed with the Board, not with the Trademark Examining 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 Trademark Act § 66(a) registration, 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 8.]

Occasionally WIPO will inform the USPTO that a Trademark Act § 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. Unlike an amendment filed with the Board, the Board has no discretion to disallow or defer that amendment until final decision or until the case is decided upon summary judgment. Thus, the Board will issue an order requiring the defendant to show cause why the Board should not enter judgment as to any goods which were deleted by the amendment and then ask the plaintiff whether it wants to continue with the proceeding. [Note 9].

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 of Trademark Services 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 10.]

NOTES:

1. *See, e.g., Gallagher's Restaurants, Inc. v. Gallagher's Farms, Inc.*, 3 USPQ2d 1864 (TTAB 1986) (amendment to named excepted users in a concurrent use application); *Giant Food Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986) (amendment to identification of goods); and *Greyhound Corporation and Armour and Company v. Armour Life Insurance Company*, 214 USPQ 473 (TTAB 1982) (amendment to dates of use).

2. *See Enbridge Inc. v. Excelerate Energy Ltd. Partnership,* 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 (TTAB 1990) (motion to amend identification of goods deferred); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987) (motion to amend dates of use deferred); and *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB 1985) (same).

3. *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).

4. *See* 15 U.S.C. § 1057(e); and 37 CFR § 2.173.

5. *See* Trademark Act § 7(e), 15 U.S.C. § 1057; 37 CFR § 2.71(b); 37 CFR § 2.72; 37 CFR § 2.173(a) and 37 CFR § 2.173(b); *Drive Trademark Holdings LP v. Inofin,* 83 USPQ2d 1433, 1435 (TTAB 2007); *Vaughn Russell Candy Co. and Toymax Inc. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635 (TTAB 1998) (material alteration); *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742 (TTAB 1992) (summary judgment granted in part), 26 USPQ2d 1926 (TTAB 1993) (expansion of scope of goods); *Mason Engineering and Design Corp. v. Mateson*

Chemical Corporation, 225 USPQ 956 (TTAB 1985) (amendment to dates of use not supported by affidavit or declaration).

6. *See* Trademark Act § 68 and Trademark Act § 69; 15 U.S.C. § 1141h and 15 U.S.C. § 1141i.

7. 37 CFR § 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.)

8. *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 (Comm'r 1980) (Trademark Examining Operation acted beyond its authority in denying amendment to registration which Board had already approved).

9. *Cf*. 37 CFR § 2.134(b).

10. *See* 37 CFR § 7.22.

514.02 Amendment With Consent

When a request to amend an application or registration which 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.]

NOTES:

1. *See Vaughn Russell Candy Co. and Toymax Inc. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635 (TTAB 1998) (proposed amendment not approved when no consent from opposers in two other oppositions against the application).

514.03 Amendment Without Consent

The Board, in its discretion, may grant a motion to amend an application or registration which 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 which 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. 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 CFR § 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 4.] *See* TBMP § 311.02(b) (Affirmative Defenses). The proposed restriction should be described in sufficient detail to give the plaintiff fair notice thereof. [Note 5.] *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 6.] 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 7.] 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 8.] *See* TBMP § 1101.02. Moreover, Trademark Act § 1057, 15 U.S.C. § 1057(e), and 37 CFR § 2.173 cannot be used to impose concurrent use restrictions on registrations. [Note 9.] 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 10.] *See* TBMP § 1113.

NOTES:

1. 37 CFR § 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 if applicant consents to entry of judgment on the question of likelihood of confusion as to the broader identification). *See also, e.g.*, *International Harvester Company v. International Telephone and Telegraph Corporation,* 208 USPQ 940, 941 (TTAB 1980) (where applicant was willing to accept judgment with respect to the broader identification of goods); and *Pro-Cuts v. Schilz-Price Enterprises Inc*., 27 USPQ2d 1224 (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, 1435-6 (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 (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 (TTAB 1985) (same); and *International Harvester Company v. International Telephone and Telegraph Corporation*, 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 (TTAB 1990).

3. *See Enbridge Inc. v. Excelerate Energy Ltd. Partnership,* 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 (TTAB 1990) (motion to amend identification of goods deferred); *Fort Howard Paper Co. v. C.V. Gambina Inc*., 4 USPQ2d 1552 (TTAB 1987) (motion to amend dates of use deferred); and *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB 1985) (same).

4. *See* 37 CFR § 2.133(a) and 37 CFR § 2.133(b); *Personnel Data Systems Inc. v. Parameter Driven Software Inc*., 20 USPQ2d 1863 (TTAB 1991); *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970 (TTAB 1991); and *Space Base Inc. v. Stadis Corp*., 17 USPQ2d 1216 (TTAB 1990).

5. *See Space Base Inc. v. Stadis Corp*., 17 USPQ2d 1216 (TTAB 1990). *See also Flow Technology Inc. v. Picciano,* 18 USPQ2d 1970 (TTAB 1991).

6. Requests to record changes to a Trademark Act § 66(a) registration must be filed with the International Bureau. *See* 37 CFR § 7.22. *See also* TMEP § 1904.06.

7. *See* 37 CFR § 2.133(b). *See also* Trademark Act § 18, 15 U.S.C. § 1068.

8. *See* 37 CFR § 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); and *Snuffer &*

Watkins Management Inc. v. Snuffy's Inc., 17 USPQ2d 1815 (TTAB 1990) (allegations of abandonment in a particular geographic location constitute an insufficient pleading).

9. *See In re Forbo*, 4 USPQ2d 1415 (Comm'r 1984) (petition to Commissioner to territorially restrict a registration denied); and *In re Alfred Dunhill Ltd.*, 4 USPQ2d 1383 (Comm'r 1987).

10. *See Faces, Inc. v. Face's, Inc.*, 222 USPQ 918 (TTAB 1983).

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 CFR § 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 trademark examining attorney, render the mark in the application unregistrable, the facts should be called to the attention of the Trademark Trial and Appeal Board. The Board may suspend the proceeding and refer 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 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 pendency 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, the examining attorney learns of facts which, in his or her 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 CFR § 2.130 or 37 CFR § 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 which 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 or Trademark Act § 44, 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, 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 CFR § 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 CFR § 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 Trademark Act § 66(a), 15 U.S.C. § 1141f(a), may not be remanded under 37 CFR § 2.130 or 37 CFR § 2.131. [Note 5.]

NOTES:

1. 37 CFR § 2.130.

2. *See* 37 CFR § 2.130 and 37 CFR § 7.25 ("Sections of part 2 applicable to extension of protection").

3. *See generally* 37 CFR § 2.133(a).

4. *See*, *e.g.*, 37 CFR § 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 (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 (TTAB 1984); *Color Key Corp. v. Color 1 Associates, Inc.*, 219 USPQ 936 (TTAB 1983); and *Antillian Cigar Corp. v. Benedit Cigar Corp.*, 218 USPQ 187 (TTAB 1983).

5. *See* 37 CFR § 2.131.

516 Motion to Divide Application or Registration

An application which 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. 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 3.]

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 4.]

Any request to divide an application which 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 5.]

For further information concerning division of an application, *see* TMEP § 1110.

NOTES:

1. 37 CFR § 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 CFR § 2.87(a) and 37 CFR § 2.87(b).

3. *See* 37 CFR § 2.87(a) and 37 CFR § 2.87(b).

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

5. 37 CFR § 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 which 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 CFR § 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. Whether the Board decides to grant a motion as conceded or consider the motion on its merits is a matter of discretion. Surreply briefs, even if timely filed, will be given no consideration by the Board. [Note 3.] Accordingly, it is not necessary (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 CFR § 2.127. *See* TBMP § 502.02(b).

NOTES:

1. *See* 37 CFR § 2.127(a).

2. *See Corporacion Habanos S.A. v. Guantanamera Cigars*, 86 USPQ2d 1473, 1474 (TTAB 2008).

3. *See* 37 CFR § 2.127(a).

518 Motion for Reconsideration of Decision on Motion

37 CFR § 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 15 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 CFR § 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 15 days from the date of service of the request (20 days if service of the request was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.120(c)). [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 CFR § 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 CFR § 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 properly 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. 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 7.] *Cf.* TBMP § 543 (Motion for Reconsideration of Final Decision).

An interlocutory motion, request, or other matter which is not actually or potentially dispositive of a proceeding, may be acted upon by a single Board judge, or by a Board attorney to whom authority so to act has been delegated. [Note 8.] *See also* TBMP § 502.04. When a single Board judge, or a single duly authorized attorney, has acted upon an interlocutory motion, request, or other matter not actually or potentially dispositive of the proceeding, and one or more of the parties is dissatisfied with the action, the dissatisfied party or parties may seek review thereof by requesting, under 37 CFR § 2.127(b), the same single Board judge, or the same single attorney, to reconsider the action, and/or by filing a petition to the Director for review of the decision under 37 CFR § 2.146(e)(2) (*see* TBMP § 905). A request that the action of the single Board judge, or single 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 9.]

NOTES:

1. 37 CFR § 2.127(b). *See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000).

2. *See Avedis Zildjian Co. v. D. H. Baldwin Co.*, 181 USPQ 736 (Comm'r 1974).

3. *See Giant Food, Inc. v. Standard Terry Mills, Inc*., 231 USPQ 626 (TTAB 1986); *Avedis Zildjian Co. v. D.G. Baldwin Co.*, 181 USPQ 736 (Comm'r 1974).

4. *See Avedis Zildjian Co. v. D. H. Baldwin Co.*, 181 USPQ 736 (Comm'r 1974).

5. *See* 37 CFR § 2.127(b).

6. *See Joy Manufacturing Co. v. Robbins Co.*, 181 USPQ 408 (TTAB 1974). *Cf. General Tire & Rubber Co. v. Gendelman Rigging & Trucking Inc.,* 189 USPQ 425 (TTAB 1975).

7. *See Vignette Corp. v. Marino,* 77 USPQ2d 1408, 1411 (TTAB 2005*)* (reconsideration denied because Board did not err in considering disputed evidence).

8. *See* 37 CFR § 2.127(c).

9. *See*, *e.g.*, *Harley-Davidson Motor Co. v. Pierce Foods Corp.*, 231 USPQ 857, 859 n.13 (TTAB 1986).

519 Motion for Leave to Serve Additional Interrogatories

37 CFR § 2.120(d)(1) *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. ...*

A motion under 37 CFR § 2.120(d)(1) for leave to serve additional interrogatories must be filed and granted prior to service of the proposed additional interrogatories, and must be accompanied both by a copy of any interrogatories which have already been served by the moving party, and by a copy of the interrogatories proposed to be served. [Note 1.]

Good cause for the service of additional interrogatories will generally be found only where it is shown that there is a legitimate need for further discovery by interrogatories. [Note 2.] The mere fact that the additional interrogatories 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 additional interrogatories. [Note 3.] Given the Board's limited jurisdiction and the generous number of interrogatories provided under the Rule, such motions for leave to serve additional interrogatories are disfavored.

For further information concerning good cause for a motion to serve additional interrogatories, *see* TBMP § 405.03(c). For information concerning the interrogatory limit specified in 37 CFR § 2.120(d)(1), *see* TBMP § 405.03.

NOTES:

1. 37 CFR § 2.120(d)(1). *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466 (TTAB 1990); *Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398 (TTAB 1990); *Chicago Corp. v. North American Chicago Corp.*, 16 USPQ2d 1479 (TTAB 1990); *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572 (TTAB 1990); and Notice of Final Rulemaking, published in the Federal Register on September 12, 1991 at 56 FR 46376, and in the Official Gazette of October 22, 1991 at 1131 TMOG 54, as corrected in the Federal Register of October 23, 1991 at 56 FR 54917.

2. *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466 (TTAB 1990).

3. *See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466 (TTAB 1990); *Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc.*, 16 USPQ2d 1398 (TTAB 1990); and *Brawn of California Inc. v. Bonnie Sportswear Ltd.*, 15 USPQ2d 1572 (TTAB 1990).

520 Motion to Take Foreign Deposition Orally

37 CFR § 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 or the parties stipulate, that the deposition be taken by oral examination.*

37 CFR § 2.123(a)(2) *A testimonial deposition 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.*

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)(3) 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 CFR § 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 his or her 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 Hague 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)(7) [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.]

Similarly, a testimonial deposition taken in a foreign country must be taken by deposition upon written questions in the manner described in 37 CFR § 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. [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 CFR § 2.120(c)(1).

2. *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429 (TTAB 1998). *See also Rosenruist-Gestao E Servicos LDA v. Virgin Enters. Ltd.*, 511 F.3d 437, 85 USPQ2d 1385 (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 (TTAB 1991).

4. *See* 37 CFR § 2.120(c)(1); *Orion Group Inc. v. Orion Insurance Co. P.L.C.,* 12 USPQ2d 1923 (TTAB 1989) (good cause to take oral deposition of witness in England); and *Jonergin Co. Inc. v. Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r 1983) (stipulation to take oral deposition in Canada).

5. 37 CFR § 2.123(a)(2). *See 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 (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]; or (2) constitutes harassment or is without proper basis [Note 2]; or (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 [Note 3]; or (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 CFR § 2.120(c) or 37 CFR § 2.123(a)(2) [Note 4]; or (5) that 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]; or (6) that there was not due (i.e., reasonable) notice of the proposed deposition [Note 6]; *see* TBMP § 404.05 and TBMP § 703.01(e) or (7) that 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; or (8) that the deposing party improperly seeks to force a foreign natural person to come to the United States for the taking of his or her deposition [Note 7]; s*ee* TBMP § 404.03(b) or (9) that 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] or (10) that the deposing party seeks to take the testimonial deposition of a witness who was not identified in that party's pretrial disclosures. [Note 9.]

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 10.] *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 11.] 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 (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); and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (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 (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 (TTAB 1976) (written discovery requests directed to assignor need not be answered where assignment occurred prior to institution of proceeding).

3. *See* 37 CFR § 2.120(b).

4. *See Rhone-Poulenc Industries v. Gulf Oil Corp*., 198 USPQ 372 (TTAB 1978).

5. *See* 37 CFR § 2.123(c).

6. *See* 37 CFR § 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); and *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 (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); and *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 USPQ 1429 (TTAB 1998) (issue raised by motion to compel). *See also Rosenruist-Gestao E Servicos LDA v. Virgin Enters. Ltd*., 511 F.3d 437, 85 USPQ2d 1385 (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 CFR § 2.123(a)(1); *Century 21 Real Estate Corp. v. Century Life of America,* 15 USPQ2d 1079 (TTAB 1990) (good cause shown for oral deposition), *corrected*, 19 USPQ2d 1479 (TTAB 1990); and *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589 (TTAB 1980) (good cause shown for oral deposition).

9. *Cf. Jules Jurgenson/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443 (TTAB 2009) (motion to strike testimony of witness not identified in pretrial disclosures).

10. *See 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 2008) (failure to have subpoena for discovery deposition quashed resulted in sanction precluding party from using survey evidence at trial).

11. *See* 37 CFR § 2.120(i)(1).

522 Motion for Order re Manner or Place of Document Production

37 CFR § 2.120(d)(2) *The production of documents and things under the provisions of Rule 34 of the Federal Rules of Civil Procedure will be made at the place where the documents and things are usually kept, or where the parties agree, 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 CFR § 2.120(d)(2). 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 (TTAB 2000) (improper to object regarding place of production when ordered to provide responses without objection); *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013 (TTAB 1983); and *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193 (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 (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); and *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1432 (TTAB 1998).

523 Motion to Compel Disclosure or Discovery

523.01 In General

37 CFR § 2.120(e) Motion for an order to compel disclosure or discovery.

(1) *If a party fails to make required initial disclosures or expert testimony disclosures, 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 or 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 disclosure, 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 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.*

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 or sanction a party for failing to make initial disclosures after being ordered to do so. [Note 3.] 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 4.]

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 5.]

In accordance with 37 CFR § 2.120(e)(2), 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 which 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 prior to the opening of 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 6.]

This rule, in conjunction with 37 CFR § 2.120(e)(1) and 37 CFR § 2.120(h)(1) which provide, respectively, that a motion to compel initial disclosures or expert testimony disclosure must be filed prior to the close of the discovery period, and a motion to compel discovery must be filed prior to the commencement of the first testimony period as originally set or as reset, and that the period between the end of the discovery period and the opening of the first testimony period is sixty days, is designed to ensure that all discovery disputes are resolved prior to the commencement of trial. [Note 7.] A motion to compel discovery is untimely if filed after the first testimony period commenced, even if the first testimony period is subsequently reset. [Note 8.] *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 CFR § 2.120(h) and Fed. R. Civ. P. 36(a) and *see* 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 (regarding time for service of discovery responses), TBMP § 405.04(a) (regarding time for service of interrogatory responses), TBMP § 406.04(a) (regarding time for service of responses to document requests), and TBMP § 411 (remedy for failure to provide disclosures or discovery); and *see* TBMP § 523 (regarding motion to compel discovery) and TBMP § 524 (regarding motion to test sufficiency of responses to admission requests).

NOTES:

1. *See* 37 CFR § 2.120(e). *See also, e.g.*, *Johnson and Johnson and Roc International S.A.R.L. v. Obschestvo s Oranitchennoy; Otvetstvenn Ostiu "Wds,"* 95 USPQ2d 1567 (TTAB 2010) (TTAB 2010) (motion to compel applicant to supplement interrogatory responses granted); *Jain v. Ramparts Inc.*, 49 USPQ2d 1429 (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 (TTAB 1979) (interrogatories); *General Sealer Corp. v. H. H. Robertson Co.*, 193 USPQ 384 (TTAB 1976) (motion for sanctions treated as motion to compel); and *Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.*, 191 USPQ 127 (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 (TTAB 1975); *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615 (TTAB 1974); *Neville Chemical Co. v. Lubrizol Corp*., 183 USPQ 184 (TTAB 1974); and *Dow Corning Corp. v. Doric Corp.*, 183 USPQ 126 (TTAB 1974). *Cf.* Fed. R. Civ. P. 37(a)(2)(B).

2. *Promgirl Inc. v. JPC Co.,* 94 USPQ2d 1759 (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 CFR § 2.120(g)(1).

3. *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1860 n.3 (TTAB 2008).

4. *See* 37 CFR § 2.120(e); *Neville Chemical Co. v. Lubrizol Corp*, 183 USPQ 184, 189 (TTAB 1974).

5. 37 CFR § 2.120(a)(3); *Dating DNA LLC v. Imagini Holdings Ltd.,* 94 USPQ2d 1889 (TTAB 2010); *Amazon Technologies v. Jeffrey S. Wax,* 93 USPQ2d 1702 (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).

6. *See* 37 CFR § 2.120(e)(2). *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).

7. *See H.D. Lee Co. v. Maidenform Inc.,* 87 USPQ2d 1715, 1719 n.10 (TTAB 2008) (motion to compel need not be filed during discovery period, but must be filed prior to opening of first testimony period); and *Luemme Inc. v. D.B. Plus, Inc*., 53 USPQ2d 1758 (TTAB 1999) (motions to compel and motions to test the sufficiency of responses to requests for admission must be filed prior to the opening of the first testimony period).

8. *Cf. La Maur, Inc. v. Bagwells Enterprises, Inc.,* 193 USPQ 234 (Comm'r 1976).

523.02 Special Requirements for Motion

***37 CFR § 2.120(e)* Motion for an order to compel disclosure or discovery.**

(1) ... *A motion to compel discovery shall include a copy of the request for designation 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 or 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 written statement 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 CFR § 2.120(e). [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.]

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 which no longer require determination. [Note 3.]

For information concerning the special requirements for a motion to compel answers to interrogatories that are the subject of a general objection on the ground of excessive number, *see* TBMP § 405.03(e). *Cf.* TBMP § 526.

NOTES:

1. *See Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, In*c., 191 USPQ 127 (TTAB 1976) (Board must be able to render a meaningful decision on a motion to compel); *Amerace Corp. v. USM Corp.*, 183 USPQ 506 (TTAB 1974); and *Helene Curtis Industries, Inc. v. John H. Breck, Inc*., 183 USPQ 126 (TTAB 1974).

2. 37 CFR § 2.120(e). *See Amazon Techonologies, Inc. v. Jeffrey S. Wax,* 93 USPQ2d 1702, 1705 (TTAB 2009) (good faith effort requirement); *Pioneer Kabushiki Kaisha v. Hitachi,* 74 USPQ2d 1672, 1679 n.1 (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 (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); and *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. 37 CFR § 2.120(e). *See*, *e.g., Luehrmann v. Kwik Kopy Corp*., 2 USPQ2d 1303 (TTAB 1987) (late responses rendered motion to compel, based on complete non-responsiveness, moot).

523.03 Time for Filing Motion

***37 CFR § 2.120(e)* Motion for an order to compel disclosure or discovery.**

(1) *... A motion to compel initial disclosures or expert testimony disclosure must be filed prior to the close of the discovery period. A motion to compel discovery must be filed prior to the commencement of the first testimony period as originally set or as reset. ...*

A motion to compel initial or expert testimony disclosures must be filed prior to the close of the discovery period to allow time for the non-compliant party to conduct discovery after making its disclosures. [Note 1.]

A motion to compel discovery does not necessarily have to be filed during the discovery period. [Note 2.] 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 first testimony period opens. [Note 3.] 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 4.] If testimony periods are reset prior to the opening of the plaintiff's testimony period-in-chief, a motion to compel filed before a first trial period opens is timely. However, once the first trial period opens, a motion to compel filed thereafter is untimely, even if it is filed prior to the opening of a rescheduled or reset testimony period-in-chief for plaintiff. [Note 5.] There is no provision in the rule for Board discretion to consider an untimely motion to compel. Trial schedules include a sixty-day period between the close of discovery and the opening of the first testimony period to allow time for the filing of any necessary discovery motions.

NOTES:

1. 37 CFR § 2.120(e).

2. *See H.D. Lee Co. v. Maidenform, Inc.,* 87 USPQ2d 1715, 1719 n.10 (TTAB 2008); and *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 617 (TTAB 1974).

3. 37 CFR § 2.120(e).

4. 37 CFR § 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).

5. *Cf. La Maur, Inc. v. Bagwells Enterprises, Inc.,* 193 USPQ 234 (Comm'r 1976).

523.04 Failure to File Motion to Compel

If a party that served a request for discovery receives a response thereto which 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. *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); *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 (TTAB 2001) (because plaintiff's first testimony period had already opened, any motion to compel to test alleged deficiencies in discovery responses would be 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 CFR § 2.120(h) 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 filing and service of the motion, no party should file any paper which is not germane to the motion, except as otherwise specified in the Board's suspension order. Nor may any party thereafter 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 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. *See* TBMP § 525 and TBMP § 527.01(d) for further discussion.

NOTES:

1. *See* 37 CFR § 2.120(h); Fed. R. Civ. P. 36(a); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 188 USPQ 690 (TTAB 1975); and *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696, 697 n.7 (TTAB 1971). *Cf.* 37 CFR § 2.120(e).

2. Fed. R. Civ. P. 36(a).

3. *Cf.* comments to Fed. R. Civ. P. 36(a)(4 – 6) regarding improper responses which may be considered effective admissions.

4. Fed. R. Civ. P. 36(a)(3).

524.02 Special Requirements for Motion

37 CFR § 2.120(h) 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 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 which no longer require determination. [Note 3.]

NOTES:

1. 37 CFR § 2.120(h). *Cf.* 37 CFR § 2.120(e).

2. 37 CFR § 2.120(h). *Cf.* 37 CFR § 2.120(e); *Amazon Technologies v. Wax,* 93 USPQ2d 1702 (TTAB 2009) (TTAB 2009).

3. 37 CFR § 2.120(h). *Cf.* 37 CFR § 2.120(e).

524.03 Time for Filing Motion

***37 CFR § 2.120(h)* Request for admissions.**

(1) *Any motion by a party to determine the sufficiency of an answer or objection to a request made by that party for an admission must be filed prior to the commencement of 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 filing and service of the motion, no party should file any paper which is not germane to the motion, except as otherwise specified in the Board's suspension order. ... 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.*

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 prior to the commencement of the first testimony period, as originally set or as reset. [Note 1.] Once the first testimony period opens, a motion to test the sufficiently filed thereafter is untimely, even if testimony periods are subsequently reset. However, if testimony periods are reset prior to the opening of the plaintiff's testimony period-in-chief as originally set, a motion to test sufficiency will be timely if it is filed before the rescheduled opening of plaintiff's testimony period. If testimony periods are reset prior to the opening of the plaintiff's testimony period-in-chief, a motion to compel filed before a first trial period opens is timely. However, once the first trial period opens, a motion to compel filed thereafter is untimely, even if it is filed prior to the opening of a rescheduled or reset testimony period-in-chief for plaintiff. [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 sixty-day period between the close of discovery and the opening of the first testimony period to allow time for the filing of any necessary discovery motions. *Cf.* TBMP § 523.03.

NOTES:

1. 37 CFR § 2.120(h)(1).

2. 37 CFR § 2.120(h)(1). *Cf. La Maur, Inc. v. Bagwells Enterprises Inc.,* 193 USPQ 234 (Comm'r 1976); *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615 (TTAB 1974) (motion to compel timely even if filed after close of discovery).

524.04 Failure to File Motion

If a party that served a request for admission receives a response thereto which 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 CFR § 2.120(h)(1).

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)(2) Computing and 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).*

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)(2), 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)(2), 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) and Fed. R. Civ. P. 36.

3. *Giersch v. Scripps,* 85 USPQ2d 1306, 1307 (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)).

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); and *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*). See also American Automobile Ass'n (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).

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); and *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 CFR § 2.120(f)* 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 (1) through (8), inclusive, of Rule 26(c) 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 CFR § 2.120(f).

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. *See* TBMP § 410 (Asserting Objections to Requests for Discovery; Motions Attacking Requests for Discovery). [Note 1.]

Moreover, if a party upon which interrogatories have been served believes that the number of interrogatories served exceeds the limitation specified in 37 CFR § 2.120(d)(1), 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, 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 interrogatories, *see* TBMP § 405.03(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 those situations, 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.]

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 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. [Note 5.] Subject to Board approval, however, parties are free to agree to a substitute protective order or to supplement or amend the Board's standard order. [Note 6.]

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 CFR § 2.120(d)(1).

3. *See*, *e.g.*, 37 CFR § 2.120(f); Fed. R. Civ. P. 26(c); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.,* 74 USPQ2d 1672 (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); and *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 (TTAB 1988).

For other examples of cases involving a motion for a protective order relating to discovery, *see Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609 (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 (TTAB 1975) (motion for protective order that discovery not be taken pending Board's determination of motion to dismiss).

5. 37 CFR § 2.116(g).

6. *See Bausch & Lomb v. Karl Storz GmbH*, 87 USPQ2d 1526, 1532 (TTAB 2008). *See also Red Wing Co. v. Smucker Co.*, 59 USPQ2d 1861, 1862 (TTAB 2001) (protective order adding an addendum excluding production of "trade secret manufacturing and technical information unrelated to the trademark forming the subject of the opposed application, which involves the visual appearance of a jarred food product.")

527 Motion for Sanctions

527.01 Motion for Discovery Sanctions

527.01(a) For Failure to Comply With Board Discovery Order

37 CFR § 2.120(g) 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 CFR § 2.120(g)(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 CFR § 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 a 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 CFR § 2.120(g)(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 CFR § 2.120(g)(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 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; 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 CFR § 2.120(g)(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 CFR § 2.120(g)(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 CFR § 2.120(g)(1). *Cf. Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448 (Fed. Cir. 1988) (question of proper sanction committed to sound discretion of the court); *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); and *Nobelle.com LLC v. Qwest Communications Int'l 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 CFR § 2.120(g)(1).

3. *Cf. Promgirl, Inc., v. JPC Co., Ltd.,* 94 USPQ2d 1759 (TTAB 2009).

4. 37 CFR § 2.120(g)(1). *See Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC,* 88 USPQ2d 1541, 1543 (TTAB 2008) (sanctions allowed under 37 CFR §2.120(g)(2) in absence of prior Board order for failure to participate in discovery conference); *HighBeam Marketing LLC v. HighBeam Research LLC,* 85 USPQ2d 1902, 1904 (TTAB 2008).

5. *See e.g. Promgirl, Inc., v. JPC Co., Ltd.,* 94 USPQ2d 1759 (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 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 (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 Mfg. 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); and *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 (TTAB 1984) and *Unicut Corp. v. Unicut, Inc*., 220 USPQ 1013 (TTAB 1983) (in 1983 decision, respondent sanctioned by order to produce documents by mailing them to petitioner's attorney at petitioner's expense; in 1984 decision, respondent's continued refusal to obey Board orders sanctioned by entry of judgment); and *Caterpillar Tractor Co. v. Catfish Anglers Together, Inc.*, 194 USPQ 99 (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 1348 (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 Int'l Inc., 6*6 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); and *Seligman & Latz, Inc. v. Merit Mercantile Corp.*, 222 USPQ 720 (TTAB 1984) (sanction of drawing adverse inference best left to situations where witness fails or refuses to answer during testimonial as opposed to discovery deposition).

7. *See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000), and other cases cited in previous note.

8. *See* 37 CFR § 2.120(g)(1) and 37 CFR § 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 (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 (TTAB 1976) (motion for summary judgment on basis of petitioner's failure to answer interrogatories denied); and *Johnson & Johnson v. Diamond Medical, Inc*., 183 USPQ 615 (TTAB 1974) (motion for judgment denied).

10. *See HighBeam Marketing LLC v. HighBeam Research LLC,* 85 USPQ2d 1902 (TTAB 2008).

11. *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 CFR § 2.120(h).

527.01(b) If Party Says It Will Not Respond to Discovery Request or Make Required Disclosures

37 CFR § 2.120(g)(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 (g)(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 (g)(1) of this section.*

The motion for sanctions under 37 CFR § 2.120(g)(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 CFR § 2.120(g)(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 CFR § 2.120(g)(1), discussed infra.

The sanctions 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; 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 CFR § 2.120(g)(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 CFR § 2.120(g)(1); 37 CFR § 2.120(g)(2); and 37 CFR § 2.127(f).

527.01(c) Untimely Response to Discovery Requests

A party which fails to respond to a request for discovery (except for a request for admission) 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 1.] 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 (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 (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 (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); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691 (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 CFR § 2.120(h) 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 CFR § 2.120(j)(3)(i), 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 CFR § 2.120(h).

2. *See* 37 CFR § 2.120(h); Fed. R. Civ. P. 36(a); *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp*., 188 USPQ 690 (TTAB 1975);*Watercare Corp. v. Midwesco-Enterprise, Inc*., 171 USPQ 696 (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.] 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 3.] *See* TBMP § 523.04 (Failure to File a Motion to Compel).

NOTES:

1. *See Panda Travel, Inc. v. Resort Option Enterprises, Inc.,* 94 USPQ2d 1789 (TTAB 2009) (documents not produced until after the start of trial stricken).

2. *See*, *e.g.*, *Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448 (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); and *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. 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); *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); and *Charrette Corp. v. Bowater Communication Papers Inc.,* 13 USPQ2d 2040 (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. *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").

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.*, *Carefirst of Maryland Inc. v. FistHealth of the Carolinas Inc.,* 77 USPQ2d 1492 (TTAB 2005); *JSB Int'l Inc. v. Auto Sound North Inc.,* 215 USPQ 60 (TTAB 1982).

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.*

<u>37 CFR § 11.18</u> 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) 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 challenged submission and allows the motion to be filed only if the challenged submission is not withdrawn or appropriately corrected. The Board will deny motions for Fed. R. Civ. P. 11 sanctions which 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 CFR § 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 CFR § 2.116(a); *The Clorox co. v. Chemical Bank*, 40 USPQ2d 1098, n.9 (TTAB 1996) (accuracy in factual representations is expected); and *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)(1)(B); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021 (TTAB 1998) (order to show cause issued where, although Fed. R. Civ. P. 56(f) motion was granted, party responded to summary judgment without taking the requested discovery); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 633 n.19 (TTAB 1986) (Rule 11 permits court to enter sanctions sua sponte).

3. *See Business Guides, Inc. v. Chromatic Communications Enterprises, In*c., 498 U.S. 533, 547 (1991); and *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 CFR § 11.18(c).

4. *See* 37 CFR § 2.127(f). *Compare* 37 CFR § 2.120(f) and 37 CFR § 2.120(g)(1).

5. *See* 37 CFR § 2.116(a); *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 CFR § 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, 633 n.19 (TTAB 1986) (applicant's frivolous request for reconsideration of order imposing Rule 11 sanctions resulted in entry of judgment); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (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 CFR § 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 CFR § 11.19 *et seq*. In addition, conduct in violation of the Canons and Disciplinary Rules set forth in 37 CFR part 10 and 11 may be referred to the Office of Enrollment and Discipline for appropriate action. *See* 37 CFR § 11.18(d) and 37 CFR § 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 copy of a petition to cancel its registration) 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.

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 (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").

2. *See Chambers v. NASCO, Inc.*, 501 U.S. 32 (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."); *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); and *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 CFR § 2.127(a).

4. *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 (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); and *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 Corporation 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 CFR § 2.119(a) and 37 CFR § 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) By a Claiming Party. *A party claiming relief may move, with or without supporting affidavits, for summary judgment on all or part of the claim. ...*

(b) By a Defending Party. *A party against whom relief is sought may move ... with or without supporting affidavits, for summary judgment on all or part of the claim.*

(c) Serving the Motion; Proceedings. *... An opposing party may serve opposing affidavits ... The judgment sought should be rendered if the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law.*

(d) Case Not Fully Adjudicated on the Motion.

(1) Establishing Facts. *If summary judgment is not rendered on the whole action, the court should, to the extent practicable, determine what material facts are not genuinely at issue. The court should so determine by examining the pleadings and evidence before it ... It should then issue an order specifying what facts ... are not genuinely at issue. The facts so specified must be treated as established in the action.*

(e) Affidavits; Further Testimony.

(1) In General. *A supporting or opposing affidavit must be made on personal knowledge, set out facts that would be admissible in evidence, and show that the affiant is competent to testify on the matters stated. If a paper or part of a paper is referred to in an affidavit, a sworn or certified copy must be attached to or served with the affidavit. The court may permit an affidavit to be supplemented or opposed by depositions, answers to interrogatories, or additional affidavits.*

(2) Opposing Party's Obligation to Respond. *When a motion for summary judgment is properly made and supported, an opposing party may not rely merely on allegations or denials in its own pleading; rather, its response must — by affidavits or as otherwise provided in this rule — set out specific facts showing a genuine issue for trial. If the opposing party does not so respond, summary judgment should, if appropriate, be entered against that party.*

(f) When Affidavits Are Unavailable. *If a party opposing the motion shows by affidavit that, for specified reasons, it cannot present facts essential to justify its opposition, the court may:*

(1) *deny the motion;*

(2) *order a continuance to enable affidavits to be obtained, depositions to be taken, or other discovery to be undertaken; or*

(3) *issue any other just order.*

* * * *

528.01 General Nature of Motion

The motion for summary judgment is a pretrial device to dispose of cases in which "the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law." [Note 1.] The purpose of the motion is judicial economy, that is, to avoid an unnecessary trial where there is no genuine issue 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 2.]

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 3.]

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. [Note 4.] This burden is greater than the evidentiary burden at trial. [Note 5.] 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 6.]

If the moving party meets its burden, that is, if the moving party has supported its motion with affidavits or other evidence which 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 7.] A factual dispute is genuine if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party. [Note 8.]

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 issues of material fact to be tried. [Note 9.] The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues 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 non-moving party. [Note 10.]

A fact is material if it "may affect the decision, whereby the finding of that fact is relevant and necessary to the proceedings." [Note 11.] 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 12.] 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 13.]

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 issues of material fact, or authorize the resolution of such issues, or dictate that judgment should be entered in favor of one of them. [Note 14.]

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.

If the Board concludes that there is no genuine issue of material fact, but that the nonmoving party is the one entitled to judgment as a matter of law, the Board may enter summary judgment sua sponte in favor of the nonmoving party. [Note 15.]

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 16.] 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 two months

from the date on which a final order is entered in the case. Any appeal prior to that time is premature. [Note 17.] *See* TBMP § 518 and TBMP § 901.

Where appropriate, partial summary judgment may be entered as to separate classes of goods or services. [Note 18.]

NOTES:

1. Fed. R. Civ. P. 56(c). *See, e.g.*, *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Anderson v. Liberty Lobby, Inc*., 477 U.S. 242 (1986); *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996); *Dana Corp. v. Belvedere International Inc*., 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); and *Copelands' Enterprises Inc. v. CNV Inc*., 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). *See also Octocom Systems Inc. v. Houston Computer Services Inc*., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Sweats Fashions Inc. v. Pannill Knitting Co*., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); *Pure Gold, Inc. v. Syntex (U.S.A.), Inc*., 221 USPQ 151 (TTAB 1983), *aff'd,* 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376 (TTAB 1986); *Bongrain International (American) Corp. v. Moquet Ltd*., 230 USPQ 626 (TTAB 1986); and *Giant Food, Inc. v. Standard Terry Mills, Inc*., 229 USPQ 955 (TTAB 1986).

2. *See, e.g.*, *Pure Gold, Inc. v. Syntex (U.S.A.), Inc*., 221 USPQ 151 (TTAB 1983), *aff'd,* 739 F.2d 624, 222 USPQ 741, 743 (Fed. Cir. 1984) (evidence which might be adduced at trial would not change result given the differences in the goods of the parties); *Larami Corp. v. Talk To Me Programs Inc*., 36 USPQ 1840, 1843 (TTAB 1995) (where issue involved collateral estoppel); and *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).

3. *See, e.g., Sweats Fashions Inc. v. Pannill Knitting Co*., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987) (no relevant evidence to raise genuine issue of material fact); *Levi Strauss & Co. v. Genesco, Inc*., 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984) (response contained only unsupported arguments and conclusions); and *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); and *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (question of intent regarding filing of ITU application generally unsuitable for disposal by summary judgment).

4. *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); and *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).

5. *See, e.g., Gasser Chair Co. Inc. 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).

6. *Celotex Corp. v. Catrett*, 477 U.S. 317 (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 (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 Limited Partnership*, 92 USPQ2d 1537, 1540 (TTAB 2009) (nonmovant must proffer countering evidence to show existence of genuine factual dispute for trial); and *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 (Fed. Cir. 1988); and *Sweats Fashions Inc. v. Pannill Knitting Co*., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

7. Fed. R. Civ. P. 56(e). *See also Octocom Systems Inc. v. Houston Computer Services Inc*., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990) (non-moving 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."); and *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").

8. *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., Inc*., 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"); and *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).

9. *See Dyneer Corp. v. Automotive Products plc*, 37 USPQ 1251, 1254 (TTAB 1995); *University*

Book Store v. University of Wisconsin Board of Regents, 33 USPQ2d 1385, 1389 (TTAB 1994).

10. *See Lloyd's Food Products Inc. v. Eli's Inc*., 987 F.2d 766, 25 USPQ2d 2027 (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 (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); and *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. 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).

11. *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); and *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).

12. *See, e.g.*, *Kellogg Co. v. Pack'Em Enterprises Inc*., 14 USPQ2d 1545 (TTAB 1990), *aff'd,* 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). *See also Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986); and *Institut National Des Appellations d'Origine v. Brown-Forman Corp*., 47 USPQ2d 1875, 1879 (TTAB 1998).

13. *See United States Olympic Committee v. O-M Bread Inc*., 29 USPQ2d 1555 (TTAB 1993) (genuine issues of fact as to grounds which were asserted in opposition but were not grounds for summary judgment were irrelevant).

14. *See Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433 (TTAB 2007); *Fishking Processors Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1764 (TTAB 2007); and *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

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15. *See 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).

16. 37 CFR § 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).

17. *See Copelands' Enterprises, Inc. v. CNV, Inc.*, 887 F.2d 1065, 12 USPQ2d 1563 (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).

18. *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).

528.02 Time For Filing Motion

37 CFR § 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, if filed, should be filed prior to the commencement of the first testimony period, as originally set or as reset, and the Board, in its discretion, may deny as untimely any motion for summary judgment filed thereafter.*

For inter partes proceedings commenced on or after November 1, 2007, 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 CFR § 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 should be filed before the opening of the first testimony period, as originally set or as reset. 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 issue of material fact, and that it is entitled to judgment as a matter of law. [Note 3.] In inter partes proceedings before the Board, trial commences with the opening of the first testimony period. [Note 4.] *See* TBMP § 701. Therefore, a motion for summary judgment should be filed prior to the opening of the first testimony period, as originally set or as reset, and the Board, in its discretion, may deny as untimely any summary judgment motion filed thereafter. [Note 5.] If testimony periods are reset prior to the opening of the plaintiff's testimony period-in-chief, a motion for summary judgment filed before such testimony period commences is timely. [Note 6.] Once the first testimony period commences, however, any summary judgment motion filed thereafter is untimely, even if filed prior to the opening of a

rescheduled testimony period-in-chief for plaintiff, and also if no trial evidence has actually been adduced by the plaintiff.

The Board will generally not consider a motion for summary judgment filed after the first testimony period commences unless (1) it involves a matter of res judicata (claim preclusion) or collateral estoppel (issue preclusion) or (2) was submitted by stipulation of the parties filed with the Board prior to the taking of any testimony or under the provisions of Accelerated Case Resolution (ACR). [Note 7.] *See* TBMP § 528.05(a). In fact, the Board often will deny a summary judgment motion on the basis of untimeliness without waiting to see whether the nonmoving party raises this objection in its response.

In certain situations, however, the Board may exercise its discretion to consider an untimely summary judgment motion if the circumstances warrant and judicial economy will be served thereby. [Note 8.]

When a motion for summary judgment is filed, a brief in response, or a motion under Fed. R. Civ. P. 56(f) of the Federal Rules of Civil Procedure, must be filed within 30 days from the date of service of the motion. A reply brief, if any, must be filed within 15 days from the service date of the brief in response. The time for filing a reply brief will not be extended. [Note 9.] The time for filing a responsive brief may be extended, but the time for filing a motion under Fed. R. Civ. P. 56(f) in lieu thereof, will not be extended. *See* TBMP § 528.06.

NOTES:

1. 37 CFR § 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 CFR § 2.127(e)(1); *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255 n1. (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"). *See also* 37 CFR § 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); and *Mayer/Berkshire Corp. v. Berkshire Fashions*, 424 F.3d 1229, 76 USPQ2d 1310, 1312 (Fed. Cir. 2005).

3. *Celotex Corp. v. Catrett*, 477 U.S. 317, 327 (1986); *Hewlett-Packard Development Co. v. Vudu Inc.*, 92 USPQ2d 1630, 1631 (TTAB 2009).

4. *See* 37 CFR § 2.127(e)(1). *See also Blansett Pharmacal Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992) (motion filed three days before testimony period opened was not untimely despite respondent's claim that it would have conducted additional discovery if it had known petitioner was planning to file motion rather than go to trial); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376 (TTAB 1986) (motion filed after trial

period opens does not serve purpose of eliminating need for trial); and *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co*., 226 USPQ 718 (TTAB 1985) (motion filed after close of applicant's testimony period untimely).

5. *See La Maur, Inc. v. Bagwells Enterprises, Inc*., 193 USPQ 234 (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).

6. 37 CFR § 2.127(e)(1).

7. 37 CFR § 2.127(e)(1).

8. *See Bausch & Lomb Inc. v. Leupold & Stevens Inc*., 1 USPQ2d 1497, 1498 n.2 (TTAB 1986) (untimely cross-motions decided where parties acknowledged that both were untimely but Board granted request for a ruling thereon); *Lukens Inc. v. Vesper Corp*., 1 USPQ2d 1299, 1300 n.2 (TTAB 1986), *aff'd,* 831 F.2d 306 (Fed. Cir. 1987) (untimely motion decided where non-moving party did not object to timeliness and responded on merits and, moreover, motion was based on collateral estoppel); and *Buffett v. Chi Chi's, Inc*., 226 USPQ 428 (TTAB 1985) (untimely motion decided where no objection to timeliness was raised and delay was relatively insignificant).

9. 37 CFR § 2.127(e)(1).

528.03 Suspension Pending Determination of Motion

37 CFR § 2.127(d) *When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be 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 specified in the 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.*

When a party files a timely motion for summary judgment , the Board generally will issue an order suspending proceedings in the case 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, in its discretion, may issue an immediate action denying the motion for that reason. The filing of a summary judgment motion does not, in and of itself, automatically suspend proceedings in a case; rather, proceedings are suspended only when the Board issues an order to that effect. [Note 2.] However, on a case-by-case basis, the Board may find that the filing of a motion for summary judgment provides a party with good cause for not complying with an otherwise outstanding obligation, for example, responding to discovery requests. [Note 3.] Notwithstanding, the Board has found that the filing of a motion for summary judgment does not provide a party good cause not to timely comply with a Board order granting discovery sanctions which required the services of complete

discovery responses. [Note 4.] 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 5.] Examples of papers which 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(f) 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 6.] *See* TBMP § 528.07.

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(f) 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 7.]

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 8.]

NOTES:

1. *See* 37 CFR § 2.127(d) and 37 CFR § 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 Super Bakery Inc. v. Benedict,* 96 USPQ2d 1134, 1135 (TTAB 2010) (mere filing of motion for summary judgment does not automatically suspend proceedings; only an order of the Board formally suspending proceedings has such effect); *Giant Food, Inc. v. Standard Terry Mills, Inc*., 229 USPQ 955, 965 (TTAB 1986). *Cf. Consultants & Designers, Inc. v. Control Data Corp*., 221 USPQ 635, 637 n.8 (TTAB 1984) (filing of motion for entry of default judgment for failure to answer does not automatically suspend proceedings).

3. *Cf. Leeds Technologies Limited v. Topaz Communications Ltd*., 65 USPQ2d 1303 (TTAB 2002) (regarding suspension in the case of a motion for judgment on the pleadings); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999) (regarding suspension in the case of a motion for sanctions in the nature of judgment).

4. *See Super Bakery Inc. v. Benedict,* 96 USPQ2d 1134, 1135 (TTAB 2010) (filing of motion for summary judgment one day before Board ordered discovery responses were due, and prior to issuance of Board suspension order, does not establish good cause for failure to comply with discovery obligations under Board order granting discovery sanctions).

5. *See* 37 CFR § 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).

6. *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 USPQ 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); and *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).

7. *See* 37 CFR § 2.127(e)(1).

8. 37 CFR § 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 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 CFR § 2.127(e)(1); *Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009) (proceeding involved two consolidated oppositions with one subject to current rules; motion to dismiss not converted to motion for summary judgment in opposition subject to current rules).

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* 10A C. WRIGHT, A. MILLER & M. KANE, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2722 (2009).

528.05 Summary Judgment Evidence

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 "the pleadings, the discovery and disclosure materials on file, and any affidavits…." [Note 1.]

The evidentiary record upon summary judgment in an inter partes proceeding before the Board also includes, without action by any party, the file of any application or registration which is the subject of the proceeding as provided in 37 CFR § 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 CFR § 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 which 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.] 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 4.] *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. However, such a submission may not be used as a subterfuge to avoid the prohibition on filing sur-replies 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 5], and any registration pleaded and made of record by the plaintiff with its complaint. Any other evidence, which a party wishes to have considered upon summary judgment, must be submitted in connection with the summary judgment motion. [Note 6.]

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 7.] *See* TBMP § 527.01(f). Objections to evidence may be made in a party's responsive brief, if one is permitted.

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 8.] 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 9.] 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 10.] *See* TBMP § 528.05(a)(2).

NOTES:

1. Fed. R. Civ. P. 56(c). *See also* Fed. R. Civ. P. 56(e).

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).

3. *See* 37 CFR § 2.122(b), 37 CFR § 2.122(d)(2), 37 CFR § 2.122(e), 37 CFR § 2.122(f), and 37 CFR § 2.127(e)(2). *See also Racciopp i v. Apogee Inc*., 47 USPQ 1368, 1369-70 (TTAB 1998) (party may rely on documents admissible under 2.122(e)).

4. *See generally University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc*., 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); and *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1515 (TTAB 2009).

5. *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).

6. *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).

7. *See Greenhouse Systems Inc. v. Carson,* 37 USPQ2d 1748 (TTAB 1995).

8. *See 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 (TTAB 1993) (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); and *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).

9. *See, e.g.*, *Eveready Battery Co., Inc. 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).

10. *See, e.g.*, *Freeman v. National Association of Realtors*, 64 USPQ2d 1700 (TTAB 2002); *Miller Brewing Company 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, including those filed prior to the amendments to the Trademark Rules of Practice effective as of November 1, 2007.

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. [Note 3.]

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 CFR § 2.145. [Note 4.] *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 5.] Oral hearings are available in ACR cases in accordance with 37 CFR § 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 6.] 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.

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.

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 Weatherford/Lamb, Inc. v. C&J Energy Services, Inc.*, 96 USPQ2d 1834 (TTAB 2010) (parties stipulated to ACR after filing cross motions for summary judgment); *Eveready Battery Co., Inc. 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).

2. *See, e.g.*, *Freeman v. National Association of Realtors*, 64 USPQ2d 1700 (TTAB 2002); *Miller Brewing Co. v. Coy International Corp*., 230 USPQ 675 (TTAB 1986).

3. *See* 37 CFR § 2.120(a)(2) ("The parties may stipulate to a shortening of the discovery period"); *Christopher Brooks v. Creative Arts by Calloway*, 93 USPQ2d 1823, 1825-6 (TTAB 2009) (appeal pending *Creative Arts by Calloway v. Christopher Brooks*, Civ. No. 09 10488 (S.D.N.Y. filed Dec. 28, 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); *Eveready Battery Co., Inc. 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)); and *Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007) (parties stipulated to 13 paragraphs of facts). *See also Ballet Tech Foundation Inc. v. Joyce Theater Foundation Inc.*, 89 USPQ2d 1262, 1265 n.8 (TTAB 2008) (although documents produced in response to document production requests cannot normally be made of record by notice of reliance, the parties stipulated that documents exchanged during discovery are authentic and may be made of record by either party); *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. *Cf. Copelands' Enterprises, Inc. v. CNV, Inc*., 887 F.2d 1065, 12 USPQ2d 1563 (Fed. Cir. 1989); *Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc.*, 86 USPQ2d 1572, 1579, n.6 (TTAB 2008).

5. *See Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007).

6. *See 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).

528.05(b) Affidavits and Accompanying Exhibits

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(f) 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 CFR § 2.20. [Note 5.]

NOTES:

1. *See* Fed. R. Civ. P. 56(e). *See also* Fed. R. Civ. P. 56(c); *Sweats Fashions Inc. v. Pannill Knitting Co*., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987) (moving party's affidavit and other evidence were not contradicted by nonmoving party); *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 USPQ 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 (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 (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); and *4U Company of America, Inc. v. Naas Foods, Inc*., 175 USPQ 251 (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(e). *See also Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516 (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 Company 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., for example*, 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); and *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. *See* 37 CFR § 2.20. *See also Taylor Brothers, Inc. v. Pinkerton Tobacco Co*., 231 USPQ 412, 415 n.3 (TTAB 1986).

528.05(c) Discovery Responses and Disclosures

37 CFR § 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).*

37 CFR § 2.120(j)(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.*

See also TBMP § 409. *Cf.* 37 CFR § 2.120(j), governing the use of discovery responses as trial evidence, and TBMP § 704.09–TBMP § 704.11.

528.05(d) Registrations

37 CFR § 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 United States Patent and Trademark Office showing both the current status of and current title to the registration, or by a current printout of information from the electronic database records of the USPTO 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 CFR § 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 TESS or TARR 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 TESS or TARR 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 issue 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 n.3 (TTAB 1986). *Cf.* 37 CFR § 2.122(d)(2).

2. *See Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 123 (TTAB 1977) (third-party registrations may be plain copies). *See also* 37 CFR § 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). *See also*, with respect to third-party applications, *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463 (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

Printed publications, as described in 37 CFR § 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 CFR § 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 which qualify as printed publications or official records under 37 CFR § 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 which identify: (1) either their dates of publication or the dates they were accessed and printed; 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 CFR § 2.122(e). [Note 6.] TBMP § 704.08(b). If properly identified in accordance with the above requirements, Internet printouts are considered the equivalent of printouts from, for example, a NEXIS search where printouts are the electronic equivalents of the printed publications and permanent sources for the publications are identified. [Note 7.] 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 8.] *See* TBMP § 708.

Materials that are not self-authenticating. Materials which do not fall within 37 CFR § 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(e). *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 9.]

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 10.]

NOTES:

1. *See* 37 CFR § 2.122(e). *See also Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1857 (TTAB 2007).

2. *See Christopher Brooks v. Creative Arts by Calloway*, 93 USPQ2d 1823, 1825-6 (TTAB 2009) (appeal pending *Creative Arts by Calloway, LLC v. Christopher Brooks,* Civ. No. 09 10488 (SDNY filed Dec. 28, 2009) (applicant's own file copies of briefs from district court case not proper under notice of reliance as official records).

3. *See Weyerhaeuser v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992).

4. *See* 37 CFR § 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. *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). *See also Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1857 (TTAB 2007) (article from a trade magazine is admissible under 37 CFR § 2.122(e) because, "[o]n its face, it identifies the publication and the date published").

7. *See Int'l Assn. 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"); and *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).

8. *See Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2020 n.8 (TTAB 2008); and *Exxon Corp. v. Fill-R-Up Systems, Inc.,* 182 USPQ 443, 445 (TTAB 1974).

9. *See* Fed. R. Civ. P. 56(e); Fed. R. Civ. P. 56(c); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1864 n.8 (TTAB 2007); and *Westrex Corp. v. New Sensor Corp.*, 83 USPQ 1215, 1217 (TTAB 2007).

10. *See Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010) for a discussion of the probative weight given evidence obtained from the Internet.

528.05(f) Testimony from Another Proceeding

***37 CFR § 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).

NOTES:

1. 37 CFR § 2.122(f).

2. *See, e.g., Eveready Battery Co., Inc. 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)); and *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(f) When Affidavits are Unavailable. *If a party opposing the motion shows by affidavit that, for specified reasons, it cannot present facts essential to justify its opposition, the court may:*

(1) *deny the motion;*

(2) *order a continuance to enable affidavits to be obtained, depositions to be taken, or other discovery to be undertaken; or*

(3) *issue any other just order.*

37 CFR § 2.127(e)(1) *... A motion under Rule 56(f) 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(f) will not be extended. ...*

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 by affidavit facts essential to justify its opposition to the motion. [Note 1.]

In the event the moving party fails to support its Fed. R. Civ. P. 56(f) 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(f) 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 by affidavit facts sufficient to show the existence of a genuine issue of material fact for trial. [Note 2.] 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 3.] 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 4.]

In lieu of an affidavit, a party may submit a declaration meeting the requirements of 37 CFR § 2.20. [Note 5.]

When a request for discovery under Fed. R. Civ. P. 56(f) 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(f) discovery, if filed, must be filed within 30 days of the date of service of the summary judgment motion. [Note 6.] No extensions of time will be granted to file a motion under Fed. R. Civ. P. 56(f). 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(f) 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(f) discovery and response on the merits of the motion, the Board ordinarily will deem the Fed. R. Civ. P. 56(f) discovery request moot, and decide the summary judgment motion on the merits thereof. [Note 7.] Moreover, if a party's request for discovery under Fed. R. Civ. P. 56(f) 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(f) motion may be viewed as sanctionable conduct under Fed. R. Civ. P. 11. [Note 8.]

NOTES:

1. *See* Fed. R. Civ. P. 56(f); *Opryland USA Inc. v. The Great American Music Show Inc*., 970 F.2d 847, 23 USPQ2d 1471 (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 (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 (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); and *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1860 (TTAB 2007) (non-moving 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 (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., plc*, 12 USPQ2d 1923 (TTAB 1989) (Rule 56(f) declaration sufficient); and *Nature's Way Products Inc. v. Nature's Herbs Inc*., 9 USPQ2d 2077 (TTAB 1989) (mere unsupported assertion of desire to take deposition inadequate).

2. *See Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1253 (TTAB 1995) (Rule 56(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.

3. *See Orion Group Inc. v. Orion Insurance Co., plc*, 12 USPQ2d 1923 (TTAB 1989).

4. *See Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (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 (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 (TTAB 1989) (Rule. 56(f) motion, to the extent it could be construed as such, was not supported by required affidavit); and *J.I. Case Co. v. F.L. Industries, Inc*., 229 USPQ 697 (TTAB 1986) (statement by applicant of need to take discovery on validity of assignment was unsupported speculation).

5. *Cf. Taylor Brothers, Inc. v. Pinkerton Tobacco Co*., 231 USPQ 412, 415 n.3 (TTAB 1986).

6. 37 CFR § 2.127(e)(1).

7. *See Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc*., 63 USPQ2d 2009 (TTAB 2002) (Rule 56(f) motion denied where opposer filed a response to the motion for summary judgment on the merits).

8. *See ITC Entertainment Group Ltd. v. Nintendo of America Inc*., 45 USPQ2d 2021 (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.] *See* TBMP § 314 and TBMP § 507.01.

NOTES:

1. *See* Fed. R. Civ. P. 56(a) and 56(b); *Asian and Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009); *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); and *Consolidated Foods Corp. v. Berkshire Handkerchief Co. Inc*., 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, 1766 n.4 (TTAB 2007) (Board sua sponte allowed movant time to amend pleading to assert matter raised at summary judgment); *Vaughn Russell Candy Co. and Toymax Inc. 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); and *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* (unpub'd), 108 F.3d 1392 (Fed. Cir. 1997); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 81 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 CFR 2.107(b). *See* Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act (Final Rule), 68 Fed. Reg. 55748, 55757 (September 26, 2003).

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 issues of material fact as to an unpleaded claim or defense. [Note 1.]

However, a party which seeks to defend against a motion for summary judgment by asserting the existence of genuine issues 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 issues 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 CFR § 2.107(b).

528.08 Entry of Summary Judgment in Favor of Nonmoving Party

If the Board concludes, upon motion for summary judgment, that there is no genuine issue 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, in appropriate cases, enter summary judgment sua sponte 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 Company v. Chemical Bank*, 40 USPQ2d 1098 (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 (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); and *Visa International Service Assn v. Life-Code Systems, Inc*., 220 USPQ 740 (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 CFR § 2.120(j)* 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 (j)(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 at the time of the purported offer of the deposition in evidence, 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, 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)(3), 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 at the time of the purported offer of the deposition in evidence. 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 CFR § 2.120(j)(2). *Cf.* 37 CFR § 2.120(j)(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 non-party witness admissible at trial given that witness lives outside United States and does not plan to be present during trial); and *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 either a "party" as contemplated by 37 CFR § 2.120(j)(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 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); and *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 CFR § 2.120(j)(2).

530 Motion to Use Testimony From Another Proceeding

***37 CFR § 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 in another Board proceeding, or testimony taken in a suit or action in a court, is governed by 37 CFR § 2.122(f). *Cf.* TBMP § 704.11.

A party may seek, by motion, to use testimony from another proceeding, either as evidence in 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. 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 1.] 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 with its motion under 37 CFR § 2.122(f) a motion to extend its testimony period.

However, 37 CFR § 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 CFR § 2.122(f) filed prior to the opening of the moving party's testimony period will not be denied as untimely. [Note 2.]

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 3.]

The Board has construed the term "testimony," as used in 37 CFR § 2.122(f), as meaning only trial testimony, [Note 4] or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding.

NOTES:

1. *Cf.* 37 CFR § 2.120(j)(2).

2. *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992) (motion to admit testimony from prior opposition filed during discovery period).

3. *See* 37 CFR § 2.119(a); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992).

4. *See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992).

531 Motion That Deposition Upon Written Questions Be Taken Orally

***37 CFR § 2.123(a)(1)* Trial testimony in inter partes cases.** *The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by § 2.124. 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 fifteen 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.*

A party served with notice of the taking, by an adverse party, 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, may, within 15 days from the date of service of the notice (20 days if service of the notice was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.119(c)), file a motion with the Board, showing good cause, for an order that the deposition be taken by oral examination. [Note 1.]

The Board on a case-by-case basis, depending upon the particular facts and circumstances in each case, makes the determination of whether good cause exists for a motion that a testimonial deposition upon written questions instead be taken by oral examination. [Note 2.] *Cf.* TBMP § 520.

NOTES:

1. *See* 37 CFR § 2.123(a)(1).

2. *See Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079 (TTAB 1990) (unjust to deprive applicant of oral cross-examination opposer's expert rebuttal witness present in U.S.), corrected, 19 USPQ2d 1479 (TTAB 1990); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589 (TTAB 1980) (proposed deposition on written questions of petitioner's employees during rebuttal period would deprive applicant of cross-examination and confronting witness). *Cf. Orion Group Inc. v. Orion Insurance Co., plc*, 12 USPQ2d 1923 (TTAB 1989) (good cause to take oral discovery deposition of witness in England).

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 CFR § 2.120(j) 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 CFR § 2.122(e). 37 CFR § 2.122(d)(2), provides for the introduction, by notice of reliance, of a registration owned by a party to a proceeding. 37 CFR § 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; 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 CFR § 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, *see* TBMP § 707.02(b)(2), or that the proffered materials are not appropriate for introduction by notice of reliance. [Note 1.] *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 which filed the notice of reliance time within which to cure the defect, failing which the notice will stand stricken. [Note 2.]

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 3.] *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 4.]

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 5.] *See* TBMP § 707.02(c).

NOTES:

1. *See, e.g.*, *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).

2. *See M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (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).

3. *See Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007); *The Ritz Hotel Limited v. Ritz Closet Seat Corp.*, 17 USPQ2d 1466 (TTAB 1990). *See also, Corp. v. Seaward Int'l, Inc.*, 223 USPQ 58, 59 n.4 (TTAB 1984); *Otis Elevator Co. v. Echlin Mfg. Co.*, 187 USPQ 310, 313 n.4 (TTAB 1975).

4. *See M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990) (questions of admissibility of documents based on hearsay and lack of authentication deferred).

5. *See M-Tek Inc. v. CVP Systems Inc.*, 17 USPQ2d 1070 (TTAB 1990).

533 Motion to Strike Trial Testimony Deposition

533.01 On Ground of Untimeliness

37 CFR § 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. No testimony shall be taken 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. ...*

A party may not take testimony 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 a testimony deposition is taken after the close of the deposing party's testimony period, an adverse party may file a motion to strike the deposition, in its entirety, as untimely. [Note 2.] Alternatively, the adverse party may raise this ground for objection in its brief on the case. [Note 3.] *See* TBMP § 707.03(b)(1).

NOTES:

1. 37 CFR § 2.121(a). *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).

2. *See* 37 CFR § 2.121(a) and 37 CFR § 2.123(l); *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 (TTAB 1990) (motion to strike testimony for insufficient notice construed as motion to strike testimony taken out of time).

3. *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555 (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

***37 CFR § 2.123(c)* Notice of examination of witnesses.** *Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing 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; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. ...*

***37 CFR § 2.123(e)(3)* Examination of witnesses.** *Every adverse party shall have full opportunity to cross-examine each witness. 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. 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 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 the notice of examination of witnesses 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 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 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 a testimony deposition 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 2.]

Parties should note that objections to a testimony deposition based upon improper or inadequate 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.

Parties also should note that the majority of disputes arising from the improper or inadequate notice of 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 CFR § 2.123(e)(3); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1652-3, (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 (TTAB 1986) (substitute witness not identified but adverse party failed, after deposition, to move to strike); *Home Juice Co. v. Runglin Companies Inc*., 231 USPQ 897, 898 n.4 (TTAB 1986) (motion to strike filed four months after testimony taken was untimely); and *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 (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); and *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 CFR § 2.123(e)(3).

3. *See* 37 CFR § 2.123(c); Fed. R. Civ. P. 30(b) and Fed. R. Civ. P. 31(a); and *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 or Pretrial Disclosures

37 CFR § 2.120(a)(1) ***In general****...The Board will specify the deadline … for making … expert disclosure.*

37 CFR § 2.121(e) ***Assignment of times for taking testimony.*** *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. Pretrial disclosure of a witness under this subsection 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.*

37 CFR § 2.123(e)(3) ***Examination of Witnesses.*** *Every adverse party shall have full opportunity to cross-examine each witness. 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. 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 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.*

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 that the disclosing party may use to support its claims or defenses." [Note 1.] In the event either party intends to use an expert, the deadline for expert disclosure is thirty days prior to the close of the discovery period. [Note 2.] 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 3.] Pretrial 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 4.]

If pretrial disclosures are improper or inadequate with respect to a particular witness, 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 5.]

Parties should note that, in accordance with the above discussion, objections to a testimony deposition based upon improper or inadequate notice may also be raised by a motion to quash. *See* TBMP § 521 and TBMP § 533.02(a).

NOTES:

1. Fed. R. Civ. P. 26(a)(1). *See* 37 CFR § 2.116(a); *Byer California v. Clothing for Modern Times Ltd.,* 95 USPQ2d 1175 (TTAB 2010); *Jules Jurgensen/Rhapsody, Inc.,* 91 USPQ2d 1443, n.1 (TTAB 2009).

2. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

3. *See* 37 CFR § 2.120(a)(2).

4. *See* 37 CFR § 2.121(e); *Jules Jurgensen/Rhapsody, Inc.,* 91 USPQ2d 1443, 1444 (TTAB 2009).

5. *See* 37 CFR § 2.123(e)(3); *Jules Jurgensen/Rhapsody, Inc.,* 91 USPQ2d 1443 (TTAB 2009) (testimony deposition of witness stricken where witness was not identified in pretrial or initial disclosures).

533.03 When Motion to Strike Should Not Be Filed

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. *See* TBMP § 707.03(c).

NOTES:

1. *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).

534 Motion For Judgment For Plaintiff's Failure to Prove Case

534.01 In General

***37 CFR § 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 that party has not taken testimony or offered any other evidence, 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 fifteen days from the date of service of the motion to show cause why judgment should not be rendered against him. In the absence of a showing of good and sufficient cause, 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 a copy or copies of Patent and Trademark Office records 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 fifteen 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 of the evidence is in the record. If judgment is not rendered, 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.*

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 CFR § 2.132(a) and 37 CFR § 2.132(b). Only in these two situations will the Board entertain such a motion. *See* TBMP § 534.04. *But cf.* TBMP § 527.03.

534.02 Motion For Judgment Under Trademark Rule 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. 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 1.] A motion for judgment under 37 CFR § 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 2.]

When a motion for judgment under 37 CFR § 2.132(a) has been filed by a defendant, the plaintiff has 15 days from the date of service of the motion (20 days, if service of the motion was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.119(c)) in which to respond and show cause why judgment should not be rendered against it. In the absence of a showing of good and sufficient cause, judgment may be rendered against the plaintiff. [Note 3.]

The "good and sufficient cause" 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 4.]

For examples of cases involving the question of whether good and sufficient cause has been shown for a plaintiff's failure to offer any evidence, see note below. [Note 5.] 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 CFR § 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 6.] For proceedings commenced on or after November 1, 2007, the deadlines for defendant's pretrial disclosures and plaintiff's rebuttal disclosures will be reset as well.

The purpose of the motion under 37 CFR § 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 7.] However, the defendant is under no obligation to file such a motion; the motion is optional, not mandatory. [Note 8.] If no motion under 37 CFR § 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 9.]

The fact that a defendant may have previously sought judgment under 37 CFR § 2.132(b) does not preclude it from thereafter seeking judgment under 37 CFR § 2.132(a). [Note 10.]

NOTES:

1. *See* 37 CFR § 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. and Shoppers Food Warehouse 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 (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 CFR § 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); and *Loren Cook Co. v. Acme Engineering and Manufacturing Corp*., 216 USPQ 517 (TTAB 1982) (where evidence was presented by plaintiff, motion for judgment under 37 CFR § 2.132 was not entertained).

2. *See* 37 CFR § 2.132(c). *See also Hewlett-Packard Co. v. Olympus Corp*., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); and *Atlanta Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858 (TTAB 1998).

3. *See* 37 CFR § 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"); *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).

4. *See PolyJohn Enterprises Corp. v. 1-800-Toilets Inc*., 61 USPQ2d 1860-61 (TTAB 2002) (good and sufficient cause standard in context of motion to dismiss under 37 CFR § 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); and *Grobet File Co. of America Inc. v. Associated Distributors Inc.*, 12 USPQ2d 1649 (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).

5. *See Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (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 Old Nutfield Brewing Company, Ltd. v. Hudson Valley Brewing Company, Inc.*, 65 USPQ2d 1701 (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 1860-61 (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); and *Atlanta Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858 (TTAB 1998) (mere existence of settlement negotiations insufficient).

6. *See* 37 CFR § 2.132(a).

7. *See Litton Business Systems, Inc. v. J. G. Furniture Co. Inc.*, 190 USPQ 428, *recon. denied*, 90 USPQ 431 (TTAB 1976).

8. *See Pfaltzgraf v. William Davies Co. Inc.*, 175 USPQ 620 (TTAB 1972).

9. *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 (TTAB 1972).

10. *See W. R. Grace & Co. v. Red Owl Stores, Inc.*, 181 USPQ 118 (TTAB 1973).

534.03 Motion For Judgment Under 37 CFR § 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 CFR § 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 CFR § 2.132(b) has been filed by a defendant, the plaintiff has 15 days from the date of service of the motion (20 days, if service of the motion was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.119(c)) to file a brief in response. [Note 3.]

In determining a motion under 37 CFR § 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 CFR § 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 CFR § 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 CFR § 2.132(a) does not preclude it from thereafter seeking judgment under 37 CFR § 2.132(b). [Note 8.]

NOTES:

1. *See* 37 CFR § 2.132(b).

2. *See* 37 CFR § 2.132(c).

3. *See* 37 CFR § 2.132(b).

4. 37 CFR § 2.132(b). *See Merker Counter Co., Inc. v. Central Counter Co*., 310 F.2d 746, 135 USPQ 433 (CCPA 1962) (declined to render judgment); *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); and *Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc*., 193 USPQ 313 (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 CFR § 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 CFR § 2.132(b).

6. *See, e.g.*, *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); *Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc*., 193 USPQ 313 (TTAB 1976) (37 CFR § 2.132(b) requires decision on merits of the case); and *Litton Business Systems, Inc. v. J. G. Furniture Co., Inc*., 190 USPQ 431, 434 (TTAB 1976) (Board will not use judicial notice to remedy plaintiff's failure to present adequate evidence).

7. *Cf. Pfaltzgraf v. William Davies Co.*, 175 USPQ 620, 621 (TTAB 1972) (respondent under no obligation to move for judgment under 37 CFR § 2.132(a)).

8. *See Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc*., 193 USPQ 313 (TTAB 1976).

534.04 Motion Under Fed. R. Civ. P. 41(b) or 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 CFR § 2.132(a) and 37 CFR § 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 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 CFR § 2.132(a) denied; six days notice reasonable for testimony deposition which 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.2 (TTAB 1985) (Fed. R. Civ. P. 41(b) motion unavailable).

535 Motion For Order to Show Cause Under Trademark Rule 2.134(b)

37 CFR § 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 his involved registration to be cancelled under section 8 of the Act of 1946 or has failed to renew his involved registration under section 9 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 or failure to renew 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 CFR § 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.

The purpose of 37 CFR § 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, 15 U.S.C. § 1058 or renewal application under Trademark Act § 9, 15 U.S.C. § 1059. [Note 1.]

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 CFR § 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 two-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 2.] 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 CFR § 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*, *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.)

2. *See C.H. Guenther & Son, Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450, 1452 n.4 (TTAB 1988).

536 Motion For Order to Show Cause Under 37 CFR § 2.128(a)(3)

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

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. *Cf.* TBMP § 513.01 (Motion to Withdraw as Representative).

The principal purpose of 37 CFR § 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 CFR § 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. However, 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. 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 2.]

When the Board discharges a 37 CFR § 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. 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.

It is not unusual for a plaintiff to file a response to the Board's 37 CFR § 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 3.]

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 the motion is granted (either on the merits, as consented or as conceded) and there is evidence in the record. In instances where plaintiff argues that it has established excusable neglect to reopen its testimony period 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).

2. *See, e.g., CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1302 (TTAB 1999) (no response filed).

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 CFR § 2.132(a) where opposer's motion to reopen its testimony period denied for failure to establish excusable neglect).

537 Motion For Leave to Exceed Page Limit For Brief On Case

37 CFR § 2.128(b) *... 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.*

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 which exceeds the 37 CFR § 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 CFR § 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 overlength 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 CFR § 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 which conforms to the page limit set out in 37 CFR § 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 which 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, 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 which 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 (7th Cir. 1988).

2. *See* 37 CFR § 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 (TTAB 1994).

4. *See United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542 (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 (TTAB 1994).

6. *See United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542 (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 (TTAB 1987) (due to size of record, parties allowed to file overlength briefs). *Cf*. 37 CFR § 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. 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 which 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 CFR § 2.128(b), it may be stricken, or given no consideration, by the Board. [Note 2.] *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 CFR § 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 3.]

Evidence may not be submitted with a brief, with the exception of a proper request for judicial notice. [Note 4.] 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 5.]

NOTES:

1. *See* 37 CFR § 2.128(a).

2. *See Ariola-Eurodisc Gesellschaft v. Eurotone International Ltd*., 175 USPQ 250 (TTAB 1972) (brief filed three weeks late stricken); *American Optical Corp. v. Atwood Oceanics, Inc*., 177 USPQ 585 (Comm'r 1973) (brief which was too long and not in proper form was not considered).

3. *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); and *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 (TTAB 1977); *L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254 (TTAB 1975); and *Globe-Union Inc. v. Raven Laboratories Inc*., 180 USPQ 469 (TTAB 1973).

4. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008).

5. *See, e.g.*, *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 (TTAB 1976); *L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254 (TTAB 1975); *Tektronix, Inc. v. Daktronics, Inc*., 187 USPQ 588 (TTAB 1975), *aff'd,* 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp*., 178 USPQ 429 (TTAB 1973).

540 Motion For Augmented Panel Hearing

"The Trademark Trial and Appeal Board…include[s] 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 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. Further, the Board may use an augmented panel to hear a case. [Note 3.] 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 4.]

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 CFR § 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 5.]

NOTES:

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

2. *See, e.g.*, 37 CFR § 2.129(a) and 37 CFR § 2.142(e)(1). *See also* Trademark Act § 17, 15 U.S.C. § 1067.

3. *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); *In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010) (augmented panel of five judges in view of the disparagement issue presented; two judges dissented); *Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG,* 34 USPQ2d 1266 (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 (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 (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).

4. 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).

5. *See, e.g.*, *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 (TTAB 1988); *In re McDonald's Corp*., 230 USPQ 210 (TTAB 1986); and *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 (TTAB 1984) (augmented panel of eight-members because of the importance of the issues). *Cf. Fioravanti v. Fioravanti Corrado S.R.L*, 230 USPQ 36 (TTAB 1986), *recon. denied*, 1 USPQ2d 1304, 1305 (TTAB 1986) (case not appropriate for designation of more than three-member panel).

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 paper, not later than 10 days after the due date for the filing of the last reply brief in the proceeding. *See* TBMP § 802. When a request for an oral hearing is filed, the Board sets the date and time for the hearing, and sends 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 Standard Time). It is the normal practice of the Board, in setting an oral hearing, to telephone the parties, or their attorneys or other authorized representatives, to determine a convenient date and time for the hearing, following which the written notice formally scheduling the hearing is mailed.

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. [Note 2.] 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 Chief Administrative Trademark Judge's secretary 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.

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 electronically by means of ESTTA, and telephone the Chief Administrative Trademark Judge's secretary. *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.]

Repeated stipulations or consented requests to reset an oral hearing should not be filed and in most cases will be denied.

For further information concerning oral hearings, *see* TBMP § 802.

NOTES:

1. *See* 37 CFR § 2.129(a).

2. *See* 37 CFR § 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).

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. [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 CFR § 2.129(a).

2. *See* 37 CFR § 2.129(a); *U.S. Navy v. United States Manufacturing Co*., 2 USPQ2d 1254 (TTAB 1987) (additional time for arguments allowed in view of voluminous record). *Cf*. 37 CFR § 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 are capable of remote, electronic, attendance by a party or Board judge must contact by telephone the Chief Administrative Trademark Judge's secretary in order to schedule such attendance.

543 Motion For Reconsideration of Final Decision

37 CFR § 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 fifteen 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 CFR § 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 15 days from the date of service of the request (20 days if service of the request was made by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.119(c)).

Although 37 CFR § 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 15 days from the date of service of the responsive brief (20 days if service of the response was made by first-class mail, "Express Mail," or overnight courier -- *see* 37 CFR § 2.119(c)). [Note 3.] *See* TBMP § 502.02(b).

Generally, the premise underlying a request for rehearing, reconsideration, or modification under 37 CFR § 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 two months 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 CFR § 2.127(b).

2. *See Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.*, 201 USPQ 410 (TTAB 1979) (serious questions raised by applicant's request for reconsideration ought to have generated response by opposer).

3. *See 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 CFR § 2.127(a).

4. *See Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126 (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 (TTAB 1984). *Cf. In re Kroger Co*., 177 USPQ 715, 717 (TTAB 1973).

6. *See* 37 CFR § 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) Computing and Extending Time; Time for Motion Papers; 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 CFR § 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. [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. *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 7.] *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 8.] If the Board grants the motion, the Director, as a ministerial act, will reinstate the subject registration. [Note 9.]

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 Board ordinarily will grant a consented request for relief from judgment.

NOTES:

1. *See* 37 CFR § 2.116(a).

2. *See Pramil S.R.L. v. Michael Farah*, 93 USPQ2d 1093 (TTAB 2009) (motion denied because registration not yet in existence at time of Board's decision 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) (reasons (4), (5) and (6) denied); *CTRL Systems Inc. v. Ultraphonics of North America Inc*., 52 USPQ2d 1300 (TTAB 1999) (reason (1) denied; counsel and client share

duty [suggesting *General Motors Corp. v. Cadillac Club Fashions Inc*., 22 USPQ2d 1933 (TTAB 1992), where relief was granted due to negligent conduct of counsel who concealed critical facts from petitioner, is no longer good law]); *S. Industries Inc. v. Lamb-Weston Inc*., 45 USPQ2d 1293 (TTAB 1997) (reason (1) granted; petitioner contributed to respondent's delay and confusion); *Jack Lenor Larsen Inc. v. Chas. O. Larson Co*., 44 USPQ2d 1950 (TTAB 1997) (reasons (4) and (6), 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) (reason (6) 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 (TTAB 1991) (reason (1) granted; respondent's failure to answer resulted from mistake due to involvement in numerous Board proceedings); and *Regatta Sport Ltd. v. Telux-Pioneer Inc*., 20 USPQ2d 1154 (TTAB 1991) (reason (1) 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).

3. *See* Fed. R. Civ. P. 60(b) and Fed. R. Civ. P. 6(b)(2); *Pramil S.R.L. v. Michael Farah*, 93 USPQ2d 1093 (TTAB 2009) (motion denied where movant waited until Federal Circuit denied appeal prior to filing 60(b) motion); *Djeredjian v. Kashi Co*., 21 USPQ2d 1613 (TTAB 1991) (filed 15 days after entry of default judgment); and *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc*., 200 USPQ 819 (TTAB 1978) (motion denied where judgment was entered under 37 CFR § 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(b).

5. *See Djeredjian v. Kashi Co*., 21 USPQ2d 1613, 1615 (TTAB 1991).

6. *See Djeredjian v. Kashi Co*., 21 USPQ2d 1613, 1615 (TTAB 1991).

7. *See Djeredjian v. Kashi Co*., 21 USPQ2d 1613, 1615 (TTAB 1991) (granted pending showing of meritorious defense where other two elements were established); and *Regatta Sport Ltd. v. Telux-Pioneer Inc*., 20 USPQ2d 1154 (TTAB 1991) (respondent's employees had limited knowledge of English and were unaware opposition and cancellation were separate proceedings). *Compare Jack Lenor Larsen Inc. v. Chas. O. Larson Co*., 44 USPQ2d 1950 (TTAB 1997) (motion denied).

8. *See National Telefilm Associates, Inc. v. Craig Denney Productions*, 228 USPQ 61 (Comm'r 1985).

9. *See National Telefilm Associates, Inc. v. Craig Denney Productions*, 228 USPQ 61 (Comm'r 1985).

CHAPTER 600
WITHDRAWAL; SETTLEMENT

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606 EFFECT ON COUNTERCLAIM

601 Withdrawal by Opposition or Cancellation Plaintiff

601.01 Withdrawal by Opposer

37 CFR § 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 filing with the Board a written withdrawal signed by the opposer or the opposer's attorney. Written consent must be signed with an original, handwritten signature, 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 CFR § 2.106(c). *See Estee Lauder Inc. v. Aloe Creme Labs., 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 CFR § 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 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); and *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 CFR § 2.193(c)(1).

4. 37 CFR § 2.119(a).

601.02 Withdrawal by Petitioner

37 CFR § 2.114(c) *The petition for cancellation may be withdrawn without prejudice before the answer is filed. After the answer is filed, the 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 may withdraw its petition for cancellation without prejudice at any time before the registrant's answer is filed. After the answer is filed, however, the petition for cancellation 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 may withdraw its petition for cancellation by filing with the Board a written withdrawal signed by the petitioner or the petitioner's attorney. Written consent must be in the form of an original, handwritten signature, 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 CFR § 2.114(c); *Johnson & Johnson v. Bio-Medical Sciences, Inc.*, 179 USPQ 765, 766 (TTAB 1973). *Cf.* 37 CFR § 2.106(c) (Withdrawal of Notice of Opposition); *Estee Lauder Inc. v. Aloe Creme Labs., Inc.*, 178 USPQ 254, 256 (TTAB 1973).

2. *See 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 Mfg. 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); and *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 CFR § 2.193(c)(1).

4. *See* 37 CFR § 2.119(a).

601.03 Effect of Motion for Judgment

A plaintiff in an opposition or cancellation proceeding 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 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 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 CFR § 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).*

(b) *Rights in the mark not affected. Except as provided in § 2.135, the fact that an application has been expressly abandoned shall not, in any proceeding in the Office, affect any rights that the applicant may have in the mark in the abandoned application.*

***37 CFR § 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 CFR § 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 USC § 1051(a); (2) bona fide intention to use a mark in commerce under Trademark Act § 1(b), 15 USC § 1051(b); (3) a claim of priority, based on an earlier-filed foreign application under Trademark Act § 44(d), 15 USC § 1126(d); (4) ownership of a registration of the mark in the applicant's country of origin under Trademark Act § 44(e), 15 USC § 1126(e); and (5) extension of protection of an international registration to the United States, under Trademark Act § 66(a), 15 USC § 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, the basis for a § 66(a) application cannot be changed and there cannot be more than one basis. [Note 1.]

An applicant may expressly abandon its application by filing in 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. [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 with an original, handwritten signature, a copy of an original, handwritten signature, or a complying electronic signature. [Note 5.]

For information concerning the effect of a 37 CFR § 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 CFR § 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 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. The Board encourages the use of ESTTA (Electronic System for Trademark Trials and Appeals), the Board's electronic filing system, for filing an abandonment of an opposed application. Use of the TEAS system is not appropriate for filing and abandonment of an opposed application.

The abandonment should include proof of service upon every other party to the proceeding. [Note 8.] *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 9.] *Cf.* TBMP § 218. If an opposition and an unconsented abandonment of the opposed application are filed on the same day, 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 10.] *Cf.* TBMP § 218.

Abandonment prior to publication. If, after an 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 CFR § 2.66 or 37 CFR § 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 11.]

Abandonment for failure to respond to office action after remand. If, during the pendency of an opposition, the Board grants a request by the trademark examining attorney for remand of a § 1 or § 44 application under 37 CFR § 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 CFR § 2.135 will not be entered against applicant in the opposition. *See* TBMP § 515 (Motion to Remand Application to Examining Attorney). 37 CFR § 2.135 comes into play only when there is a written abandonment by the applicant. 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 12.] *Cf.* TBMP § 602.02(b). If, after remand under 37 CFR § 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 CFR § 2.135. A Trademark Act § 66(a) application may not be remanded under 37 CFR § 2.130. [Note 13.]

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 14.] 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 CFR § 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 CFR § 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 15.]

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 16.]

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 17.]

NOTES:

1. *See* 37 CFR § 2.34(b)(3) and 37 CFR § 2.35; TMEP § 806.01(e) and TMEP § 1904.09. *Cf.* TMEP §1904.09, which discusses the limited ability to transform a § 66(a) application to one under §§ 1 or 44.

2. 37 CFR § 2.68.

3. 37 CFR § 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 application 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 nonparty to the case); and *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 Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1453 (TTAB 1991), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992) (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). *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 CFR § 2.135.

5. 37 CFR § 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); and *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 a estoppel in subsequent application for a distinctly different mark). *But cf. Sharp Kabushiki Kaisha v. ThinkSharp Inc.*, 448 F.3d 1368, 79 USPQ2d 1376 (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). *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 CFR § 2.135.

8. *See* 37 CFR § 2.119(a).

9. *Cf. In re First National Bank of Boston*, 199 USPQ 296, 301 (TTAB 1978) (where opposition and abandonment were filed on same day).

10. *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).

11. *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1080 (TTAB 1992).

12. *Cf. Bank of America National Trust & Savings Ass'n 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), *rev'd on other grounds,* 275 F.2d 955, 125 USPQ 236 (CCPA 1960) (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).

13. *See* 37 CFR §7.25 (Sections of part 2 applicable to extension of protection); TMEP § 1504.05(a) ("In a § 66(a) application, the examining attorney may not request a remand during an inter partes proceeding.").

14. *See* 37 CFR § 7.30; TMEP § 1904.08.

15. 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).

16. *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 (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).

17. *Cf. Montana v. United States,* 440 U.S. 147 (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 (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 (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* 6 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION: *Res Judicata and Changes in the Facts,* § 32:88 (2010).

602.02 Withdrawal by Respondent

602.02(a) Surrender or Voluntary Cancellation of Registration

***37 CFR § 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 CFR § 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.*

***37 CFR § 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 CFR

§ 10.1(c) 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.]

For information concerning the effect of a judgment of this type, *see* TBMP § 602.01.

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 CFR § 2.134(a). [Note 6.] 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 7.] For information about amendments to registrations involved in Board proceedings, *see* TBMP § 514.

In a cancellation proceeding against a § 66(a) registration, 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. [Note 8.] The USPTO will notify the IB about the change in the registered extension of protection to the United States. [Note 9.] 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 10.] 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 11.] 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 CFR § 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 12.] 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 proceedings, 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 13.]

An application for voluntary surrender of a registration that is the subject of a Board inter partes proceeding should be 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. The Board encourages the use of the ESTTA filing system for filing a voluntary surrender where the registration is subject to a petition to cancel. 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 14.] *See* TBMP § 113.

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 15.]

NOTES:

1. *See* TMEP § 1608 (Surrender of Registration For Cancellation).

2. *See* Trademark Act § 7(e), 15 U.S.C. § 1057(e); 37 CFR § 2.172; TMEP § 1403.07 (for multiple class registrations) and 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 must be filed with the IB).

4. *See* 37 CFR § 2.134(a). *Cf.* 37 CFR § 2.135; *Goodway Corp. v. Int'l Mktg. 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 nonparty to the case); *In re First Nat'l 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 CFR § 2.134(a).

6. *See G&W Labs., 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.").

7. 37 CFR § 2.172. *See also* TMEP § 1403.07 and TMEP § 1609.03.

8. *See* TMEP §§ 1609.03 and 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.

9. *See* TMEP § 1904.13(a).

10. *See* TMEP § 1904.02(e)(ii), TMEP § 1904.02(e)(iii), and TMEP § 1904.15.

11. *See* 15 USC § 1141j(a); TMEP § 1609.03. *Cf. G&W Labs., 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.").

12. *See* TMEP § 1904.09.

13. 37 CFR § 2.134(a).

14. *See* 37 CFR § 2.119(a).

15. *Cf. Montana v. United States,* 440 U.S. 147 (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 (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 (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* 6 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION: *Res Judicata and Changes in the Facts,* § 32:88 (2010).

602.02(b) Cancellation Under Section 8 or 71; Expiration Under Section 9 or 70

37 CFR § 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 his involved registration to be cancelled under § 8 of the Act of 1946 or has failed to renew his involved registration under § 9 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 or failure to renew 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 CFR § 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 CFR § 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 six-month period preceding the end of each ten-year period after the date of registration in the United States, or the three-month grace period immediately following, with payment of the grace period surcharge required by section 71(a)(2)(B) of the Act and § 7.6.*

(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 CFR § 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 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, [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 or 70 with respect to that class, the cancellation or failure to renew with respect to that class is governed by 37 CFR § 2.134(b).

An order to show cause under 37 CFR § 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

4.]

For information concerning motions for an order to show cause under 37 CFR § 2.134(b), *see* TBMP § 535.

The purpose of 37 CFR § 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 5.] The Board's policy governing application of 37 CFR § 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 6.]

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 or registered extension of protection under Trademark Act §§ 9 or 70, respectively, was the result of inadvertence or mistake, judgment will not be entered against it by reason of the cancellation. [Note 7.]

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 or registered extension of protection under Trademark Act §§ 9 or 70, respectively, 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, plaintiff will be allowed to amend its pleading appropriately). [Note 8.]

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 9.] 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 10.]

As noted above, the purpose of 37 CFR § 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 70. The rule provides not 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 70, occurs after the filing of a petition for cancellation, but before respondent has been notified by the Board. [Note 11.] 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 has not been renewed under § 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 received its service copy of the petitioner to cancel and had not been notified by the Board of the commencement of the proceeding), and that respondent deliberately failed to file a required affidavit of use under §§ 8 or 71, or renewal application under §§ 9 or 70, in an effort to moot the proceeding, and avoid judgment, the petitioner may file a motion for an order to show cause under 37 CFR § 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, 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 12.]

NOTES:

1. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154 (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 (TTAB 1986). *Cf. In re Checkers of North America Inc.*, 23 USPQ2d 1451 (Comm'r 1992), *aff'd sub nom., Checkers Drive-In Rests., Inc. v. Comm'r of Patents and Trademarks*, 51 F.3d 1078, 34 USPQ2d 1574 (D.C. Cir. 1995); *Global Maschinen GmbH v. Global Banking Sys., Inc.*, 227 USPQ 862 (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. §1114k; 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. *See C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1452 (TTAB 1988) (motion for order to show cause); *Abraham's Seed v. John One Ten*, 1 USPQ2d 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).

5. *See In re Checkers*, 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); *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).

6. *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); *C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450 (TTAB 1988) (failure to renew was unintentional and not due to abandonment); *Abraham's Seed v. John One Ten*, 1 USPQ2d 1232 (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).

7. *See C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450 (TTAB 1988) (failure to renew was unintentional and not due to abandonment); *Abraham's Seed v. John One Ten*, 1 USPQ2d 1232 (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).

8. *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).

9. *See Abraham's Seed v. John One Ten*, 1 USPQ2d 1230 (TTAB 1986) (opted for decision on merits). *Cf. C.H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450 (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).

10. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154 (TTAB 1989). *Cf. United Rum Merchants Ltd. v. Distillers Corp. (S.A.)*, 9 USPQ2d 1481, 1484 n.3 (TTAB 1988);

Bank of Am. Nat'l Trust & Savings Ass'n v. First Nat'l Bank of Allentown, 220 USPQ 892, 894 n.6 (TTAB 1984) (where application was held void ab initio, opposer elected to adjudicate pleaded issues); and *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).

11. *See Global Maschinen GmbH v. Global Banking Sys. Inc.*, 227 USPQ 862, 863 n.1 (TTAB1985).

12. *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 CFR § 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).*

(b) *Rights in the mark not affected. Except as provided in § 2.135, the fact that an application has been expressly abandoned shall not, in any proceeding in the Office, affect any rights that the applicant may have in the mark in the abandoned application.*

***37 CFR § 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 CFR § 2.135.

A request for abandonment of an application that is the subject of an interference or concurrent use proceeding should be filed with the Board. The Board encourages the use of the ESTTA filing system for filing an abandonment of an application involved in an interference or in a concurrent use proceeding. 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 4.] *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 Trademark Examining Attorney for remand under 37 CFR § 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 CFR § 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 CFR § 2.135 comes into play only when there is a written abandonment by the applicant. If, after remand under 37 CFR § 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 CFR § 2.135. An application under Trademark Act § 66(a) may not be remanded under 37 CFR § 2.130. [Note 5.]

Applications based solely on Trademark Act §§ 44 or 66(a) are not subject to concurrent use registration proceedings. [Note 6.] Applications under § 66(a) are not permitted to have more than one basis. [Note 7.] As a consequence, § 66(a) applications cannot be subject to concurrent use proceedings.

NOTES:

1. 37 CFR § 2.135.

2. *See Fleming Cos. Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1456 (TTAB 1991), *aff'd,* 809 F. Supp. 38, 26 USPQ2d 1551 (S.D.Ohio 1992) (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); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305 (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 CFR § 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 (TTAB 1984).

4. *See* 37 CFR § 2.119(a).

5. *See* 37 CFR § 2.130 and 37 CFR § 7.25 ("Sections of part 2 applicable to extension of protection").

6. *See* 37 CFR § 2.99(g); TMEP § 1207.04(b).

7. *See* 37 CFR § 2.34(b)(3); 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.

605 Settlement

605.01 In General

A substantial percentage of the inter partes cases filed with the Board are eventually settled. 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.

605.02 Suspension for Settlement Negotiations

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 are encouraged to use the ESTTA system to file their consented motions (using the "consent motions" option), which in most cases provides an immediate grant of the consented scheduling motion.

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, 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. 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 1.] 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.

For inter partes proceedings commenced on or after November 1, 2007, 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 2.] *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 3.]

NOTES:

1. *Cf. Central Mfg. 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).

2. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

3. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

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 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.]

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 CFR § 2.134 and 37 CFR § 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 CFR § 2.133(a) and should be filed with the Board. *See* TBMP § 514 (Motion to Amend Application or Registration). The request should list at the top of the page both the number of the subject application or registration, and the Board proceeding number and title. The request also should include proof of service thereof upon every other party to the proceeding. [Note 1.] *See* TBMP § 113.

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 § 1 or § 44 application or registration that materially alters the character of the defendant's subject mark, [Note 2] or a proposed amendment to a § 66(a) application or registration that involves an amendment to the mark at all, [Note 3] cannot be approved by the Board. [Note 4.] 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 therefrom. *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 CFR § 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 CFR § 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 5.] *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 CFR § 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 6.] Such a limitation is also subject to 37 CFR § 2.133.

NOTES:

1. *See* 37 CFR § 2.119(a).

2. *See* Trademark Act § 7(e), 15 U.S.C. § 1057(e); 37 CFR §§ 2.72 and 2.173.

3. The mark in a § 66(a) registration cannot be amended under Trademark Act § 7, 15 U.S.C. § 1057. *See* 37 CFR § 2.72, providing only for amendments to the mark in § 1 and § 44

applications; and the *International Bureau's Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol*, Para. B.ll.69.02 (2002) at www.wip.int/madrid/en/guide. *See also* TMEP § 1609.02(a) 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).

4. *See* Trademark Act § 7(e), 15 U.S.C. § 1057; 37 CFR § 2.71(b), 37 CFR § 2.72, 37 CFR § 2.173(a), and 37 CFR § 2.73(b); *Vaughn Russell Candy Co. and Toymax Inc. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635 (TTAB 1998) (material alteration); *Aries Sys. Corp. v. World Book Inc.*, 23 USPQ2d 1742 (TTAB 1992), summ. judgment granted in part, 26 USPQ2d 1926 (TTAB 1993) (expansion of scope of goods); *Mason Eng'g and Design Corp. v. Mateson Chem. Corp.*, 225 USPQ 956 (TTAB 1985) (amendment to dates of use not supported by affidavit or declaration).

5. *Cf.* Trademark Act § 70, 15 USC § 1141j. *Cf.* 37 CFR § 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.).

6. *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 trademark 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 trademark 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.

NOTES:

1. *See Home Juice Co. v. Runglin Cos.*, 231 USPQ 897, 898 n.7 (TTAB 1986) (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); and *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).

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.]

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); and *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 CFR § 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).

CHAPTER 700
TRIAL PROCEDURE AND INTRODUCTION OF EVIDENCE

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701 Time of Trial

37 CFR § 2.116(b) *The opposer in an opposition proceeding or the petitioner in a cancellation proceeding shall be in the position of plaintiff, and the applicant in an opposition proceeding or the respondent in a cancellation proceeding shall be in the position of defendant. A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.*

(c) *The 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 taking of depositions during the assigned testimony periods corresponds to the trial in court proceedings.*

37 CFR § 2.121 Assignment of times for taking testimony.

(a)(1) *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. No testimony shall be taken 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.*

* * * *

(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 extended by stipulation of the parties approved by the Trademark Trial and Appeal Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the testimony periods 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.*

(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. Pretrial disclosure of a witness under this subsection 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 at the time described in 37 CFR § 2.92 for an interference, *see* TBMP § 1003, or 37 CFR § 2.99(c) for a concurrent use proceeding which is not based on a court decision or a prior Board decision, *see* TBMP § 1106.04), the Board sends out a 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 disclosures, and assigning each party's time for taking testimony and introducing 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 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.] For cases commenced on or after November 1, 2007, the trial order also schedules the time for pretrial disclosures of witnesses: each party must make pretrial disclosures no later than fifteen days prior to the opening of its testimony period. [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 CFR § 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 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, 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 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 and must be presented in the form used in a trial order, specifying the deadline for each subsequent period, including, as applicable, the deadline for initial, expert and pretrial disclosures, and the closing date for discovery and testimony periods. [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. However, the resetting of a party's time to respond to an outstanding request for discovery does not result in the automatic rescheduling of the closing date for discovery, pretrial disclosure and expert disclosure deadlines, and/or testimony periods. [Note 10.] When a party's time to respond to an outstanding request for discovery is reset, the closing date for discovery, pretrial disclosure and expert disclosure deadlines, and/or testimony 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. [Note 11.]

In Board inter partes proceedings, 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 12.] *See* TBMP § 504.01. *Cf.* TBMP § 528.02.

NOTES:

1. *See* 37 CFR § 2.120(a) and 37 CFR § 2.121.

2. *See* 37 CFR § 2.121(b)(1) and 37 CFR § 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 CFR § 2.121(e).

5. *See* 37 CFR § 2.121(b)(2) and 37 CFR § 2.121(c). Examples of trial schedules can be found in the Appendix of Forms.

6. *See* 37 CFR § 2.96 and 37 CFR § 2.99(e).

7. *See* 37 CFR § 2.121(a)(1). *See also Baseball America Inc. v. Powerplay Sports*, 71 USPQ2d 1844, 1846 n.8 (TTAB 2004) (documentary evidence submitted outside assigned testimony period given no consideration); *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 nonparty witness treated as testimony deposition taken by stipulation prior to trial); and *Fischer Gesellschaft m.b.H. v. Molnar & Co*., 203 USPQ 861, 867 (TTAB 1979) (discovery deposition of nonparty 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. 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. *See* Fed. R. Civ. P. 6(b); 37 CFR § 2.121(a)(1), 37 CFR § 2.121(c) and 37 CFR § 2.121(d). *See e.g., 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); and *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 CFR § 2.121(d).

10. *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; periods not reopened).

11. *See* 37 CFR § 2.121(a)(1).

12. *See 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 (TTAB 2002) (trial in a Board proceeding takes place during the testimony periods).

702 Pretrial Disclosures; Manner of Trial; and Introduction of Evidence

37 CFR § 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. Pretrial disclosure of a witness under this subsection 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.*

37 CFR § 2.123(e)(3) *Every adverse party shall have full opportunity to cross-examine each witness. 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. 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 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 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 CFR § 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 by affidavit, in accordance with a written stipulation of the parties under 37 CFR § 2.123(b), must be disclosed under Fed. R. Civ. P. 26(a)(3)(A) along with disclosure of witnesses who are expected to or may testify by giving oral testimony. [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 CFR § 2.121(e) does not substitute for issuance of a proper notice of examination under 37 CFR § 2.123(c) or 37 CFR § 2.124(b). [Note 7.]

If a party does not plan to take testimony from any witnesses, 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 and may move to strike the testimony of a witness for lack of proper pretrial disclosure. [Note 10.] 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. 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 12.] A party planning to introduce an adverse party's discovery deposition, or part thereof, need not disclose such plans. [Note 13.]

If pretrial disclosures or the notice of examination of witnesses served pursuant to 37 CFR § 2.123(c) 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. 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 CFR § 2.121(e). [Note 14.]

For information on pretrial disclosure of expert witnesses, *see* TBMP § 401.02.

NOTES:

1. *See* 37 CFR § 2.121(e); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

2. *See 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).

3. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

4. *See* 37 CFR § 2.121(e); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

5. 37 CFR § 2.121(e). *See 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 CFR § 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).

6. 37 CFR § 2.121(e).

7. 37 CFR § 2.121(e).

8. 37 CFR § 2.121(e).

9. 37 CFR § 2.121(e).

10. *See* 37 CFR § 2.123(e)(3). *See also* 37 CFR § 2.118; Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

11. *See Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009).

12. *See* 37 CFR § 2.118; Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

13. *See* 37 CFR § 2.118; Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42247 (August 1, 2007) (Fed. R. Civ. P. 26(a)(3)(B), which discusses objections to the use under Fed. R. Civ. P. 32(a) of a deposition designated by another party under Fed. R. Civ. P. 26(a)(3)(A)(ii), does not apply to the situation where a party plans to introduce an adverse party's discovery deposition, or part thereof).

14. 37 CFR § 2.123(e)(3). *See 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).

702.02 Introduction 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.] *Cf.* TBMP § 101.01 and TBMP § 101.02.

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 in the form of testimony depositions taken by a party during its testimony period, and documents and other exhibits may be made of record with appropriate identification and introduction by the witness during the course of the deposition. *See generally*, TBMP § 703 regarding testimony depositions. *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 CFR § 2.122(e) and discovery responses under 37 CFR § 2.120(j), 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 2.] *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 testimony may be submitted in the form of an affidavit, 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 3.] *See generally* TBMP § 704 regarding the introduction of other evidence.

A discussion of the time and manner of taking testimony depositions and introducing evidence is presented in the sections that follow.

NOTES:

1. 37 CFR § 2.122(a).

2. *See Sports Authority Michigan Inc. v. PC Authority Inc*., 63 USPQ2d 1782, 1786 n.4 (TTAB 2001) (notices of reliance must be filed before closing date of party's testimony period).

3. *See e.g., Coach Services Inc. v. Triumph Learning LLC,* 96 USPQ2d 1600, 1603, n.3 (TTAB 2010).

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, 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, and the written transcripts thereof, 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. 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. An oral hearing is held only if requested by a party to the proceeding. [Note 5.]

Because the vast majority of filings are now made via ESTTA (Electronic System for Trademark Trials and Appeals), the Board’s electronic filing system, most 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 web site via TTABVUE (http://ttabvue.uspto.gov). Paper submissions are scanned into the electronic record, and 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 6], 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 (Fed. Cir. 1988); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976). For a discussion concerning the general nature of trials in proceedings before the Board, *see Fischer Gesellschaft m.b.H. v. Molnar & Co.*, 203 USPQ 861, 867 (TTAB 1979); and *Litton Business Systems, Inc. v. J. G. Furniture Co.*, 190 USPQ 428, *recon. denied*, 190 USPQ 431 (TTAB 1976).

2. *See* 37 CFR § 2.191.

3. *See Hewlett-Packard Co. v. Healthcare Personnel In*c., 21 USPQ2d 1552 (TTAB 1991); *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234, 235 (Comm'r 1976).

4. *See* 37 CFR § 2.123(c).

5. *See* 37 CFR § 2.129(a).

6. *See* 37 CFR § 2.123(l).

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.] Oral hearings are available in ACR cases in accordance with 37 CFR § 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 thereby 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.

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 3.] 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 4.] 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 commitment to render a decision within fifty days from the completion of briefing. [Note 5.]

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. By limiting the number or duration of testimonial depositions, they may realize additional savings in cost and time. They may also agree to use discovery depositions at trial or to introduce testimony by affidavit or declaration, with the non-offering party reserving the right to cross-examine the witness in a later testimonial deposition.

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 6.]

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 7.]

The Board maintains a list of cases in which ACR has been used or other efficiencies have been agreed to, such as stipulations of fact, at http://www.uspto.gov/trademarks/process/appeal/acrcase_list.doc. Parties may review these cases in developing an ACR strategy.

NOTES:

1. *See, e.g., Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675 (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., Target Brands, Inc. v. Shaun N.G. 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 Ballet Tech Foundation Inc. v. Joyce Theater Foundation Inc.*, 89 USPQ2d 1262, 1226 n.9 (TTAB 2008) (on final decision noting that the "case would have been a good candidate for

accelerated case resolution" because "there is no dispute about the operative facts; rather, the parties disagree about what the facts mean").

4. *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).

5. *Promgirl, Inc. v. JPC Co.,* 94 UPSQ2d 1759, 1762 (TTAB 2009).

6. *Dan Robbins & Associates, Inc. v. Questor Corporation*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979).

7. *See* 37 CFR § 2.145.

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; 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. 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. A party may not raise objections to the admissibility of evidence that it has stipulated into the record. [Note 1.]

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 2.] 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 3.] 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 4.] Reply briefs are limited to 10 pages [Note 5] 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 issues of material fact that may be presented by the record or which may be discovered by the panel considering the case at final hearing.

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.

For more information regarding ACR motions for summary judgment, *see* TBMP § 528.05(a)(2).

NOTES:

1. *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).

2. 37 CFR § 2.127(a) and 37 CFR § 2.127(e)(1).

3. 37 CFR § 2.127(a) and 37 CFR § 2.127(e)(1).

4. 37 CFR § 2.127(a).

5. 37 CFR § 2.127(a).

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. 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 1.]

In either case, the parties must stipulate that the Board may resolve any genuine issues 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., Freeman v. National Association of Realtors*, 64 USPQ2d 1700 (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 (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. However, by limiting the number or duration of testimonial depositions, they may realize additional savings in cost and time. They may also agree to use discovery depositions at trial or to introduce testimony by affidavit or declaration, with the non-offering party reserving the right to cross-examine the witness in a later testimonial deposition.

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., testimony by affidavit, using discovery depositions in lieu of testimonial depositions). [Note 2.]

The stipulations regarding the submission of evidence remove any question about the admissibility of the evidence, and the parties may reserve the right to object to the evidence on substantive grounds such as competency, relevancy or materiality. [Note 3.] A party may not raise objections to the admissibility of evidence that it has stipulated into the record. [Note 4.]

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 5.] Unless counterclaims are involved, only plaintiff is entitled to file a reply which is limited to 25 pages. [Note 6.] A reply brief is limited to a rebuttal of the adverse party's case in chief.

For additional information regarding stipulated evidence and ACR, *see* TBMP § 705.

NOTES:

1. *See, e.g., Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511 (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. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007) (parties stipulated to the entirety of the record and agreed to forgo trial).

2. *See, e.g., Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511 (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. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007) (parties stipulated to the entirety of the record and stipulated to forgo trial); *Zimmerman v. National Association of Realtors*, 70 USPQ2d 1425 (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 Corporation*, 227 USPQ 705 (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).

3. *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).

4. *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).

5. 37 CFR § 2.128(b).

6. 37 CFR § 2.128(b).

702.04(e) Utilizing Stipulations in Non-ACR Board cases

Parties may utilize stipulations of facts and evidence to realize cost efficiencies in non-ACR cases. They may stipulate to the entire record, to portions of the record, or to particular facts. [Note 1.] Parties may stipulate to ACR-type efficiencies at any stage of a proceeding in order to expedite the remainder of the trial schedule.

A list of cases in which the parties have used stipulations to expedite discovery, trial and/or briefing is provided at the USPTO web site at http://www.uspto.gov/trademarks/process/appeal/acrcase_list.doc. *See also* TBMP § 705 regarding stipulated evidence.

NOTES:

1. *See e.g.*, *Brooks v. Creative Arts by Calloway*, LLC, 93 USPQ2d 1823 (TTAB 2010) (parties stipulated to admission of various testimony declarations and to facts); *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042 (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 (TTAB 2008) (parties stipulated to testimony by declaration, with exhibits); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc*., 89 USPQ2d 1844 (TTAB 2008) (stipulation to use discovery depositions as trial testimony); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628 (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 (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 (TTAB 1984) (stipulated to the filing of facts and exhibits on behalf of each party during each party's testimony period); and *Hayes Microcomputer Products, Inc. v. Business Computer Corporation*, 219 USPQ 634 (TTAB 1983) (parties stipulated to facts, legal conclusions and testimony, including cross-examination and redirect examination with respect to stipulated testimony).

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 instance, in lieu of filing discovery deposition transcripts in their entirety, it is preferable that parties file only those portions that are relevant to the pleaded claims and explain their relevance in the notice of reliance. [Note 4.] *See* TBMP § 704.09. For materials obtained from the Internet, parties should only submit relevant evidence, and should not submit duplicative and irrelevant materials. [Note 5.] For a detailed discussion of the relevancy requirements for Internet evidence, *see* TBMP § 704.08(b).

NOTES:

1. *See e.g.*, *Stuart Spector Designs Ltd. v. Fender Musical Instruments, Corp.*, 94 USPQ2d 1549 (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."); *Blue Man Productions v. Tarmann*, 75 USPQ2d 1811, 1814 (TTAB 2005) ("[t]here are literally hundreds of documents …"), *rev'd on other grounds*, slip. op. 05-2037, (D.D.C. Apr. 3, 2008).

2. *See e.g.*, *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.*, *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,* No. 05-2037, slip op. (D.D.C. Apr. 3, 2008).

4. *See Sports Authority Michigan Inc. v. PC Authority Inc*., 63 USPQ2d 1782, 1787 (TTAB 2001) (“[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).

5. *Safer, Inc. v. OMS Investments, Inc*., 94 USPQ2d 1031 (TTAB 2010).

703 Taking and Introducing Testimony

703.01 Oral Testimony Depositions

703.01(a) In General

A testimony deposition is a device used by a party to a Board inter partes proceeding to present evidence in support of its case. Testimony is taken out of the presence of the Board, on oral examination or written questions, and the written transcripts thereof, 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 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) in behalf of the party.

Testimony depositions are the means by which a party may introduce into the record not only the testimony of its witnesses, but also 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; inadmissibility is a valid ground for objection. [Note 1.] *See* TBMP § 707.03.

For a comparison of testimony depositions and discovery depositions, *see* TBMP § 404.09.

NOTES:

1. *See* 37 CFR § 2.122(a) and 37 CFR § 2.123(k).

703.01(b) Form of Testimony

37 CFR § 2.123(a)

(1) *The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by § 2.124. 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 fifteen 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.*

(2) *A testimonial deposition 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.*

(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. By written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses. The parties may stipulate in writing what a particular witness would testify to if called, or the facts in the case of any party may be stipulated in writing.*

Ordinarily, the testimony of a witness may be taken either on oral examination pursuant to 37 CFR § 2.123, or by deposition on written questions pursuant to 37 CFR § 2.124. [Note 1.] For information concerning testimony depositions on written questions, *see* TBMP § 703.02.

However, 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 15 days from the date of service of the notice (20 days if service of the notice was by first-class mail, "Express Mail," or overnight courier-- *see* 37 CFR § 2.119(c)), file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination. [Note 2.] What constitutes good cause to take an oral deposition is determined on a case-by-case basis. [Note 3.] *See* TBMP § 531.

In addition, a testimony deposition 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. [Note 4.] *See* TBMP § 520 and § 404.03(b). By written agreement of the parties, the testimony of any witness or witnesses of any party may be submitted in the form of an affidavit or declaration by such witness or witnesses. [Note 5.] The parties may stipulate that the non-submitting party may cross-examine the affiant or declarant in person. [Note 6.] The parties may also stipulate in writing the facts in the case of any party, or what a particular witness would testify to if called, or that a party may use a discovery deposition as testimony. [Note 7.]

NOTES:

1. *See* 37 CFR § 2.123(a)(1).

2. 37 CFR § 2.123(a)(1). *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 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).

3. *See Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980).

4. *See* 37 CFR § 2.123(a)(2). With respect to discovery depositions, *see* 37 CFR § 2.120(c)(1); *Jain v. Ramparts Inc*., 49 USPQ2d 1429, 1431 (TTAB 1998); *Orion Group Inc. v. Orion Insurance Co.* P.L.C., 12 USPQ2d 1923, 1925-26 (TTAB 1989) (good cause 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).

5. 37 CFR § 2.123(b). *See Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1914 (TTAB 2007) (declaration cannot be submitted in lieu of testimony deposition absent a stipulation of the parties); *Order Sons of Italy in America v. Memphis Mafia Inc*., 52 USPQ2d 1364, 1365 n.3 (TTAB 1999) ("statement" with exhibits by defendant's officer stricken where there was no agreement that defendant could file testimony in form of affidavit or declaration); *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1403-04 n.9 (TTAB 1998) (no agreement; officer's affidavit not considered); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1897 n.3-4 (TTAB 1989) (although parties had stipulated to submission of testimony by affidavit, opposer's objection was well taken because applicant's unsworn statement did not constitute testimony); *Chase Manhattan Bank, N.A. v. Life Care Services Corp*., 227 USPQ 389, 390 (TTAB 1985) (affidavits submitted by agreement of the parties); *Oxy Metal Industries Corp. v. Transene Co*., 196 USPQ 845, 847 n.20 (TTAB 1977) (stipulation to presentation of evidence by affidavit evidence reduces cost of litigation); and *National Distillers and Chemical Corp. v. Industrial Condenser Corp*., 184 USPQ 757, 758-59 (TTAB 1974) (both parties submitted stipulated testimony and exhibits).

Cf. Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, 1425 n.8 (TTAB 1993) (objection waived where although there was no such agreement, plaintiff did not object to declarations with exhibits submitted by defendant and moreover treated the evidence as if properly of record).

6. *See UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1044 (TTAB 2009) (parties stipulated to the introduction of applicant's testimony by declaration and live cross-examination of applicant by opposer).

7. 37 CFR § 2.123(b). *See 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); *Health-Tex Inc. v. Okabashi (U.S.) Corp*., 18 USPQ2d 1409, 1410 (TTAB 1990) (stipulation for use of discovery deposition as testimony deposition); and *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 Testimony

A party may take 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 CFR § 2.121(a). *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. 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 Deposition

37 CFR § 2.123(a)

(1) *The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by § 2.124. 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 fifteen 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.*

(2) *A testimonial deposition 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 depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing 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; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. 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.*

A testimony deposition may be noticed for any reasonable time during the deposing party's testimony period. [Note 1.] 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 2.] *See* TBMP § 701.

A testimony deposition to be taken in the United States may be noticed for any reasonable place. [Note 3.] A party may not 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. [Note 4.]

A 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 CFR § 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 5.] *See* TBMP § 703.01(b).

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 6.]

NOTES:

1. *See* 37 CFR § 2.123(c).

2. *See* 37 CFR § 2.121(a)(1); *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).

3. *See* 37 CFR § 2.123(c).

4. *See* 37 CFR § 2.123(c).

5. *See* 37 CFR § 2.123(a)(2) and 37 CFR § 2.123(c).

6. 37 CFR § 2.123(b).

703.01(e) Notice of Deposition

***37 CFR § 2.123(c)* Notice of examination of witnesses.** *Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing 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; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. 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.*

Before the oral depositions of witnesses may be taken by a party, the party must give due (i.e., reasonable) notice in writing to every adverse party. [Note 1.] *See* TBMP § 533.02. *Cf.* TBMP § 404.05. In assessing whether a party gave reasonable notice of a deposition, the Board does not count only 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. If the name of a witness is not known, the notice must include a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation. [Note 3.] *Cf.* TBMP § 404.05.

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 4.]

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 for purposes of certification. *See* TBMP § 122 and TBMP § 703.01(f)(2).

For information concerning the raising of an objection to a testimony deposition on the ground of improper or inadequate notice, *see* 37 CFR § 2.123(e)(3) and TBMP § 533.02.

NOTES:

1. 37 CFR § 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 Assn 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); and *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 CFR § 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); and *Allstate Life Insurance Co. v. Cuna International, Inc.*, 169 USPQ 313, 314 (TTAB 1971) (objections sustained where identification of possible witnesses as "such other persons as may be called" insufficient to identify witness or group to which witness belongs), *aff'd without opinion*, 487 F.2d 1407, 180 USPQ 48 (CCPA 1973).

4. 37 CFR § 2.123(b).

5. *See* 37 CFR § 2.123(f).

703.01(f) Securing Attendance of Unwilling Adverse Party or Nonparty

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 nonparty, or an official or employee of an adverse party or nonparty, 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 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 nonparty (or an official or employee of an adverse party or nonparty) 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. [Note 1.] *Cf*. TBMP § 404.03(a)(2) (securing attendance of nonparty 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. 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 2.] 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 3.]

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 (TTAB 1990)*; Consolidated Foods Corp. v. Ferro Corp*., 189 USPQ 582 (TTAB 1976).

2. Please Note: The Board no longer provides verified copies of filings.

3. *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.2 (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).

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 nonparty (or an official or employee of an adverse party or nonparty), 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).

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.]

NOTES:

1. *See 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).

703.01(g) Persons Before Whom Depositions May be Taken

37 CFR § 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 Board proceeding testimony deposition "shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the deposition is held, or before a person appointed by the court in which the action is pending." [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 Board proceeding testimony deposition may be taken pursuant to Fed. R. Civ. P. 28(b). This means, for example, that a Board proceeding testimony deposition 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 Citizens Consular Services, 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 nonparty 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 nonparty 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 CFR § 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 3d § 2083 (2009).

4. *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 n.5 (TTAB 2009).

5. 37 CFR § 2.123(b).

703.01(h) Examination of Witnesses

37 CFR § 2.123(e) Examination of witnesses.

(1) *Each witness before testifying shall be duly sworn according to law by the officer before whom his deposition is to be taken.*

(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 taken stenographically and transcribed, unless the parties present agree otherwise. In the absence of all opposing parties and their attorneys or other authorized representatives, depositions may be taken in longhand, typewriting, or stenographically. 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) *Every adverse party shall have full opportunity to cross-examine each witness. 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. 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). 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 the 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 CFR § 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.*

Fed. R. Civ. P. 30(b)(4) *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 testifying, 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).

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 testimony is taken stenographically and transcribed, unless the parties present agree otherwise. If no adverse party, or its attorney or other authorized representative, attends the deposition, the testimony may be taken in longhand, typewriting, or stenographically. [Note 2.]

The Board does not accept videotape depositions. A deposition must be submitted to the Board in written form. [Note 3.]

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 4.] 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 5.]

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 6.]

Every adverse party must be given a full opportunity to cross-examine the witness. 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 cross-examine the witness under protest while reserving the

right to object to the receipt of the testimony in evidence. [Note 7.] 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 CFR § 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 8.] *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, *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 9.]

NOTES:

1. 37 CFR § 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).

2. 37 CFR § 2.123(e)(2).

3. 37 CFR § 2.123(g) and 37 CFR § 2.126.

4. *See* Fed. R. Civ. P. 30(b)(4); *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).

5. Fed. R. Civ. P. 30(b)(4).

6. 37 CFR § 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).

7. 37 CFR § 2.123(e)(3).

8. 37 CFR § 2.123(e)(4).

9. 37 CFR § 2.123(b).

703.01(i) Form of Deposition and Exhibits

37 CFR § 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.*

(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 an index of the names of the witnesses, giving the pages where their 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 CFR § 2.125(d) *Each transcript shall comply with § 2.123(g) with respect to arrangement, indexing and form.*

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.*

* * * *

A deposition must be submitted to the Board in written form. The Board does not accept videotape depositions. [Note 1.]

The general requirements for submissions to the Board, including depositions and exhibits thereto, are specified in 37 CFR § 2.126. *See also* TBMP § 106.03. The particular requirements for the form of a written deposition are specified in 37 CFR § 2.123(g).

Depositions may be submitted to the Board on paper or electronically over the Internet through ESTTA, the Board's electronic filing system. [Note 2.] *See* TBMP § 106.03, TBMP § 106.09 and TBMP § 110.09 for further information about ESTTA. The requirements for each form of submission are set out in 37 CFR § 2.126(a) and 37 CFR § 2.126(b), respectively. The Board prefers that depositions and exhibits be filed using ESTTA, rather than in paper form.

A paper deposition 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 deposition must not be stapled or bound. 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 misfeeds to the scanning equipment and increasing the likelihood that pages will become disordered during scanning. [Note 3.]

The requirements for electronic submissions filed via ESTTA over the Internet can be found in 37 CFR § 2.126(b). [Note 4.]

Exhibits to a deposition are also subject to the requirements of 37 CFR § 2.126. If a deposition is submitted on paper, any exhibits pertaining to the deposition must be filed on paper and comply with the requirements for a paper submission. [Note 5.] As with any paper submission, paper exhibits may not contain tabs, dividers or any other devices that extend beyond the edges of the paper, and moreover, may not be stapled or bound. However, it would be acceptable to

use binder clips, rubber bands, or other such means for containing the materials that would allow for easy separation of the papers for scanning. Further, when an exhibit is scanned, the image quality may degrade. The original paper documents are usually sent to a warehouse and the Board works from the scanned images rather than the originals.

Exhibits pertaining to a deposition that is filed electronically through ESTTA must also be filed electronically as an attachment to the deposition and conform to the requirements for electronic submissions. [Note 6.] ESTTA exhibits may be in PDF, TIFF or TXT format. [Note 7.] 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. The image quality of ESTTA submissions is often better than images created by scanning paper submissions.

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 videotapes or audiotapes of commercials, demonstrations, etc., may be transferred to an appropriate electronic format such as a CD-ROM for submission to the Board.

Each party which files a document, either electronically or in paper form, is responsible for ensuring that its submission is legible. 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 CFR § 2.126(c). The Board strongly recommends that confidential materials be filed through ESTTA using the "CONFIDENTIAL" option. For further information concerning the submission of confidential information, *see* TBMP § 703.01(p) and TBMP § 703.02(l).

Exhibits must be marked as specified in 37 CFR § 2.123(g)(2). The Board, in its discretion, may refuse to enter and consider improperly marked exhibits. [Note 8.]

For information concerning deposition objections based on errors or irregularities in form, *see* TBMP § 707.03(c).

NOTES:

1. 37 CFR § 2.123(g) and 37 CFR § 2.126.

2. *See* 37 CFR § 2.126.

3. *See* Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. Reg. 42242, 42245 (September 26, 2003).

4. *See* 37 CFR § 2.2(g).

5. *See* 37 CFR § 2.126(a)(6).

6. *See* 37 CFR § 2.126(b).

7. 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.

8. 37 CFR § 2.123(g)(2). *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).

703.01(j) Signature of Deposition by Witness

37 CFR § 2.123(e)(5) *When the deposition has been transcribed, the deposition shall be carefully read over by the witness or by the officer to him, 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 a deposition by the witness is governed by 37 CFR § 2.123(e)(5). The deposition does not have to be signed in the presence of the officer before whom the deposition was taken. It may be signed in the presence of any officer authorized to administer oaths.

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 CFR § 2.123(e)(5). *See also, Tampa Rico Inc. v. Puros Indios Cigars Inc*., 5 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 2001) (depositions which were not signed and included no waiver were nevertheless considered where no objections were made).

703.01(k) Certification and Filing of Deposition

***37 CFR § 2.123(f)* Certification and filing of deposition.**

(1) *The officer shall annex to the deposition his certificate showing:*

(i) *Due administration of the oath by the officer to the witness before the commencement of his 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 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 seal of office, if he has such a seal. Unless waived on the record by an agreement, he shall then securely seal in an envelope all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate giving the number and title of the case, the name of each witness, and the date of sealing. The officer or the party taking the deposition, or its attorney or other authorized representative, shall then promptly forward the package to the address set out in § 1.1(a)(2)(i). If the weight or bulk of an exhibit shall exclude it from the envelope, it shall, unless waived on the record by agreement of all parties, be authenticated by the officer and transmitted by the officer or the party taking the deposition, or its attorney or other authorized representative, in a separate package marked and addressed as provided in this section.*

***37 CFR § 2.125* Filing and service of testimony.**

(a) *One copy of the transcript of testimony taken 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 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.*

* * * *

(c) *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 CFR § 2.123(f). The certified transcript, with exhibits, may be filed electronically using the Board's ESTTA filing system. *See* TBMP § 106 and TBMP § 110.09 for more information about using ESTTA. Alternatively, a paper submission of the certified transcript, with exhibits, should be sent 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.

The certified transcript and exhibits must be filed with the Board. [Note 1.] The Board interprets "promptly forward," in 37 CFR § 2.123(f)(2) which concerns the filing of transcripts and exhibits, as meaning forwarded at any time prior to the submission of the case for final decision. [Note 2.] Therefore, the Board will accept transcripts of testimony depositions at any time prior to the submission of the case for final decision. [Note 3.] In addition, a notice of reliance on the deposition transcript need not (and should not) be filed. [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.] For information concerning the remedy that an adverse party may have if it is not timely served with a copy of the deposition and exhibits, *see* TBMP § 703.01(m).

NOTES:

1. *See* 37 CFR § 2.125(c).

2. *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 CFR § 2.123(f) and 37 CFR § 2.125(c).

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 CFR § 2.123(f) and 37 CFR § 2.125(c). *See also 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); and *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 CFR § 2.125(c) was construed as meaning filed at any time prior to final hearing).

4. *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); *Paramount Pictures Corp. v. Romulan Invasions*, 7 USPQ2d 1897, 1898 n.2 (TTAB 1988); *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).

5. *See* 37 CFR § 2.125(c). *See also Sports Authority Michigan Inc. v. PC Authority Inc*., 63 USPQ2d 1782, 1786 n.4 (TTAB 2001) (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 CFR § 2.125(a).

703.01(l) Testimony Deposition Must be Filed

***37 CFR § 2.123(h)* Depositions must be filed.** *All depositions which are taken must be duly filed in the Patent and Trademark 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.*

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.]

NOTES:

1. *See* 37 CFR § 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 (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); and *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 CFR § 2.123(h). *See Motion Picture Ass'n 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).

703.01(m) Service of Deposition

***37 CFR § 2.125(a)* Filing and service of testimony.** *One copy of the transcript of testimony taken 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 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.

One copy of the transcript of trial testimony, 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 1.]

The requirement that a copy of the transcript, with exhibits, be served on every adverse party within the time specified in 37 CFR § 2.125(a) 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 2.] If a copy of the 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 transcript, with exhibits. [Note 3.]

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 CFR § 2.125(a). [Note 4.]

NOTES:

1. 37 CFR § 2.125(a). *See Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009).

2. *See 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).

3. 37 CFR § 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 (TTAB 1983).

4. *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009) (striking of testimony).

703.01(n) Correction of Errors in Deposition

37 CFR § 2.125(b) *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 CFR § 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).

3. *See* 37 CFR § 2.125(b). *See also Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390 (TTAB 1991).

703.01(o) Objections to Testimony Depositions

For information concerning objections to testimony depositions, *see* TBMP § 707.03 and TBMP § 533.

703.01(p) Confidential or Trade Secret Material

37 CFR § 2.116(g) *The Trademark Trial and Appeal Board's standard protective order is applicable during disclosure, discovery and at trial in all opposition, cancellation, interference and concurrent use registration 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, or upon request, a copy will be provided. 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.*

37 CFR § 2.125(e) *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(g).*

37 CFR § 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(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.*

The requirements for confidential submissions are specified in 37 CFR § 2.126(c). To be handled as confidential, and kept out of the public record, submissions to the Board that are confidential when submitted by paper 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. [Note 1.] If a party submits a transcript or other such filing containing confidential information under seal, the party must also submit for the public record a redacted version of said papers. [Note 2.] *Cf.* TBMP § 120.02 (Confidential Materials), TBMP § 412 (Protective Orders), TBMP § 526 (Motion for a Protective Order), and TBMP § 527.01 (Motion for Discovery Sanctions). A rule of reasonableness dictates what information should be redacted, and only in very rare instances should an entire submission be deemed confidential. [Note 3]. In cases where a redacted version has not been provided, the confidentiality of the information may be deemed waived. [Note 4.]

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.

37 CFR § 2.116(g) provides that the Board's standard protective order, which is available on the Board home page of the USPTO website or upon request made to the Board, is applicable to all inter partes trademark proceedings, unless the parties agree to, and the Board approves, an alternative protective order, or unless a motion by a party to enter a specific protective order is granted by the Board. [Note 5.]

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. [Note 6.] Therefore, only the particular exhibits or deposition transcript pages 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 only testimony and evidence that is truly confidential and commercially sensitive (such as sales expenditures, revenues and trade secrets) as confidential. [Note 7.] Similarly, if a party designates portions of its brief as confidential, and the statements in such portions do not appear to be confidential, the Board may order the party to submit a redacted brief in which only information that is truly confidential is deleted; failure to comply with the Board's order may result in the original brief with the confidential portions becoming part of the public record. [Note 8.]

NOTES:

1. *See* 37 CFR § 2.126(d).

2. *Cf.* 37 CFR § 2.120(f).

3. See e.g., Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc., 77 USPQ2d 1492, 1495 n.5 (TTAB 2005) (where briefs in their entirety were deemed "confidential," Board requested redacted copies).

4. See e.g., Wet Seal, Inc. v. FD Management, Inc., 82 USPQ2d 1629, 1633 n.6 (TTAB 2007).

5. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42248 (August 1, 2007).

6. *See Duke University v. Haggar Clothing Co*., 54 USPQ2d 1443, 1445 (TTAB 2000).

7. 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).

8. Morgan Creek Productions Inc. v. Foria International Inc., 91 USPQ2d 1134, 1136 n.9 (TTAB 2009).

703.02 Testimony Depositions on Written Questions

703.02(a) Depositions on Written Questions: When Available

37 CFR § 2.123(a)(1) *The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by § 2.124. 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 fifteen 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.*

(2) *A testimonial deposition 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.*

(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. By written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses. The parties may stipulate in writing what a particular witness would testify to if called, or the facts in the case of any party may be stipulated in writing.*

Ordinarily, the testimony of a witness may be taken either on oral examination pursuant to 37 CFR § 2.123, or by deposition on written questions pursuant to 37 CFR § 2.124. [Note 1.] For information concerning depositions on oral examination, *see* TBMP § 703.01.

However, 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 15 days from the date of service of the notice (20 days if service of the notice was by first-class mail, "Express Mail," or overnight courier--*see* 37 CFR § 2.119(c)), file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination. [Note 2.] *See* TBMP § 703.01(b).

In addition, a testimony deposition 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. [Note 3.] *See* TBMP § 703.01(b).

NOTES:

1. 37 CFR § 2.123(a)(1).

2. *See* 37 CFR § 2.123(a)(1).

3. 37 CFR § 2.123(a)(2).

703.02(b) Depositions on Written Questions: Before Whom Taken

37 CFR § 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.] For further information, *see* TBMP § 703.01(g).

NOTES:

1. *See* 37 CFR § 2.124(a). *See, e.g., Corporacion Habanos S.A. v. Anncas, Inc.*, 88 USPQ2d 1785 (TTAB 2008) (testimony deposition of opposer's vice president taken upon written questions).

703.02(c) Depositions on Written Questions: When Taken

37 CFR § 2.121 Assignment of times for taking testimony. (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. No testimony shall be taken 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 CFR § 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.

* * * *

(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 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.]

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 case to allow for the orderly completion of the depositions on written questions. [Note 3.]

For information concerning the time for taking a discovery deposition, *see* TBMP § 404.01.

NOTES:

1. 37 CFR § 2.121(a)(1).

2. 37 CFR § 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 CFR § 2.124(d)(2). *See 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 if it so desires, not for the purpose of participating (its participation will have occurred previously, through its service of cross questions, recross questions, and objections, if any, pursuant to 37 CFR § 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 CFR § 2.123(c). *Cf. also* 37 CFR § 2.123(b) regarding stipulations as to place, manner and notice of depositions.

703.02(e) Depositions on Written Questions: Notice of Deposition

37 CFR § 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.*

* * * *

(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 paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of 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; it must be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken, and 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.]
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 4.]

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 CFR § 2.124(b)(1). *See Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 152 (TTAB 1990).

2. 37 CFR § 2.124(b)(1), 37 CFR § 2.124(c), and 37 CFR § 2.124(d)(1).

3. 37 CFR § 2.124(b)(1).

4. 37 CFR § 2.123(b).

703.02(f) Depositions on Written Questions: Securing Attendance of Unwilling Witness

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 CFR § 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.*

* * * *

(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 paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Within twenty days from the date of service of the notice, any adverse party may serve cross questions upon the party who proposes to take the deposition; any party who serves cross questions 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 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; 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.*

(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.

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 (25 days, if service of the notice and accompanying questions was made by first-class mail, "Express Mail," or overnight courier -- *see* 37 CFR § 2.119(c)), 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 of them on every other adverse party. Within 10 days from the date of service of the cross questions (15 days, if service of the cross questions was made by first-class mail, "Express Mail," or overnight courier), the deposing party may serve redirect questions on every adverse party. Within 10 days from the date of service of the redirect questions (15 days, if service of the redirect questions was made by first-class mail, "Express Mail," or overnight courier), any party that served cross questions may serve recross questions on the deposing party. A party that serves recross questions on the deposing party must also serve copies thereof on every other adverse party. [Note 4.]

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 (15 days, if service of the objections was made by first-class mail, "Express Mail," or overnight courier). The substitute questions must also be served on every other adverse party. [Note 5.]

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 CFR § 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 6.] *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 take the testimony of the witness in response to the questions, and shall record each answer immediately after the corresponding question. [Note 7.]

An adverse party may attend the taking of the deposition if it so desires, not for the purpose of participating (its participation will have occurred previously, through its service of cross questions, recross questions, and objections, if any, pursuant to 37 CFR § 2.124(d)(1)), but rather merely for the purpose of observing. Any attempt to engage the witness during the deposition 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 8.]

NOTES:

1. 37 CFR § 2.124(b)(1).

2. 37 CFR § 2.124(b)(1), 37 CFR § 2.124(c), and 37 CFR § 2.124(d)(1).

3. 37 CFR § 2.124(b)(1).

4. 37 CFR § 2.124(d)(1). *See Fischer Gesellschaft m.b.H. v. Molnar & Co*., 203 USPQ 861, 866 (TTAB 1979).

5. 37 CFR § 2.124(d)(1). *See Health-Tex Inc. v. Okabashi (U.S.) Corp*., 18 USPQ2d 1409, 1411 (TTAB 1990).

6. 37 CFR § 2.124(d)(2).

7. 37 CFR § 2.124(e).

8. *See* 37 CFR § 2.123(b).

703.02(h) Depositions on Written Questions: Form, Signature and Certification of Deposition

37 CFR § 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 CFR § 2.123(g) and 37 CFR § 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 CFR § 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 CFR § 2.124(e). For information concerning certification of a deposition taken in an inter partes proceeding before the Board, *see* 37 CFR § 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 CFR § 2.124(e).

2. *See* 37 CFR § 2.124(e).

703.02(i) Depositions on Written Questions: Service, Correction and Filing of Deposition

37 CFR § 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(b)). If the deposition is a discovery deposition, it may be made of record as provided by § 2.120(j). 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 CFR § 2.124(f).

2. 37 CFR § 2.124(f) and 37 CFR § 2.125(b).

3. *See* 37 CFR § 2.124(f).

703.02(j) Testimony Depositions on Written Questions Must be Filed

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 CFR § 2.120(j) and TBMP § 704.09.

NOTES:

1. *See* 37 CFR § 2.123(h).

703.02(k) Depositions on Written Questions: Objections to Deposition

37 CFR § 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 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 CFR § 2.124(d)(1).

2. 37 CFR § 2.124(g). *See 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 deposition transcript or exhibits thereto, *see* 37 CFR § 2.125(e) and 37 CFR § 2.126(d); TBMP § 703.01(p).

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, it has some utility. It 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 nonparty 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. Thus, even for a deposition to be taken in the United States, a deposing party may prefer to use the deposition on written questions, particularly in those cases where the testimony will be short, simple, straight-forward, and not likely to be disputed, such as to establish for the record examples of third-party usage. [Note 3.]

NOTES:

1. *See* 37 CFR § 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 Gesellschaft m.b.H. v. Molnar & Co*., 203 USPQ 861, 866 (TTAB 1979); and *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923, 1926 (TTAB 1989) (motion to take discovery deposition in foreign country orally).

2. *See* 37 CFR § 2.120(c)(1) and 37 CFR § 2.123(a)(2). *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).

3. *Cf. Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589 (TTAB 1980).

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. The first part of this chapter discusses the introduction of evidence in the form of testimony depositions with accompanying exhibits. The following sections discuss other forms of evidence and the methods available for their introduction. Parties are cautioned, however, to submit only relevant, non-cumulative evidence in support of their pleaded claims. *See* TBMP § 702.05 (Overly Large Records).

704.02 Notice of Reliance – Generally

Certain types of evidence, such as official records and printed publications as described in 37 CFR § 2.122(e), 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. A notice of reliance is essentially a cover sheet for the materials sought to be introduced. This cover sheet is entitled "notice of reliance" and it serves, as the title suggests, to notify opposing parties that the offering party intends to rely on the materials submitted thereunder in support of its case. The notice of reliance must include a description of the proffered materials and, in some instances, must indicate the relevance of those materials to the case. 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.

704.03 Applications and Registrations

704.03(a) Subject of Proceeding

37 CFR § 2.122(b) Application 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.*

(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.*

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.

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 4.]

For further information concerning the probative value of applications and registrations, *see* TBMP § 704.03(b).

NOTES:

1. 37 CFR § 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); *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); and *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) (submission of portions of application unnecessary since file is automatically of record), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

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*, slip. op. 2010-1191 (Fed. Cir. Nov. 18, 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); and *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 CFR § 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); and *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. *The Cold War Museum, Inc. v. Cold War Air Museum, Inc*., 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009).

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 CFR § 2.122(d)* Registrations.**

(1) *A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by an original or photocopy of the registration prepared and issued by the United States Patent and Trademark Office showing both the current status of and current title to the registration, or by a current printout of information from the electronic database records of the USPTO 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, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to 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 printout of information from the electronic database records of the Office such as (i) TARR (Trademark Application and Registration Retrieval) showing the current status and title (owner) of the registration and, if the TARR printout does not reflect the current owner of the registration, a printout from the Office's Assignment database demonstrating an assignment to the current owner of the registration, or (ii) TESS (Trademark Electronic Search System) along with a copy of any records from the Assignment 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 of information from the electronic database records of the Office such as (i) TARR (Trademark Application and Registration Retrieval) showing the current status and title (owner) of the registration and, if the TARR printout does not reflect the current owner of the registration, a printout from the Office's Assignment database demonstrating an assignment to the current owner of the registration, or (ii) TESS (Trademark Electronic Search System) along with a copy of any records from the Assignment 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 CFR § 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 CFR § 2.122(d) allows a party to submit copies of its registrations taken from the Office's electronic database records such as TARR (Trademark Application and Registration Retrieval) or TESS (Trademark Electronic Search System) databases.

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 CFR § 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 CFR § 2.122(e) (*see* TBMP § 704.05); 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).

2. 37 CFR § 2.122(d)(1). *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); *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); *Research In Motion Ltd. v. NBOR Corp*., 92 USPQ2d 1926, 1928 (TTAB 2009) (printouts from 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); and *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc*., 204 USPQ 144, 146 (TTAB 1979).

3. *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).

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 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 Mfg. Co*., 77 USPQ2d 1220, 1223 n.6 (TTAB 2005); and *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 CFR § 7.22 and 37 CFR § 7.23.

7. *See* TMEP § 1906.01(a) and TMEP § 1906.01(a)(i).

8. 37 CFR § 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); *Research In Motion Ltd. v. NBOR Corp*., 92 USPQ2d 1926, 1928 (TTAB 2009) (printouts from 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); and *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 (TTAB 1979); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co*., 204 USPQ 76 (TTAB 1979); and *W. R. Grace & Co. v. Red Owl Stores, Inc*., 181 USPQ 118 (TTAB 1973).

9. *See* 37 CFR §2.122(d); Notice of Final Rulemaking, 48 Fed. Reg. 23122 (May 23, 1983); *In re Inter-State Oil Co*., 219 USPQ 1229 (TTAB 1983).

10. *See Electronic Data Systems Corp. v. EDSA Micro Corp*., 23 USPQ2d 1460, 1461 n.4 (TTAB 1992).

11. 37 CFR § 2.122(e). Although status and title copies need not be certified (*see* 37 CFR § 2.122(e)), at present all status and title copies prepared and issued by the Office are 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 CFR § 2.6(b)(4).

12. 37 CFR § 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 Research In Motion Ltd. v. NBOR Corp*., 92 USPQ2d 1926, 1928 (TTAB 2009) (printouts from 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*., 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (photocopy of registration without status and title information insufficient to establish prima facie showing); and *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116-17 (TTAB 2009) (copy of registration certificate insufficient).

15. *See 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 (TTAB1990) (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 Aktiengesellschaft v. Clement Wheel Co*., 204 USPQ 76 (TTAB 1979); and *Marriott Corp. v. Pappy's Enterprises, Inc*., 192 USPQ 735 (TTAB 1976).

16. *See Duffy-Mott Co. v. Borden, Inc*., 201 USPQ 846, 847 n.5 (TTAB 1978) (USPTO error in identification of owner).

17. *See 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 (TTAB 1978); and *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co*., 204 USPQ 76, 80 n.3 (TTAB 1979).

18. 37 CFR § 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); *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); and *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 (TTAB 1979); *Alcan Aluminum Corp. v. Alcar Metals Inc*., 200 USPQ 742 (TTAB 1978); *Groveton Papers Co. v. Anaconda Co*., 197 USPQ 576 (TTAB 1977); *Maybelline Co. v. Matney*, 194 USPQ 438 (TTAB 1977); *GAF Corp. v. Anatox Analytical Services, Inc*., 192 USPQ 576 (TTAB 1976); *American Manufacturing Co., v. Phase Industries, Inc*., 192 USPQ 498 (TTAB 1976); and *West Point-Pepperell, Inc. v. Borlan Industries Inc*., 191 USPQ 53 (TTAB 1976).

19. *See 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); *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); and *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. 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 CFR § 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); and *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 (TTAB 1977); *Angelica Corp. v. Collins & Aikman Corp*., 192 USPQ 387 (TTAB 1976); and *West Point-Pepperell, Inc. v. Borlan Industries Inc*., 191 USPQ 53 (TTAB 1976).

21. *See* 37 CFR § 2.123(b); *Industrial Adhesive Co. v. Borden, Inc*., 218 USPQ 945 (TTAB 1983); *Plus Products v. Natural Organics, Inc*., 204 USPQ 773 (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); and *Zirco Corp. v. American Telephone and Telegraph Co*., 21 USPQ2d 1542 (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 (TTAB 1976); *David Crystal, Inc. v. Glamorise Foundations, Inc*., 189 USPQ 740 (TTAB 1975); *Johnson & Johnson v. E. I. du Pont de Nemours & Co*., 181 USPQ 790 (TTAB 1974); and *Gates Rubber Co. v. Western Coupling Corp*., 179 USPQ 186 (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 (Fed. Cir. 1989) (does not provide constructive notice of anything); *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, In*c., 191 USPQ 292, 294 (TTAB 1976) (lapsed registration of affiliated company is not evidence of use of mark at any time); and *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).

See also Borden, Inc. v. Kerr-McGee Chemical Corp., 179 USPQ 316 (TTAB 1973), *aff'd without opinion*, 500 F.2d 1407, 182 USPQ 307 (CCPA 1974); *Unitec Industries, Inc. v. Cumberland Corp*., 176 USPQ 62 (TTAB 1972); and *Monocraft, Inc. v. Leading Jewelers Guild*, 173 USPQ 506 (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); and *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 (TTAB 1978); *Angelica Corp. v. Collins & Aikman Corp*., 192 USPQ 387 (TTAB 1976); *State Historical Society of Wisconsin v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc*., 190 USPQ 25 (TTAB 1976); *Old Dutch Foods, Inc. v. Old Dutch Country House, Inc*., 180 USPQ 659 (TTAB 1973); and *Philip Morris Inc. v. Liggett & Myers Tobacco Co*., 139 USPQ 240 (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); and *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 (TTAB 1973); and *Barash Co. v. Vitafoam Ltd*., 155 USPQ 267 (TTAB 1967), *aff'd*, 427 F.2d 810, 166 USPQ 88 (CCPA 1970). *Cf. In re Hag Aktiengesellschaft*, 155 USPQ 598 (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 CFR § 2.122(e).

704.03(b)(1)(B) Third-Party Registration

***37 CFR § 2.122(e)* Printed publications and official records.** *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, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice 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 Patent and Trademark 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 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 or a printout 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. [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.

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 3.]

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 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 a trademark 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 4.]

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 5.]

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 6.] *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 issue 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 7.] 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 8.]

A state registration, whether or not owned by a party, has very little, if any, probative value in a proceeding before the Board. [Note 9.] *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 CFR § 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 the Trademark Document Retrieval (TDR) database.

It is not necessary that the copy of the registration file, or portions thereof, be certified. [Note 10.] However, third-party registration histories are of very limited probative value. [Note 11.]

NOTES:

1. *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1110 (TTAB 2007).

2. 37 CFR § 2.122(e). *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* 37 CFR § 2.122(e); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998)

(incomplete excerpts of registrations from TRAM system was insufficient); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994); and *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992). *See also Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 123 (TTAB 1977).

4. *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); and *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).

5. *See Merritt Foods Company v. Americana Submarine*, 209 USPQ 591, 593 n.16 (TTAB 1980); and *Hiram Walker & Sons, Inc. v. Milstone*, 130 USPQ 274, 276 (TTAB 1961).

6. *See, e.g., 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); and *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); and *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 registration 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.

7. *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); *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 2001) (not evidence of use or that consumers have been exposed to them); and *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), *aff'd*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976) (little weight on likelihood of confusion); *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); and *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 In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (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).

8. *See Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976); *Conde Nast Publications Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 USPQ 422, 425 (CCPA 1975). *See also Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2001) (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); and *Bottega Veneta, Inc. v. Volume Shoe Corp.*, 226 USPQ 964, 968 (TTAB 1985) (to show geographic significance of terms).

9. *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).

10. 37 CFR § 2.122(e).

11. *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 CFR § 2.122(e)* Printed publications and official records.** *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, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice 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 Patent and Trademark 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. [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 Trademark Document Retrieval ("TDR") 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.

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 3.] *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.

NOTES:

1. *See* 37 CFR § 2.122(e); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231 (TTAB 1992) (copy of drawing from abandoned application); *Glamorene Products Corporation. v. Earl Grissmer Company, Inc*., 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).

2. *See* 37 CFR § 2.122(e).

3. *See Glamorene Products Corporation. v. Earl Grissmer Company, Inc*., 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 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 (TTAB 1976); and *Andrea Radio Corp. v. Premium Import Co*., 191 USPQ 232 (TTAB 1976).

704.04 Statements and Things in Application or Registration

37 CFR § 2.122(b) Application 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.*

(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.*

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 CFR § 2.122(b). *See* TBMP § 704.03(a). [Note 1.]

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 2.] The date of use must be established by competent evidence, properly adduced at trial, [Note 3] 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 4.]

Similarly, the allegations of use in a third-party registration do not constitute evidence that the mark shown therein has actually been used. [Note 5.]

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 6.]

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. *See, e.g., UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1047 (TTAB 2009) (allegations in application are not evidence); *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); and *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).

3. *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); and *Textron Inc. v. Arctic Enterprises, Inc*., 178 USPQ 315 (TTAB 1973) (applicant cannot rely on dates of use alleged in application).

4. 37 CFR § 2.122(b). *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).

5. 37 CFR § 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); and *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).

6. *See 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); and *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); and *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).

704.05 Exhibits to Pleadings or Briefs

704.05(a) Exhibits to Pleadings

***37 CFR § 2.122(c)* Exhibits to pleadings.** *Except as provided in paragraph (d)(1) of this*

section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony.

***37 CFR § 2.122(d)* Registrations.**

***(1)** A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by an original or photocopy of the registration prepared and issued by the U. S. Patent and Trademark Office showing both the current status of and current title to the registration, or by a current printout of information from the electronic database records of the USPTO 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).*

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 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 of information from the electronic database records of the USPTO showing the current status and title of the registration. When a plaintiff submits a printout 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 may be taken from (a) the TARR (Trademark Application and Registration Retrieval) electronic database of the Office showing the current status and title (owner) of the registration or, if the TARR printout does not reflect the current owner of the registration, a printout from the Office's Assignment database demonstrating an assignment to the current owner of the registration should be included with the TARR printout, or (b) the TESS (Trademark Electronic Search System) electronic database of the Office along with a copy of records from the Assignment database showing and assignment to the current owner of the registration.

NOTES:

1. 37 CFR § 2.122(c).

2. *See* 37 CFR § 2.122(c) and 37 CFR § 2.122 (d)(1).

3. *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 n.4 (TTAB 2008).

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.

NOTES:

1. *See, e.g., 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 (TTAB 1978); *Astec Industries, Inc. v. Barber-Greene Co*., 196 USPQ 578 (TTAB 1977); and *Angelica Corp. v. Collins & Aikman Corp*., 192 USPQ 387 (TTAB 1976). *See also, L. Leichner (London) Ltd. v. Robbins*, 189 USPQ 254 (TTAB 1975); *American Crucible Products Co. v. Kenco Engineering Co*., 188 USPQ 529 (TTAB 1975); *Tektronix, Inc. v. Daktronics, Inc*., 187 USPQ 588 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc*., 185 USPQ 61 (TTAB 1975), *aff'd*, 530 F.2d 1396, 189 USPQ 138 (CCPA 1976); and *Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp*., 178 USPQ 429 (TTAB 1973).

Compare, e.g., 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, 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); and TBMP § 704.12 regarding judicial notice.

2. *See 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); and *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. Statements in a brief have no evidentiary value, except to the extent that they may serve as admissions against interest. [Note 1.]

NOTES:

1. *See, e.g., 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 Mfg. 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); and *Plus Products v. Physicians Formula Cosmetics, Inc*., 198 USPQ 111, 112 n.3 and 113 (TTAB 1978).

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); *In re Simulations Publications, Inc*., 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975).

704.07 Official Records

***37 CFR § 2.122(e)* Printed publications and official records.** *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, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice 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 Patent and Trademark 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 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 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 CFR § 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.] These official records are considered self-authenticating, and as such, require no extrinsic evidence of authenticity as a condition to admissibility. [Note 3.]

For examples of cases concerning the admissibility of specific documents, by notice of reliance, as "official records" under 37 CFR § 2.122(e), *see* cases cited in the note below. [Note 4.] 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), 901(b)(7), and 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 5.]

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 6.] *Cf*. TBMP § 704.08.

Although official records may be made of record by notice of reliance under 37 CFR § 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 7.] These latter two methods may also be used to introduce types of official records that are not admissible by notice of reliance under 37 CFR § 2.122(e). [Note 8.]

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 CFR § 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 9.]

NOTES:

1. *See* 37 CFR § 2.122(e). *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); and *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 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); and *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. *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1603, n.2 (TTAB 2010) (corporate annual reports not printed from the Internet – 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); *Research In Motion Ltd. v. NBOR Corp*., 92 USPQ2d 1926, 1929 (TTAB 2009) (printouts of abandoned applications obtained from 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), *aff'd*, 1 F.3d 1252, 28 USPQ2d 1687 (Fed. Cir. 1993) (trademark search report -- no; third-party registrations -- yes); *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); and *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).

5. *See* 37 CFR § 2.122(e).

6. *See Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992).

7. *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).

8. *See, e.g., 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); *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), and *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).

9. *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); and *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 CFR § 2.122(e) ***Printed publications and official records.*** *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, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice 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 Patent and Trademark 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.*

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 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 NEXIS 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 CFR § 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 CFR § 2.122(e), see cases cited in the note below. [Note 5.]

Printed publications made of record by notice of reliance under 37 CFR § 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.]

Although the types of printed publications described above may be made of record by notice of reliance under 37 CFR § 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 7.] These latter two methods may also be used for the introduction of printed publications that are not admissible by notice of reliance under 37 CFR § 2.122(e). [Note 8.]

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 CFR § 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 9.]

NOTES:

1. *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 Corporation. v. Earl Grissmer Company, Inc.*, 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); and *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 CFR § 2.122(e), even though it may constitute hearsay or be of dubious relevance).

2. *See* 37 CFR § 2.122(e). *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 CFR § 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*, No. 05-2037, slip op. (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); and *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 Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *International Ass'n 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 Glamorene Products Corporation. v. Earl Grissmer Company, Inc.*, 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. *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); and *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.*, *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); *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); *In re Omaha National 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); *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 Aktiengesellschaft 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); and *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. *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).

8. *See, e.g., 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); *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).

9. *See, e.g., 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 CFR § 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), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (neither party objected to the annual reports submitted by the other party); *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); and *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 (TTAB 1979) (improper subject matter excluded, although

no objection).

704.08(b) Internet Materials

In *Safer, Inc. v. OMS Investments, Inc*., 94 USPQ2d 1031 (TTAB 2010) ("*Safer*"), the Board changed its practice regarding Internet evidence, holding that a document obtained from the Internet 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 CFR § 2.122(e). [Note 1.] The following policies and procedures follow the Board's decision in *Safer*.

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). As with traditional printed publications submitted by notice of reliance, the propounding party must indicate in the notice of reliance "generally the relevance of the material being offered." However, for Internet documents it is not sufficient for the propounding party to broadly state that the materials are being submitted to support the ground at issue. 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.

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. 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. Otherwise, the document may not be considered to have much probative value.

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.

If the propounding party fails to indicate the relevance of the material being offered, the adverse party must lodge an objection before the opening of the next testimony period following that in which the material was offered into the record, or risk a finding that any objection on this basis

was waived. The failure to indicate such relevance can be cured by the propounding party as soon as the evidentiary defect is raised by an adverse party, without reopening the testimony period of the propounding party. 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.

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 2.] Internet documents may be objectionable under Fed. R. Evid. 403 on the ground that they constitute a "needless presentation of cumulative evidence."

NOTES:

1. *See e.g., 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).

Safer, Inc. v. OMS Investments, Inc., 94 USPQ2d 1031 (TTAB 2010), effectively overrules 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 NEXIS database with respect to whether they may be submitted as official records.
2. *Safer, Inc. v. OMS Investments, Inc*., 94 USPQ2d 1031, 1040 n.19 (TTAB 2010).

704.08(c) Other Printed Materials

Certain printed publications qualify for submission by notice of reliance under 37 CFR § 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 CFR § 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.] 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 5.]

NOTES:

1. *See 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. *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 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), *rev'd on other grounds*, No. 05-2037, slip op. (D.D.C. Apr. 3, 2008) (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); and *Sports Authority Michigan Inc. v. PC Authority Inc*., 63 USPQ2d 1782, 1798 (TTAB 2001) (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 CFR § 2.120(j)* Use of discovery deposition, answer to interrogatory, or admission.**

(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 (j)(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 at the time of the purported offer of the deposition in evidence, 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, 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 disclosure (but not a disclosed document), 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 disclosure, together with a notice of reliance. 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 (j) of this section will not be interpreted to preclude the 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, has been made of record by one party in accordance with the provisions of paragraph (j)(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 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)(3) 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 at the time of the purported offer of the deposition in evidence, 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 CFR § 2.120(j) 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.] While the notice of reliance need not indicate the relevance of the deposition, or parts thereof, relied on, it is preferable to do so. [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. [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 CFR § 2.120(j), 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 CFR § 2.120(j), 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 CFR § 2.120(j) 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.]

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 CFR § 2.120(j) 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 current 37 CFR § 2.120(j), or were decided under rules that were the predecessors to such provisions.

NOTES:

1. 37 CFR § 2.120(j)(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 Gesellschaft m.b.H. v. Molnar & Co*., 203 USPQ 861, 867 n.7 (TTAB 1979) (discovery deposition of nonparty taken on written questions inadmissible); and *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 CFR § 2.120(j)(2). *See Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons Inc*., 55 USPQ2d 1298, 1302 n.11 (TTAB 2000) (deposition of nonparty properly in evidence by stipulation of parties).

3. 37 CFR § 2.120(j)(2). *See 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 Gesellschaft m.b.H. v. Molnar & Co*., 203 USPQ 861, 867 (TTAB 1979) (mere speculation that nonparty witness would be unavailable is insufficient); and *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 nonparty).

4. 37 CFR § 2.120(j)(4). *See 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); and *Johnson Publishing Co. v. Cavin & Tubiana OHG*, 196 USPQ 383, 384 n.5 (TTAB 1977).

5. 37 CFR § 2.120(j)(3)(i). *See Galaxy Metal Gear Inc. v. Direct Access Technology Inc*., 91 USPQ2d 1859, 1862 (TTAB 2009); *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); *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc*., 6 USPQ2d 1215 (TTAB 1988); *Fischer Gesellschaft m.b.H. v. Molnar & Co*., 203 USPQ 861 (TTAB 1979); *Ethicon, Inc. v. American Cyanamid Co*., 192 USPQ 647 (TTAB 1976); *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); and *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 CFR § 2.120(j)(3)(i). *Cf. Sports Authority Michigan Inc. v. PC Authority Inc*., 63 USPQ2d 1782, 1787 (TTAB 2001) (noting that it is more effective to file only those portions of the deposition that are relevant and explain their relevancy in the notice of reliance).

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

2001) ("[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 CFR § 2.120(j)(7). *See 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 Int'l, 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); and *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 nonparty 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 nonparty 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); and *Insta-Foam Products, Inc. v. Instapak Corporation*, 189 USPQ 793, 795 n.4 (TTAB 1976) (discovery deposition of nonparty deemed stipulated into the record where there was no objection and both parties relied on the deposition).

12. *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 CFR § 2.120(j)(8). *See Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 n.3 (TTAB 1999).

14. 37 CFR § 2.120(j)(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 CFR § 2.120(j)

* * * *

(3)(i) *A discovery deposition, an answer to an interrogatory, or an admission to a request for admission, or a written disclosure (but not a disclosed document), 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 disclosure, together with a notice of reliance. 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) *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 except that, if fewer than all of the answers to 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, which should in fairness be considered so as to make not misleading what was offered by the inquiring party. The notice of reliance filed by the responding party must be supported by a written statement explaining why the responding party needs to rely upon each of the additional discovery responses listed in the responding party's notice, failing which the Board, in its discretion, may refuse to consider the additional responses.*

(6) *Paragraph (j) of this section will not be interpreted to preclude the 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, has been made of record by one party in accordance with the provisions of paragraph (j)(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 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.]

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), or an admission to a request for admission, [Note 4], that may be offered in evidence under 37 CFR § 2.120(j) 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 need not indicate the relevance of the discovery responses relied on. [Note 6.] Interrogatory answers, or admissions, may be admitted into evidence through the testimony deposition 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 CFR § 2.120(j), 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 CFR § 2.120(j) 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: 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.

Nothing in 37 CFR § 2.120(j) 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 12.]

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 current 37 CFR § 2.120(j), or were decided under rules which were the predecessors to such provisions.

NOTES:

1. 37 CFR § 2.120(j)(5). *See 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); and *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) ; and *Beecham Inc. v. Helene Curtis Industries, Inc*., 189 USPQ 647, 647 (TTAB 1976).

2. 37 CFR § 2.120(j)(5). *See Heaton Enterprises of Nevada Inc. v. Lang,* 7 USPQ2d 1842, 1844 n.5 (TTAB 1988).

3. 37 CFR § 2.120(j)(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); and *Beecham Inc. v. Helene Curtis Industries, Inc*., 189 USPQ 647 (TTAB 1976).

4. *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 CFR § 2.120(j)(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); and *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 den.*, 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); and *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 CFR § 2.120(j)(3)(i); *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881, 883 (TTAB 1979) (not required to set forth the relevance of interrogatory answers).

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 CFR § 2.120(j)(7). *See 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). *See also Henry Siegel Co. v. M & R International Mfg. 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., 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); and *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).

Compare, *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 of record).

11. 37 CFR § 2.120(j)(8).

12. 37 CFR § 2.120(j)(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 witnesses' memory), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984).

704.11 Produced Documents

***37 CFR § 2.122(e)* Printed publications and official records.** *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, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice 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 Patent and Trademark 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.*

37 CFR § 2.120(j)(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).*

Documents provided as all or part of an answer to an interrogatory may be made of record, as an interrogatory answer, by notice of reliance filed in accordance with 37 CFR §§ 2.120(j)(3)(i) and 2.120(j)(5). [Note 1.]

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 CFR § 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. [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 CFR § 2.120(j)(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). 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 prior to the expiration of the discovery period. *See* TBMP § 403.05(a) and TBMP § 403.05(b) regarding the need for early initiation of discovery.

(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. *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 3.] 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 4.]

(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 CFR § 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; official records, if the publication or official record is competent evidence and relevant to an issue" and Internet materials. [Note 5.] *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 (this period is lengthened to 35 days if service of the request is made by first-class mail, "Express Mail," or overnight courier -- *see* 37 CFR § 2.119(c)). *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 6.]

(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 7.]

For information on initial disclosures and on obtaining of 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 8.]

NOTES:

1. *See 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 CFR § 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 (TTAB 1986).

2. 37 CFR § 2.120(j)(3)(ii). *See, e.g., 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); and *Jeanne-Marc, Inc. v. Cluett, Peabody & Co*., 221 USPQ 58, 59 n.4 (TTAB 1984) (documents were not printed publications).

3. *See Harvey Hubbell, Inc. v. Red Rope Industries, Inc*., 191 USPQ 119, 121 n.1 (TTAB 1976).

4. *See Harvey Hubbell, Inc. v. Red Rope Industries, Inc*., 191 USPQ 119, 121 n.1 (TTAB 1976).

5. 37 CFR § 2.122(e); 37 CFR § 2.120(j)(3)(ii); *Safer, Inc. v. OMS Investments, Inc*., 94 USPQ2d 1031, 1039 (TTAB 2010).

6. *See Ballet Tech Foundation Inc. v. Joyce Theater Foundation Inc*., 89 USPQ2d 1262, 1265 n.8 (TTAB 2008).

7. *See, e.g., 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); and *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).

Compare, 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).

8. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, n.5 (TTAB 2008).

704.12 Judicial Notice

***37 CFR § 2.122(a)* Rules of Evidence.** *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 of Title 37 of the Code of Federal Regulations.*

Fed. R. Evid. 201. Judicial Notice of Adjudicative Facts.

(a) Scope of rule. *This rule governs only judicial notice of adjudicative facts.*

(b) Kinds of facts. *A judicially noticed fact must be one 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.*

(c) When discretionary. *A court may take judicial notice, whether requested or not.*

(d) When mandatory. *A court shall take judicial notice if requested by a party and supplied with the necessary information.*

(e) Opportunity to be heard. *A party is entitled upon timely request to an opportunity to be heard as to the propriety of taking judicial notice and the tenor of the matter noticed. In the absence of prior notification, the request may be made after judicial notice has been taken.*

(f) Time of taking notice. *Judicial notice may be taken at any stage of the proceeding.*

In appropriate instances, the Board may take judicial notice of adjudicative facts. *See* 37 CFR § 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); *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 (TTAB 1985); *United States National Bank of Oregon v. Midwest Savings and Loan Ass'n*, 194 USPQ 232 (TTAB 1977).

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 CFR § 2.122(d) and 37 CFR § 2.122(e).

2. *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, 1379 n.7 (TTAB 2006) ("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 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (dictionary definitions -- yes); *General Mills Fun Group, Inc. v. Tuxedo Monopoly, Inc*., 204 USPQ 396 (TTAB 1979), *aff'd*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (frequent use of famous marks on collateral products such as clothing, glassware, trash cans, etc. -- yes); *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); *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) (on-line 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 (TTAB 1989) (Catonsville, Maryland is located between Baltimore, Maryland and Washington, D.C. -- yes); *Los Angeles Bonaventure Co. v. Bonaventure Associates*, 4 USPQ2d 1882 (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 (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 (TTAB 1985) (presumptions concerning the significance in trade of certain terms -- no); *Hertz System, Inc. v. A-Drive Corp*., 222 USPQ2d 625 (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 (TTAB 1981) (use of antimicrobial agents in the floor covering industry -- no); *Marcal Paper Mills, Inc. v. American Can Co*., 212 USPQ 852 (TTAB 1981) (dictionary definitions -- yes); *Sprague Electric Co. v. Electrical Utilities Co*., 209 USPQ 88 (TTAB 1980) (standard reference works -- yes); *Cities Service Co. v. WMF of America, Inc*., 199 USPQ 493 (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 (TTAB 1975) (food supplements and fortifiers are commonly used in producing bakery products -- yes); and *Bristol-Myers Co. v. Texize Chemicals, Inc*., 168 USPQ 670 (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(d). *See United States National Bank of Oregon v. Midwest Savings and Loan Ass'n*, 194 USPQ 232 (TTAB 1977); *Litton Business Systems, Inc. v. J. G. Furniture Co*., 190 USPQ 431 (TTAB 1976).

2. *See Litton Business Systems, Inc. v. J. G. Furniture Co*., 190 USPQ 431 (TTAB 1976). *See also Wright Line Inc. v. Data Safe Services Corp*., 229 USPQ 769 (TTAB 1985); *Sprague Electric Co. v. Electrical Utilities Co*., 209 USPQ 88 (TTAB 1980).

3. Fed. R. Evid. 201(c). *See 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); *United States National Bank of Oregon v. Midwest Savings and Loan Ass'n*, 194 USPQ 232 (TTAB 1977); and *Litton Business Systems, Inc. v. J. G. Furniture Co*., 190 USPQ 431 (TTAB 1976).

704.12(c) Opportunity to be Heard

A party to a proceeding before the Board is entitled, on timely request, "to an opportunity to be heard as to the propriety of taking judicial notice and the tenor of the matter noticed. In the absence of prior notification, the request may be made after judicial notice has been taken." [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 (TTAB 1976).

2. *See In re Sarkli, Ltd*., 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983). *See also General Mills Fun Group, Inc v. Tuxedo Monopoly, Inc*., 204 USPQ 396 (TTAB 1979), *aff'd*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

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(f); *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); and *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 CFR § 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 CFR § 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.

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 3.] 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.

A testimony deposition 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 CFR § 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), *summ. judgment granted*, 191 USPQ 50 (TTAB 1976); and *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440 (TTAB 1973).

2. *See 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. *See, e.g., 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 CFR § 2.120(j) Initial disclosures and disclosed documents.

(3)(i) *A discovery deposition, an answer to an interrogatory, an admission to a request for admission, or a written disclosure (but not a disclosed document), 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 disclosure, together with a notice of reliance. 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)*

* * * *

(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 (j) 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, has been made of record by one party in accordance with the provisions of paragraph (j)(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 disclosure (but not a disclosed document), which may be offered in evidence under 37 CFR § 2.120(j) 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 CFR § 2.122(e). [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 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 CFR § 2.120(j) 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 CFR § 2.120(j)(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.]

NOTES:

1. 37 CFR § 2.120(j)(3)(i). *See Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1117 (TTAB 2005); *Life Zone Inc. v. Middleman Group Inc*., 87 USPQ2d 1953, 1956 (TTAB 2008).

2. 37 CFR § 2.120(j)(3)(i).

3. 37 CFR § 2.120(j)(3)(ii).

4. *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008); Notice of Final Rulemaking, Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

5. 37 CFR § 2.120(j)(5).

6. 37 CFR § 2.120(j)(6).

7. 37 CFR § 2.120(j)(7).

8. 37 CFR § 2.120(j)(8). *See 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)

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 that the testimony of a witness may be submitted in the form of an affidavit by the witness; 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.] *See* TBMP § 704.07– 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), TBMP § 702.04, and TBMP § 705. 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 and introduction of evidence by affidavit or declaration. [Note 5.] *See also* TBMP § 528.05(a)(2), TBMP § 702.04, and TBMP § 705 for further information about ACR.

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 Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007).

3. *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).

4. *See* 37 CFR § 2.123(b).

5. *See 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); *Eveready Battery Co., Inc. 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); *Ballet Tech Foundation Inc .v. Joyce Theater Foundation Inc.*, 89 USPQ2d 1262, 1265 n.8 (TTAB 2008) (although documents produced in response to document production requests cannot normally be made of record by notice of reliance, the parties stipulated that documents exchanged during discovery are authentic and could be made of record by either party); and *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).

706 Noncomplying Evidence

***37 CFR § 2.123(l)* 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.]

NOTES:

1. 37 CFR § 2.123(l). *See 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); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 948 (TTAB 1983) (neither a recent photocopy of opposer's claimed registration attached to pleading without status and title notation nor introduction during testimony of original certificate of registration without testimony as to status and title is sufficient); *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); and *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 CFR § 2.122(a)* Rules of Evidence.** *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 of Title 37 of the Code of Federal Regulations.

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.

NOTES:

1. 37 CFR § 2.122(a).

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 CFR § 2.120(j), provides for the introduction, by notice of reliance, of a discovery deposition, answer to interrogatory, or admission; 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 CFR § 2.122(e). 37 CFR § 2.122(d)(2), provides for the introduction, by notice of reliance, of a registration owned by a party to a proceeding. 37 CFR § 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) and TBMP § 704.07- 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. [Note 2.] If the objection which 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., 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. *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 Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (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); and *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. [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); and *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).

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); and *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. 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 CFR § 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 thereof, [Note 1] or that 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.

NOTES:

1. *See, e.g., 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 CFR § 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 CFR § 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); and *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., 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).

3. *See 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 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 CFR § 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 [Note 1] the objecting party's brief on the case, 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. *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).

2. *See* 37 CFR § 2.123(k); Fed. R. Civ. P. 32(d)(3)(A).

3. *See 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).

707.03 Objections to Trial Testimony Depositions

707.03(a) In General

As in the case of an objection to a notice of reliance, an objection to a testimony deposition must be raised promptly if the defect is one that can be obviated or removed, failing which it is deemed waived. 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 1.] The objections, which are waived unless promptly raised, are basically procedural in

nature. 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 are basically substantive in nature. The grounds for objection to testimony depositions and the procedures for raising them are discussed below.

NOTES:

1. *See e.g., 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.").

707.03(b) On Procedural Grounds

707.03(b)(1) On Ground of Untimeliness

A party may not take testimony 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 after the close of the deposing party's testimony period, an adverse party may file a motion to strike the deposition, 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. *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, an adverse party that fails to promptly object to the scheduled deposition on the ground of untimeliness may be found to have waived this ground for objection, because the premature scheduling of a deposition is an error which can be corrected on seasonable objection. [Note 2.]

NOTES:

1. 37 CFR § 2.121(a).

2. *See 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 CFR § 2.123(c) ***Notice of examination of witnesses.*** *Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing 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; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. 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.*

* * * *

(e)(3) *Every adverse party shall have full opportunity to cross-examine each witness. 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. 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 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. If the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. [Note 1.] *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 2.] *See* TBMP § 533.02.

A motion to strike a testimony deposition 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 3.]

For further information concerning the motion to strike a testimony deposition for improper or inadequate notice, *see* TBMP § 533.02.

NOTES:

1. 37 CFR § 2.123(c). *Cf.* Fed. R. Civ. P. 30(b)(1).

2. *See* 37 CFR § 2.123(e)(3). *See also 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).

3. 37 CFR § 2.123(e)(3).

707.03(b)(3) On Ground of Failure to Disclose

37 CFR § 2.121(e) *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. …*

37 CFR § 2.123(e)(3) *Every adverse party shall have full opportunity to cross-examine each witness. 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. 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 disclosures and may move to strike the testimony of a witness for lack of proper pretrial disclosure. [Note 1.]

If pretrial disclosures or the notice of examination of witnesses served pursuant to 37 CFR § 2.123(c) 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, must move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. 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 CFR § 2.121(e). [Note 2.]

NOTES:

1. *See* 37 CFR § 2.123(e)(3). *See also* 37 CFR § 2.118; Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007); *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009) (testimony stricken because identity of witness not disclosed prior to trial).

2. 37 CFR § 2.121(e). *See 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.)

707.03(c) On Other Procedural Grounds and on Substantive Grounds

37 CFR § 2.123(e)(3) *Every adverse party shall have full opportunity to cross-examine each witness. 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. 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 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 the 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.*

* * * *

(j) 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.*

(k) Objections to admissibility. *Subject to the provisions of paragraph (j) of this section,*

objection may be made to receiving in evidence any 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 will 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 5 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 a testimony deposition not only on the grounds of untimeliness, *see* TBMP § 707.03(b)(1), and improper or inadequate notice, s*ee* TBMP § 707.03(b)(2), but also on the ground that the deposing party has not complied with one or more of the other

procedural requirements specified in the rules governing the taking of testimony in Board inter partes proceedings. In addition, objection may be made to a testimony deposition 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.

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 CFR § 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 depositions are 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 a deposition, which is the subject of the motion to strike procedure described in 37 CFR § 2.123(e)(3), and TBMP § 533.02 and TBMP § 707.03(b)(2)), generally should not be raised by motion to strike. Rather, the 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 at trial, 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.]

When a deposition is taken on written questions pursuant to 37 CFR § 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 15.] *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. *See* TBMP § 703.02(k).

Because parties that have raised objections to testimony depositions generally will not know the disposition thereof until final decision, they should argue the matters alternatively in their briefs on the case.

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 CFR § 2.123(e)(3) and 37 CFR § 2.123(j); Fed. R. Civ. P. 32(d)(1),(2), and (3)(A) and (B). *See also Hornby v. TJX Companies, Inc*., 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. TBMP § 707.02(b)(2); *Miss Nude Florida, Inc. v. Drost*, 193 USPQ 729, 731 (TTAB 1976), *pet. to Comm'r den*., 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 CFR § 2.123(j). *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 CFR § 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); and *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (Board has discretion to consider improperly marked exhibits).

5. *See* 37 CFR § 2.123(k); 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); and *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. *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. *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., Krause v. Krause Publications Inc*., 76 USPQ2d 1904, 1907 (TTAB 2005) (Board considers substantive objections in evaluating probative value of testimony at final hearing); *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); and *Globe-Union Inc. v. Raven Laboratories Inc*., 180 USPQ 469, 471 n.5 (TTAB 1973) (objection to testimony as lacking foundation deferred).

9. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321 (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); and *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 CFR § 2.123(k).

12. *See Anthony's Pizza & Pasta International, Inc. v. Anthony's Pizza Holding Co., Inc*., 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*, slip. op. 2010-1191 (Fed. Cir. Nov. 18, 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 Corporation 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 Aktiengesellschaft 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 Gesellschaft m.b.H. v. Molnar & Co*., 203 USPQ 861 (TTAB 1979); and *Copperweld Corp. v. Astralloy-Vulcan Corp*., 196 USPQ 585 (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.").

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).

15. *See* 37 CFR § 2.124(d)(1).

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, 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 § 404.02 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 nonparty residing in the United States, TBMP § 404.08(c) (Objections During Deposition), TBMP § 404.09 (Discovery Depositions Compared to Testimony Depositions), TBMP § 411.03 (Remedy for Failure to Provide Disclosures or Discovery), and TBMP § 523 (Motion to Compel Disclosures or Discovery).

NOTES:

1. *See 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 (TTAB 1990); *Seligman & Latz, Inc. v. Merit Mercantile Corp*., 222 USPQ 720 (TTAB 1984); *Ferro Corp. v. SCM Corp*., 219 USPQ 346 (TTAB 1983); *Entex Industries, Inc. v. Milton Bradley Co*., 213 USPQ 1116 (TTAB 1982); *Data Packaging Corp. v. Morning Star, Inc*., 212 USPQ 109 (TTAB 1981); *Donut Shops Management Corp. v. Mace*, 209 USPQ 615 (TTAB 1981); *S. Rudofker's Sons, Inc. v. "42" Products, Ltd*., 161 USPQ 499 (TTAB 1969); and *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 (CCPA 1965). *But see 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, 510 (Fed. Cir. 1983).

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 a testimony deposition, 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).

If testimony is submitted in affidavit form by stipulation of the parties pursuant to 37 CFR § 2.123(b), any objection, which is waived if not made at deposition, must be raised promptly after receipt of the affidavit submission, failing which it is waived. [Note 3.]

If a party fails to attend a testimony deposition, any objection, which is waived if not made at the deposition, is waived. [Note 4.]

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 5.] *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 6.]

NOTES:

1. *See* 37 CFR § 2.123(e)(3), 37 CFR § 2.123(j), and 37 CFR § 2.123(k); and Fed. R. Civ. P. 32(d)(1),(2), and (3)(A) and (B). *See e.g. Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1603, n.3 (TTAB 2010).

2. *See Hornby v. TJX Companies, Inc*., 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 authentication testimony in testimonial deposition).

3. *See Chase Manhattan Bank, N.A. v. Life Care Services Corp*., 227 USPQ 389 (TTAB 1985).

4. *See* Notice of Final Rulemaking, 48 Fed. Reg. 23122, 23132 (May 23, 1983); *Wright Line Inc. v. Data Safe Services Corp*., 229 USPQ 769 (TTAB 1985); and *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845 (TTAB 1984).

5. *See also Anthony's Pizza & Pasta International, Inc. v. Anthony's Pizza Holding Co., Inc*., 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*, slip. op. 2010-1191 (Fed. Cir. Nov. 18, 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 Aktiengesellschaft 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 Gesellschaft m.b.H. v. Molnar & Co*., 203 USPQ 861 (TTAB 1979); and *Copperweld Corp. v. Astralloy-Vulcan Corp*., 196 USPQ 585 (TTAB 1977).

6. *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.").

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.

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) (Exhibits to Briefs) and TBMP § 704.06(b) (Statements in Briefs). 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.]

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, 2022-2023 (TTAB 1998) (submission of duplicative papers is a waste of time and resources, and is a burden on the Board).

2. *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).

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.]

However, 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.]

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 (Motion to Strike Brief on Case). 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) (Time for Filing – Special Situations).

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 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 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). *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 2.] *See* TBMP § 1007 (Interferences – Conduct of Proceeding) and TBMP § 1109 (Concurrent Use Proceedings – Conduct of Proceeding).

NOTES:

1. 37 CFR § 2.128(a)(2).

2. 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 (Form of Submissions).

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. *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).

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 *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 UPSQ2d 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. *In re Carlson,* 91 USPQ2d 1198, 1199 n.2 (TTAB 2009).

7. *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. Haggar 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 (Statements in Pleadings or Briefs) and TBMP § 801.01 (Briefs on the Case – In General).

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 are almost exclusively held at the offices of the Board. However, parties may request attendance at the hearings remotely via video conference. 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 Board may, in its discretion, use an augmented panel to hear a case. 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. [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 (Fed. Cir. 1994).

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). Note that judges no longer provide a handwritten signature on decisions.

2. *See 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, e.g., 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 (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 (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*, 230 USPQ 36 (TTAB 1986), *recon. denied*, 1 USPQ2d 1304, 1305 (TTAB 1986) (case not appropriate for designation of more than three-member panel).

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 (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 some time 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 (Fed. Cir. 1994).

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 web site 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 (Motion to Remand Application to Examining Attorney). *Cf.* TBMP § 1217 (Final Decision).

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.

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 (Final Decision Remand to Examining Attorney).

(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 (Final Decision Remand to Examining Attorney).

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.]

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).

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)(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)(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 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(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.*

* * * *

***37 CFR § 2.145* Appeal to court and civil action.**

(a) Appeal to U.S. Court of Appeals for the Federal Circuit. *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 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 U.S. Court of Appeals for the Federal Circuit. ...

* * * *

(c) *Civil Action.*

(1) *Any person who may appeal to the U.S. 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. Such civil action must be commenced within the time specified in paragraph (d) of this section.*

(2) *Any applicant or registrant in an ex parte case who takes an appeal to the U.S. Court of Appeals for the Federal Circuit waives any right to proceed under section 21(b) of the Act.*

(3) *Any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding may file a notice with the Office, addressed to the Office of General Counsel, according to part 104 of this chapter, within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in section 21(b) of the Act. The notice of election must be served as provided in § 2.119.*

* * * *

(d) *Time for appeal or civil action.*

(1) *The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (b) of this section), or for commencing a civil action (paragraph (c) of this section), is two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, as the case may be. If a request for rehearing or reconsideration or modification of the 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 two months after action on the request. In inter partes cases, the time for filing a cross-action or a notice of a cross-appeal expires (i) 14 days after service of the notice of appeal or the summons and complaint; or (ii) two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

(2) *The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, 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.*

(3) *If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under section 21(a)(1) of the Act electing to have all further proceedings conducted under section 21(b) of the Act, the time for*

filing a civil action thereafter is specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.

* * * *

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. 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 1.]

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 2.] 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 3.]

The Federal Circuit is often referred to in Board decisions as "our primary reviewing court." [Note 4.]

NOTES:

1. Trademark Act § 21, 15 U.S.C. § 1071; 37 CFR § 2.145. *See CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1458 (7th Cir. 2001) (choice of appealing to Federal Circuit on closed record of Board proceedings or a federal district court with the option of presenting additional evidence and raising additional claims); *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); and *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).

2. Trademark Act § 21(a)(1), 15 U.S.C. § 1071(a)(1); 37 CFR § 2.145(c)(3).

3. Trademark Act § 21(a)(1), 15 U.S.C. § 1071(a)(1); 37 CFR § 2.145(d)(3).

4. *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 may not be used as a substitute for the appeal procedure specified in Trademark Act § 21, 15 U.S.C. § 1071. [Note 9.]

NOTES:

1. *See 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"); *Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel*, 1 USPQ2d 1424, 1427 (Comm'r 1986).

2. *See Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1565 (Fed. Cir. 1989) (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); *Hewlett Packard v. Vudu, Inc.,* 92 USPQ2d 1630, 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.*, 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) (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); and *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.*, *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); and *Williams v. Five Platters, Inc.*, 181 USPQ 409 (TTAB 1970), *aff'd*, 510 F.2d 963, 184 USPQ 744, 745 (CCPA 1975) (decision denying petitioner's Fed. R. Civ. P. 60(b) motion to vacate earlier decision granting respondent's uncontested motion for summary judgment was reviewable).

4. *See 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) (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 and 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, *Alltrade Inc. v. Uniweld Products Inc.,* 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991).

7. *See Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358 (TTAB 1978), *aff'd,* 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).

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 CFR § 2.129(d). *See also 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 CFR § 2.129(d). *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544-45 (TTAB 1991).

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 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 CFR § 2.145 Appeal to court and civil action.

(a) *Appeal to U.S. Court of Appeals for the Federal Circuit. 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 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 U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal:*

(1) *In the Patent and Trademark Office give written notice of appeal to the Director (see paragraphs (b) and (d) of this section);*

(2) *In the court, file a copy of the notice of appeal and pay the fee for appeal, as provided by the rules of the Court.*

(b) Notice of appeal. *(1) When an appeal is taken to the U.S. Court of Appeals for the Federal*

Circuit, the appellant shall give notice thereof in writing to the Director, which notice shall be filed in the Patent and Trademark Office, within the time specified in paragraph (d) of this section. The notice shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.

(2) *In inter partes proceedings, the notice must be served as provided in § 2.119.*

(3) *Notices of appeal directed to the Director shall be mailed to or served by hand on the General Counsel according to part 104 of this chapter, with a duplicate copy mailed or served by hand on the Trademark Trial and Appeal Board.*

37 CFR § 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.

(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 CFR § 2.145(d). [Note 2.] *See* TBMP § 902.02. The certificate of mailing and certificate of transmission procedures described in 37 CFR § 2.197, and the "Express Mail" procedure described in 37 CFR § 2.198, are available for filing a notice of appeal. 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 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 CFR § 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.]

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 in the USPTO, the filing date of a notice of appeal, and the address to be used on a notice of appeal mailed to the USPTO, *see* 37 CFR § 2.190, 37 CFR § 2.195, 37 CFR § 2.197, 37 CFR § 2.198, and 37 CFR § 2.145(b)(3).

For further information concerning how to file a notice of appeal, contact the Office of the Solicitor in the USPTO at (571) 272-9035.

Three copies of the notice of appeal must be filed in the Court of Appeals for the Federal Circuit and the appeal fee required by the rules of the Court must be paid to the Court. Please Note: while 37 CFR § 2.145(a) requires the filing of only one copy of the notice with the Federal Circuit, Fed. Cir. R. 15(a)(1) requires that three copies of the notice be filed with 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.]

NOTES:

1. 37 CFR § 2.145(a) and 37 CFR § 2.145(b); Fed. Cir. R. 15. (The Federal Circuit Rules and Forms can be found on the Court's website at: www.cafc.uscourts.gov.).

2. Trademark Act § 21(a)(2), 15 U.S.C. § 1071(a)(2); 37 CFR § 2.145(a) and 37 CFR § 2.145(b)(1).

3. 37 CFR § 2.145(b)(1).

4. 37 CFR § 2.145(b)(1).

5. *See* 37 CFR § 2.145(b)(2).

6. *See* 37 CFR § 104.2.

7. *See* 37 CFR § 2.145(a).

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 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 CFR § 2.145(d) ***Time for appeal or civil action.***

(1) *The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (b) of this section), or for commencing a civil action (paragraph (c) of this section), is two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, as the case may be. If a request for rehearing or reconsideration or modification of the 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 two months after action on the request. In inter partes cases, the time for filing a cross-action or a notice of a cross-appeal expires (i) 14 days after service of the notice of appeal or the summons and complaint; or (ii) two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

(2) *The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, 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.*

(3) *If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under section 21(a)(1) of the Act electing to have all further proceedings conducted under section 21(b) of the Act, the time for filing a civil action thereafter is specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.*

***37 CFR § 2.145(e)* Extensions of time to commence judicial review.** *The Director may extend the time for filing an appeal or commencing a civil action (1) for good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or (2) upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.*

The time for filing a notice of appeal to the United States Court of Appeals for the Federal Circuit ("Federal Circuit") is two months from the date of the Board decision which is the subject of the appeal. [Note 1.] When the two-month period includes February 28, an additional day is added. [Note 2.] Likewise, 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 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 filing an appeal 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 CFR § 2.127(b), 37 CFR § 2.129(c), or 37 CFR § 2.144, or within any extension of time granted thereunder, the time for filing an appeal expires two months after action on the request. [Note 5.] When the two-month period includes February 28, an additional day is added. [Note 6.] Likewise, 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 7.] 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) two months from the date of the Board decision which is the subject of the appeal, whichever is later. [Note 8.]

The certificate of mailing and certificate of transmission procedures described in 37 CFR § 2.197, and the "Express Mail" procedure described in 37 CFR § 2.198, are available for filing a notice of appeal or a notice of cross-appeal.

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 9.] A request for an extension of time to file an appeal should be directed to the attention of the Office of the Solicitor at the following address:

Office of the Solicitor
Mail Stop 8
U.S. Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450.

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 10.]

An appellant that has received an order to show cause from the clerk of the Federal Circuit may file a request under 37 CFR § 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 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 CFR § 2.145(d)(1).

2. 37 CFR § 2.129(d)(2).

3. 37 CFR § 2.129(d)(2).

4. 37 CFR § 2.129(d); *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).

5. 37 CFR § 2.145(d)(1).

6. 37 CFR § 2.129(d)(2).

7. 37 CFR § 2.129(d)(2).

8. 37 CFR § 2.145(d)(1).

9. 37 CFR § 2.145(e).

10. *See* Fed. Cir. R. 15(b)(1)(B).

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. *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 CFR § 2.145(c)(2) (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).

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 CFR § 2.145(c)(3) *Any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding may file a notice with the Office, addressed to the Office of the General Counsel, according to part 104 of this chapter, within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in section 21(b) of the Act. The notice of election must be served as provided in § 2.119.*

* * * *

(d)(3) *If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under section 21(a)(1) of the Act electing to have all further proceedings conducted under section 21(b) of the Act, the time for filing a civil action thereafter is specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.*

* * * *

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 USPTO 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 USPTO, 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 and certificate of transmission procedures described in 37 CFR § 2.197, and the "Express Mail" procedure described in 37 CFR § 2.198, are available for filing a notice of election. A copy of the notice must be served on every other party to the proceeding, in the manner prescribed in 37 CFR § 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 CFR § 2.145(c)(3).

2. 37 CFR § 2.145(c)(3).

3. Fed. Cir. R. 15(e).

4. Trademark Act § 21(a)(1), 15 U.S.C. § 1071(a)(1); 37 CFR § 2.145(d)(3).

5. 37 CFR § 2.145(d)(3).

902.05 Information Concerning Times Specified In 37 CFR § 2.145

37 CFR § 2.145(d)(2) *The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, 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 37 CFR § 2.145 (which concerns appeals and civil actions seeking review of Board decisions), the times specified in days are calendar days, while the times specified in months are calendar months (except that one day is added to any two-month period which includes February 28). 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 CFR § 2.145(d)(2).

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 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 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 mails a copy of the certified list to every party to the proceeding. [Note 2.]

When the Federal Circuit receives the notice of appeal and the certified list, the Court dockets the appeal, and gives notice to all parties of the date of docketing. [Note 3.] The appellant's time in which to file its initial brief runs from the date of service of the certified list or the date of docketing the appeal, whichever is later. Because an appeal is not docketed until after the certified list is served in appeals from Board decisions, the appellant's time for filing its brief normally runs from the date of docketing. [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)(1).

4. Fed. Cir. R. 31(a).

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 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 CFR § 2.145(c)(2) *Any applicant or registrant in an ex parte case who takes an appeal to the U.S. 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 CFR § 2.145(c)(2).

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 Appeal By Civil Action

903.01 Notice Of Civil Action

37 CFR § 2.145(c)(4) *In order to avoid premature termination of a proceeding, a party who commences a civil action, pursuant to section 21(b) of the Act, must file written notice thereof at the Trademark Trial and Appeal Board.*

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 within one month after the expiration of the time for appeal or civil action. 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.

NOTES:

1. *See* 37 CFR § 2.145(c)(4).

903.02 Parties To And Service Of Civil Action

Trademark Act § 21(b), 15 U.S.C. § 1071(b)

* * * *

(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 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 Director (who is a party to the proceeding). [Note 3.] 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." [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).

4. *See* 37 CFR § 104.2.

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 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 be 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 District of Columbia 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 District of Columbia 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 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) *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); *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).

Cf. 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 CFR § 2.145(d)* Time for appeal or civil action.**

(1) *The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (b) of this section), or for commencing a civil action (paragraph (c) of this section), is two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, as the case may be. If a request for rehearing or reconsideration or modification of the 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 two months after action on the request. In inter partes cases, the time for filing a cross-action or a notice of a cross-appeal expires (i) 14 days after service of the notice of appeal or the summons and complaint; or (ii) two months from the date of the decision of the Trademark Trial and Appeal Board or the Director, whichever is later.*

(2) *The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, 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.*

* * * *

(*e*) *Extensions of time to commence judicial review. The Director may extend the time for filing an appeal or commencing a civil action (1) for good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or (2) upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.*

The time for commencing a civil action under Trademark Act § 21(b), 15 U.S.C. § 1071(b), is two months from the date of the Board decision of which review is sought. [Note 1.] When the two-month period includes February 28, an additional day is added. [Note 2.] Likewise, 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 3.] A civil action is commenced by the filing of a complaint with the court. [Note 4.] 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 5.]

If a request for rehearing, reconsideration, or modification of the Board's decision is filed within the time specified in 37 CFR § 2.127(b), 37 CFR § 2.129(c), or 37 CFR § 2.144, or within any extension of time granted thereunder, the time for commencing a civil action expires two months after action on the request. [Note 6.] When the two-month period includes February 28, an additional day is added. [Note 7.] Likewise, 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 8.] 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) two months from the date of the Board decision which is the subject of the civil action, whichever is later. [Note 9.]

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 10.] A request for an extension of time to file an appeal should be directed to the attention of the Office of the Solicitor at the following address:

Office of the Solicitor
Mail Stop 8
U.S. Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450.

NOTES:

1. Trademark Act § 21(b)(1), 15 U.S.C. §1071(b)(1); 37 CFR § 2.145(d)(1).

2. 37 CFR § 2.145(d)(2).

3. 37 CFR § 2.145(d)(2).

4. Fed. R. Civ. P. 3.

5. 37 CFR § 2.129(d); *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).

6. 37 CFR § 2.145(d)(1).

7. 37 CFR § 2.145(d)(2).

8. 37 CFR § 2.145(d)(2).

9. 37 CFR § 2.145(d)(1).

10. 37 CFR § 2.145(e).

903.05 Information Concerning Times Specified In 37 CFR § 2.145

37 CFR § 2.145(d)(2) *The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, 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 37 CFR § 2.145 (which concerns appeals and civil actions seeking review of Board decisions), the times specified in days are calendar days, while the times specified in months are calendar months (except that one day is added to any two-month period which includes February 28). 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 CFR § 2.145(d)(2).

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.

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 CFR § 2.145(c)(2) (applicant in ex parte case which takes an appeal to the Federal Circuit waives any right to proceed under Trademark Act § 21(b)).

903.07 Special Provisions For Ex Parte Cases

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 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 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 pursuant to Fed. R. Civ. P. 4(i), and all the expenses, including expert witness fees and travel, of the proceeding 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.]

NOTES:

1. Trademark Act § 21(b)(3), 15 U.S.C. § 1071(b)(3).

904 Access To Record During Appeal

904.01 Access During Appeal To Federal Circuit

During an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board in an inter partes case, the USPTO will retain the record of the case. However, when it deems necessary, the Federal Circuit may, on motion or sua sponte, order transmission (via the Office of the Solicitor) of the original or certified copies of the record, or portions thereof, or the physical exhibits, at any time during the pendency of the appeal. [Note 1.]

During an appeal to the Federal Circuit from a decision of the Board in an ex parte case, the subject application file is retained by the USPTO.

Nonconfidential papers 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. You may call the Board to arrange for inspection of older, non-confidential Board files. 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 Appeal By Civil Action

During a civil action seeking review of a decision of the Board in an inter partes case, the Board retains the original USPTO record of the case. The Board will release the original record for submission (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.

Nonconfidential papers 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. You may call the Board to arrange for inspection of older, non-confidential TTAB files. 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 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.

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 CFR § 2.146* Petitions to the Director.**

(a) *Petition may be taken to the Director: (1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by § 2.63(b); (2) in any case for which the Act of 1946, or Title 35 of the United States Code, or this Part 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 this Part of Title 37 of the Code of Federal Regulations; (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 §§ 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 affidavits or declarations in accordance with §2.20, signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.*

(d) *A petition must be filed within two months of the mailing date of the action from which relief is requested, unless a different deadline is specified elsewhere in this chapter.*

(e)(1) *A petition from the grant or denial of a request for an extension of time to file a notice of opposition shall be filed within fifteen days from the date of mailing of the denial of the request. A petition from the grant of a request shall 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 shall 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(a). The potential opposer or the applicant, as the case may be, may file a response within fifteen days from 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(a). No further paper relating to the petition shall be filed.*

(2) *A petition from an interlocutory order of the Trademark Trial and Appeal Board shall be filed within thirty days after the date of mailing of the order from which relief is requested. Any brief in response to the petition shall be filed, with any supporting exhibits, within fifteen days from the date of service of the petition. Petitions and responses to petitions, and any papers accompanying a petition or response, under this subsection shall be served on every adverse party pursuant to § 2.119(a).*

(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.*

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).

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 within 30 days after the mailing 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, within 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 papers accompanying a petition or response, must be served on every adverse party in the manner prescribed in 37 CFR § 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 CFR § 2.146(e)(1), and TBMP § 211.03.

A petition on any matter not otherwise specifically provided for must be filed within two months from the mailing 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 CFR § 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 affidavits or declarations in accordance with 37 CFR § 2.20, 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 CFR § 2.146. *Cf.* TMEP Chapter 1700.

NOTES:

1. *See* 37 CFR § 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); and *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 CFR § 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 CFR § 2.146(e)(2).

3. 37 CFR § 2.146(d).

4. 37 CFR § 2.146(g). *Se 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 CFR § 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 CFR § 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 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 raise additional claims. [Note 2.]

Questions of fact. The district court sits as the appellate reviewer of facts found by the Board and as the fact-finder with respect to new evidence and additional claims. [Note 3.] Both the Federal Circuit and the district court, in reviewing factual findings, will afford deference to those fact-findings. [Note 4.]

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 5.] 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 6.]

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 7.] 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 8.] A number of circuit courts of appeals have also indicated that "substantial evidence" review is appropriate. [Note 9.]

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 10.] 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 11.] 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 12.] 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 13.] "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 14.]

Examples of findings of fact include abandonment [Note 15]; functionality [Note 16]; descriptiveness [Note 17]; and whether trade dress is product design. [Note 18.]

Conclusions of law. While the Board's findings of fact are reviewed for substantial evidence, conclusions of law are reviewed de novo. [Note 19.]

Examples of legal conclusions that receive de novo review include whether the Board properly granted summary judgment or a motion to dismiss. [Note 20.] The U.S. Court of Appeals for the Federal Circuit treats the issue of likelihood of confusion as a question of law, based on underlying factual determinations. [Note 21.]

The Board's interpretations of the Lanham 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 22.] "Substantial deference" is given to the USPTO's interpretation of its own regulations. [Note 23.]

NOTES:

1. Trademark Act § 21(a)(4), 15 U.S.C. § 1071(a)(4).

2. *See 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).

3. *See CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1458 (7th Cir. 2001).

4. *See CAE Inc. v. Clean Air Engineering Inc.*, 267 F.3d 660, 60 USPQ2d 1449, 1458 (7th Cir. 2001).

5. *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).

6. *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1936 (TTAB 1999) (rejecting the argument that the "two paths" for review would create "an anomaly" in the standard of review). *See 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), *and aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009).

7. 5 U.S.C. §§ 706(2)(A) and (E). *See In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1773 (Fed. Cir. 2000).

8. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000). *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.").

9. *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).

10. *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."); *Dickinson v. Zurko*, 527 U.S. 150, 165, 50 USPQ2d 1930 (1999).

11. *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).

12. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000).

13. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1773, 1775 (Fed. Cir. 2000), *quoting Consolo v. Federal Maritime Comm'n*, 383 U.S. 607, 620 (1966).

14. *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).

15. *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).

16. *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002) (functionality is a question of fact).

17. *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.").

18. *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).

19. *On-line Careline Inc. v. America Online Inc*., 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Glendale Int'l. Corp. v. USPTO*, 374 F. Supp. 2d 479, 75 USPQ2d 1139, 1143 (E.D. Va. 2005).

20. *See 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).

21. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (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).

22. *See ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 159, 82 USPQ2d 1414 (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); *Int'l Bancorp, LLC, et al. v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco,* 329 F.3d 359, 66 USPQ2d 1705 (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).

23. *See Custom Computer Services Inc. v. Paychex Properties Inc.*, 337 F.3d 1334, 67 USPQ2d 1638, 1639 (Fed. Cir. 2003).

906.02 Petition To Director

In reviewing non-final rulings of the Board, the Director will exercise supervisory authority under 37 CFR § 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. Paolo Bodo*, 21 USPQ2d 1899 (Comm'r 1990).

CHAPTER 1000
INTERFERENCES

1001 IN GENERAL

1002 DECLARATION OF INTERFERENCE

1003 INSTITUTION OF INTERFERENCE

1004 ISSUES IN INTERFERENCE

1005 BURDEN OF PROOF

1006 ADDITION OF PARTY

1007 CONDUCT OF PROCEEDING

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 CFR § 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 CFR § 2.91 Declaration of interference.

(a) *An interference will not be declared between two applications or between an application and a registration except upon petition to the Director. Interferences will be declared by the Director only upon a showing of extraordinary circumstances which would result in a party being unduly prejudiced without an interference. In ordinary circumstances, the availability of an opposition or cancellation proceeding to the party will be deemed to remove any undue prejudice.*

(b) *Registrations and applications to register on the Supplemental Register, registrations under the Act of 1920, and registrations of marks the right to use of which has become incontestable are not subject to interference.*

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 CFR § 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 and Trademark Act § 18, 15 U.S.C. § 1066 and 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 CFR § 2.83; TMEP § 1208.03 *et seq.* and TMEP §1507.

3. 37 CFR § 2.83; TMEP § 1208.02(c).

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

1002 Declaration of Interference

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 CFR § 2.91 ***Declaration of interference.***

(a) *An interference will not be declared between two applications or between an application and a registration except upon petition to the Director. Interferences will be declared by the Director only upon a showing of extraordinary circumstances which would result in a party being unduly prejudiced without an interference. In ordinary circumstances, the availability of an opposition or cancellation proceeding to the party will be deemed to remove any undue*

prejudice.

(b) *Registrations and applications to register on the Supplemental Register, registrations under the Act of 1920, and registrations of marks the right to use of which has become incontestable are not subject to interference.*

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.] However, a petition to the Director to declare an interference has been granted where, but for the interference, multiple oppositions would be 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 separate paper bearing the title "PETITION TO THE DIRECTOR," and be accompanied by the fee specified in 37 CFR § 2.6. For further information concerning the form for a petition to the Director, *see* 37 CFR § 2.146(c), TMEP § 1208.03 and TBMP § 905.

A petition to declare an interference should not be filed in an application until the trademark 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 examining attorney will immediately forward the petition, together with the application file, to the Office of the Commissioner for Trademarks for determination of the petition. [Note 7.]

NOTES:

1. 37 CFR § 2.91(a). *See also In re Ratny*, 24 USPQ2d 1713, 1715 (Comm'r 1992); *In re Kimbell Foods, Inc.*, 184 USPQ 172, 173 (Comm'r 1974); *In re Family Inns of America, Inc.*,

180 USPQ 332, 332 (Comm'r 1974).

2. 37 CFR § 2.91(a). *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 and 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, and 15 U.S.C. § 1051; 37 CFR § 2.91(b).

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* 37 CFR § 2.96; *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); *Cudahy Packing Co. v. York Pharmacal Co.*, 93 USPQ 227, 228 (Comm'r 1952).

7. *See* TMEP § 1208.03.

1003 Institution of Interference

***37 CFR § 2.92* Preliminary to interference.** *An interference which has been declared by the Director will not be instituted by the Trademark Trial and Appeal Board until the Examiner of Trademarks has determined that the marks which are to form the subject matter of the controversy are registrable, and all of the marks have been published in the Official Gazette for opposition.*

***37 CFR § 2.93* Institution of interference.** *An interference is instituted by the mailing of a notice of interference to the parties. The notice shall be sent to each applicant, in care of the applicant's attorney or other representative of record, if any, and if one of the parties is a registrant, the notice shall be sent to the registrant or the registrant's assignee of record. The notice shall give the name and address of every adverse party and of the adverse party's attorney or other authorized representative, if any, together with the serial number and date of filing and publication of each of the applications, or the registration number and date of issuance of each of the registrations, involved.*

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 trademark 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 trademark 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 the notice of interference to the parties. The notice is mailed 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 to the registrant or its assignee of record. [Note 5.]

There are no pleadings in an interference proceeding. *Cf.* TBMP § 1004 (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 6.]

NOTES:

1. *See* 37 CFR § 2.92; TMEP § 1208.03(c).

2. *Cf.* 37 CFR § 2.99(c).

3. 37 CFR § 2.93.

4. 37 CFR § 2.93.

5. *See* 37 CFR § 2.93.

6. *See* 37 CFR § 2.6.

1004 Issues in Interference

***37 CFR § 2.96* Issue; burden of proof.** *The issue in an interference between applications is normally priority of use, but the rights of the parties to registration may also be determined. ... The issue in an interference between an application and a registration shall be the same, but in the event the final decision is adverse to the registrant, a registration to the applicant will not be authorized so long as the interfering registration remains on the register.*

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; 37 CFR § 2.96; *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 (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); and Rules of Practice in Trademark Cases, Final Rule, 48 Fed. Reg. 23122 (May 23, 1983), (deleting former 37 CFR § 2.97, which contained a requirement for an affirmative pleading of registrability issues).

1005 Burden of Proof

***37 CFR § 2.96* Issue; burden of proof.** *... The party whose application involved in the interference has the latest filing date is the junior party and has the burden of proof. When there are more than two parties to an interference, a party shall be a junior party to and shall have the burden of proof as against every other party whose application involved in the interference 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 will be deemed to have the latest filing date and that applicant will be the junior party. ...*

37 CFR § 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.]

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. 37 CFR § 2.96.

2. 37 CFR § 2.96 and 37 CFR § 2.116(b). *See also Jim Dandy Co. v. Martha White Foods, Inc.*, 458 F.2d 1397, 173 USPQ 673 (CCPA 1972); *McNeil v. Mini Mansions, Inc.*, 178 USPQ 312 (TTAB 1973).

1006 Addition of Party

37 CFR § 2.98 ***Adding party to interference.*** *A party may be added to an interference only upon petition to the Director by that party. If an application which is or might be the subject of a petition for addition to an interference is not added, the examiner may suspend action on the application pending termination of the interference proceeding.*

A party may be added to an interference only upon petition to the Director filed, pursuant to 37 CFR § 2.98, 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) and TBMP § 1003 (Institution); TBMP § 1003 and 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 CFR § 2.107 and 37 CFR § 2.115.

2. *See, e.g.*, *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1662 n.2 (TTAB 1998) (parties stipulated that evidence submitted in connection with summary judgment motion be deemed of record for trial). *See also Eveready Battery Co., Inc. v. Green Planet, Inc.*, 91 USPQ2d 1511 (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)).

3. 37 CFR § 2.121(e).

CHAPTER 1100
CONCURRENT USE PROCEEDINGS

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1101 In General

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.*

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. …*

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. Restrictions are generally to claimed geographic areas of use. [Note 1.]

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 concurrent use proceedings commenced on or after November 1, 2007, the Board has adopted a modified disclosure and conferencing regime. [Note 6.] For further information regarding disclosures and discovery conferences, *see* TBMP § 401.

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 CFR § 2.133(c); *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 . . ."); *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); *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); and *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); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc*., 227 USPQ 879, 882 (TTAB 1985).

4. *See 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 it 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).

6. Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244-7 (August 1, 2007).

1101.02 Context for USPTO Determination of Concurrent Rights

37 CFR § 2.99(h) *The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.*

37 CFR § 2.133(c) *Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.*

Within the U.S. Patent and Trademark Office ("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 CFR § 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 CFR § 2.99(h) and 37 CFR § 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*., 220 USPQ 52 (TTAB 1983), *aff'd*, 737 F.2d 1576, 222 USPQ 665, 669 (Fed. Cir. 1984) (attempt to interject concurrent use proceeding into cancellation unavailing); *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); and *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 (Comm'r 1984).

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).

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 (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 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 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 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 Inland Oil & Transport Co. v. IOT Corp.*, 197 USPQ 562 (TTAB 1977); *Hollowform, Inc. v. Delma Aeh*, 180 USPQ 284 (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 CFR § 2.42; and TMEP § 1207.04.

3. *See* 37 CFR § 2.42.

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, the registration sought, if otherwise appropriate, will be issued based on the court determination, without any concurrent use proceeding before the Board. [Note 5.] 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 CFR § 2.99(f); *Holiday Inn v. Holiday Inns, Inc*., 534 F.2d 312, 189 USPQ 630 (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 (CCPA 1961) (court ordered restricted registration); *In re Alfred Dunhill Ltd*., 4 USPQ2d 1383 (Comm'r 1987); and *In re Forbo*, 4 USPQ2d 1415 (Comm'r 1984).

2. *See In re Home Federal Savings & Loan Ass'n*., 213 USPQ 68, 69 (TTAB 1982).

3. *See* 37 CFR § 2.42.

4. *Cf*. 37 CFR § 2.99(f).

5. *See* 37 CFR § 2.99(f).

1103 Requirements for Concurrent Use Application

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.*

* * * *

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 CFR § 2.42 ***Concurrent use.*** *An application for registration as a lawful concurrent user shall specify and contain all the elements required by the preceding sections. The applicant in addition shall state in the application the area, the goods, and the mode of use for which applicant seeks registration; and also shall state, to the extent of 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 areas of such use; the goods on or in connection with which such use is made; the mode of such use; and the periods of such use.*

37 CFR § 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 CFR § 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 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). The notification 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 notification may be transmitted via e-mail.*

(d)(1) *Within ten days from the date of the Board's notification, the applicant for concurrent use registration must serve copies of its application, specimens and drawing on each applicant, registrant or user specified as a concurrent user in the application for registration, as directed by the Board. If any service copy is returned to the concurrent use applicant as undeliverable, the concurrent use applicant must notify the Board within ten days of receipt of the returned copy.*

(2) *An answer to the notice is not required in the case of an applicant or registrant whose application or registration is specified as a concurrent user in the 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 specified user from claiming any right more extensive than that acknowledged in the application(s) for concurrent use registration, but the applicant(s) will remain with the burden of proving entitlement to registration(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 examiner; 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) state the geographic area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration of the mark [Note 3];

(4) 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 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. Within ten days from the date the Board notifies the excepted users (applicant, registrant or common law user) of the institution of the proceeding, the concurrent use applicant must serve copies of its application, specimens and drawing on each excepted user (applicant, registrant or common law user) specified in the application as a concurrent user. [Note 6.]

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 CFR § 2.99(g).

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

3. *See* 37 CFR § 2.42. *See also* Trademark Act § 1(a)(3)(D), 15 U.S.C. § 1051(a)(3)(D).

4. *See* 37 CFR § 2.42.

5. *See* 37 CFR §§ 2.32-2.41.

6. *See* 37 CFR § 2.99(b). *Cf.* 37 CFR § 2.99(c).

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 CFR § 2.76 or 37 CFR § 2.88 has been filed in the application. [Note 4.]

Applications based solely on Trademark Act § 44, 15 U.S.C. § 1126 or 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 CFR § 2.76 or 37 CFR § 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.]

NOTES:

1. Trademark Act § 2(d), 15 U.S.C. § 1052(d). *See* 37 CFR § 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."); *Fleming Companies v. Thriftway Inc*., 21 USPQ2d 1451 (TTAB 1991), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551, 1553 (S.D. Ohio 1992) (use must be lawful).

2. TMEP § 1207.04(b).

3. *See* 37 CFR § 2.99(g); TMEP § 1207.04(b).

4. *See* 37 CFR § 2.73.

5. 37 CFR § 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 CFR § 2.73.

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 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); *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); *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*., 21 USPQ 1451 (TTAB 1991), *aff'd*, 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); *Morgan Services Inc. v. Morgan Linen Services Inc*., 12 USPQ2d 1841 (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); and *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 CFR §§ 2.32-2.41. *See also DataNational Corp. v. BellSouth Corp*., 18 USPQ2d 1862, 1866 (TTAB 1991), *aff'd*, 60 F.3d 1565, 35 USPQ2d 1554 (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 does not function as a mark in non-territory); *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); and *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).

1103.01(d) Application Must Identify Nature and Extent of Restriction Sought

1103.01(d)(1) In General

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 CFR § 2.42 ***Concurrent use****. An application for registration as a lawful concurrent user shall specify and contain all the elements required by the preceding sections. The applicant in addition shall state in the application the area, the goods, 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 areas of such use; the goods on or in connection with which such use is made; the mode of such use; and the periods of such use.*

The applicant must state in the application 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 provide, 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. 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 CFR § 2.42. *See also* Trademark Act § 1(a), 15 U.S.C. § 1051(a)(3)(D).

2. *See* 37 CFR § 2.99(d)(1) and 37 CFR § 2.99(d)(3); *In re Wells Fargo & Co*., 231 USPQ 95 (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); *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); *Fleming Companies v. Thriftway Inc*., 21 USPQ 1451 (TTAB 1991), *aff'd,* 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); *DataNational Corp. v. BellSouth Corp*., 18 USPQ2d 1862, 1866 (TTAB 1991), *aff'd,* 60 F.3d 1565, 35 USPQ2d 1554 (Fed. Cir. 1995); and *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); and *Zimmerman v. Holiday Inns of America, Inc*., 123 USPQ 86 (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); *Pinocchio's Pizza Inc. v. Sandra Inc*., 11 USPQ2d 1227, 1228 (TTAB 1989). *Cf. Newsday, Inc. v. Paddock Publications, Inc*., 223 USPQ 1305, 1307-8 (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 (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 (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 (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 (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 Int'l 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); and *Alfred*

Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc., 293 F.2d 685, 130 USPQ 412 (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 (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 CFR § 2.42. *See also* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007) ("The amended trademark rules continue the requirement that the concurrent use applicant provide correspondence address information for excepted parties.").

2. *See* 37 CFR § 2.42. *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); and *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 CFR § 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 CFR § 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 CFR § 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 CFR § 2.99 (d)(1) *Within ten days from the date of the Board's notification, the applicant for concurrent use registration must serve copies of its application, specimens and drawing on each applicant, registrant or user specified as a concurrent user in the application for registration, as directed by the Board. If any service copy is returned to the concurrent use applicant as undeliverable, the concurrent use applicant must notify the Board within ten days of receipt of the returned copy.*

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 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. Within ten days from the date the Board notifies the excepted users (i.e., applicant, registrant or common law user) of the institution of the proceeding, the concurrent use applicant must serve copies of its application, specimens and drawing on each excepted user (i.e., applicant, registrant or common law user) specified in the application as a concurrent user. [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)(i) and TMEP § 1207.04(e)(i).

NOTES:

1. *See* 37 CFR §§ 2.99(b)-(d).

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 CFR § 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 may obtain 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 institution order includes an order to the concurrent use applicant to serve copies of its application, specimens and drawing on the involved registrant within ten days, 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.

If all of the above conditions are satisfied so that a new concurrent use proceeding is not necessary, applicant need not serve copies of its application, specimens and drawing on the excepted users (i.e., registrant, applicant or common law user) specified in the concurrent application as provided in 37 CFR § 2.99(d)(1). *Cf.* TBMP §§ 1103.01(c)-(f).

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.

Applicant will be required, following notification of the proceeding, to serve copies of its application, specimens and drawing on each applicant, registrant or user specified as a concurrent user in the application. [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 CFR § 2.42.

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 (TTAB 1988); *Carl Karcher Enterprises, Inc. v. Gold Star Chili, Inc*., 222 USPQ 979 (TTAB 1983), *recon. denied*, 222 USPQ 727 (TTAB 1983); and *Place for Vision, Inc. v. Pearle Vision Center, Inc*., 218 USPQ 1022 (TTAB 1983).

3. *Cf*. 37 CFR § 2.99(f).

4. *See* 37 CFR § 2.99(d)(1).

1103.03 Application Based on Court Determination

37 CFR § 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 examiner; 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 CFR § 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.] In such case, the concurrent use applicant must serve copies of its application, specimens and drawing on the excepted users (i.e., registrant, applicant or common law user) specified in the concurrent application as provided by 37 CFR § 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.

If all of the above conditions are satisfied, so that a concurrent use proceeding is not necessary, applicant need not serve copies of its application, specimens and drawing on the excepted users

(i.e., registrant, applicant or common law user) specified in the concurrent application as provided by 37 CFR § 2.99(d)(1). *Cf.* TBMP §§ 1103.01(c)-(f).

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.

Following notification of the proceeding, applicant will be required, to serve copies of its application, specimens and drawing on each applicant, registrant or user specified as a concurrent user in the application. [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 is 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 CFR § 2.42, described in TBMP §§ 1103.01(c)-(f) and 37 CFR § 2.32 *et. al*.

2. *See* 37 CFR § 2.42.

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 (CCPA 1961).

4. *See* 37 CFR § 2.99(f).

5. 37 CFR § 2.99(d)(1).

6. *See Holiday Inn v. Holiday Inns, Inc*., 534 F.2d 312, 189 USPQ 630 (CCPA 1976); TMEP § 1207.04(d)(i). *Cf. Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc*., 293 F.2d 685, 130 USPQ 412 (CCPA 1961). For information concerning the examination by the trademark examining attorney of a concurrent use application, *see* TMEP § 1207.04(d)(i).

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 rights are 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 (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, 1307-8 (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 Morgan Services Inc. v. Morgan Linen Services Inc*., 12 USPQ2d 1841, 1842 (TTAB 1989).

5. *See 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).

6. *See Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 n.5 (TTAB 1990) (despite parties' treatment of third-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 user).

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 CFR § 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 CFR § 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 CFR § 2.76 or 37 CFR § 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 CFR § 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 and 15 U.S.C. § 46(b), 15 U.S.C. § 1094 and 15 U.S.C. § 1051; 37 CFR § 2.99(g).

2. *See* 37 CFR § 2.99(g).

3. *See* 37 CFR § 2.99(g). *Cf*. 37 CFR § 2.73.

4. *See* 37 CFR § 2.99(g); TMEP § 1207.04(b).

5. *See* TMEP § 1104.03(b).

6. *See* 37 CFR § 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); *Holiday Inn v. Holiday Inns, Inc*., 534 F.2d 312, 189 USPT 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 (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 CFR § 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 CFR § 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 CFR § 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 § 1110.04. There is no fee for the institution of a concurrent use proceeding.

NOTES:

1. 37 CFR § 2.99(f).

2. *Cf.* 37 CFR § 2.99(f).

3. *See* 37 CFR § 2.99(c).

4. *See* 37 CFR § 2.99(c) and 37 CFR § 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 gives the applicant ten days from the date of the order to serve a copy of its application, specimens of use, and drawing of the mark on each user identified in its application. [Note 1.] If any service copy is returned to the concurrent use applicant as undeliverable, the concurrent use applicant must notify the Board within ten days of receipt of the returned copy. [Note 2.] The concurrent use applicant must also file with the Board proof that it has effected proper service of the copies, but should not file a copy of the served documents themselves with the Board. [Note 3.]

A separate order is issued to the excepted users [Note 4], 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 5]; 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 date, 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 6.] 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 7.]

If a party has provided the Office with an e-mail address, the notification may be transmitted via e-mail. [Note 8.] 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 web site (http://www.uspto.gov). [Note 9.]

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 10.] 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 11.]

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 for those cases commenced on or after November 1, 2007. [Note 12.] 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 CFR § 2.99(d)(1) and 37 CFR § 2.119(a).

2. *See* 37 CFR § 2.99(d)(1).

3. *See* 37 CFR § 2.119.

4. 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).

5. *See* 37 CFR § 2.99(c).

6. *Cf.* 37 CFR § 2.105(c) and 37 CFR § 2.119(d).

7. *Cf.* 37 CFR § 2.113(c).

8. *See* 37 CFR § 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 fax or e-mail. 37 CFR § 2.119(b).

9. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 (August 1, 2007).

10. *See* 37 CFR § 2.99(d)(1).

11. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

12. *Cf.* 37 CFR § 2.93.

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. [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. [Note 3.] 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 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 abandoned use of its mark with no intent to resume use, 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 4.] 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 CFR § 2.42 and 37 CFR § 2.99(e).

2. 37 CFR § 2.118. The period of time allowed by the notice is typically thirty days.

3. *Cf.* 37 CFR § 2.99(d)(1), which requires the concurrent use applicant to notify the Board of any service copy that has been returned to the concurrent use applicant as undeliverable, within ten days of applicant's receipt of the returned service copy.

4. *See* 37 CFR § 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 for those cases commenced on or after November 1, 2007. [Note 1.] 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. 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 no longer sends a copy of each involved concurrent use application with the notice to every person specified in the application. Instead, within ten days from the date of the Board's notification, the applicant for concurrent use registration must serve copies of its application, specimens and drawing on each excepted user identified as a concurrent user in the application for registration, and file with the Board proof of proper service of the copies. Copies of the served documents themselves should not be filed with the Board. The contents of the application file may also be viewed at the USPTO web site (http://www.uspto.gov). The concurrent use applicant must notify the Board within ten days of the date of receipt of a returned service copy, or of the date on which applicant learns that service has been ineffective. [Note 2.] *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 3.]

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, which is not involved in the proceeding, and thus stands in the position of a common law user, must file an answer to avoid default. Any answer must be filed within 40 days after the mailing date of the notice, or within an extension of time for that purpose. *See* TBMP § 501 and TBMP § 509. [Note 4.]

If a party that is required, under 37 CFR § 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 still will have 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. § 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 5.] *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 will be allowed

to contest the registration sought by the applicant, to 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 users 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* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

2. *See* 37 CFR § 2.99(d)(1) and 37 CFR § 2.119.

3. *See, e.g.*, *Pro-Cuts v. Schilz-Price Enterprises Inc*., 27 USPQ2d 1224 (TTAB 1993); *Fleming Companies v. Thriftway Inc*., 21 USPQ2d 1451 (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 (TTAB 1984); *Ole' Taco Inc. v. Tacos Ole, Inc*., 221 USPQ 912 (TTAB 1984).

4. *See* 37 CFR § 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).

5. *See* 37 CFR § 2.99(d)(3). *See also Pro-Cuts v. Schilz-Price Enterprises Inc*., 27 USPQ2d 1224 (TTAB 1993); *Precision Tune Inc. v. Precision Auto-Tune Inc*., 4 USPQ2d 1095 (TTAB 1987); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305 (TTAB 1984).

1108 Issue in Concurrent Use Proceeding; Burden of Proof

37 CFR § 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 CFR § 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 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 affidavit evidence) than those (such as depositions upon oral examination) normally required for the introduction of evidence in an inter partes proceeding. [Note 8.] Such a showing usually suffices if the concurrent use applicant can address many of the factors the Board looks 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 (TTAB 1995); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993); *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451 (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 CFR § 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); *CDS Inc. v. I.C.E.D. Management Inc.*, 80 USPQ2d 1572, 1583-4 (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 (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 CFR § 2.99(e); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (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); *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.*, 21 USPQ2d 1451, 1455 (TTAB 1991), *aff'd,* 809 F. Supp. 38, 26 USPQ2d 1551 (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); *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 (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 (TTAB 1983); and *Ole' Taco Inc. v. Tacos Ole, Inc*., 221 USPQ 912 (TTAB 1984).

4. *See DataNational Corp v. Bell South Corp*., 18 USPQ2d 1862 (TTAB 1991), *aff'd*, 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); *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*., 21 USPQ2d 1451, 1455 (TTAB 1991), *aff'd,* 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); *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 CFR § 2.116(b).

6. *See* 37 CFR § 2.99(e).

7. 37 CFR § 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. For

cases commenced on or after November 1, 2007, 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 than those normally required for the introduction of evidence in an inter partes proceeding. *See* TBMP § 1107.

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 available only in such proceedings.

The order in which the parties offer evidence depends upon whether or not they own an involved application or registration, and, 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, for cases commenced on or after November 1, 2007, 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. *See* TBMP § 801.02(e).

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):

Mailing Date	6/1/2010
Time to Answer	7/11/2010
Deadline for Discovery Conference	8/10/2010
Discovery Opens	8/10/2010
Initial Disclosures Due	9/9/2010
Expert Disclosures Due	1/7/2011
Discovery Closes	2/6/2011
A's Pretrial Disclosures Due	3/23/2011
A's 30-day Trial Period Ends	5/7/2011
B's Pretrial Disclosures Due	5/22/2011
B's 30-day Trial Period Ends	7/6/2011
C's Pretrial Disclosures Due	7/21/2011
C's 30-day Trial Period Ends	9/4/2011
D's Pretrial Disclosures Due	9/19/2011
D's 30-day Trial Period Ends	11/3/2011
E's Pretrial Disclosures Due	11/18/2011
E's 30-day Trial Period Ends	1/2/2012
A's Rebuttal Disclosures Due	1/17/2012
A's 15-day Rebuttal Period Ends	2/16/2012
B's Rebuttal Disclosures Due	3/2/2012
B's 15-day Rebuttal Period Ends	4/1/2012
C's Rebuttal Disclosures Due	4/16/2012
C's 15-day Rebuttal Period Ends	5/16/2012
D's Rebuttal Disclosures Due	5/31/2012
D's 15-day Rebuttal Period Ends	6/30/2012
Briefs on Final Hearing (37 CFR § 2.128)	
shall become due as follows:	

BRIEF FOR A is due	8/29/2012
BRIEF FOR B is due	9/28/2012
BRIEF FOR C is due	10/28/2012
BRIEF FOR D is due	11/27/2012
BRIEF FOR E is due	12/27/2012
REPLY BRIEFS, if any, shall be due as follows:	
REPLY BRIEF FOR A is due	1/11/2013
REPLY BRIEF FOR B is due	1/26/2013
REPLY BRIEF FOR C is due	2/10/2013
REPLY BRIEF FOR D is due	2/25/2013

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:

Mailing Date	6/1/2010
Time to Answer	7/11/2010
Deadline for Discovery Conference	8/10/2010
Discovery Opens	8/10/2010
Initial Disclosures Due	9/9/2010
Expert Disclosures Due	1/7/2011
Discovery Closes	2/6/2011
X's Pretrial Disclosures Due	3/23/2011
X's 30-day Trial Period Ends	5/7/2011
Y's Pretrial Disclosures Due	5/22/2011
Y's 30-day Trial Period Ends	7/6/2011
Z's Pretrial Disclosures Due	7/21/2011
Z's 30-day Trial Period Ends	9/4/2011
X's Rebuttal Disclosures Due	9/19/2011
X's 15-day Rebuttal Period Ends	10/19/2011

Briefs on Final Hearing (37 CFR § 2.128)	
shall become due as follows:	
BRIEF FOR X is due	12/18/2011
BRIEF FOR Y is due	1/17/2012
BRIEF FOR Z is due	2/16/2012
REPLY BRIEFS, if any, shall be due as follows:	
REPLY BRIEF FOR X is due	3/2/2012

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.

Deadline for Discovery Conference	8/10/2010
Discovery Opens	8/10/2010
Initial Disclosures Due	9/9/2010
Expert Disclosures Due	1/7/2011
Discovery Closes	2/6/2011
A's Pretrial Disclosures	3/23/2011
A's 30-day Trial Period Ends	5/7/2011
B's Pretrial Disclosures	5/22/2011
B's 30-day Trial Period Ends	7/6/2011
C's Pretrial Disclosures	7/21/2011
C's 30-day Trial Period Ends	9/4/2011
D's Pretrial Disclosures	9/19/2011
D's 30-day Trial Period Ends	11/3/2011
A's Rebuttal Disclosures	11/18/2011
A's 15-day Rebuttal Period Ends	12/18/2011

With the exceptions noted above, the practices and procedures in cases commenced on or after

November 1, 2007 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.

1109.02 Sample Trial Schedules - Cases Commenced Before 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):

Mailing Date	1/1/2007
Discovery Period to Open	1/21/2007
Discovery Period to Close	7/20/2007
A's 30-day Trial Period Ends	10/18/2007
B's 30-day Trial Period Ends	12/17/2007
C's 30-day Trial Period Ends	2/15/2008
D's 30-day Trial Period Ends	4/15/2008
E's 30-day Trial Period Ends	6/14/2008
A's 15-day Rebuttal Period Ends	7/29/2008
B's 15-day Rebuttal Period Ends	9/12/2008
C's 15-day Rebuttal Period Ends	10/27/2008
D's 15-day Rebuttal Period Ends	12/11/2008

BRIEFS ON FINAL HEARING (37 CFR § 2.128)
shall become due as follows:

BRIEF FOR A is due	2/9/2009
BRIEF FOR B is due	3/11/2009
BRIEF FOR C is due	4/10/2009
BRIEF FOR D is due	5/10/2009

BRIEF FOR E is due	6/9/2009

REPLY BRIEFS, if any, shall be due as follows:

REPLY BRIEF FOR A is due	7/9/2009
REPLY BRIEF FOR B is due	7/24/2009
REPLY BRIEF FOR C is due	8/8/2009
REPLY BRIEF FOR D is due	8/23/2009

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:

Mailing Date	1/1/2007
Discovery Period To Open	1/21/2007
Discovery Period To Close	7/20/2007
X's 30-day Trial Period Ends	10/18/2007
Y's 30-day Trial Period Ends	12/17/2007
Z's 30-day Trial Period Ends	2/15/2008
X's 15-day Rebuttal Period Ends	3/31/2008

BRIEFS ON FINAL HEARING (37 CFR 2.128)
shall become due as follows:

BRIEF FOR X is due	5/30/2008
BRIEF FOR Y is due	6/29/2008
BRIEF FOR Z is due	7/29/2008

REPLY BRIEFS, if any, shall be due as follows:

REPLY BRIEF FOR X is due	8/13/2008

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 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.

With the exceptions noted above, the practices and procedures in cases commenced before November 1, 2007 for 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.

NOTES:

1. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (August 1, 2007).

2. *See* 37 CFR § 2.121(b)(2).

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.

The Board is aware that the advent of Internet advertising increases the geographic scope of a party's advertising. However, 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 Companies Inc. v. Thriftway Inc*., 21 USPQ2d 1451, 1454 (TTAB 1991), *aff'd,* 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992) (concurrent use applicant not entitled to registration including expanded area of geographic use in view of agreement entered into by its predecessor); *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*, 6 USPQ2d 1305 (Fed. Cir. 1988) (agreement between parties given substantial weight); *In re Beatrice Foods Co.; In re Fairway Foods, Inc.,* 166 USPQ 431, 437 (C.C.P.A. 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."); *Precision Tune Inc. v. Precision Auto-Tune Inc.,* 4 USPQ2d 1095 (TTAB 1987) (agreement persuasive to show no likelihood of confusion); *The Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.,* 215 USPQ 1133 (TTAB 1982) (agreement sufficient; concurrent use registration granted). *Cf.*

Newsday, Inc. v. Paddock Publications, Inc., 223 USPQ 1305 (TTAB 1984) (settlement agreement rescinded; concurrent use registration denied).

3. *See CDS Inc. v. I.C.E.D. Management Inc.*, 80 USPQ2d 1572, 1583-4 (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 (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), *aff'd*, 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992) (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); *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307-8 (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 (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 Ass'n v. Home Federal Savings & Loan Ass'n of Chicago*, 205 USPQ 467 (TTAB 1979); *Cook's Pest Control, Inc. v. Sanitas Pest Control Corp*., 197 USPQ 265 (TTAB 1977); and *Chichi's, Inc. v. Chi-Chi's, Inc*., 222 USPQ 831 (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. 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 action. [Note 3.]

NOTES:

1. *Cf.* 37 CFR § 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 Inland Oil & Transport Co. v. IOT Corp.*, 197 USPQ 562 (TTAB 1977) (applicant's motion to dismiss opposition and institute concurrent use granted; 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 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 (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. *See Chichi's, Inc. v. Chi-Chi's, Inc*., 222 USPQ 831 (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).

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 CFR § 2.173(a). [Note 1.]

Further, a concurrent registrant that wishes to alter the 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 (TTAB 1989); *In re Alfred Dunhill Ltd*., 4 USPQ2d 1383 (Comm'r 1987); *In re Forbo*, 4 USPQ2d 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 CFR § 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 CFR § 7.22.

5. *Cf. Fleming Companies Inc. v. Thriftway Inc*., 21 USPQ2d 1451, 1453 (TTAB 1991), *aff'd,* 809 F. Supp. 38, 26 USPQ2d 1551 (S.D. Ohio 1992) (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); *Newsday, Inc. v. Paddock Publications, Inc*., 223 USPQ 1305, 1307-8 (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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1201.01 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 CFR § 2.63(b) *After reexamination the applicant may respond by filing a timely petition to the Director for relief from a formal requirement if: (1) The requirement is repeated, but the examiner's action is not made final, and the subject matter of the requirement is appropriate for petition to the Director (see § 2.146(b)); or (2) the examiner's action is made final and such action is limited to subject matter appropriate for petition to the Director. If the petition is denied, the applicant shall have until six months from the date of the Office action which repeated the requirement 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. A formal requirement which is the subject of a petition decided by the Director may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.*

37 CFR § 2.64(a) *On the first or any subsequent reexamination or reconsideration the refusal of the registration or the insistence upon a requirement may be stated to be final, whereupon applicant's response is limited to an appeal, or to a compliance with any requirement, or to a petition to the Director if permitted by § 2.63(b).*

37 CFR § 2.64(b) *During the period between a final action and expiration of the time for filing an appeal, the applicant may request the examiner to reconsider the final action. The filing of a request for reconsideration will not extend the time for filing an appeal or petitioning the Director, but normally the examiner will reply to a request for reconsideration before the end of the six-month period if the request is filed within three months after the date of the final action. Amendments accompanying requests for reconsideration after final action will be entered if they comply with the rules of practice in trademark cases and the Act of 1946.*

37 CFR § 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 CFR § 2.146(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 his or her 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 CFR § 2.63(b). [Note 2.] An applicant may, pursuant to 37 CFR § 2.64(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.

NOTES:

1. *See* Trademark Act § 12(b), 15 U.S.C. § 1062(b); 37 CFR § 2.64(a); TMEP § 714 and TMEP § 714.03.

2. *See* 37 CFR § 2.64(a); TMEP § 715.01. *See also* Trademark Act § 20, 15 U.S.C. § 1070, and TMEP § 1501.

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); and *In re Citibank, N.A.*, 225 USPQ 612, 613 (TTAB 1985). *See also* 37 CFR § 2.141; and TMEP § 1501.

5. *In re Page*, 51 USPQ2d 1660, 1662 n.2 (TTAB 1999).

6. *See 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); and *In re Citibank, N.A.*, 225 USPQ 612, 613 (TTAB 1985). *See also* Trademark Act § 20, 15 U.S.C. § 1070; 37 CFR § 2.64(a); 37 CFR § 2.141; and TMEP § 1501.

1201.02 Premature Final

Trademark Act § 12(b), 15 U.S.C. § 1062(b) *If the applicant 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 requirement in a second or subsequent action, a repeated refusal or requirement may not be made final.*

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 CFR § 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 submitted as a paper filing, the applicant should so advise the Board in the notice of appeal. If the notice of appeal is filed electronically through

the Electronic System for Trademark Trials and Appeals (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 "document in a Board proceeding" menu, and checking the box for "Other Motions/Papers," an additional paper advising the Board that the final action is premature or that there is a pending petition on this issue. *See* TBMP §1202.03 regarding the filing of a notice of appeal.

The prematureness of a final action 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 from a final refusal to register or a final requirement, that the final action was issued prematurely, the Board normally will decline to institute the appeal (or, if the appeal has been instituted, will vacate the institution order) and will forward 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 is issued. The Board letter will generally indicate that if the examining attorney finds, upon consideration of 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 applicant may request a refund of the previously submitted appeal fee; 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, in which the applicant requests that the previously submitted appeal fee should be applied to the appeal.

NOTES:

1. *See* Trademark Act § 12(b), 15 U.S.C. § 1062(b); 37 CFR § 2.64(a); 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).

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).

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*.

7. *See 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 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 action, will notify the applicant that the appeal was filed prematurely 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 CFR § 2.65(b) 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 request that the appeal fee previously submitted be applied to the new appeal. If, on the other hand, no new appeal is ever filed, the applicant may request that the appeal fee submitted with the premature appeal be refunded.

NOTES:

1. *In re Page*, 51 USPQ2d 1660, 1662 n.2 (TTAB 1999).

2. *In re Virshup*, 42 USPQ2d 1403 (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 CFR § 2.142(c) *All requirements made by the examiner and not the subject of appeal shall be complied with prior to the filing of an appeal.*

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 CFR § 2.142(c); *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 CFR § 2.63(b) *After reexamination the applicant may respond by filing a timely petition to the Director for relief from a formal requirement if: (1) The requirement is repeated, but the examiner's action is not made final, and the subject matter of the requirement is appropriate for petition to the Director (see § 2.146(b)); or (2) the examiner's action is made final and such action is limited to subject matter appropriate for petition to the Director. If the petition is denied, the applicant shall have until six months from the date of the Office action which repeated the requirement 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. A formal requirement which is the subject of a petition decided by the Director may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.*

37 CFR § 2.64(a) *On the first or any subsequent reexamination or reconsideration the refusal of the registration or the insistence upon a requirement may be stated to be final, whereupon applicant's response is limited to an appeal, or to a compliance with any requirement, or to a petition to the Director if permitted by § 2.63(b).*

37 CFR § 2.146(a) *Petition may be taken to the Director: (1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by § 2.63(b); (2) in any case for which the Act of 1946, or Title 35 of the United States Code, or this Part 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 this Part of Title 37 of the Code of Federal Regulations; (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 §§ 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 CFR (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 CFR § 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 Assignment Services Division of the Office. [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 CFR (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.]

The Board will not consider a matter that is appropriate only for petition. 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." [Note 13.] *See* TMEP § 706.01 regarding "clear error."

For 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 CFR § 2.63(b), 37 CFR § 2.64(a), and 37 CFR § 2.141. *See also In re Pony International Inc.*, 1 USPQ2d 1076, 1079 (Comm'r 1986).

2. *See* 37 CFR § 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., Inc.*, 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); and *In re Stenographic Machines, Inc.*, 199 USPQ 313, 315 (Comm'r 1978).

3. *See*, in this regard, 37 CFR § 2.146(b), and the preceding paragraph.

4. *See* 37 CFR § 2.63(b) and 37 CFR § 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); and *In re Stenographic Machines, Inc.*, 199 USPQ 313, 315 (Comm'r 1978) (requirement for a more particular identification of goods).

5. *See* 37 CFR § 2.63(b). *See also In re Pony International Inc.*, 1 USPQ2d 1076, 1079 (Comm'r 1986).

6. 37 CFR § 2.146(a)(2).

7. *See* TMEP § 1702, TMEP § 1703 and TMEP § 1704.

8. *See* 35 U.S.C. § 2 and 37 CFR § 2.146(a)(3).

9. *See, e.g., In re Mission Pharmacal Co., Inc.*, 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 CFR § 2.146(a)(4).

11. 37 CFR § 2.146(a)(5). For information concerning the meaning of the words "extraordinary situation" *see* TMEP § 1708.

12. *See* 37 CFR § 2.63(b), 37 CFR § 2.64(a), 37 CFR § 2.146(a), and 37 CFR § 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 Jump Designs LLC*, 80 USPQ2d 1370, 1373-74 (TTAB 2006); *In re Sambado & Son Inc.*, 45 USPQ2d 1312, 1314 (TTAB 1997).

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 CFR § 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 CFR § 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 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. [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. 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 subject of the appeal will be deemed abandoned. [Note 4.] 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 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 non-final Office action or a new final refusal (thereby giving the applicant additional time to file a notice of appeal with respect to these classes).

NOTES:

1. *See* 37 CFR § 2.6(a)(18). *See also* Trademark Act § 20, 15 U.S.C. § 1070; 37 CFR § 2.141 and 37 CFR § 2.142(a) and TMEP § 1501.

2. *See* Trademark Act § 12(b), 15 U.S.C. § 1062; 37 CFR § 2.64(a), 37 CFR § 2.65(a), and 37 CFR § 2.66. *See also* TMEP § 718.02, TMEP § 1501.04, TMEP § 1714, and TMEP § 1714.01(a).

3. 37 CFR § 2.142(c).

4. *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.

The notice of appeal to the Board (unlike other correspondence to be filed with the Board) may be filed by facsimile transmission [Note 3], as well as by any of the ordinary methods for filing correspondence intended for the Board, including electronically through ESTTA in the manner prescribed in 37 CFR § 2.126(b). [Note 4.] *See* TBMP § 106.03, TBMP § 107, TBMP § 110.09, and TBMP § 1202.03. The certificate of mailing and certificate of transmission procedures described in 37 CFR § 2.197, and the "Express Mail" procedure described in 37 CFR § 2.198, are available for the filing of an appeal to the Board. [Note 5.] TBMP § 110 and TBMP § 111. Nonetheless, filing via ESTTA is strongly encouraged. For more information regarding filing via ESTTA, *see* TBMP § 110.09.

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 [Note 8] to the final refusal has been filed during the six months following issuance of the final action, the application will be abandoned. [Note 9.] 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 10.] However, the unintentional delay standard of 37 CFR § 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 11.]

NOTES:

1. *See* TMEP § 1501.

2. *See* Trademark Act § 12(b), 15 U.S.C. § 1062; 37 CFR § 2.142(a).

3. *See* 37 CFR § 2.195(d)(3).

4. *See* 37 CFR § 2.195(c)(3); 37 CFR § 2.126.

5. *See* 37 CFR § 2.197; 37 CFR § 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 "Express Mail" procedure. *See* TMEP § 305.03. However, the "Express Mail" procedure is available for filing a notice of appeal. Further, the only paper that may be filed by facsimile transmission with the Board is the notice of appeal.

6. *See* 37 CFR § 2.64(b). *See also* TMEP § 715.02 and TMEP § 715.03.

7. *See* 37 CFR § 2.63(b) and 37 CFR § 2.64(a). *See also* 37 CFR § 2.64(b); TMEP § 715.03 and TMEP § 715.03(c).

8. *See* 37 CFR § 2.64(a); TMEP § 715.01.

9. *See* 37 CFR § 2.64 and 37 CFR § 2.142(a). *See also* TMEP § 715.03(a).

10. *See* 37 CFR § 2.66(a) and TMEP § 1714 *et seq*.

11. *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. It is strongly recommended that a notice of appeal be filed through the Board's electronic ESTTA filing system, found at http://estta.uspto.gov. [Note 1.] *See* TBMP § 106.03 and TBMP § 110.09. 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. Some advantages of filing an appeal through ESTTA are that the applicant gets immediate confirmation of the filing; the Board's order instituting the appeal is electronically generated immediately; and the applicant will know the date by which it must file its appeal brief.

An applicant may also file a notice of appeal by United States Mail or by facsimile transmission. [Note 2.] *See* TBMP § 106.03 and TBMP § 1202.02 and the rules and TMEP sections cited therein regarding certificate of mailing, certificate of Express Mailing and certificate of transmission 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 in the paper version of its notice of appeal or by checking the box on the ESTTA form indicating that it has filed a request for reconsideration. However, the request for reconsideration or amendment should not be combined in the body of the notice of appeal. The Board will institute the appeal, suspend proceedings, and remand the application to the examining attorney to consider the request for reconsideration. *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. If the notice of appeal is submitted as a paper filing, the applicant should advise the Board of its belief that the final action is premature, or that it has filed a petition, in the notice of appeal. If 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 "document in a Board proceeding" menu, and checking the box for "Other Motions/Papers," an additional paper advising the Board that the final action is premature or that there is a pending petition on this issue.

NOTES:

1. *See* 37 CFR § 2.126(b).

2. *See* 37 CFR § 2.126 for general requirements for submissions to the Board.

3. *See* 37 CFR § 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 CFR § 2.119(e).

1202.04 Appeal Fee

37 CFR § 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.*

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 CFR § 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 CFR § 2.141.

2. *See generally*, TMEP § 1714. *See also* TMEP § 1704.

3. 37 CFR § 2.208(b).

4. *See* 37 CFR § 2.86 and 37 CFR § 2.141(b).

5. 37 CFR § 2.6(a)(18).

6. *See* 37 CFR § 2.141(b) and TMEP § 1403.05(a).

7. 37 CFR § 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. 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 CFR § 2.87.

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.

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 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.*

37 CFR § 2.142(b)(2) *Briefs must be submitted in written form and must meet the requirements prescribed in § 2.126. Each brief shall contain an alphabetical index of cited cases. 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 brief filed in an ex parte appeal to the Board must conform to the requirements of 37 CFR § 2.142(b)(2) as well as the general requirements for submissions to the Board specified in 37 CFR § 2.126.

Only one copy of the brief should be submitted. The twenty-five page limit for an appeal brief does not refer to any exhibits attached to the brief. However, appendices or exhibits to a brief may not be used to avoid the page limitation. [Note 1.] 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 2.] 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. [Note 3.] If an applicant files a brief that exceeds the twenty-five page limit without prior leave of the Board, the brief will not be considered, although the failure to file a conforming brief will not be treated as a failure to file a brief which would result in the dismissal of the appeal. [Note 4.] In such a situation, the examining attorney will still file his or her 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 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 5.] An appeal brief should include an alphabetical index of cited cases [Note 6], and the case citation should include a citation to *The United States Patent Quarterly* (USPQ) if the case has appeared in that publication. *See* TBMP § 101.03 and TBMP § 1203.02(f). [Note 7.] The brief need not include the formal requirements, such as a table of contents and description of the record, of a trial brief. [Note 8.] 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 9.]

The 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 10.] Such requests should be filed by separately captioned papers. *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 may be filed through the Board's ESTTA online system or as a paper submission. Filing via ESTTA is strongly encouraged. Please Note: 37 CFR § 2.126 has been amended such that briefs may no longer be filed on CD-ROM.

NOTES:

1. *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).

2. *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).

3. *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).

4. *See In re Thomas,* 79 USPQ2d 1021 (TTAB 2006) (Board refused to consider applicant's 29-page brief).

5. *Cf*. TMEP § 302.03(a).

6. 37 CFR § 2.142(b)(2).

7. *In re Carlson*, 91 USPQ2d 1198, 1199 n.2 (TTAB 2009).

8. *Cf*. 37 CFR § 2.128(b).

9. *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").

10. *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).

1203.02 Time for Filing Brief

1203.02(a) Applicant's Main Brief

37 CFR § 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 examiner shall, within sixty days after the brief of appellant is sent to the examiner, file with the Trademark Trial and Appeal Board a written brief answering the brief of appellant and shall 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 examiner.*

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. The time for filing the brief is set by rule; therefore, 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 1.] If no brief is filed, the appeal will be dismissed. [Note 2.] 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.

If the appeal is dismissed for failure to file a timely brief, the applicant's recourse is to file a petition to the Director under the provisions of 37 CFR § 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 3.] 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 CFR § 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 CFR § 2.66(a) does not apply to the determination of whether a late-filed brief will be accepted. [Note 4.]

If a notice of appeal (accompanied by the required fee) is filed with a certificate of mailing by first-class mail pursuant to 37 CFR § 2.197, 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 applicant's main brief. [Note 5.]

If an applicant that 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, and the examining attorney has not yet considered the request for reconsideration when the appeal is filed, or if the applicant files a request for reconsideration along with the notice of appeal, the application, with the appeal and the request for reconsideration, will be forwarded to the Board. However, because papers may become separated, if an applicant files a request for reconsideration along with a paper notice of appeal, it should indicate in the notice of appeal that a request for reconsideration is being filed contemporaneously. If the applicant files its notice of appeal through the Board's electronic ESTTA filing system, it should check the box that indicates that a request for reconsideration is also being filed. The Board will acknowledge 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 remand the application to the examining attorney for consideration of the request. Because proceedings in the appeal are automatically 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 CFR § 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 6.] *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 from the paper in which such action is taken; 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. *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. The examining attorney should so notify the applicant by telephone or e-mail. [Note 7.]

NOTES:

1. *In re Live Earth Products Inc.*, 49 USPQ2d 1063, 1064 (TTAB 1998).

2. 37 CFR § 2.142(b)(1).

3. *See* TMEP § 1706.

4. *See* TMEP § 1714.01(f)(ii).

5. 37 CFR § 2.197.

6. *See In re Live Earth Products Inc.*, 49 USPQ2d 1063 (TTAB 1998).

7. *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. 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 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 his or her 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 his or her 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 by telephone or e-mail. [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 his or her 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. *See* TBMP § 1203.02(g).

On the other hand, the examining attorney, having received the application for preparation of his or her 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 a written request that the application be remanded to him or her for

further examination. For information concerning requests for remand, *see* TBMP § 1209.02, TMEP § 1504.05 and TMEP § 1504.05(a). [Note 6.] 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 7.] If a request for remand is denied, the Board will reset the examining attorney's time in which to file an appeal brief. [Note 8.] 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 his or her appeal brief.

NOTES:

1. 37 CFR § 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' Ass'n*, 223 USPQ 188 n.3 (TTAB 1984); and TMEP § 1501.02. *See also In re Miller Brewing Co.*, 226 USPQ 666, 667 n.4 (TTAB 1985).

2. 37 CFR § 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' Ass'n*, 223 USPQ 188 n.3 (TTAB 1984).

4. *See* TMEP § 1501.03.

5. *See* TMEP § 1501.03.

6. 37 CFR § 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 n.2 (TTAB 1992) (ground for refusal first raised in examining attorney's appeal brief given no consideration).

7. *In re Paper Doll Promotions Inc.*, 84 USPQ2d 1660, 1665 (TTAB 2007).

8. *See In re Miller Brewing Co.*, 226 USPQ 666, 667 n.4 (TTAB 1985).

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. [Note 1.] However, the filing of a reply brief is not mandatory.

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. Such requests should be filed by separately captioned papers. *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 by telephone or e-mail. [Note 2.]

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 3.]

NOTES:

1. *See* 37 CFR § 2.142(b)(1); *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).

2. *See* TMEP § 1501.03.

3. *See* TMEP § 1501.02(c).

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. 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.

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' Ass'n*, 223 USPQ 188, 188 n.3 (TTAB 1984).

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 papers or evidence that is already in the application because the appeal brief is associated with the application. Such papers should not, as a matter of course, be resubmitted as exhibits to the brief. *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 2.] *See* TBMP § 1207.01. However, if the examining attorney, in his or her 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 will be deemed to have been stipulated into the record and will be considered. *See* TBMP § 1207.03.

NOTES:

1. 37 CFR § 2.142(d).

2. *See 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 (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); and *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).

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, although a decision designated as not precedential is not binding upon the Board. [Note 2.] *See* TBMP § 101.03.

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 3.] *See* TBMP § 101.03 and TBMP § 801.03.

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 (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).

3. *In re Carlson*, 91 USPQ2d 1198, 1199 n.2 (TTAB 2009).

1203.02(g) Waiver of Claim or Requirement in Brief

If an applicant, in its appeal brief, does not assert a claim 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 his brief, the requirement or refusal

may be deemed withdrawn. *See* TBMP § 1203.02(b). [Note 2.] However, the better practice, if an applicant seeks to comply with a requirement, is to request remand rather than simply offering the amendment as part of its brief. *See* TBMP § 1205.

NOTES:

1. *See 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).

2. *See 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).

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 [Note 3] to the final refusal has been filed during the six months following issuance of the final action, the application will be abandoned. [Note 4.] 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 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; if the notice of appeal is filed through the Board's ESTTA electronic system, the applicant should check the box stating that a request for reconsideration has been filed, and if 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. *See* TBMP § 1209.04. Further, once briefing has begun, a request for reconsideration, even if filed within six months of a final action, is treated as a request for remand. A request for remand should not be combined with the applicant's appeal brief, but should be made by a separate document. [Note 5.]

If 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, and the

examining attorney has not yet considered the request for reconsideration when the appeal is filed, the Board will acknowledge receipt of the appeal and request, institute the appeal, 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 request. Where an applicant has timely filed both a notice of appeal 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 6.] Rather, it may assume that the Board will institute the appeal, 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 7.] 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 8.] TBMP § 1203.02(a).

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 9.] 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.

Occasionally when an applicant files its notice of appeal and a request for reconsideration at the same time, the examining attorney acts on the request for reconsideration before the Board can institute the appeal and remand the application. In that event, 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 action 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. However, the examining attorney should notify the applicant by telephone or e-mail. [Note 12.] 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 from the paper in which such action is taken; 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.

If an appeal is late-filed, but the applicant timely filed a request for reconsideration, the Board will issue an 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 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 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 § 1209.04.

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. [Note 16.] TBMP § 1207.02 and TBMP § 1209.04.

NOTES:

1. *See* 37 CFR § 2.64(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).

2. *See* 37 CFR § 2.63(b), 37 CFR § 2.64(a) and 37 CFR § 2.64(b). *See also* TMEP § 715.03 and TMEP § 715.03(c).

3. *See* 37 CFR § 2.64(a); TMEP § 715.01.

4. *See* 37 CFR § 2.64 and 37 CFR § 2.142(a). *See also* TMEP § 715.03.

5. *See In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 828 (TTAB 1984).

6. 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 non-final 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).

7. 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).

8. *In re Live Earth Products Inc.*, 49 USPQ2d 1063 (TTAB 1998).

9. *See* TMEP § 714.05.

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. *See* TMEP § 715.04.

13. *See* 37 CFR § 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 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 (TTAB 2009).

16. *See* 37 CFR § 2.142(d); *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 (TTAB 2010); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198 (TTAB 2009).

1205 Amendment of Application During Appeal

1205.01 In General

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 an ex parte appeal to the Board, and the examining attorney has not yet acted on the amendment when the appeal is filed, the applicant should indicate in its notice of appeal that it has also filed an amendment with the notice of appeal. If filing the notice of appeal through the Board's ESTTA electronic system, the applicant should check the box indicating that it has filed a request for reconsideration. *See* TBMP § 1202.03 and TBMP § 1204.

The Board will acknowledge receipt of the amendment and appeal, 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. Further, 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 CFR § 2.142(f)(6) for remand to assert the new refusal or requirement or submit additional evidence, and the request is granted. *See* 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. If 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, 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 2.] TBMP § 1203.02(a).

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 by telephone or e-mail. [Note 3.]

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 from the paper in which such action is taken; 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.

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 applicant's appeal brief or thereafter, even if filed within six months of the final action, the Board will treat the paper as a request for remand. *See* TBMP § 1204. Such a request 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, or 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). 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. 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 4.] 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, from 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 5.]

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.

If, at the time the applicant files its appeal brief, it also wishes to amend its application in order to, for example, attempt to comply with a final requirement or to overcome a final refusal, the proper procedure is to file a request for remand and a request to suspend proceedings in the appeal pending the Board's decision on the request for remand. However, occasionally an applicant 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 paper), the Board will treat the proposed amendment as a request for remand, and consider whether good cause has been shown in determining the request. 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 his or her brief that he/she has accepted the amendment; 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 6.] 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.

An application that has been considered and decided on appeal may be amended, if at all, only in accordance with 37 CFR § 2.142(g). For further information concerning amendment after decision on appeal, *see* TBMP § 1218 and TMEP § 1501.06.

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); and *In re Pierce Foods Corp.*, 230 USPQ 307, 308 n.1 (TTAB 1986).

2. *See In re Live Earth Products Inc.*, 49 USPQ2d 1063, 1064 (TTAB 1998).

3. *See* TMEP § 715.04 and TMEP § 1501.05.

4. *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).

5. *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 n.2 (TTAB 2010).

6. *See 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, rather than directed to the examining attorney or filed through the TEAS system, either electronically through the Board's ESTTA filing system or by a paper submission. If filing through 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 via ESTTA is strongly encouraged. *See* TBMP § 110.09 for more information regarding ESTTA.

NOTES:

1. *See generally,* 37 CFR § 2.87 and TMEP § 1110 regarding requests to divide.

1205.02(a) Request to Divide When Notice of Appeal is Submitted Electronically

If an applicant submits a notice of appeal through the Board's ESTTA electronic filing system, 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 the ESTTA system and the contemporaneously or previously filed request to divide through the Trademark Examining Operation's (TMEO) Trademark Electronic Application System (TEAS) system. 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 generally,* 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

The following information applies when a notice of appeal is filed as a "paper" submission, 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, 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, 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 generally*, 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.

If the notice of appeal is filed through the Board's ESTTA electronic filing system, 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 the Office's TEAS filing system. The filing of the notice of appeal through the ESTTA system, 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 strongly encouraged. *See* TBMP § 110.09 for more information regarding ESTTA.

If the applicant files its notice of appeal through a paper submission, it should indicate in the notice of appeal that it has pending, or is contemporaneously filing, an amendment to allege use. [Note 3.] 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 CFR § 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, by telephone or e-mail. [Note 4.] 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 in which such action is taken; 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 5.]

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 CFR § 2.76(a). *See also In re Sovran Financial Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1991).

2. *See* 37 CFR § 2.76(a); TMEP § 1104.03 and TMEP § 1104.07.

3. 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.

4. *See* TMEP § 1104.07.

5. *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; 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 CFR § 2.88(a).

2. *See* Trademark Act § 13(b)(2), 15 U.S.C. § 1063; 37 CFR § 2.81(b); and TMEP § 1109.04.

3. *See* 37 CFR § 2.88(a).

1207 Submission of Evidence During Appeal

1207.01 General Rule—Evidence Submitted After Appeal Untimely

37 CFR § 2.142(d) *The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request 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. Additional evidence filed after appeal normally will be given no consideration by 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 file a request for remand. [Note 4.] *See* TBMP § 1209.02 and TBMP § 1209.04.

NOTES:

1. 37 CFR § 2.142(d). *See In re Trans Continental Records Inc*, 62 USPQ2d 1541 (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); *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), *aff'd*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (evidence submitted with reply brief not considered); *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 (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 Bros., Inc.*, 218 USPQ 181, 183 (TTAB 1983); and *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 (Fed. Cir. 1986); *In re Volvo White Truck Corp.*, 16 USPQ2d 1417 (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 (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. *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 CFR § 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.

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), [Note 6] is inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability, 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 7.] However, depending on the stage of the appeal, the Board may direct that any responsive evidence be submitted with a supplemental brief. [Note 8.]

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 CFR § 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. However, the examining attorney should so notify the applicant by telephone or e-mail. [Note 9.] 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 from the 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.

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 (with no six-month response clause) relating to the new evidence to be submitted therewith. After the examining attorney's new action has been issued, the application should be returned to the Board; and proceedings with respect to the appeal will be resumed. The applicant will be allowed an opportunity to submit, if it so desires, responsive evidence; and further appropriate action with respect to the appeal will be taken. 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.

NOTES:

1. *See* 37 CFR § 2.142(d). *See also 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); and *In re Royal Viking Line A/S*, 216 USPQ 795, 797 n.3 (TTAB 1982).

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 Big Wrangler Steak House, Inc.*, 230 USPQ 634 (TTAB 1986); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763 (TTAB 1986); *In re Chung, Jeanne & Kim Co.*, 226 USPQ 938 (TTAB 1985); *In re Mayer-Beaton Corp.*, 223 USPQ 1347 (TTAB 1984); *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, 223 USPQ 363 (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 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 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).

7. *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).

8. *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 n.2 (TTAB 2010).

9. *See* TMEP § 715.04.

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.]

Copies of third-party registrations that are submitted with an applicant's brief may be considered in certain circumstances, even if the examining attorney objects to the registrations or does not discuss them in the examining attorney's brief. 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 improper form. [Note 3.] *See* TBMP § 1208.02 regarding third-party registrations, including discussion of evidentiary value of such listings.

NOTES:

1. *See, e.g.*, *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); and *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); and *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. *See In re Boyd Gaming Corp.*, 57 USPQ2d 1944, 1945 n.4 (TTAB 2000) (applicant provided list of third-party registration numbers in its response; because examining attorney did not object and made no mention of the marks, they were deemed to be of record). *See also 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).

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 CFR § 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.

When a timely request for reconsideration of an appealed action is filed (with or without new evidence), the examining attorney may submit, with his or her response to the request, new evidence directed to the issue(s) for which reconsideration is sought. [Note 2.] 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 3.] *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. *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198 (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, 1406-7 (TTAB 2006).

3. *See* 37 CFR § 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 CFR § 2.142(f)(1) (i.e., 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 CFR § 2.142(f)(6) (i.e., 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 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 knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the Office by filing, with the Office of the Deputy Commissioner for Trademark Examination Policy, a "letter of protest," that is, a letter that recites the facts and which is accompanied by supporting evidence. [Note 1.] The Deputy Commissioner will determine whether the information should be given to the examining attorney for consideration. *See* TBMP § 215. 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. [Note 2.]

Proceedings in an ex parte appeal will not be suspended pending determination by the Deputy Commissioner of a letter of protest. However, if a letter of protest is granted during the pendency of an ex parte appeal, and the examining attorney, having considered the supporting evidence submitted with the letter of protest, wishes to make that evidence of record in the application, that is, wishes to rely on the evidence to support the appealed refusal of registration, the examining attorney may file a written request with the Board, pursuant to 37 CFR § 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 sought to be introduced. *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 a letter of protest will depend on whether it meets evidentiary requirements for authentication or foundation, identified as to nature or source. [Note 3.]

NOTES:

1. *See In re Candy Bouquet International Inc.*, 73 USPQ2d 1883, 1884 n.2 (TTAB 2004); TMEP § 1715 *et seq*.

2. *In re Urbano*, 51 USPQ2d 1776, 1778 n.4 (TTAB 1999).

3. *In re Urbano*, 51 USPQ2d 1776 (TTAB 1999) (documents 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. 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. The reason for this more relaxed approach in ex parte cases is that in an ex parte proceeding there is no cross-examination of witnesses or any compelling need for the strict safeguards required in an inter partes proceeding. [Note 1.]

For example, the Board is somewhat more lenient in its approach in the consideration of surveys in ex parte proceedings than inter partes proceedings. [Note 2.] Also, the affidavit or 37 CFR § 2.20 declaration is an established method for the introduction of evidence in an ex parte proceeding. [Note 3.] In an inter partes proceeding, however, evidence may not be offered in affidavit or 37 CFR § 2.20 declaration form except by agreement of the parties. [Note 4.] TBMP § 703.01(b) (Form of 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 5.] Affidavits or declarations may have probative value even if they are form documents, or are prepared by the applicant's attorney. [Note 6.]

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 7.]

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 8.]

NOTES:

1. *See In re Hudson News Co.*, 39 USPQ2d 1915, 1920 n.10 and 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); and *In re Murphy Door Bed Co.*, 223 USPQ 1030, 1032 n.9 (TTAB 1984). *See also In re Berman Bros. Harlem Furniture Inc.*, 26 USPQ2d 1514 (TTAB 1993).

2. *In re Wilcher Corp.*, 40 USPQ2d 1929, 1934 (TTAB 1996); *In re Pillsbury Co.*, 174 USPQ 318, 320 (TTAB 1972).

3. *See, e.g.*, 37 CFR § 2.41(b); *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); and *In re Original Red Plate Co.*, 223 USPQ 836, 838 (TTAB 1984).

4. *See* 37 CFR § 2.123(b).

5. *See 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 uncontradicted by other information).

6. *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); and *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 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); and *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 (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).

7. *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).

8. *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), and *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.").

But see In re Mavety Media Group Ltd., 33 F.3d 1367, 31 USPQ2d 1923, 1928 (Fed. Cir. 1994) ("...the PTO may discharge its burden of proving that Mavety's mark BLACK TAIL is scandalous under § 1052(a) through evidence such as consumer surveys regarding the substantial composite of the general public.").

1208.01 Evidence from NEXIS Database or 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 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), *aff'd without opinion* (Fed. Cir. 1997) (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).

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 United States consumer impression of a proposed mark); *In re Cell Therapeutics, Inc.*, 67 USPQ2d 1795, 1798 (TTAB 2003). *But see 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); and *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 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 (TTAB 2010) (Board criticized applicant for submitting over 300 pages of Internet material, much of which was duplicative or irrelevant).

7. *See 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); and *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 (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 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. [Note 1.] However, the Board's well-established practice is to not 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.

37 CFR § 2.142(d) provides that the record in an appeal must be complete prior to the filing of an appeal, *see* TBMP § 1203.03(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, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic records of the Office, should be submitted during prosecution/examination of the application. [Note 2.] Mere listings of registrations, or copies of private company search reports, are not sufficient to make the registrations of record. [Note 3.] 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 stipulated the registrations into the record. [Note 4.] 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 5.] *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 6.] Thus, if the applicant has provided only a list of registration numbers and/or marks, the list will have very limited probative value. [Note 7].

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 8.]

Third-party applications, as opposed to registrations, have no probative value other than as evidence that the applications were filed. [Note 9.] 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 10.] Expired or cancelled third-party registrations generally are evidence only of the fact that the registrations issued. [Note 11.]

NOTES:

1. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1688 (Fed. Cir. 2010) ("Moreover, this court may take judicial notice of the existence of the Playboy bunny trademarks under Fed. R. Evid. 201(c), as we determine that the registration documents by the PTO are 'capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.' *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).")

2. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372-73 (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).

3. *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998) and *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996).

4. *See 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 Board deemed them stipulated into the record to the extent that the specific data provided by applicant was considered); *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); and *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).

5. *See 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).

6. *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).

7. *See In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1380 (TTAB 2006).

8. *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).

9. *In re Toshiba Medical Systems Corporation*, 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).

10. *In re Binion*, 93 USPQ2d 1531, 1535 n.3 (TTAB 2009).

11. *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006).

1208.03 Internet Material

Material obtained through the Internet or from websites is acceptable as evidence in ex parte proceedings. It is preferable that it be identified by the full address (url) for the web page, and the date it was downloaded, either by the information printed on the web page itself, or by providing this information in an Office action or an applicant's response. [Note 1.] 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 2.] Website evidence may also be used to show the translation of a word or term. [Note 3.] 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. Evidence from websites located outside the United States may have probative value depending on the circumstances. [Note 4.]

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 5.] Use in a search summary may indicate only that the two words in an overall phrase appear separately in the website literature. [Note 6.] Nor does the fact that a search by an Internet search engine retrieves a large number of hits have probative value. [Note 7.] 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 8.] *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 9.] *See* TBMP § 1203.01. The Board will not take judicial notice of Internet searches. [Note 10.]

Definitions available from an online resource, including online dictionaries and translations, that are readily available and therefore capable of being verified are acceptable. [Note 11.] 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 12.] 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 13.] TBMP § 1208.04. The Board will consider evidence taken from Wikipedia so long as the nonoffering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information. The better practice with respect to Wikipedia evidence is to corroborate the information with other reliable sources, including Wikipedia's sources. [Note 14.]

NOTES:

1. *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).

2. *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002).

3. *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).

4. *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).

5. *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 Innovative Companies LLC*, 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).

6. *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002).

7. *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).

8. *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).

9. *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").

10. *In re Viventia Biotech Inc.*, 80 USPQ2d 1376, 1377 (TTAB 2006).

11. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007); *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153 (TTAB 2009) (Board considered definition from Encarta online dictionary, made of record by examining attorney).

12. *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 (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).

13. *See Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

14. *In re Carrier Consulting Group*, 84 USPQ2d 1028, 1032-33 (TTAB 2007). *See also In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 n.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).

1208.04 Judicial Notice

The Board may take judicial notice of dictionary definitions, including definitions in technical dictionaries, translation dictionaries and online dictionaries which exist in printed format. [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, 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.] It will also consider definitions found only in online dictionaries if made of record during the prosecution of the application. 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's well-established practice is to not 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 7.] *See* TBMP § 1208.02.

For a full discussion of judicial notice, *see* TBMP § 704.12.

NOTES:

1. *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), *aff'd*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (definition from The American Heritage Dictionary of the English Language, retrieved from bartleby.com website); *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), *aff'd*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (definition from net.speak--the internet dictionary); *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); *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); and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 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. *See, e.g.*, *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, n.10, n.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); *In re Dial-A-Mattress Operating Corp.*, 52 USPQ2d 1910, 1916 (TTAB 1999), *rev'd on other grounds*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (toll-free telephone area codes such as "1-888" are used by numerous persons and businesses); *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); and *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 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 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); *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); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) (judicial notice taken of definition from *Merriam-Webster Online Dictionary*).

6. *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 Wada*, 48 USPQ2d 1689, 1689 n.2 (TTAB 1998), *aff'd*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (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); *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998); and *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).

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 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 1.]

NOTES:

1. *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).

1209 Remand

1209.01 Upon Board's Own Initiative

37 CFR § 2.142(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 examiner for further examination to be completed within thirty days.*

(2) *If the further examination does not result in an additional ground for refusal of registration, the examiner 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 examiner and appellant shall proceed as provided by §§ 2.61, 2.62, 2.63 and 2.64. If the ground for refusal is made final, the examiner 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 examiner shall, within sixty days after the supplemental brief of the appellant is sent to the examiner, file with the Board a written brief answering the supplemental brief of appellant and shall 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*

examiner.

(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.] Thus, the Board 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.

The Board may also sua sponte remand an application to the examining attorney if, after examination and/or briefing has been completed, a decision is rendered that is likely to have a bearing on the examining attorney's position. [Note 2.] 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 30 days from the date of remand, or within an extension of time for that purpose. [Note 3.]

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 4.]

If the examining attorney returns the remanded application to the Board with a written statement that further examination did not result in an additional requirement or ground for refusal of registration, the Board will resume proceedings with respect to the appeal, and take further appropriate action therein. 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 5.]

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 CFR § 2.61 through 37 CFR § 2.64. [Note 6.] If the additional requirement or ground for refusal of registration is ultimately made final, the six-month response clause should be omitted from the paper in which such action is taken; 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 7.]

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 8.] 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 9.] The examining attorney must also send a copy of his or her brief to the applicant. [Note 10.] 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 11.] 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 12.] However, 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 directed to the additional ground for refusal of registration. [Note 13.] 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 paper 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 14.]

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 CFR § 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 CFR § 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 CFR § 2.142(f)(1), submit evidence relating to a requirement or ground not specified in the Board's remand letter. [Note 15.] 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 CFR § 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); and *In re Johanna Farms, Inc.*, 223 USPQ 459, 461 (TTAB 1984). *See, in addition, In re Wella A.G.*, 230 USPQ 77, 79 (TTAB 1986) (but see *In re Wella A.G.*, 858 F.2d 725, 8 USPQ2d 1365, 1369 (Fed. Cir. 1988)).

2. *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).

3. 37 CFR § 2.142(f)(1).

4. *See* 37 CFR § 2.142(f)(2). *See In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986).

5. *See In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986).

6. 37 CFR § 2.142(f)(3).

7. 37 CFR § 2.142(f)(3).

8. 37 CFR § 2.142(f)(3).

9. *See In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1918 (TTAB 1998).

10. 37 CFR § 2.142(f)(4).

11. *Cf. In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n*, 223 USPQ 188 n.3 (TTAB 1984).

12. 37 CFR § 2.142(f)(4).

13. 37 CFR § 2.142(f)(5).

14. 37 CFR § 2.142(f)(5).

15. *See In re W.W. Henry Co.*, 82 USPQ2d 1213 (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); and *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 CFR § 2.142(f)(6) *If, during an appeal from a refusal of registration, it appears to the examiner that an issue not involved in the appeal may render the mark of the appellant unregistrable, the examiner may, by written request, ask the Board to suspend the appeal and to remand the application to the examiner for further examination. If the request is granted, the examiner 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 examiner 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 his 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 CFR § 2.61 through 37 CFR § 2.64. [Note 3.]

If, upon remand, the examining attorney determines that registration should not be finally refused on the additional ground for refusal of registration 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 CFR § 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.

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 CFR § 2.142(f)(6).

2. *See 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 CFR § 2.142(f)(6). *Cf*. 37 CFR § 2.142(f)(3).

4. *See* 37 CFR § 2.142(f)(6).

5. *See In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1918 (TTAB 1998).

1209.03 Upon Granted Letter of Protest

A third party that has knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the Office by filing, with the Office of the Deputy Commissioner for Trademark Examination Policy, a "letter of protest," that is, a letter that recites the facts and which is accompanied by supporting evidence. [Note 1.] The Deputy Commissioner will determine whether the information should be given to the examining attorney for consideration. *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 a letter of protest is granted during the pendency of an ex parte appeal, and the examining attorney, having considered the supporting evidence submitted with the letter of protest, 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 CFR § 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 CFR § 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. Requests for reconsideration are granted by the Board as a matter of right. *See* TBMP § 1204. However, if the examining attorney denies a request for reconsideration after the 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. 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), it will be treated as a request for remand, whether it is captioned as such or is captioned as a request for reconsideration.

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. No matter what the purpose, the request for remand must include a showing of good cause. [Note 1.] 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. 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.

NOTES:

1. *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).

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 by telephone or e-mail 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 CFR § 2.68* Express abandonment (withdrawal) of application.** *An application may be expressly abandoned by filing in the Patent and Trademark Office a written statement of abandonment or withdrawal of the application signed by the applicant, or the attorney or other person representing the applicant. Except as provided in § 2.135, the fact that an application has been expressly abandoned shall not, in any proceeding in the Patent and Trademark Office, affect any rights that the applicant may have in the mark which is the subject of the abandoned application.*

During an ex parte appeal to the Board, the applicant may expressly abandon its involved application by filing in the Office a written statement of abandonment or withdrawal of the application. The abandonment or withdrawal must be signed by the applicant or its attorney or other authorized representative. [Note 1.]

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 2.]

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 3.] TBMP § 602.01 and TBMP § 603.

NOTES:

1. 37 CFR § 2.68.

2. 37 CFR § 2.68. *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 (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 (TTAB 1987); and *Lukens Inc. v. Vesper Corp.*, 1 USPQ2d 1299 (TTAB 1986), *aff'd*, 831 F.2d 306 (Fed. Cir. 1987).

3. 37 CFR § 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 the 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. If the applicant learns that the registration has expired or been cancelled, the applicant should immediately notify the Board thereof. Similarly, if the registration is assigned to the applicant, the applicant should immediately notify the Board thereof.

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—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 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 paper has 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 by telephone or e-mail. 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 action 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.

The examining attorney may also request suspension if it comes to his or her attention that another application that involves the same issue is on appeal to the Board. In that circumstance, the examining attorney may also request that the appeals be consolidated. *See* TBMP § 1214.

A request 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 paper 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, 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 sua sponte suspend action in the following circumstance. When an ex parte appeal has been assigned to a judge for final decision, the case will be suspended if 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 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.

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. *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.

NOTES:

1. *Cf*. 37 CFR § 2.117.

2. A Trademark Act § 66(a), 15 USC § 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. § 1141(j)refers to a renewal of the international registration underlying a Trademark Act § 66(a), 15 USC § 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.

NOTES:

1. *See, e.g.*, *In re America Online Inc.*, 77 USPQ2d 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 (TTAB 1991); *In re Del E. Webb Corp.*, 16 USPQ2d 1232 (TTAB 1990) (proceedings consolidated because issue in two appeals the same); *In re Anton/Bauer Inc.*, 7 USPQ2d 1380 (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 (TTAB 1987); *In re Petersen Manufacturing Co.*, 2 USPQ2d 2032 (TTAB 1987) (four appeals consolidated for oral hearing and decision); *In re San Diego National League Baseball Club, Inc.*, 224 USPQ 1067 (TTAB 1983) (appeals consolidated for oral hearing and decision).
2. *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), *aff'd without opinion* (Fed. Cir. 1997) (Board issued a single opinion in interest of judicial economy, but each appeal stands on its own merits).

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 his or her position with respect to each of the applicant's alternative claims. [Note 5.]

NOTES:

1. *See, e.g.*, *In re Brouwerij Bosteels*, 96 USPQ2d 1414 (TTAB 2010); *In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992); *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Seaman & Associates Inc.*, 1 USPQ2d 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 (TTAB 1985); and TMEP § 1212.02(c). *See also*, for additional situations in which an applicant has taken alternative positions, *In re Binion*, 93 USPQ2d 1531 (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 (TTAB 1985); *In re Narwood Productions, Inc.*, 223 USPQ 1034 (TTAB 1984); *In re Anania Associates, Inc.*, 223 USPQ 740 (TTAB 1984); *In re Perfect Fit Industries, Inc.*, 223 USPQ 92 (TTAB 1984); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983); *In re Capital Formation Counselors, Inc.*, 219 USPQ 916 (TTAB 1983); and *In re Harrington*, 219 USPQ 854 (TTAB 1983)**.** *Cf.* Fed. R. Civ. P. 8(e)(2).

2. *See 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).

But see 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, 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 (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, 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 distinctivenss or accept registration under Trademark Act § 2(f)).

4. *See* TMEP § 1212.02(c).

5. *See* TMEP § 1212.02(c).

1216 Oral Hearing

37 CFR § 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 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.*

(2) *If the appellant requests an oral argument, the examiner who issued the refusal of registration or the requirement from which the appeal is taken, or in lieu thereof another examiner from the same examining division as designated by the supervisory attorney thereof, 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 examiner. The appellant may reserve part of the time allowed for oral argument to present a rebuttal argument.*

For general information concerning oral hearings in 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. [Note 1.] If the applicant does not request an oral hearing, the appeal will be decided on the record and briefs. [Note 2.] An examining attorney may not request an oral hearing. An oral hearing is particularly useful in ex parte cases involving complex issues or where the goods or services identified in the applicant's application (or a cited registration) are 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 paper filed with the Board. The Board encourages applicants to file the request for oral hearing through ESTTA, which includes "Request for Oral Hearing" among the list of entries identifying the type of paper being filed. If filed on paper, only one copy of such request should be submitted. When the applicant has filed a timely request for an oral hearing, the Board contacts the applicant with possible dates, and then sends the applicant a notice of hearing specifying the date, time, and location of the hearing. Ordinarily, hearings are scheduled on Tuesdays, Wednesdays and Thursdays between 10:00 a.m. and 3:00 p.m. (Eastern Standard Time). In setting the oral hearing, it is the normal practice of the Board to set a time that is convenient for both the applicant and the examining attorney.

Hearings are almost exclusively held at the offices of the Board. However, an applicant may request attendance at the hearing remotely via video conference. A video hearing will be conducted in the same manner as if conducted entirely in the hearing room. An applicant may request a hearing by video conference in its written request for an oral hearing, or may make such a request when the Board contacts it to schedule the hearing. An applicant that requests attendance at the oral hearing via video conferencing is responsible for arranging and paying for its video connection. The Board uses an ISDN telephone line and the applicant must use compatible technology. A day before the scheduled hearing, the Board will contact the applicant to test the video connection. *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). [Note 3.] 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 4.] Board practice in such a situation is to reschedule an oral hearing, either by postponing the date or by moving it forward, but, absent compelling circumstances, not to change a hearing date if the request for rescheduling is made within two weeks of the scheduled hearing date, unless both the applicant and the examining attorney agree to the change. Therefore, if the applicant requires a rescheduling of the oral hearing, it should inform the Board by telephoning the secretary to the Chief Judge of the Board (whose contact information appears on the scheduling order), and by a follow-up facsimile transmission, not later than two weeks prior to the scheduled hearing date. If circumstances arise that prevent the applicant from providing such notice, the applicant should inform the Board as soon as the circumstances become known. Although the Board will allow the cancellation of the oral hearing by the applicant at any point, the Board will consider the circumstances in determining whether it will grant a request by the applicant to reschedule the oral hearing, or whether it will decide the case on briefs without oral hearing. [Note 5.]

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 from the same USPTO law office who has been designated for the purpose by the managing attorney of that law office, must appear at the hearing and present an oral argument. [Note 6.] If the examining attorney requires a rescheduling of the oral hearing, he or she should advise the secretary to the Chief Judge of the Board, by telephone or e-mail, 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 the managing attorney of the law office 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 7.] 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 8.] *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 9.]

NOTES:

1. 37 CFR § 2.142(e)(1).

2. 37 CFR § 2.142(e)(2).

3. *See* Trademark Act § 17, 15 U.S.C. § 1067.

4. 37 CFR § 2.142(e)(1).

5. *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).

6. *See* 37 CFR § 2.142(e)(2).

7. 37 CFR § 2.142(e)(3).

8. 37 CFR § 2.129(a).

9. *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).

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.

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 1.] 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 2.]

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 3.] However, in certain circumstances after the Board has affirmed one requirement or refusal it will not reach any further requirement or refusal. [Note 4.]

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 5.]

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 6.] 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 CFR § 2.142(g), as discussed below. [Note 7.] 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 8] 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 9], 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 10.] *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 11.] 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 12.]

NOTES:

1. *See In re AFG Industries Inc.*, 17 USPQ2d 1162, 1163 (TTAB 1990); *In re Avocet, Inc.*, 227 USPQ 566, 567 (TTAB 1985); and *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); and *Hunt v. Treppschuh and Hentrich*, 523 F.2d 1386, 187 USPQ 426, 428 (CCPA 1975).

2. *See In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 342 n.2 (TTAB 1985).

3. *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 (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 (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).

4. *In re Max Capital Group Ltd.*, 93 USPQ2d 1243 (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 (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, 1072 (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).

5. *In re Wielinski*, 49 USPQ2d 1754 (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 (TTAB 1984) (affirming refusal to register as to class 14 and reversing refusal to register as to all remaining classes).

6. *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); and TMEP § 1501.06.

7. *See In re Johanna Farms, Inc.*, 223 USPQ 459, 460 (TTAB 1984) and *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 397 n.2 (TTAB 1982).

8. An application under Trademark Act § 66(a), 15 U.S.C. § 1141f(a) may not be remanded under 37 CFR § 2.131.

9. 37 CFR § 2.131.

10. 37 CFR § 2.142(f)(1).

11. *See In re W.W. Henry Co.*, 82 USPQ2d 1213 (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); and *In re Wallyball, Inc.*, 222 USPQ 87, 88 n.2 (TTAB 1984).

12. *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 CFR § 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, 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. *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 1.] 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 2] 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 3.]

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 examination and the submission of additional evidence. [Note 4.]

NOTES:

1. *See* 37 CFR § 2.142(g); *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); and *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 n.3 (TTAB 1986).

2. 37 CFR § 2.142(g); *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); and *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).

3. *See* 37 CFR § 2.142(g); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 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 CFR § 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); and *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); and TMEP § 1501.06.

4. *See In re Spirits International N.V.*, 563 F.3d 1347, 90 USPQ2d 1489 (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 (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 (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 (TTAB 1989).

1219 Review of Final Decision

1219.01 By Request for Reconsideration

***37 CFR § 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 two months after action on the request. [Note 4.]

NOTES:

1. 37 CFR § 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); and 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 CFR § 2.145(d)(1).

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.]

For information concerning the taking of an appeal from a final decision of the Board, *see* TBMP § 901- 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 CFR § 2.145.

APPENDIX OF FORMS

APPENDIX A: CERTIFICATE OF MAILING SUGGESTED FORMAT
APPENDIX B: CERTIFICATE OF TRANSMISSION SUGGESTED FORMAT
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: SAMPLE TRIAL ORDER FOR INTERFERENCE
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:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

on _____ _____
Date Signature

_____
Typed or printed name of
person signing certificate

APPENDIX B

Certificate of Transmission Suggested Format

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office

on _____ _____
Date Signature

_____
Typed or printed name of
person signing certificate

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 mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: (set out name and address of opposing counsel or party).

APPENDIX D

Designation of Domestic Representative

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	**10/1/2010**
Deadline for Discovery Conference	**10/31/2010**
Discovery Opens	**10/31/2010**
Initial Disclosures Due	**11/30/2010**
Expert Disclosures Due	**3/30/2011**
Discovery Closes	**4/29/2011**
Plaintiff's Pretrial Disclosures Due	**6/13/2011**
Plaintiff's 30-day Trial Period Ends	**7/28/2011**
Defendant's Pretrial Disclosures Due	**8/12/2011**
Defendant's 30-day Trial Period Ends	**9/26/2011**
Plaintiff's Rebuttal Disclosures Due	**10/11/2011**
Plaintiff's 15-day Rebuttal Period Ends	**11/10/2011**

APPENDIX F

Sample Trial Order and Briefing With a Counterclaim

Answer to Counterclaim Due	October 1, 2010
Deadline for Discovery Conference	October 31, 2010
Discovery Opens	October 31, 2010
Initial Disclosures Due	November 30, 2010
Expert Disclosures Due	March 30, 2011
Discovery Closes	April 29, 2011
Pretrial Disclosures Due for party in position of plaintiff in the main claim and as defendant in the counterclaim (hereinafter "PARTY A")	June 13, 2011
30-day testimony period for "PARTY A" to close (as plaintiff in the main claim)	July 28, 2011
Pretrial Disclosures Due for party in position of defendant in the main claim and as plaintiff in the counterclaim (hereinafter "PARTY B")	August 12, 2011
30-day testimony period for "PARTY B" (as plaintiff in the counterclaim and as defendant in the main claim) to close	September 26, 2011
Rebuttal Disclosures Due for "PARTY A" (as plaintiff in the main claim)	October 11, 2011
30-day testimony period for "PARTY A" (as defendant in the counterclaim) and rebuttal testimony for "PARTY A" (as plaintiff in the main claim) to close	November 25, 2011
Rebuttal Disclosures Due for "PARTY B" (as defendant in the main claim and as plaintiff in the counterclaim)	December 10, 2011
15-day rebuttal period for "PARTY B" to close	January 9, 2012
Brief for "PARTY A" due	March 9, 2012
Brief for "PARTY B" due	April 8, 2012
Brief for "PARTY A" (as defendant in the counterclaim) and reply brief, if any, for "PARTY A" (as plaintiff in the main claim) due	May 8, 2012
Reply brief, if any, for "PARTY B" due	May 23, 2012

APPENDIX G

Sample Trial Order for Interference

Set forth below is a sample trial and briefing schedule for an interference involving parties A, B, C, D, and E, where A is junior to every other party; B is junior to C, D, and E, and senior to A; C is junior to D and E, and senior to A and B; D is junior to E, and senior to A, B, and C; and E is senior to every other party:

THE PERIOD FOR DISCOVERY TO OPEN : January 2, 2003

THE PERIOD FOR DISCOVERY TO CLOSE : July 2, 2003

30-day testimony period for A to close : August 31, 2003

30-day testimony period for B to close : October 30, 2003

30-day testimony period for C to close : December 31, 2003

30-day testimony period for D to close : March 1, 2004

30-day testimony period for E to close : April 30, 2004

15-day rebuttal testimony period for
A to close : June 14, 2004

15-day rebuttal testimony period for
B to close : July 29, 2004

15-day rebuttal testimony period for
C to close : September 12, 2004

15-day rebuttal testimony period for
D to close : October 28, 2004

Briefs on final hearing (37 CFR 2.128) shall become due as follows:

Brief for A shall be due : December 27, 2004

Brief for B shall be due : January 26, 2005

Brief for C shall be due : February 25, 2005

Brief for D shall be due : March 27, 2005

Brief for E shall be due : April 26, 2005

Reply briefs, if any, shall be due as follows:

Reply brief for A shall be due : May 11, 2005

Reply brief for B shall be due : May 26, 2005

Reply brief for C shall be due : June 10, 2005

Reply brief for D shall be due : June 25, 2005

APPENDIX H

Sample Trial Orders for Concurrent Use Proceedings

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):

Mailing Date	6/1/2010
Time to Answer	7/11/2010
Deadline for Discovery Conference	8/10/2010
Discovery Opens	8/10/2010
Initial Disclosures Due	9/9/2010
Expert Disclosures Due	1/7/2011
Discovery Closes	2/6/2011
A's Pretrial Disclosures Due	3/23/2011
A's 30-day Trial Period Ends	5/7/2011
B's Pretrial Disclosures Due	5/22/2011
B's 30-day Trial Period Ends	7/6/2011
C's Pretrial Disclosures Due	7/21/2011
C's 30-day Trial Period Ends	9/4/2011
D's Pretrial Disclosures Due	9/19/2011
D's 30-day Trial Period Ends	11/3/2011
E's Pretrial Disclosures Due	11/18/2011
E's 30-day Trial Period Ends	1/2/2012
A's Rebuttal Disclosures Due	1/17/2012
A's 15-day Rebuttal Period Ends	2/16/2012
B's Rebuttal Disclosures Due	3/2/2012
B's 15-day Rebuttal Period Ends	4/1/2012
C's Rebuttal Disclosures Due	4/16/2012
C's 15-day Rebuttal Period Ends	5/16/2012
D's Rebuttal Disclosures Due	5/31/2012
D's 15-day Rebuttal Period Ends	6/30/2012
Briefs on Final Hearing (37 CFR § 2.128)	
shall become due as follows:	
BRIEF FOR A is due	8/29/2012

BRIEF FOR B is due	9/28/2012
BRIEF FOR C is due	10/28/2012
BRIEF FOR D is due	11/27/2012
BRIEF FOR E is due	12/27/2012
REPLY BRIEFS, if any, shall be due as follows:	
REPLY BRIEF FOR A is due	1/11/2013
REPLY BRIEF FOR B is due	1/26/2013
REPLY BRIEF FOR C is due	2/10/2013
REPLY BRIEF FOR D is due	2/25/2013

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:

Mailing Date	6/1/2010
Time to Answer	7/11/2010
Deadline for Discovery Conference	8/10/2010
Discovery Opens	8/10/2010
Initial Disclosures Due	9/9/2010
Expert Disclosures Due	1/7/2011
Discovery Closes	2/6/2011
X's Pretrial Disclosures Due	3/23/2011
X's 30-day Trial Period Ends	5/7/2011
Y's Pretrial Disclosures Due	5/22/2011
Y's 30-day Trial Period Ends	7/6/2011
Z's Pretrial Disclosures Due	7/21/2011
Z's 30-day Trial Period Ends	9/4/2011
X's Rebuttal Disclosures Due	9/19/2011
X's 15-day Rebuttal Period Ends	10/19/2011
Briefs on Final Hearing (37 CFR § 2.128)	
shall become due as follows:	
BRIEF FOR X is due	12/18/2011

BRIEF FOR Y is due	1/17/2012
BRIEF FOR Z is due	2/16/2012
REPLY BRIEFS, if any, shall be due as follows:	
REPLY BRIEF FOR X is due	3/2/2012

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.

Deadline for Discovery Conference	8/10/2010
Discovery Opens	8/10/2010
Initial Disclosures Due	9/9/2010
Expert Disclosures Due	1/7/2011
Discovery Closes	2/6/2011
A's Pretrial Disclosures	3/23/2011
A's 30-day Trial Period Ends	5/7/2011
B's Pretrial Disclosures	5/22/2011
B's 30-day Trial Period Ends	7/6/2011
C's Pretrial Disclosures	7/21/2011
C's 30-day Trial Period Ends	9/4/2011
D's Pretrial Disclosures	9/19/2011
D's 30-day Trial Period Ends	11/3/2011
A's Rebuttal Disclosures	11/18/2011
A's 15-day Rebuttal Period Ends	12/18/2011

With the exceptions noted above, the practices and procedures in cases commenced on or after November 1, 2007 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.

APPENDIX I

Notice 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)

INDEX TO CHANGES IN THIRD EDITION
CHAPTER 100

TBMP SECTION	NATURE OF CHANGE
101 Applicable Authority	Section Heading only.
101.01 Statute and Rules of Practice	Amended first paragraph to indicate that proceedings are governed by rules relating to conduct of practitioners and that such rules may be found in Parts 10 and 11 of 37 CFR.
	Amended paragraph 2 to update websites for accessing 37 CFR online. Amended paragraph 3 to update website for accessing information regarding rule changes.
101.02 Federal Rules	Added reference to 37 CFR § 2.122(a); amended first paragraph to include reference to 37 CFR § 2.116(a).
	Added new cases to Note 1: *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112 , 1117 (TTAB 2009); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1956 (TTAB 2008); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1861 (TTAB 2008); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104-05 (TTAB 2007); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1264-65 (TTAB 2003); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370, 1372 (TTAB 1998); *HRL Assoc. Inc. v. Weiss Assoc. Inc.*, 12 USPQ2d 1819, 1822 (TTAB 1989); and *Miles Labs. Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1448, n.20 (TTAB 1986).
	Deleted the following from Note 1: references to 37 CFR §§ 2.116(a) and 2.120(a); and citations to *Young v. AGB Corp.,* 152 F.3d 1377, 47 USPQ2d 1752, 1753 n.3 (Fed. Cir. 1998); and *Cerveceria India Inc. v. Cervecevia Centroamericana, S.A.,* 10 USPQ2d 1064 (TTAB 1989), *aff'd*.
	Added signal "e.g." to preface cases cited in Note 2 and added parenthetical to *In re Foundry Products, Inc.*, 193 USPQ 565 (TTAB 1976) in Note 2.

101.03 Decisional Law	Amended paragraph 2 to inform reader that Board decisions are also available online and provided website addresses.
	Amended paragraph 3 to revise policy on citation of non-precedential decisions; and to inform reader that Board decisions should be cited by reference to the USPQ volumes if available; otherwise to a USPTO publically available electronic database.
	Deleted the following from paragraph 3: "A nonprecedential or digest decision will, however, be considered in determining issues of claim preclusion, issue preclusion, judicial estoppel, law of the case, or the like, provided that (1) a party to the pending Board proceeding, or its privy, was also a party to the prior proceeding, and (2) a complete copy of the decision is submitted."
	Added new paragraph 4 indicating that parallel citations to Federal Reporter or Federal Supplement should be given.
	New reference added to Note 1: *Citation of Opinions to the Trademark Trial and Appeal Board*, O.G. Notice (Jan. 23, 2007); new website addresses added to Note 1: http://des.uspto.gov/Foia/TTABReadingRoom.jsp and files of TTAB proceedings are available at http://ttabvue.uspto.gov/.
	Deleted the following from Note 1: "*In re Polo International, Inc.*, 51 USPQ2d 1061, 1063 n.3 (TTAB 1999) (non-precedential case disregarded); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1336 (TTAB 1997) *citing General Mills Inc. v. Health Valley Foods,* 24 USPQ2d 1270, 1275 n.9 (TTAB 1992); and *In re American Olean Tile Co., supra* at 1825 n.3 (published digests do not indicate the facts on which the determinations were based). *See also Marcon, Ltd. v. Merle Norman Cosmetics, Inc.,* 221 USPQ 644, 645 n.4 (TTAB 1984) and *Roberts Proprietaries, Inc. v. Rumby International, Inc.*, 212 USPQ 302, 303 (TTAB 1981)."
	Deleted former Note 6, citing: General Mills Inc. v. Health Valley Foods, supra.
101.04 Director's Orders and Notices	Updated website address at which to find Director's orders and notices.

101.05 Trademark Trial And Appeal Board Manual Of Procedure (new subsection)	This is a new subsection on the purpose and authority of the TBMP.
	Added new Note 1, citing: *Rosenruist-Gestao E Servicos LDA v. Virgin Enters. Ltd*., 511 F.3d 437, 85 USPQ2d 1385, 1393 (4th Cir. 2007); and, by comparison, *cf. In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009).
	Added new Note 2, providing reader with mailing address for sending suggestions and comments to the Board.
102 Nature of Board Proceedings	Section Heading only.
102.01 Jurisdiction of Board	Amended first paragraph to delete reference to Board's placement as tribunal within the Office of General Counsel.
	Added new cases to Note 2: *FirstHealth of the Carolinas Inc. v. CareFirst of Md. Inc*., 479 F.3d 825, 81 USPQ2d 1919, 1921 (Fed. Cir. 2007) (quoting TBMP); *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006) *aff'd, unpubl'd,* 240 Fed. Appx. 865 (Fed. Cir. 2007), *cert. den'd,* 128 S.Ct. 893, 169 L.Ed.2d 746 (2008); and *Mario Diaz v. Servicios De Franquicia Pardo's S.A.C.,* 83 USPQ2d 1320, 1326 (TTAB 2007).
	Added pin cite to *Carano v. Vina Concha Y Toro S.A*., 67 USPQ2d 1149, 1151-52 (TTAB 2003) in Note 2.
	Added new cases to Note 3: *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). Changed signal from "see also, for example," to "cf." as preface to *Capital Speakers Inc. v. Capital Speakers Club of Washington, D.C. Inc*., 41 USPQ2d 1030, 1034 n.3 (TTAB 1996).
102.02 Types of Board Proceedings	Amended first paragraph to indicate that an opposition seeks to prevent issuance of a registration in whole or in part.
	Amended second paragraph to indicate that a cancellation seeks to cancel a registration in whole or in part, of a Principal or Supplemental

	Register registration.
	Amended paragraph 4 to clarify that concurrent use registrations are only available on the Principal Register.
	Deleted the following from former Note 18: "*See also, e.g., In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994) *citing In re BankAmerica Corp*., 231 USPQ 873 (TTAB 1986)," because cited cases are not about the Board's jurisdiction, but rather the Board's obligation to decide each appeal on its own merits.
102.03 General Description of Board Proceedings	Amended first paragraph to include conferencing, disclosures, trial, and oral hearings as part of Board proceedings; and to inform reader of option to use ACR to expedite proceeding.
	Amended paragraph 2 to include statement discussing makeup of Board; and to indicate that certain motions may be acted upon by Board paralegals or through ESTTA.
	Added parenthetical to *La Maur, Inc. v. Bagwells Enter., Inc*., 193 USPQ 234, 235 (Comm'r 1976) in Note 2.
	Added new Note 3, referencing Trademark Act § 17(b).
103 Location and Address of Board	Updated addresses.
104 Business to be Conducted in Writing	Added reference to telephone conferences as exception to rule that all business be conducted in writing.
105 Contact With Board Personnel	Updated telephone number. Deleted invitation to "come to the offices of the Board." Added prohibition against e-mail inquiries.
106 Identification, Signature, and Form of Submissions	Section Heading only.
106.01 Identification of Submissions	Amended first paragraph to add reference to extension of time to oppose; amended second paragraph to emphasize that documents filed in an application which is the subject of a Board proceeding should not be filed with the Trademark Examining Operation.
106.02 Signature of Submissions	Replaced 37 CFR § 10.14(e) with 37 CFR § 11.14(e) and replaced 37 CFR § 10.18(a) with 37 CFR § 11.18. Updated reference to 37 CFR §

	2.198.
	Amended first paragraph to inform reader that signatory to document filed in Board proceeding must be identified.
	Amended second paragraph to indication that documents filed through ESTTA may bear a signature on only the cover sheet but that the signature must be that of the party filing the document, or its attorney or authorized representative.
	Amended paragraph 3 by deleting “documents filed by the corporation” from statement clarifying that corporate party acting in its own behalf should have an officer sign documents.
	Amended paragraph 4 to indicate that documents must be personally signed or signature inserted by the attorney or representative, unless party must personally sign document; updated 37 CFR § 11.18(b) from 37 CFR § 10.18(b); updated paragraph to clarify that cover letter does not need to be signed by attorney.
	Updated reference to 37 CFR § 2.198 in paragraph 7, changing it from 37 CFR § 2.198(c) to 37 CFR § (b); further updated paragraph to amend “paper copy” to “copy.”
	Updated reference to 37 CFR §§ 2.193 and 11.18(a) by changing “37 CFR § 2.193(c)” to “37 CFR § 2.198(d)-(e) and changing “37 CFR § 10.18(a)” to “37 CFR § 11.18(a).”
	Added new cases to Note 2: *DaimlerChrysler Corp. v. Maydak,* 86 USPQ2d 1945, 1946 (TTAB 2008); and *PPG Indus. Inc. v. Guardian Indus. Corp*., 73 USPQ2d 1926, 1927 (TTAB 2005).
	Added new cases to Note 3: *DaimlerChrysler Corp. v. Maydak,* 86 USPQ2d 1945, 1946 (TTAB 2008); and *PPG Indus. Inc. v. Guardian Indus. Corp*., 73 USPQ2d 1926, 1928 (TTAB 2005).
	Updated references in Note 4 to 37 CFR § 11.14 and 2.11 by changing “37 CFR § 10.14” to “37 CFR § 11.14” and by deleting the “cf.” signal prefacing 37 CFR § 2.11.
	Updated reference in Note 5 from “37 CFR § 10.14(e)” to “37 CFR § 11.14(e).”
	Updated reference in Note 6 from “37 CFR § 10.18 to “37 CFR § 11.18.” Updated signal

	prefacing *Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098, 1100 n.9 (TTAB 1996) from "see also, for example" to "see also."
	Added new Note 7, referencing 37 CFR § 2.193(e)(10).
	In Note 8: Updated reference from "37 CFR § 10.18(a)" to "37 CFR § 11.18(a)"; amended parenthetical to *Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017 (TTAB 2003) by deleting "to suspend" after "motion"; added "cf." signal prefacing citation to *Cerveceria India Inc. v. Cerveceria Centroamericana, S.A.*, 10 USPQ2d 1064, 1067 (TTAB 1989); and deleted "*In re Cowan*, 18 USPQ2d 1407, 1409 (Comm'r 1990) (Section 8 declaration in name of sole proprietor, but signed for him by his attorney, not acceptable)."
	Added new Note 9, referencing 37 CFR § 2.193(d).
	Updated reference in Note 10 from "37 CFR § 2.193(c)(1)(ii)" to "37 CFR § 2.198(b)."
106.03 Form of Submissions	Updated reference to 37 CFR § 2.126 to reflect rules changes; eliminated discussion of CD-ROM filings in first paragraph and added that CD-ROM filing rules have been revoked.
	Amended paragraph 3 to add that disassembling stapled or bound papers can result in jammed scanning equipment or lost pages.
	Changed the word "paper" to "document" in paragraph 4.
	Deleted the following from paragraph 5: "CD-ROM submissions are governed by part (b) of 37 CFR § 2.126" and "The Board's electronic filing system is also available to the public in the Trademark Library Search Room."
	Added new paragraphs 6-9 to include further discussion of (and encouragement to use) ESTTA and to provide toll free telephone number and other contact information for technical ESTTA questions.
	Deleted reference to "CD-ROM" filings in paragraph 10.
	Amended paragraph 11 to advise reader that audio and video tape exhibits may not filed electronically; deleting the following from the paragraph "[may] be transferred to an appropriate

	electronic format for submission to the Board."
	Amended paragraph 12 to indicate that 37 CFR § 2.126(d) has been changed to 37 CFR § 2.126(c); and added recommendation that confidential materials be filed through ESTTA; deleting the following from the paragraph "Confidential materials filed in the absence of a protective order are not regarded as confidential and will not be kept confidential by the Board."
	Deleted the following from subheading "Format of submissions" in the final paragraph of this subsection: "As an aid to litigants, however, suggested formats for certain types of documents filed in Board proceedings can be found in the Appendix of Forms to this manual as well as in the section where the particular type of document is discussed. These include a notice of appeal to the Board, designation of domestic representative, certificate of mailing or certificate of transmission under 37 CFR § 2.197, and a certificate of service."
	Deleted former footnotes 41, 45, 46, referencing 37 CFR § 2.126(c); TBMP 120.02 and 37 CFR § 2.126, respectively, as unnecessary.
107 How and Where to File Papers and Fees	Amended reference to 37 CFR §§ 2.195(b), (d) and (e) to reflect rules changes.
	Amended first paragraph to encourage use of ESTTA and to delete the following: "An increasing number of documents can be filed with the Office through its web site at www.uspto.gov."
	Updated addresses for delivery of documents relating to Board proceedings, and included Trademark Assistance Center as alternate address for same; also eliminated distinction between documents filed with a fee and those not accompanied by a fee.
	Deleted extensive discussion of fax filing as unnecessary.
	Deleted former notes 48 and 49, referencing 37 CFR § 2.193(c) and TMEP § 306.02, respectively.
	Added final note that Board does not accept any filings by e-mail.

	Amended Note 1 by changing reference to 37 CFR § 2.195 from 2.195(c)(3) to 2.195(d)(3); Added new case to Note 1: *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280 (TTAB 2008); added information on filing notice of ex parte appeal to Note 1.
	Amended Note 2 by eliminating reference to 37 CFR § 2.193(c) and by adding that Board may specifically direct party to make a fax filing.
108 Filing Receipts	Amended first paragraph to eliminate distinction between filing a document with or without a fee.
	Added new second paragraph to explain successful filing of ESTTA documents.
	Amended fourth paragraph to update hand delivery information to Trademark Assistance Center from former "Customers' Window" and deleted fax information as unnecessary.
	Amended Note 1 to include USPTO web site address and deleted former footnote 51, which had cited 37 CFR § 2.195(c)(3) and TBMP § 107.
109 Filing Date	Updated 37 CFR §§ 2.195 (b), (d) and (e) to reflect rules changes; amended first paragraph to indicate that cover sheet transmitted through ESTTA will be affixed with the date ("and time" deleted) of receipt.
	Deleted the following: "The "date of receipt" of correspondence mailed to the Office is the date stamped by the Post Office on the mailbags in which the correspondence is delivered to the Office."
	Added new case to Note 1: *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1282 (TTAB 2008); added reference to USPTO web site address.
	Deleted former footnote 54 as follows: "*See* 37 CFR § 2.195(b); *In re Amethyst Investment Group*, 37 USPQ2d 1735 (Comm'r 1995); and *In re Klein*, 6 USPQ2d 1528, 1536 (Dep't Comm. 1986), *aff'd sub nom. Klein v. Peterson*, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd*, 866 F.2d 912, 9 USPQ2d 1558 (Fed. Cir. 1989)."
	Added new reference to Note 3: 37 CFR § 2.198(d).
	Added new reference to Note 4: 37 CFR § 2.195(d)(3).

	Amended reference in Note 6 from "37 CFR §§ 1.6(d) and 1.8(a)" to "37 CFR § 2.195(a) and 2.197(a)" and from "37 CFR § 1.6(e)" to "37 CFR § 2.195(e)."
110 Certificate Of Mailing Procedure and Electronic Filing Using ESTTA (new title)	Changed title from "Certificate of Mailing or Transmission Procedure"
110.01 Certificate Of Mailing – In General (new title)	Changed title from "In General"
	Updated reference to 37 CFR § 2.197(a)(2) to reflect rules changes.
	Amended parenthetical to *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1759 n.1 (TTAB 1999) in Note 2.
	Added pin cite to *S. Indus. Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1295 (TTAB 1997) in Note 3.
	Changed reference to 37 CFR § 2.195(e)(3) from 37 CFR § 2.1954(c) in Note 4; deleted reference to 37 CFR § 2.197(a) from Note 4.
110.02 Requirements for Certificate	Updated reference to 37 CFR § 2.190 to reflect rules changes.
	Changed the address for correspondence to the Board deposited with the U.S. Postal Service in second paragraph.
	Amended paragraph 5 to indicate that requests for copies of trademark documents are no longer handled by the "Certification Division, Office of Public Records;" provided new contact information.
	Amended paragraph 6 to indicate that the Assignment Services Division is no longer of the "Office of Public Records," but rather the "Public Records Division;" provides updated address for accessing Trademark Assignment Recordation Coversheet and information regarding same.
	Added new Notes 2 and 4, citing 37 CFR § 2.190(c).
110.03 Suggested Format	Updated address to use for certificate of mailing.
110.04 Location of Certificate	Deleted references to "rubber stamp" application of certificate of mailing.
110.05 Loss Of Certificate Of Mailing	No substantive changes.

110.06 No receipt of Correspondence Bearing Certificate	Updated reference to 37 CFR § 11.1 from "37 CFR § 10.1(r)" to reflect rules changes.
	Added new reference to Note 2: 37 CFR § 2.195(d)(3).
110.07 Excluded Filings	Amended first paragraph to indicate that certificate of mailing procedure is not applicable to extension of time to oppose filing or filing of notice of opposition against application under Trademark Act § 66(a).
	Amended second paragraph to explain that certificate of mailing is not applicable to ESTTA filing.
	Added new Note 1, referencing 37 CFR §§ 2.102(a)(2), 2.101(b)(2), 2.197(a)(2)(i) and (ii) and TMEP § 305.02(a).
110.08 A Certificate of Mailing or Transmission is Not ...	Deleted list of methods by which service may be made, as it is no longer complete (deleting "by hand delivery, first class mail, "Express Mail," or overnight courier").
110.09 Electronic Filing Using ESTTA (new subsection)	This is a new subsection, referencing 37 CFR §§ 2.2(g), 2.126(b) and 2.101(b)(2) and 2.121(a)(2), and providing general introduction to ESTTA's benefits and availability and some basic facts about its use.
	Added new Note 1, referencing 37 CFR § 2.195(a)(2) and USPTO web site address for instructions on filing through ESTTA.
	Added new Note 2, referencing 37 CFR § 2.197 and 2.198 and noting that filers outside of the U.S. cannot utilize either provision.
	Added new Note 3 to inform readers that ESTTA provides contextually appropriate help online.
110.09(a) Plan Ahead (new subsection)	This is a new section to advise reader that ESTTA users should allow sufficient time to deal with filing difficulties or file in paper.
	Added new Note 1, citing *Vibe Records Inc. v. Vibe Media Group LLC,* 88 USPQ2d 1280 (TTAB 2008).
	Added new Note 2 to alert reader that extension of time to oppose or notice of opposition against an application filed under Trademark Act § 66(a) must be filed through ESTTA.
110.09(b) ESTTA is Mandatory for Some Filings (new subsection)	This is a new subsection to explain that ESTTA is mandatory for extensions of time to oppose and notices of opposition against Trademark Act §

	66(a) applications.
	Added new Note 1, referencing 37 CFR § 2.102(a)(2) and 37 CFR § 2.101(b)(2); and citing *O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.,* 95 USPQ2d 1327, 1328 n.2 (TTAB 2010).
	Added new Notes 2 and 3, citing *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019, 2020-21 (TTAB 2005).
110.09(c) Attachments to ESTTA Filings (new subsection)	Subsection Heading only.
110.09(c)(1) In General (new subsection)	This is a new subsection providing general instructions for attaching electronic files to ESTTA forms.
110.09(c)(2) Form of ESTTA Attachments (new subsection)	This is a new subsection describing file formats permitted for ESTTA filing attachments and to warn reader that filer is responsible for ensuring that submissions are legible.
	Added new Note 1 to define meaning of file extensions PDF, TIFF, and TXT.
	Added new Note 2 to encourage ESTTA filings as quality may be better than paper filings.
	Added new Note 3, referencing 37 CFR § 2.126(b).
110.09(c)(3) Size Limitations (new subsection)	This is a new subsection describing limitations on file size and adding new Note 1 to discourage parties from filing overly large records.
110.09(d) Service of ESTTA Filings (new subsection)	This is a new subsection describing service of papers filed via ESTTA.
	Added new Note 1, referencing 37 CFR § 2.119(a).
	Added new Note 2, citing *Springfield Inc. v. XD*, 86 USPQ2d 1063, 1064 (TTAB 2008) and referencing 37 CFR § 2.119(b).
	Added new Note 3, citing *Equine Touch Foundation Inc. v. Equinology Inc.,* 91 USPQ2d 1943, 1944 n.5 (TTAB 2009); *Schott AG v. Scott,* 88 USPQ2d 1862, 1863 n.3 (TTAB 2008); and, by example, *Chocoladefabriken Lindt & Sprungli AG v. Flores,* 91 USPQ 2d 1698, 1699 n.2 (TTAB 2009).
110.09(e) Questions About ESTTA filing (new subsection)	This is a new subsection describing resources for questions and solving ESTTA-related problems.

111 "Express Mail" Procedure	Section Heading only.
111.01 In General	Added parenthetical to *In re Pacesetter Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm'r 1994) in Note 2.
111.02 Requirements for "Express Mail"	No substantive changes
111.03 Questionable Date of Mailing	No substantive changes
112 Times for Taking Action	Amended paragraph 3 to indicate that Office hours are Eastern time (from "Standard time") and added statement that ESTTA generally remains available despite official closure of the Office.
	Added new cases to Note 1: *Nat'l Football League v. DNH Mgmt. LLC*, 85 USPQ2d 1852, 1854 n.6 (TTAB 2008); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 n.8 (TTAB 2007).
	Amended Note 2 to add reference to web site for locating Office Gazette notice.
	Amended Note 3 to update reference to online Office Gazette notice regarding USPTO closure related to September 11, 2001.
113 Service of Papers	Updated reference to 37 CFR § 2.119 to reflect rules changes.
113.01 Requirement for Service of Papers	Updated text pursuant to rule change to delete the following: "The only exceptions to this rule are the notice of opposition and petition for cancellation, which are sent by the Board to the defendant or defendants."
113.02 Requirement for Proof of Service	Amended text to add that Board may provide an electronic link to TTABVUE database to expedite matters where service not effected by party.
113.03 Elements of Certificate of Service	Added signature line to suggested format for certificate of service.
113.04 Manner of Service	Amended first paragraph to indicate that service by electronic transmission is acceptable when mutually agreed upon by the parties and deleted discussion regarding facsimile transmission as a courtesy.
	Added new Note 1, referencing 37 CFR § 2.119(b).
	Added new Note 2, referencing 37 CFR § 2.119(b)(6).
113.05 Additional Time for Taking Action After Service	Amended first paragraph to indicate that 37 CFR § 2.119(c) (providing for 5-day enlargement) does

by Mail	not apply to service by electronic transmission, and that Fed. R. Civ. P. 6(d) (3-day enlargement) does not apply to Board proceedings.
	Amended second paragraph to instruct reader to add additional 5 days to response period before applying 37 CFR § 2.196 (last day for action falling on Saturday, Sunday or holiday).
	Amended third paragraph to add that 5-day enlargement is not available to deadline for filing parties' trial briefs.
113.06 A Certificate of Service Is Not...	No substantive changes.
114 Representation of a Party	Updated 37 CFR § 11.14 (from 37 CFR § 10.14) to reflect rules changes.
114.01 Party May Represent Itself	Updated Notes 1 and 2 to change to "37 CFR § 11.14(e)" from "37 CFR § 10.14(e)."
114.02 Selection of Attorney	No substantive changes.
114.03 Representation by Attorney	Amended first paragraph to update the definition of "attorney" as set forth in 37 CFR § 11.1 (formerly 37 CFR § 10.1(c)).
	Updated reference to 37 CFR § 11.1 from 37 CFR § 10.1(c) throughout subsection, including in Note 1. Further updated Note 1 to change reference to "37 CFR § 11.14(a)" from "37 CFR § 10.14(a)."
	Added parenthetical to *Weiffenbach v. Klempay*, 29 USPQ2d 2027, 2030 (Dep't Comm. 1993) in Note 1 and updated pin cite to the case from 2031 to 2030.
114.04 Representation by Non-lawyer (i.e., "Other Authorized Representative")	Amended Note 1 by changing reference to "37 CFR § 11.14(b)" from "37 CFR § 10.14(b)" and by amending parenthetical to *Weiffenbach v. Frank*, 18 USPQ2d 1397, 1400 (consent order) (Comm'r 1991).
114.05 Representation by Foreign Attorney or Agent	Updated reference to 37 CFR § 11.14(c) (formerly 37 CFR § 10.14(c)) and added reference to 37 CFR § 11.14(f).
	Amended first paragraph to inform reader that individual seeking recognition under 37 CFR § 11.14(c) must apply to Director of the Office of Enrollment and Discipline and to provide telephone number and mailing address for further information.
	Amended second paragraph to inform reader that only Canadian attorneys qualify under 37 CFR §

	11.14(c).
	Added new Note 1, referencing 37 CFR § 11.14(f).
	Added new Note 2, referencing TMEP § 602.06.
114.06 Individual Not Entitled to Represent Others	Updated reference to "37 CFR § 11.14(a)" from "37 CFR § 10.14(a)" throughout subsection, changed "party" to "client" in second paragraph to clarify that prohibition does not prevent officer from representing corporation in Board proceeding.
114.07 Designation of Domestic Representative	Updated references to 37 CFR §§ 2.24 and 2.119(d) to reflect rules changes and changed reference to "37 CFR § 11.14(c)" from "37 CFR § 10.14(c)" in first paragraph.
114.08 Adverse Parties Represented by Same Practitioner	Added new cases to Note 1: *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 221 USPQ 1077, 1082 (Comm'r 1984) and *Plus Products v. Con-Stan Indus., Inc.*, 221 USPQ 1071, 1075 (Comm'r 1984); deleted the following from Note 1: "*Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 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); and *Halcon International, Inc. v. Werbow*, 228 USPQ 611, 613 (Comm'r 1980) (attorney representing one party in a patent interference proceeding disqualified in view of his previous representation of the adverse party in connection with a process similar to the process involved in the interference)."
	Amended parenthetical to *Gilman Corp. v. Gilman Brothers Co.*, 20 USPQ2d 1238, 1240 (Comm'r 1991) in Note 1.
115 Conduct of Practitioner	Section Heading only.
115.01 Applicable Rules	Amended first paragraph to delete reference to specific rules in Part 10 and to add reference to Part 11 of 37 CFR.
	Added new second paragraph describing contents of Part 11 of 37 CFR.

	Added new third paragraph to direct all parties in matters before the Board to conduct business with decorum and courtesy.
	Added new Note 2, referencing 37 CFR § 2.192 and *MySpace Inc. v. Mitchell*, 91 USPQ2d 1060, 1062 n.4 (TTAB 2009).
115.02 Disciplinary Proceedings	Updated 37 CFR §§ 2.193 and 11.18 (formerly 37 CFR § 10.18), and added 37 CFR § 11.20, to reflect rules changes.
	Amended first paragraph to delete reference to 37 CFR § 2.193(c)(2); amended second paragraph to change reference to "37 CFR §§ 11.19-11.61" from "37 CFR §§ 10.130-10.170" and to change reference to "37 CFR § 11.19" from "37 CFR §§ 10.131-10.132."
	Added new cases to Note 1: *Bender v. Dudas,* 490 F.3d 1361, 83 USPQ2d 1065 (Fed. Cir. 2007); *Sheinbein v. Dudas,* 465 F.3d 493, 80 USPQ2d 1537 (Fed. Cir. 2006); *Moatz v. Colitz*, 68 USPQ2d 1079 (Dir. USPTO 2003); *In re Rivera,* 67 USPQ2d 1952 (Dir. USPTO 2003); *In re Ryznic,* 67 USPQ2d 1115 (Dir. USPTO 2003); *In re Cohen,* 66 USPQ2d 1782 (Dir. USPTO 2003); and *Moatz v. Kersey*, 67 USPQ2d 1291 (Dir. USPTO 2002).
115.03 Petitions to Disqualify	Updated reference to 37 CFR § 11.19(c) (formerly 37 CFR § 10.130(b)). Amended first paragraph to change reference to "37 CFR §§ 11.19-11.60" from "37 CFR §§ 10.130-10.170."
	Amended second paragraph to add that case will be suspended upon motion to disqualify pending briefing and consideration of the motion.
116 Termination Of Representation	Section Heading only.
116.01 Revocation of Authority	Updated reference to 37 CFR § 2.19.
116.02 Withdrawal As Representative--In General	Updated reference to 37 CFR § 2.19(b).
116.03 When Withdrawal Is Mandatory	No substantive changes.
116.04 When Withdrawal Is Permissive	No substantive changes.
116.05 Request to Withdraw	Amended reference to "trademark examining operation" from "examining operation" in second paragraph.

	Added new cases to Note 1: *In re Slack*, 54 USPQ2d 1504, 1505 (Comm'r 2000) and *SFW Licensing Corp. v. Di Pardo Packing Ltd*., 60 USPQ2d 1372 (TTAB 2001).
117 Correspondence - With Whom Held	Updated references to 37 CFR §§ 2.18, 2.24, and 2.119(d) to reflect rules changes.
117.01 In General	Amended first paragraph to reference 37 CFR § 11.1 (formerly 37 CFR § 10.1(c)).
	Added new paragraphs 2-4 to inform reader about notice of all Board actions by e-mail.
	Added new case to Note 2: *Equine Touch Foundation Inc. v. Equinology Inc*., 91 USPQ2d 1943, 1944 n.3 (TTAB 2009).
	Added new Note 3, referencing Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243-44 (Aug. 1, 2007).
117.02 When There is More Than One Attorney or Other Authorized Representative	Added first paragraph to explain that Board will send multiple copies of e-mail correspondence. Amended third paragraph to include TTABVUE as additional location where first-named attorney will be listed for correspondence. Changed reference in Note 2 to "*See* TMEP § 603.02(a)" from "*Cf.* TMEP § 603."
117.03 Continuation of Correspondence With Representative in Application or Registration When Inter Partes Proceeding Commences	Amended first paragraph to include e-mail address for correspondence authorized by party; changed web site address for finding the form for recording a change of address.
	Changed reference to "37 CFR § 2.105(c)" from "37 CFR § 2.105" in Note 1.
	Changed reference to "37 CFR § 2.2(f)" from "37 CFR § 7.1" in Note 3.
117.04 Continuation of Correspondence With Representative of Potential Opposer After Opposition Is Filed	No substantive changes.
117.05 Correspondence After Revocation Or Withdrawal	No substantive changes.
117.06 Correspondence With Foreign Party	Updated reference to "37 CFR § 11.14(c)" from "37 CFR § 10.14(c)" to reflect rules changes.
117.07 Change of Address	Updated to include change of e-mail address, added new third paragraph to advise reader on

	"best practice" for changing address.
117.08 Individual Not Entitled to Represent Others	Updated reference to "37 CFR § 11.14(a), (b), or (c)" from "37 CFR § 10.14(a), (b), or (c)" to reflect rules changes.
118 Payment of Fees	Section Heading only.
118.01 Lists of Fees and Charges	Added new Note 1, referencing "www.uspto.gov" and added new Note 2, referencing "www.wipo.int."
118.02 Fees Payable in Advance	Updated to include reference to 37 CFR § 2.101 and 37 CFR § 2.111. Added text to reflect new practice requiring full fee upon institution of opposition or cancellation.
	Added new Note 1, referencing 37 CFR §§ 2.101(d)(4) and 2.111(c)(4).
	Added new Note 2, citing *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009).
	Added new Note 3, referencing 37 CFR § 2.111(c)(3).
118.03 Method of Payment--In General	Updated reference to 37 CFR § 2.207 to reflect rules changes; included new third paragraph to provide information for payment of fees through ESTTA. Deleted the following: "Papers accompanied by fees may be filed by delivery to the finance window at 2900 Crystal Drive, South Tower Building, Third Floor, Arlington, VA."
	Added parenthetical to *Dubost v. U.S. Patent and Trademark Office*, 777 F.2d 1561, 227 USPQ 977, 980 (Fed. Cir. 1985) in Note 2.
	Deleted former footnote 118, referencing TBMP § 107.
118.04 Method of Payment--Deposit Accounts	Updated text to indicate payment is allowed by check or electronic funds transfer (formerly "credit card") and that deposit account may be used for payment of any necessary fee.
	Added new Note 2, referencing 37 CFR § 2.208(c).
	Deleted former footnote 121, referencing "Notice at 824 TMOG 1200 (February 23, 1966)."
	Added parenthetical to *In re Sky is the Ltd.*, 42 USPQ2d 1799, 1800 (Comm'r 1996) in Note 4.
119 Papers And Fees Generally Not Returnable	Section Heading only.

119.01 Fee Refunds--General Rule	No substantive changes.
119.02 Papers and Fees--Ex Parte Cases	Changed reference to retention of papers in "Board's file" (formerly "application file") to reflect Board's electronic file practice.
119.03 Papers and Fees--Inter Partes Cases	Amended first paragraph to address parties' choice to have confidential papers returned or destroyed; deleting the following: "ordinarily are returned after the conclusion of a proceeding, including any appeal period, to the party that filed them." Added statement to inform reader that electronic versions of all submissions are retained and that confidential submissions filed in paper form remain sealed following termination of proceedings.
	Amended paragraph 9 to inform reader that when filing a petition through ESTTA, time-barred grounds for cancellation will not be presented as an option.
	Amended final paragraph in this subsection to advise reader that refund will ordinarily be issued where proceeding has been declared a nullity; deleted, after "proceeding will be dismissed as a nullity," the following: "rather than vacated, so as to maintain the integrity of the proceeding numbers."
120 Access to Files	Amended reference to 37 CFR § 2.27(d) to reflect rules changes.
120.01 Non-confidential Files (new title)	Amended title (formerly "Nonconfidential").
	Amended first paragraph to clarify that all pending Board proceeding files and exhibits are available for public inspection except those filed under seal; added that most Board records since 2001 are electronic; and indicated that particulars of applications and registrations involved in Board proceedings may be viewed online.
	Amended second paragraph and added new paragraphs 3-5 to describe current practice for requesting paper files and making copies of same; deleted statements describing old practices.
120.02 Confidential Materials	Amended first paragraph to include materials filed under seal pursuant to Board's standard protective order; amended second paragraph to note that confidential materials must be

	designated as such at time of filing; added new third paragraph to detail method of filing confidential materials electronically.
	Added new fifth paragraph discouraging submission of sensitive personally-identifiable information.
	Amended paragraph 6 to delete references to files of applications and registrations that are the subject matter of pending proceedings.
	Added new Note 1, referencing 37 CFR § 2.120(g).
	Added new Note 3, referencing http://estta.uspto.gov/filing-type.jsp.
	Amended Note 4 by changing to "37 CFR § 2.126(c)" from "37 CFR §§ 2.27(d)-(e), 2.126(d)" and by deleting reference to "Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981)."
	Amended Note 5, by referencing 37 CFR § 2.126(c) and by deleting: "*See Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1714 (TTAB 1999) (Board agreed to hold exhibits marked confidential for thirty days pending receipt of motion for protective order but advised that in 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)."
120.03 Files of Terminated Proceedings	Amended second paragraph to explain creation of electronic records began in 2001 and that official records now kept electronically.
	Amended paragraph 3 to indicate that paper files of cancelled and expired registrations, and abandoned applications, are destroyed after three years (formerly "two").
	Amended paragraphs 4 and 5 to inform reader of procedures for inspecting or copying paper file stored by the Office.
121 Copying of Files	Deleted former first paragraph, describing photocopier maintained by Board for public use, because Board no longer maintains such machine.
	Added new paragraphs 2-5 describing current procedures for copying Board electronic and paper files; and amended paragraphs 6 and 7 to describe procedures for having the Office furnish

	copies of proceeding files.
	Added new Note 1, referencing http://ttabvue.uspto.gov/.
	Added new Note 2, referencing http://tmportal.uspto.gov/external/portal/tow.
	Added new Note 3, referencing 37 CFR § 2.6(b)(9).
122. Certification	Section Heading only.
122.01 Court Requirements	Revised to reflect current address for obtaining copy of Board proceeding file for use before a court.
122.02 Certified Copies	Revised to reflect current address for obtaining certified copies of Office proceeding files.
123 Status Information for Applications, Registrations and Board Proceedings	Added new first paragraph to introduce resources for obtaining information about status and prosecution history of, and title to, applications and registrations.
	Revised second and last paragraphs to delete information about Trademark Status (telephone) Line as it is no longer maintained.
	Updated paragraphs 2 and 3 to include current telephone numbers and online customer assistance database information. Deleted reference to the Board Information Systems Index (BISX), found in third paragraph, as the online resource is no longer available.
	Deleted former footnote 135, as follows: "*See In re Sovran Financial Corp.*, 25 USPQ2d 1537, 1538 (Comm'r 1992)."
124 Action by Assignee	Amended first paragraph to eliminate as unnecessary, the following: "(either itself, or through its attorney or other authorized representative)" when describing how assignee may act.
	Added new references to Note 1: Trademark Act § 72 and 37 CFR §§ 7.22-7.24.
	Added new references to Note 2: TMEP § 503.05 and 37 CFR §§ 7.22-7.24.
	Added new Note 3, referencing TMEP § 1906.01(a)(i).
	Amended Note 4 by adding reference to TMEP § 1906, *et seq.* and by deleting the following: "*See* Section 72 of the Trademark Act §, 15 U.S.C. 1141/" and also "Rules of Practice for Trademark-

	Related Filings Under the Madrid Protocol Implementation Act; Final Rule, published in the Federal Register on September 26, 2003 at 68 FR 55748, 55751; Exam Guide No. 2-03, Guide to Implementation of Madrid Protocol in the United States (part V.I) (October 28, 2003); and Exam Guide No. 1-03, Changes Affecting All Applications and Registrations (part V.D) (October 30, 2003)."
	Deleted the following reference from Note 5: "Exam Guide No. 2-03, supra (parts IV.F and VI.A.1) (October 28, 2003)."

INDEX TO CHANGES IN THIRD EDITION
CHAPTER 200

TBMP SECTION	NATURE OF CHANGE
201 In General	Amended reference to Trademark Act § 13 and to rules to reflect recent changes.
	Amended Note 1 to delete reference to TBMP chapter 300."
202 Time for Filing Request	Section heading only.
202.01 In General	Amended reference to Trademark Act § 13 and to rules to reflect recent changes.
	In first paragraph, added information to assist reader to calculate thirty-day opposition period.
	Amended paragraph 4 to instruct reader that using ESTTA to file extension request will prevent untimely filing.
	Amended paragraph 5 to delete requirement that consent of applicant to final extension request must be "written."
	Added new paragraph 6 to inform reader that final extension request will be denied if based on consent and request is for less than 60 days but will be granted if request is based on extraordinary circumstances and is for less than 60 days (in which case extension will be granted for full 60 days regardless of amount of time requested).
	Added visual chart to illustrate sequence of extension requests that are available.
	Added parenthetical to citation of *In re Pacesetter Group, Inc.*, 45 USPQ2d 1703, 1704 (Comm'r 1994) in Note 3.
	Amended Note 3 to inform readers regarding restrictions on filing extension requests internationally.
	Amended Note 8 (originally footnote 12) to revise reference to Trademark Rule from 37 CFR § 2.102(c)(3) to 37 CFR § 2.102(c).
	Amended Note 9 (originally footnote 13) to include reference to 37 CFR § 2.102(c)(1).
	Added new Note 10, citing: 37 CFR § 2.102(c)(1).
	Added new Note 12, citing: 37 CFR §

	2.102(c)(3).
202.02 Date of Publication of Mark	Added sentence to inform reader that date of publication is first day of the opposition period.
202.03 Premature Request	No substantive changes.
202.04 Late Request	Added pin cite to citation of *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) in Note 1.
203 Form of Request	Section Heading only.
203.01(a) In General (new title)	Created subsections (a) and (b) of Section 203.01
	Amended references to 37 CFR §§ 2.102 and 2.126 to reflect 2007 rules changes, and added reference to 37 CFR § 2.126(b).
	Amended paragraph 3 to delete requirement that applicant's consent to a final extension request must be in writing.
	Added new paragraph 4 to inform reader that final extension request will be denied if based on consent and request is for less than 60 days but will be granted if request is based on extraordinary circumstances and is for less than 60 days (in which case extension will be granted for full 60 days regardless of amount of time requested).
	Added visual chart to illustrate sequence of extension requests that are available.
	Updated reference to 37 CFR § 2.102 to 37 CFR § 2.102(a) in Note 1.
	Added new Note 8, citing: 37 CFR § 2.101(c)(3).
203.01(b) Note on Electronic Filing With ESTTA (new section)	This is a new section to instruct reader on use of ESTTA for filing extensions of time to oppose. Advises that ESTTA is not available for filings in connection with "Madrid Protocol" applications but otherwise encourages use of ESTTA to avoid common pitfalls. Gives website address for forms, instructions and answers to general questions. Gives e-mail address for answers to technical questions.
	Added new Note 1, citing 37 CFR § 2.102(a); and *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005).
	Added new Note 2, explaining the information that should be included in an e-mail describing a technical ESTTA problem, and contrasting

	questions of a general nature. Further informs reader that papers may not be filed via e-mail.
203.02 Identifying Information	Section heading only.
203.02(a) In General	Added comment that when filing via ESTTA, once correct form is selected, the system will properly identify it as an extension of time request.
	Added reference, by comparison, to 37 CFR § 2.194(b)-(c) in Note 1.
203.02(b) Requirement for Identification of Potential Opposer	Amended first paragraph to advise filers that while it is less likely a potential opposer would identify itself with insufficient particularity when using ESTTA, care must still be taken to identify the filer correctly.
	Added new paragraph 3, "Tip for ESTTA filers" informing ESTTA filers that if there is more than one potential opposer, each should be named in a separate request and not in a single request naming them as joint opposers.
	Deleted from Note 2: "*In re Software Development Systems, Inc.,* 17 USPQ2d 1094, 1095 (Comm'r 1989) (inadvertent oversight does not constitute extraordinary circumstance to waive [former] requirement for proof of service."
	Added new Note 3, citing, by comparison, *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009).
203.03 Signature	Amended reference to 37 CFR § 2.102(a) to conform to rule changes.
	Amended first paragraph to update reference to 37 CFR §§ 11.1 and 11.14(b) (formerly 37 CFR §§ 10.1(c) and 10.14(b)).
	Amended paragraph 4 to indicate that if time for opposing expires, involved application will be sent to issuance of a registration or notice of allowance, as appropriate.
	In Note 1, removed signal "*see"* before reference to 37 CFR § 2.102(a); removed signal "*see also"* from reference to *La Maur, Inc. v. Andis Clipper Co.*, 181 USPQ 783, 784 (Comm'r 1974); and replaced parenthetical following *La Maur, Inc.,* formerly reading "(petition filed by applicant denied; extension requests were filed on behalf of potential

	opposer by its attorney as its representative not as another party)" with the following: "(extension requests signed and filed on behalf of potential opposer by its attorney acceptable)."
	In Note 2, changed reference to 37 CFR § 2.193(c)(1)(iii) by deleting "(1)(iii);" changed signal before reference to TMEP from "*see also"* to "*see"* and changed reference from "TMEP § 804.05" to "TMEP §§ 611.01(b) and 611.01(c)."
203.04 Service	Amended text by deleting "with certain exceptions" from statement that every paper filed in Board *inter partes* proceeding must be served on adverse party; moved references to 37 CFR §§ 2.119(a) and 2.101(a) to new Notes 1 and 2, respectively.
	Clarified that request for extension of time need not be served on applicant.
	Deleted from Note 3: "*See* 37 CFR § 2.102(c) and, for example, *In re Docrite Inc.*, 40 USPQ2d 1636, 1638 (Comm'r 1996) (request for extension of time aggregating more than 120 days does not have to include proof of service on applicant or applicant's attorney when the request includes a statement that applicant has consented to the extension)."
	Added parenthetical to citation of *La Maur, Inc. v. Andis Clipper Co.*, 181 USPQ 783, 784 (Comm'r 1974) in Note 3 as follows: "(request for extension of time is an ex parte matter; requests need not be served on applicant)."
	Deleted signal *"see"* from citation to Trademark Act § 13 in Note 4.
203.05 Duplicate Requests	Clarifies that when duplicate *paper* requests have been filed, Board will disregard second request if first request has been granted.
	Added new Note 1 to explain that requests for extensions of time filed via ESTTA are not examined by Board staff and thus duplicate requests may be granted by ESTTA; counsel should check the application status in TTABVUE before filing any paper.
204 Fee	Added signal *"see"* before reference to 37 CFR § 2.6.
205 Mark On	Deleted signal *"see"* in Notes 1, 2, and 3 before

Supplemental Register Not Subject To Opposition	the following references: Trademark Act § 24 (Note 1); Trademark Act § 23(b) (Note 2); and Trademark Act § 24 (Note 3).
	Deleted references to Trademark Act §§ 12(a) and 13(a) from Note 1.
206 Who May File An Extension Of Time To Oppose	Amended reference to 37 CFR § 2.102(b) to reflect rules changes.
206.01 General Rule	Edited wording in first paragraph to substitute "would" for "would will" before "be damaged."
	Added new second paragraph alerting reader that request for extension of time may not be used for purposes of harassment or delay.
	Deleted signal "*see*" from citation to Trademark Act § 13(a) in Note 1; and deleted general reference: "For further information concerning the filing of an opposition, *see* TBMP chapter 300" from Note 1.
	In Note 2, deleted signal "*see*" from citation to Trademark Act § 13(a).
	In Note 4, deleted signal "*see*" from citation to *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993); and edited parenthetical to that citation by changing "another, unrelated party" to "another (unrelated) party."
206.02 Request For Further Extension Filed By Privy	Added "Tip for ESTTA filers" informing ESTTA filers that if there is more than one potential opposer, each should be named in a separate request and not in a single request naming them as joint opposers.
	Deleted signal "*see*" from citation to 37 2.102(b) in Note 1; deleted signal "*see*" from citation to *In re Spang Indus., Inc.*, 225 USPQ 888 (Comm'r 1985) in Note 3; and deleted signal "*cf.*" from citation to *Rolex Watch U.S.A., Inc. v. Madison Watch Co., Inc.*, 211 USPQ 352, 358 (TTAB 1981) in Note 2.
	Added citation, by comparison, to *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1946-47 (TTAB 2010) in Note 2.
	Added parenthetical to *In re Spang Indus., Inc.*, 225 USPQ 888 (Comm'r 1985) in Note 3.
	Added new Note 4, citing, by comparison: *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009).

206.03 Misidentification Of Potential Opposer	Added pin cite to citation to *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993) in Notes 1 and 2.
	Deleted signal "*see*" from citation to *Custom Computer Services., Inc. v. Paychex Properties, Inc.*, 337 F.3d 1334, 67 USPQ2d 1638, 1640 (Fed. Cir. 2003) in Note 2.
	Deleted signal *"see also"* from citation to TMEP § 1503.04 in Note 2; added reference to TMEP § 803.06 in Note 2; and deleted citation as well as preceding signal "*Cf. also"* to TMEP § 803.06 in Note 2.
207 Requirements For Showing Of Cause; Extraordinary Circumstances	No changes.
207.01 In General	Amended first paragraph to emphasize that final extension of time may only be filed with the consent of applicant or upon a showing of extraordinary circumstances.
	Inserted new second paragraph before final sentence of original first paragraph and made that final sentence the final sentence of the new second paragraph. Added text to inform reader that final extension may only be granted for 60 days, no less, and that if final extension requests less than 60 days and is filed on basis of applicant's consent without showing of extraordinary circumstances, request will be denied.
	Added chart to illustrate extension periods which may be granted.
	Added new Note 5, citing: 37 CFR § 2.102(c)(3).
207.02 Extensions Up To 120 Days From The Date Of Publication	Deleted citation to "*Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991)" from Notes 1 and 2.
	Added new Note 3, citing: 37 CFR § 2.102(c)(3).
	Amended citation to *Lotus Development Corp. v. Narada Productions, Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) by noting in the parenthetical that the case issued under previous rule. Also deleted "*Kimberly-Clark Corp. v. Paper Converting Industry, Inc.*, 21 USPQ2d 1875, 1877 (Comm'r 1991) (initial

	request for 60 days with showing of good cause in compliance with the rules)" from Note 4.
207.03 Extensions Beyond 120 Days From The Date Of Publication	Added new second paragraph to inform reader that final extension may only be granted for 60 days, no less, and that if final extension requests less than 60 days and is filed on basis of applicant's consent without showing of extraordinary circumstances, request will be denied.
	Added new paragraph 4 to inform reader of circumstances that are and are not considered to be extraordinary.
	Deleted discussion of rules and practice applying to cases where a first request for extension of time was filed prior to November 2, 2003.
	Added new Note 2, citing: 37 CFR § 2.102(c)(3).
	Deleted from Note 4: "Please Note: Proof of service of the request on applicant is no longer required. *See* 37 CFR § 2.102(c), as amended. *See also In re Docrite Inc.*, 40 USPQ2d 1636, 1638 (Comm'r 1996)."
	In Note 6, edited parenthetical to *In re Su Wung Chong*, 20 USPQ2d 1399, 1400 (Comm'r 1991) by adding new text and deleting: "(since potential opposer failed to submit required showing of extraordinary circumstances with extension request as required by Rule 2.102(c)(3), question on petition was not whether any such extraordinary circumstances existed at time of request but instead whether potential opposer showed extraordinary circumstances existed that prevented compliance with that rule)." Also deleted "*In re Software Development Systems, Inc.*, 17 USPQ2d 1094, 1095 (Comm'r 1989) (inadvertent failure to provide proof of service not extraordinary circumstance to waive [former] rule requiring proof of service); and *In re Societe Des Produits Nestle S.A.,* 17 USPQ2d 1094 (Comm'r 1990) (extraordinary circumstances not shown to waive requirement that showing of extraordinary circumstances be submitted with extension request and

	subsequently obtained consent insufficient). *Cf. In re Spang Industries, Inc.*, 225 USPQ 888, 888 (Comm'r 1985) (identification of potential opposer omitted)" from Note 6.
	Added new Note 7, citing: *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093, 1094 (Comm'r 1990); and, by comparison, *In re Spang Indus., Inc.* 225 USPQ 888 (Comm'r 1985).
208 Essential Element Omitted	Amended second paragraph to further explain that by using ESTTA for filing extension requests, user will be prompted to supply all essential elements.
	Amended Note 1 by deleting "*In re Su Wung Chong*, supra; (showing of extraordinary circumstances omitted)"; and by inserting a "semi-colon" to replace the word "and" in the parenthetical to *In re Societe Des Produits Nestle S.A.*; and by amending the parenthetical to *In re Spang Industries, Inc.* from "(identification of potential opposer omitted)" to "(potential opposer not identified with reasonable certainty; defect not curable after time for filing extension expired)."
209 Action By Board On Request	Section Heading only
209.01 Suspension Policy	Amended references for TBMP sections for clarity by adding parentheticals to describe section contents.
209.02 Determination Of Extension Expiration Date	Amended first paragraph by changing wording "the further extension" to "any subsequent extension."
	Added first sentence to paragraph 3 to emphasize that extensions of time will only be granted in increments set out in 37 CFR § 2.102(c) and changed wording in paragraph 3 from "If good cause for the time beyond thirty days has not been shown" to "If good cause for a first extension beyond thirty days has not been shown."
	Deleted the following as redundant of paragraph 4: "If a further request seeks an extension of time to oppose beyond 120 days from the date of publication, but specifies a date which is longer or shorter than the prescribed additional sixty day period, the

	extension, if granted, will be set to expire in sixty days."
	Added new paragraph 4 to inform reader that a request for additional time beyond 120 days from publication that asks for a time period other than 60 days will be denied unless party cited extraordinary circumstances.
	Added new paragraph 5 to inform reader that ESTTA automatically calculates extension dates.
	Added reference to 37 CFR § 2.196 to Note 1; changed parenthetical to *Lotus Dev. Corp. v. Narada Prods., Inc.*, 23 USPQ2d 1310, 1312 (Comm'r 1991) from "(potential opposer miscalculated first 30-day extension request and threw off all subsequent periods)" to "(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)."
	Added new reference to 37 CFR § 2.102(c)(1) in Note 3.
	Changed reference to 37 CFR § 2.102(c) to 37 CFR § 2.102(c)(2) in Note 4.
	Changed parenthetical to *Kimberly-Clark Corp. v. Paper Converting Indus., Inc.*, 21 USPQ2d 1875, 1877 (Comm'r 1991) from "(initial request extending beyond thirty days with required showing granted)" to "(under former rules – initial request extending beyond thirty days with required showing of good cause granted)."
	Added new Note 9, citing: 37 CFR § 2.102(c)(3).
210 Objections To Request	Deleted reference to "if there is no proof of service by potential opposer" in first paragraph.
	Amended third paragraph to advise reader that applicant rarely learns of extension request before Board action on the request since requests filed electronically will be automatically processed within minutes.
211 Relief From Action Of Board	Section Heading only.
211.01 Request For Reconsideration	Added sentence to paragraph 4 to warn reader that time for filing opposition or further

	extension will not be suspended pending determination of request for reconsideration.
211.02 Relief After Institution Of Opposition	Deleted reference to TBMP § 502 from Note 1; changed parenthetical to *Central Mfg. Inc. v. Third Millennium Tech. Inc.,* 61 USPQ2d 1210, 1215 (TTAB 2001) from "(motion to dismiss granted where it was found that opposer's allegations of consent and good cause [i.e., that the parties were engaged in settlement discussions] to extend beyond 120 days were untrue)" to "(motion to dismiss granted where it was found that opposer's allegations of consent and good cause for extension request were untrue)"; added parenthetical to *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1075 n.2 (TTAB 1993).
211.03 Petition To The Director	Added sentence to paragraph 4 to advise reader that Board will not suspend time for filing opposition or extension of time pending decision of petition to Director.
	Deleted reference to Board's transmission of notice of opposition in paragraph 6, i.e., "and a copy of the notice, along with a copy of the motion to suspend, will be sent to the applicant" in light of opposer's obligation to serve copy of notice of opposition on applicant under 2007 rules changes.
	Amended paragraph 7 by deleting, after the wording "and the opposition will be dismissed," the following: "as a nullity, and the fee will be refunded."
	Added reference to 37 CFR § 2.146 to Note 1.
	Deleted "*see"* signal from Notes 2-5 and from Notes 7 and 8.
	Added new Note 6, citing: 37 CFR § 2.146(e)(1).
	Added reference to 37 CFR § 2.146(g) to Note 9.
212 Amendment Of Application During Or After Extension	Section Heading only.
212.01 Jurisdiction To Consider Amendment	Added sentence to first paragraph to clarify that Board has no jurisdiction over application until it becomes involved in opposition proceeding.
	Amended paragraph 2 to indicate that the Trademark Examining Operation must

	determine propriety of an amendment filed during pendency of request for extension of time; changed the wording "examining attorney" to "Trademark Examining Operation (and not the Board.)" Also added final sentence to paragraph 2 advising that post-publication amendments filed prior to commencement of inter partes proceedings are determined by (and should be filed with) the Petitions Office.
	Amended paragraph 4 to clarify that amendments discussed in this section are those filed prior to commencement of an inter partes proceeding. Also amended paragraph 4 to instruct reader to file any amendment, proposed prior to commencement to an inter partes proceeding, to the Petitions Office; to make any inquiry about such amendment to the Petitions Office or through the Trademark Assistance Center or by sending an e-mail to TMPostPubQuery@uspto.gov. Deleted the following from paragraph 4: "sent to the Board's attention, not to the examining attorney who approved the mark for publication. The Board will note the amendment and transfer the file to the examining attorney. Because the examining attorney eventually will consider the amendment, any phone inquiry for discussion of the content of the amendment should be directed to the examining attorney."
	Added new paragraph 5, cautioning parties to take care to direct amendments to the Petitions Office and not the Board; that the Board will not suspend the time for filing an opposition or extension pending consideration of an amendment; and that pendency of amendment may constitute good cause but not extraordinary circumstances to justify further extension.
	Added reference to TMEP § 1504 in Note 1; and added parentheticals to citations of 37 CFR § 2.84 and 2.133 in Note 1.
	Added new Note 3, citing, generally, TMEP § 1505.
212.02 Conditions For Petitions Office Approval	Amended second paragraph to delete the following: "or an application under Section 44

Of Amendment (new title)	or 66(a) of the Act in which an appropriate allegation of use has been made."
	In Note 1, added parenthetical to references to TMEP §§ 1504.01 and 1505.
	In Note 2, changed signal for *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1539 (Comm'r 1991) from "*see*" to "*e.g.*"
	In Note 2, changed signal for TMEP § 1505.01 from "*see*" to "*see generally*" and changed description of that citation from "regarding approval of amendments after publication" to "regarding procedures for processing amendments filed after publication."
212.03 Form Of Amendment	Amended text to notify reader that papers relating to applications that are subject of a request for extension of time should now be submitted to Petitions Office, and not Board. Deleted, from the end of the last sentence in the text, the following: "except that it should be directed to the attention of the Trademark Trial and Appeal Board (i.e., Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514)."
212.04 Action By Board -- Upon Receipt Of Amendment	Deleted entire section, as Board no longer processes amendments to applications that are subject to extension of time requests. Added text to explain that such amendments should be filed with the Petitions Office.
212.05 Action By Board – During Consideration Of Amendment By TMEO (new title)	Amended first paragraph to clarify that the filing of an amendment does not constitute extraordinary circumstances justifying an extension for final 60 days (i.e., from 120 to 180 days from the date of publication).
	Amended second paragraph to inform reader that opposition may be suspended for consideration, by Petitions Office, of amendment, upon filing of a motion therefor; and deleted wording indicating that Board would institute the opposition absent such motion. Deleted: the Board will institute the opposition, and at the same time the Board will normally suspend the opposition pending consideration of the amendment by the examining attorney."
	Further amended second paragraph by substituting "Petitions Office" for "examining

	attorney" and by deleting: "A copy of the institution order will be sent to both parties, and a copy of the notice of opposition and any motion to suspend will be sent to the applicant."
	Added new paragraph 3 to instruct reader that when filing notice of opposition through ESTTA, any motion to suspend should not be filed until after receipt of the opposition proceeding number from ESTTA.
212.06 Action By Board – After Consideration Of Amendment By TMEO (new title)	Revised section to reflect current practice by deleting the entire section except for the last paragraph.
	Deleted footnotes from original section, as follows: Note 1: "*See In re MCI Communications Corp.*, 21 USPQ2d 1534, 1539 (Comm'r 1991) (entry of voluntary disclaimer)." Note 2: "*See* TMEP 707."
	Amended the last paragraph in this section to add that where opposition has been suspended prior to Petitions Office's action on a post-publication amendment, and the amendment is approved, the Board will notify the parties. Deleted option of declaring opposition a nullity and having the fee refunded.
212.07 Amendment During Opposition	No substantive changes.
213 Effect of Restoration of Jurisdiction	Amended paragraph 3 to inform reader that application subject to extension of time remains subject thereto following restoration of jurisdiction to examining attorney. Further amended paragraph 3 to delete reference that Board's order includes instruction to examining attorney to return file to the Board.
	Amended paragraph 4 to advise reader that Board will not suspend time for filing notice of opposition or further extension during pendency of the restoration of jurisdiction to examining attorney.
	Amended paragraph 5 to indicate that if mark is republished or registration ultimately denied, any remaining time in opposition period and any further extension requests, will be moot.
	Amended paragraph 6 to delete reference to

	copies of Board's action, notice of opposition, and any motion to suspend being mailed to applicant.
	Amended paragraph 7 to indicate that opposition filing fee will not be refunded in case where opposer decides to have its opposition dismissed following notice from Board of republication of application.
	Amended paragraph 8 to indicate that opposition filing fee will not be refunded where registration of mark is ultimately denied following restoration of application to examining attorney.
	Deleted Note 3, which advised that should request for restoration be granted, opposer's time to file notice of opposition continues to run.
214 Effect Of Republication	Amended first paragraph to delete reference to situation where mark was originally published in wrong class, as requiring republication, as this situation no longer requires republication.
	Amended second paragraph to indicate that opposition will be dismissed, and filing fee will not be refunded, in case where mark is republished by order of the examining attorney.
	Amended paragraph 4 to indicate that republication is "sometimes," rather than "often" necessary to give notice to potential opposers; further amended paragraph to indicate that "occasionally," rather than "sometimes," a mark is republished by inadvertence.
	Amended paragraph 5 to indicate that any opposition filed in response to an inadvertent republication will not be considered or (if instituted) will be dismissed.
	Deleted from Note 1: *See also, for example, 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).
	Added references to TMEP §§ 1505.03(a) and 1505.03(b) to Note 1.
	In Note 2, added citation to *In re Börlind*

	Gesellschaft für kosmetische Erzeugnisse mbH, 73 USPQ2d 2019, 2020 (TTAB 2005).
215 Effect Of Letter Of Protest	In the section throughout, changed "Administrator for Trademark Identifications, Classifications and Practice (Administrator)" and "Administrator" to "Deputy Commissioner."
	In the second paragraph, added that letter of protest will usually be denied as untimely if filed more than thirty days after publication.
	In the third paragraph, clarified that the filing of a letter of protest does not stay the time for filing either a notice of opposition or a request for an extension of time to oppose; that if mark publishes during pendency of the letter of protest, party must file extension of time request if party wishes to preserve its right to oppose; and that party may choose to file notice of opposition regardless of when letter of protest was filed, once mark is published.
	Added sentence to paragraph 4 to inform reader that Board will not suspend time for filing notice of opposition or extension of time request pending consideration of letter of protest.
	Added new paragraph 5 to explain that a potential opposer may not rely upon filing of letter of protest by a third party to establish good cause for extension of time.
	Revised section, as set forth in paragraph 6, to clarify practice with regard to the filing of a letter of protest before or after publication in the Official Gazette.
	In paragraph 7, added to the first sentence that jurisdiction may or may not have been restored to the examining attorney at time when letter of protest granted. Further added that question of registrability is not before the examiner if jurisdiction has not been restored.
	Updated pin cite to *In re Urbano*, 51 USPQ2d 1776, 1778-79 n.5 (TTAB 1999) in Note 1.
	Added references to TMEP §§ 1715.02 and 1715.03 in Note 2.
	Deleted reference to TMEP § 1715.03, and added reference to TMEP § 1715.03(b), in Note 3.
	Amended reference in Note 4 to TMEP

	§ 1715.03(c) and deleted "*see"* signal.
	Added reference to TMEP § 1715.03(c) in Note 5.
	Deleted "*cf."* signal from Note 6.
	Changed signal in Note 7 from *"cf."* to "*see."*
216 Inadvertently Issued Registration	Added sentence to paragraph 4 to inform reader that Board will not suspend time for filing opposition or extension of time request pending cancellation of inadvertently-issued registration.
	Deleted entire paragraph 5, as follows: "If, during the running of an extension of time, the Director cancels and restores to application status a registration that issued inadvertently during an extension of time to oppose, the potential opposer and applicant will be informed of the inadvertent issuance of the registration, its cancellation by the Director, and the status of the extension request in an action prepared by a Board administrative staff member."
	Amended paragraph 7 to indicate that Board no longer institutes notice of opposition filed during pendency of Director's cancellation of inadvertently-issued registration, but institutes only if and when registration has been cancelled. In accordance, deleted reference to earlier practice. Also, deleted statement that Board will send copy of notice of opposition to applicant with copy of any motion to suspend filed by opposer.
	Amended paragraph 8 to indicate that if Director cancels and restores registration to application status, the Board will institute (rather than "resume") the opposition; and that if Director declines to cancel the registration, the opposition will not be instituted (rather than "dismissed as a nullity").
	Deleted signal *"see"* in Notes 1, 2, and 3.
217 Relinquishment Of Extension	Amended first and second paragraphs to indicate that where Board forwards application, it is for issuance of registration or statement of use, as appropriate.
218 Abandonment Of Application	Amended first paragraph to indicate that instead of returning opposition filed on or after abandonment of application, it will not be

	considered. Further added sentence in first paragraph explaining that opposition instituted prior to Board's knowledge of abandonment will be dismissed as a nullity and fee refunded.
	Added sentence to second paragraph, to clarify that abandonment during extension of time to oppose is without prejudice to applicant.
	Amended paragraph 4 to encourage reader to use TEAS to file express abandonment prior to commencement of opposition and to inform reader that such abandonments should not be filed with the Board.
	Added information regarding transformation of applications that are cancelled under Article 6(4) of the Madrid Protocol to Note 1.
219 Amendment To Allege Use; Statement Of Use	Amended third paragraph to indicate that late-filed amendments to allege use or premature statements of use will not be considered (deleting statement that they will be returned to filer).
	Amended paragraph 5 to delete reference to Board returning application to examining attorney to process amendment to allege use.
	Amended paragraph 6 to indicate that Board does not suspend time for filing notice of opposition or to request extension of time to oppose pending consideration of an amendment to allege use.
	Amended paragraph 7 to indicate that examining attorney should notify Board (rather than return file to Board) following processing of amendment to allege use.
	Deleted signal "*see"* in Notes 1, 2, 3, 4, and 8; changed signal in Note 5 from "*described in"* to "*see"* and changed signal in Note 7 from "*as described in"* to *"see."*
220 Inadvertent Issuance Of A Notice Of Allowance	Updated reference to "ITU/Divisional Unit" (formerly the Intent to Use Division) in first paragraph.
	Deleted references in first paragraph to receipt by Board of untimely statement of use inasmuch as Board no longer receives these filings.
	Amended second paragraph to delete reference to Board's receipt of "file for action" and replace with reference to Board's learning

	of issuance of notice of allowance.

INDEX TO CHANGES IN THIRD EDITION
CHAPTER 300

TBMP SECTION	NATURE OF CHANGE
301 Types of Board Proceedings	Section Heading only
301.01 In General	Moved section entitled "Mark on Supplemental Register not Subject to Opposition" to TBMP § 301.01. Deleted "[see] authorities cited therein" from reference to statute in Note 5.
301.01 Mark on Supplemental Register not Subject to Opposition (new section)	This is a new subsection based on prior TBMP § 301 section, including footnotes. Amended to reflect that current Board practice is not to return improperly filed opposition in paper form to parties.
301.02 Mark Filed Under the Madrid Protocol is Subject to Opposition (new section)	This is a new subsection to inform readers that applications filed under Madrid Protocol are subject to opposition.
302 Commencement of Proceeding	Amended references to 37 CFR §§ 2.101(a) and 2.111(a) to reflect rule changes; amended first paragraph to inform reader that plaintiff must include proof of service with its complaint and notify Board of undeliverable service copy; added references in first paragraph to TBMP §§ 309.02(c) and 306.05.
	In Note 1, added parenthetical to *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); and added new case to Note 1: *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280 (TTAB 2008).
	Added new Note 2, referencing 37 CFR § 2.101(a); added new Note 3, referencing 37 CFR § 2.101(b); added new Note 4, referencing 37 CFR § 2.101(b).
303 Who May Oppose or Petition to Cancel	Section Heading only.
303.01 In General	Amended references to Trademark Act §§ 13(a), 14, 24 and 45 and to 37 CFR § 2.101(b) to reflect statutory and rule changes.
303.02 Meaning of the Term "Person"	Clarified when Board may inquire regarding complaints filed in name of division; and added parenthetical to citation of *In re Cambridge Digital Systems*, 1 USPQ2d 1659,

	1660 n.1 (TTAB 1986) in Note 4.
303.03 Meaning of the Term "Damage"	Amended the section to add to discussion on meaning of term "damage."
	Added new Note 1, citing *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 n.2 (Fed. Cir. 1999).
	Added new Note 3, citing *Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023, 1025 n.2 (Fed. Cir. 1999).
	Added new Note 4, citing *Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023, 1025 n.2 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.,* 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).
	Added new case to Note 5: *Enbridge, Inc. v. Excelerate Energy Limited Partnership,* 92 USPQ2d 1537, n.10 (TTAB 2009).
	Added new Note 6,citing *Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023, 1025 n.2 (Fed. Cir. 1999).
303.04 Federal Trade Commission	Amended references to Trademark Act § 14 to reflect statutory changes.
303.05 Opposition Filed During Extension of Time to Oppose	Added reference to 37 CFR § 2.102(a).
303.05(a) General Rule	Added parenthetical to citation of *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) in Note 2.
303.05(b) Opposition Filed by Privy	Amended parenthetical to *SDT Inc. v. Patterson Dental Co.,* 30 USPQ2d 1707, 1709 (TTAB 1994) in Note 1.
	Added parentheticals to cases cited in Note 2: *SDT Inc. v. Patterson Dental Co.,* 30 USPQ2d 1707, 1709 (TTAB 1994) *and In re Cooper,* 209 USPQ 670, 671 (Comm'r 1980).
	Added parentheticals to cases cited in Note 3: *SDT Inc. v. Patterson Dental Co.,* 30 USPQ2d 1707, 1709 (TTAB 1994) and *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980).
	Added new case to Note 2: *In re Spang Industries*, 225 USPQ 888.
	New cases added, by comparison, to Note 3: *Leading Jewelers Guild, Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1901 n.1

	(TTAB 2007); *Missouri Silver Pages Directory Publishing Corp. Inc. v. Southwestern Bell Media, Inc.,* 6 USPQ2d 1028 (TTAB 1988); *Raker Paint Factory v. United Lacquer MFG. Corp.,* 141 USPQ 407 (TTAB 1964); *Pyco, Inc. v. Pico Corp*., 165 USPQ 221, 222 (TTAB 1969); and, by comparison, *Chien Ming Huang v. Tzu Wei Chen Food Co*., 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988).
303.05(c) Misidentification of Opposer	Changed "by" to "through" to conform to 37 § CFR 2.102(b) in second and third paragraphs.
	Added new cases to Note 2: *Missouri Silver Pages Directory Publishing Corp. Inc. v. Southwestern Bell Media, Inc*., 6 USPQ2d 1028 (TTAB 1988); *Chien Ming Huang v. Tzu Wei Chen Food Co.,* 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988); *Societe Civile Des Domaines Dourthe Freres v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde,* 6 USPQ2d 1205 (TTAB 1988) and *Argo & Company v. Springer,* 189 USPQ 581 (TTAB 1976).
	Deleted from Note 2: "*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); *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); and TBMP § 512.04 (Misidentification)" from Note 2; also deleted *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.,* 183 USPQ 613 (Comm'r 1974) (deletion of "company" was correctable mistake)."
303.05(d) (new) Misidentification of Applicant or Respondent	This is a new subsection discussing misidentification of defendant. Added new Note 1, citing: *Argo & Company v. Springer,* 189 USPQ 581 (TTAB 1976); *In re Tong Yang*

	Cement Corp., 19 USPQ2d 1689 (TTAB 1991); and *Societe Civile Des Domaines Dourthe Freres v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205 (TTAB 1988).
303.06 Joint Opposers or Petitioners	Added new case to Note 3: *Sun Valley Company Inc. v. Sun Valley Manufacturing Co.,* 167 USPQ 304 (TTAB 1970).
304 Proceeding Against Multiple Class Application or Registration	Added new Note 1, referencing 37 § CFR 2.86; added information explaining allocation of fees where insufficient fees submitted and referencing TBMP § 308.
305 Consolidated and Combined Complaints	Divided TBMP § 305 into TBMP §§ 305.01 and 305.02.
305.01 Consolidated Complaint (new section)	This is a new subsection that discusses consolidated complaints only. Removed text regarding combined complaints and re-entered it into TBMP § 305.02. Moved the following to Note 3 of TBMP § 305.02: "*Nabisco Brands Inc. v. Keebler Co.,* 28 USPQ2d 1238 n.2 (defendant who believes marks and issues are sufficiently different such that combined proceeding is not appropriate may file motion to separate proceedings)." Changed signal in Note 3, referencing Fed. R. Civ. P. 42(a) from "*cf."* to *"See."*
305.02 Combined Complaint (new section)	This is a new subsection regarding combined complaints. Added text taken from TBMP § 305 regarding combined complaints and inserted it here; added information about ESTTA; rearranged order of citations in Note 3 from most recent to oldest.
306 Time For Filing Opposition	Section Heading only.
306.01 In General	Amended references to Trademark Act §§ 12(a) and 13(a) and to 37 CFR § 2.101 to reflect recent changes; updated subsection to include information on ESTTA filing, new rules on service requirements; and amendments to opposed applications.
	Added new case to Note 2: *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280 (TTAB 2008); added new Trademark Rule to Note 2: 37 CFR § 2.195(d)(3).

	Added new Note 3, citing: *In re: Börlind Gesellschaft für Kosmetische Erzeugnisse GmbH,* 73 USPQ2d 2019 (TTAB 2005); and 37 CFR § 2.101(b)(2).
	Added new case to Note 4: *Vibe Records Inc. v. Vibe Media Group LLC,* 88 USPQ2d 1280 (TTAB 2008).
	Added new Note 5, citing: 37 CFR § 2.198(a)(2).
	Added new Note 6, citing: *Drive Trademark Holdings LP v. Inofin and Mark Walsh*, 83 USPQ2d 1433 (TTAB 2007); and 37 CFR § 2.107.
	Added new Note 7, citing: *Yahoo! Inc. v. Loufrani,* 70 USPQ2d 1735 (TTAB 2004); *Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent Inc.,* 60 USPQ2d 1703 (Comm'r 2000); and *In re Merck & Co. Inc.,* 24 USPQ2d 1317 (Comm'r 1992).
	Added new Note 8, citing: *Schott AG v. L'Wren Scott,* 88 USPQ2d 1862, 1863 n.3 (TTAB 2008); *Chocoladefabriken Lindt & Sprungli AG v. Flores*, 91 USPQ2d 1698, 1699 n.3 (TTAB 2009), citing *Vibe Records, Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1282 (TTAB 2008).
	Added new Note 9, citing: *The Equine Touch Foundation, Inc. v. Equinology, Inc.,* 91 USPQ2d 1943, 1944 n.5 (TTAB 2009).
306.02 Date Of Publication Of Mark	Added reference to Official Gazette and new Note 1 regarding same.
306.03 Premature Opposition	No substantive changes.
306.04 Late Opposition	Added new paragraph 3 to advise that filing via ESTTA may avoid certain filing errors. Added new case to Note 1: *The Equine Touch Foundation, Inc. v. Equinology, Inc.,* 91 USPQ2d 1943, 1945 n.6 (TTAB 2009); and explained in Note 1 that 37 CFR § 2.197 has replaced former Patent and Trademark Office Rule 1.8 for trademark correspondence.
	Added new Note 2, citing: *Drive Trademark Holdings LP v. Inofin,* 83 USPQ2d 1433, 1436 n.10 (TTAB 2007).

307 Time For Filing Petition To Cancel	Amended references to Trademark Act § 14 and 24 and to 37 CFR § 2.111 to reflect statutory and rule changes.
307.01 Petition That May Be Filed At Any Time After Registration	Added reference to 37 CFR § 2.198 and new Note 9 regarding same.
307.02 Petition That Must Be Filed Within Five Years From The Date Of Registration	Section Heading only.
307.02(a) In General	Deleted reference to "deceptively misdescriptive" as grounds not permitted after five years; added "genericness claim made to only a portion of the mark" as ground not permitted after five years.
	Added reference to 37 CFR § 2.198; indicated when Board may not dismiss timely petition to cancel served on registrant's attorney.
	Added new cases to Note 1: *Otto International Inc. v. Otto Kern GmbH,* 83 USPQ2d 1861, 1863 (TTAB 2007); and *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1913 (TTAB 2007).
	Added new case to Note 4: *Otto International Inc. v. Otto Kern GmbH,* 83 USPQ2d 1861, 1863 (TTAB 2007).
	Added new Note 5, citing: *The Equine Touch Foundation Inc. v. Equinology, Inc.*, 91 USPQ2d 1943 (TTAB 2009); *Montecash LLC v. Anzar Enterprises Inc.,* 95 USPQ2d 1060, 1063 (TTAB 2010); and *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1480 (TTAB 2007).
	Added new Note 6, citing: *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862-63 (TTAB 2007).
	Added new Note 7, citing: *Finanz St. Honore B.V.*, 85 USPQ2d 1478, 1480 (TTAB 2007).
	Added new Note 11, citing: Trademark Rule 37 CFR § 2.198.
	Added new Note 13, citing: *The Equine Touch Foundation Inc. v. Equinology, Inc.*, 91 USPQ2d 1943 (TTAB 2009).
307.02(b) Trademark Act § 14, 15 U.S.C.§ 1064, Limitation is Independent	No substantive changes made.

of Trademark Act § 15, 15 U.S.C. § 1065, Affidavit (new title)	
307.02(c) Factors Affecting the Five-Year Period	Section Heading only.
307.02(c)(1) Reliance on Registration by Plaintiff	Added parenthetical to citation of *UMC Industries, Inc. v. UMC Electronics Co.,* 207 USPQ 861, 862 n.3 (TTAB 1980) in Note 1.
307.02(c)(2) Amendment of Registration	No substantive changes made.
307.03 Premature Petition To Cancel	No substantive changes made.
307.04 Late Petition To Cancel	No substantive changes made.
308 Filing Fees	Section Heading only.
308.01 Fee For Filing Opposition	Section Heading only.
308.01(a) In General	Amended references to Trademark Act § 13(a) and 37 CFR § 2.101 to reflect statutory and rule changes; added reference to TBMP § 304 in second paragraph. Added new case to Note 1: *Vibe Records Inc. v. Vibe Media Group LLC,* 88 USPQ2d 1280 (TTAB 2008); added new Note 2, citing: *Syngenta Crop Protection Inc. v. Bio-Chek LLC,* 90 USPQ2d 1112, 1115 n.2 (TTAB 2009).
308.01(b) Insufficient Fee	Added to Notes 1 and 2: "Board practice does not permit the filing of a petition for cancellation on CD-ROM. *See* 37 CFR § 2.126; Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42247 (August 1, 2007)."
	Added new cases to Note 3: *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009); and *Vibe Records Inc. v. Vibe Media Group LLC,* 88 USPQ2d 1280 (TTAB 2008).
	Added new Note 4, citing: 37 CFR § 2.101(d)(3)(i).
308.02 Fee For Filing Petition To Cancel	Section Heading only.
308.02(a) In General	Amended references to Trademark Act § 14 and 24 and 37 CFR § 2.111(c)(1) to reflect

	statutory and rule changes; added reference to TBMP § 304 in second paragraph; added new case to Note 1: *Fred Beverages, Inc. v. Fred's Capital Management Company*, 605 F.3d 968, 94 USPQ2d 1958 (Fed. Cir. 2010).
308.02(b) Insufficient Fee	Added to Note 1: 37 CFR § 2.126 and reference to Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42247 (August 1, 2007); added new Note 2, citing, by comparison: *Syngenta Crop Protection Inc. v. Bio-Chek LLC,* 90 USPQ2d 1112, 1115 n.2 (TTAB 2009); and *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280 (TTAB 2008); added new Note 3, citing: 37 CFR § 2.111(c)(3)(i); added new Note 4, citing, as example: *Giersch v. Scripps Networks Inc.,* 90 USPQ2d 1020, 1021 n.1 (TTAB 2009). Clarified requirements to correct defective renewal application in Note 5.
308.02(c) Petition Filed by Federal Trade Commission	No substantive changes made.
308.02(d) Fee for Counterclaim	No changes made.
308.03 Fees for Joint Opposers or Petitioners	Added reference to ESTTA filing procedures, including information on ESTTA's calculation of filing fees; added reference to TBMP §§ 308.01(b) and 308.02(b) to text. Added new Note 2, citing: 37 CFR § 2.101(d)(2) and 37 CFR § 2.111(c)(2). Added new Note 3, citing: *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009); *Giersch v. Scripps Networks Inc*., 90 USPQ2d 1020, 1021 n.1 (TTAB 2009); and, by comparison, *Vibe Records Inc. v. Vibe Media Group LLC,* 88 USPQ2d 1280 (TTAB 2008).
308.04 Fees For Proceeding Against Multiple Class Application Or Registration	Added reference to ESTTA filing procedures; added reference to TBMP §§ 308.01(b) and 308.02(b); added new Note 2, citing: 37 CFR § 2.101(d)(2) and 37 CFR § 2.111(c)(2).
308.05 Fees For Consolidated And Combined Complaints	No substantive changes made.

309 Form And Content Of Oppositions And Petitions To Cancel	Section Heading only.
309.01 In General	Amended references to 37 CFR §§ 2.101(b), 2.111(b), and 2.126 to reflect statutory and rule changes; amended first paragraph to inform reader that Board no longer accepts CD-ROM filings; added new Note 1 regarding same, citing: 37 CFR § 2.126(a) and (b) and Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42247 (August 1, 2007); added new Note 3, citing: 37 CFR § 2.111(a) and (b). Deleted the following from Note 3: "See, e.g., 37 CFR § 2.126(b) ('Submissions may be made to the...Board on CD-ROM where the rules in this part or Board practice permit.')."
309.02 Form Of Complaint	Added reference to 37 CFR §§ 2.111(a) and 2.111(b) in Note 2.
309.02(a) Format for Complaint	Added information in first paragraph about filing complaints through ESTTA and about using ESTTA for general filing purposes.
	Amended section under heading: "name of proceeding" by deleting "the Board will insert, in the blank space, the number assigned to the proceeding."
	Amended section under heading: "Registrant information in petition to cancel" by including information on how to determine correspondence address of registration owner.
	Added new Note 1, citing: *PPG Industries Inc. v. Guardian Industries Corp.,* 73 USPQ2d 1926, 1928 (TTAB 2005) and *Schott AG v. Scott*, 88 USPQ2d 1862, 1863 n.3 (TTAB 2008).
309.02(b) Signature of Complaint	Amended first paragraph to add information about signature on complaints filed via ESTTA.
	New case added to Note 1: *Media Online Inc. v. El Clasificado, Inc.* 88 USPQ2d 1285, 1286 n.3 (TTAB 2008).
	Added new Note 3, citing: *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1927 (TTAB 2005) and *Schott AG v. Scott*, 88 USPQ2d 1862, 1863 n.3 (TTAB

	2008).
	Added new Note 4, citing: *PPG Industries Inc.*, *v. Guardian Industries Corp,* 73 USPQ2d 1926, 1928 (TTAB 2005).
	Deleted the following from Note 7: "Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 329 (1985)."
309.02(c) Service of Complaint	Deleted existing subsection, which read (in its entirety) as follows: "The complaint need not be served by the plaintiff on the defendant. Rather, the complaint, and any exhibits thereto, will be forwarded to the defendant by the Board itself. See 37 CFR §§ 2.105(b) and (c), 2.113(b) and (c), and 2.119(a). See also TBMP § 310 (Notification to Parties of Proceeding)."
309.02(c)(1) Service of Opposition on Applicant (new subsection)	This is a new subsection, referencing 37 CFR § 2.101 and describing service requirements for plaintiffs in opposition proceedings, including how proceeding is commenced; whom to serve; how to determine the service address; the manner of service; use of ESTTA; how to handle undeliverable service copies and determine the filing date of the opposition.
309.02(c)(2) Service of Petition on Respondent (new subsection)	This is a new subsection referencing 37 CFR § 2.111 and describing service requirements for plaintiffs in cancellation proceeding, including how proceeding is commenced; whom to serve; how to determine the service address; the manner of service; use of ESTTA; how to handle undeliverable service copies and determine the filing date of the cancellation.
309.03 Substance Of Complaint	Amended references to Trademark Act § 18 to reflect statutory changes; amended references to 37 CFR §§ 2.99(h), 2.11(b), 2.112(a), and 2.133(c); and added reference to 37 CFR § 2.101(b) to reflect recent changes.
309.03(a) In General	Section Heading only.

309.03(a)(1) Scope of Opposition and Petition to Cancel	Added reference to TBMP Chapter 1100 in first paragraph.
309.03(a)(2) Elements of Complaint – In General	Added information about factual allegations made in pleadings and added new Note 4, citing: *Bell Atlantic Corp. v. Twombly,* 550 U.S. 554, 570, 127 S.Ct. 1955 (2007); *Ashcroft v. Iqbal,* 556 U.S. __, 129 S.Ct. 1937 (2009).
	Added *Bell Atlantic Corp. v. Twombly,* 550 U.S. 554, 570, 127 S.Ct. 1955 (2007); *Fair Indigo LLC v. Style Conscience,* 85 USPQ2d 1536, 1538 (TTAB 2007) to Note 3; deleted: *Harsco Corp. v. Electrical Sciences Inc.,* 9 USPQ2d 1570 (TTAB 1988); "Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff,* 81 Trademark Rep. 302 (1991)" from Note 4.
	Added new Note 4, citing: *Bell Atlantic Corp. v. Twombly,* 550 U.S. 554, 570, 127 S.Ct. 1955 (2007); *Ashcroft v. Iqbal,* 556 U.S. __, 129 S.Ct. 1937 (2009); Fed. R. Civ. P. 8(a)(2).
	Added *O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1329 (TTAB 2010) to Note 6.
	Amended Fed. R. Civ. P. 8(e)(2) to Fed. R. Civ. P. 8(d)(2) in Note 8 to reflect recent changes.
	Added new Note 9, citing: Fed. R. Civ. P. 8(d)(2).
	Added new Note 11, citing: *Brown Shoe Co. v. Robbins,* 90 USPQ2d 1752 (TTAB 2009); *Baseball America Inc. v. Powerplay Sports, Ltd.,* 71 USPQ2d 1844, 1846 n.6 (TTAB 2004); and *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008).
309.03(b) Standing	Expanded discussion of standing requirement; expanded discussion of examples of claims under likelihood of confusion and disparagement where standing was considered. In second paragraph, deleted "and cases cited therein" following reference to TBMP § 303.03.
	Added new cases to Note 2: *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 7

	USPQ2d 1628 (Fed. Cir. 1988), *Enbridge, Inc. v. Excelerate Energy Limited Partnership*, 92 USPQ2d 1537, n.10 (TTAB 2009), *Syngenta Crop Protection Inc. v. Bio-Chek LLC,* 90 USPQ2d 1112 (TTAB 2009); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008), *Kellogg Co. v. General Mills Inc.,* 82 USPQ2d 1766, 1767 (TTAB 2007), and *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).
	Added new cases to Note 3: *Corporacion Habanos S.A. v. Anncas Inc.,* 88 USPQ2d 1785 (TTAB 2008).
	Added new cases to Note 5: *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1037 (TTAB 2007) and *Demon International LC v. Lynch*, 86 USPQ2d 1058 (TTAB 2008).
	Added new Note 6, citing: *Ritchie v. Simpson*, 170 F.3d 1092, 1095-6 (Fed. Cir. 1999); *Jansen Enterprises Inc. v. Rind,* 85 USPQ2d 1104, 1107 (TTAB 2007); *Cunningham v. Laser Golf Corp.,* 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.,* 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).
	Added new cases to Note 7: *Cunningham v. Laser Golf Corp.,* 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co*., 213 USPQ 185, 189 (CCPA 1982); *Otto Roth & Co. v. Universal Foods Corp.,* 640 F.2d 1317, 209 USPQ 40 (CCPA 1981); *Bausch & Lomb Incorporated v. Karl Storz GmbH & Co KG*, 87 USPQ2d 1526, 1530 (TTAB 2008); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008); *Herbaceuticals Inc. v. Xel Herbaceuticals Inc.,* 86 USPQ2d 1572, 1576 (TTAB 2008), *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1502 (TTAB 2008); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1324 (TTAB 2007), *Chicago Bears Football Club Inc. v. 12TH*

	Man/Tennessee LLC, 83 USPQ2d 1073, 1075 (TTAB 2007); *Wet Seal Inc. v. FD Management Inc.,* 82 USPQ2d 1629, 1634 (TTAB 2007); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007); *L. & J.G. Stickley Inc. v. Cosser,* 81 USPQ2d 1956, 1964 (TTAB 2007); and *Baseball America Inc. v. Powerplay Sports Ltd*., 71 USPQ2d 1844 (TTAB 2004).
	Added new Note 8, citing: *Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.,* 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); *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752 (TTAB 2009); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc*., 89 USPQ2d 1844, 1849 (TTAB 2008); *Corporacion Habanos S.A. v. Anncas Inc.,* 88 USPQ2d 1785 (TTAB 2008); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1586 (TTAB 2008); *H.D. Lee Co. v. Maidenform Inc.,* 87 USPQ2d 1715, 1721 (TTAB 2008); *Apple Computer v. TVNET.net Inc.,* 90 USPQ2d 1393 (TTAB 2007); *Sinclair Oil Corp. v. Kendrick,* 85 USPQ2d 1032, 1037 n.10 (TTAB 2007); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007); *Christian Broadcasting Network Inc. v. ABS-CBN International,* 84 USPQ2d 1560, 1565 (TTAB 2007); *Otto International Inc. v. Otto Kern GmbH,* 83 USPQ2d 1861 (TTAB 2007*); B.V.D. Licensing Corp. v. Rodriguez,* 83 USPQ2d 1500, 1505 (TTAB 2007); *Truescents LLC v. Ride Skin Care LLC,* 81 USPQ2d 1334, 1337 (TTAB 2006); *Tea Board of India v. Republic of Tea Inc.,* 80 USPQ2d 1881, 1897 (TTAB 2006); *DC Comics v. Pan American Grain Mfg. Co.,* 77 USPQ2d 1220, 1225 (TTAB 2005); and *Knight Textile Corp. v. Jones Investment Co.,* 75 USPQ2d 1313 (TTAB 2005).
	Added new Note 9, citing: *First Niagara Insurance Brokers Inc. v. First Niagara*

	Financial Group Inc., 81 USPQ2d 1375 (Fed. Cir. 2007); *Syngenta Crop Protection Inc. v. Bio-Chek LLC,* 90 USPQ2d 1112, 1118 n.8 (TTAB 2009); *Giersch v. Scripps Networks Inc.,* 90 USPQ2d 1020, 1022 (TTAB 2009); *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd*., 86 USPQ2d 1283 (TTAB 2008); *General Motors Corp. v. Aristide & Co., Antiquaire de Marques,* 87 USPQ2d 1179, 1181 (TTAB 2008); and *Kohler Co. v. Baldwin Hardware Corp.,* 82 USPQ2d 1100, 1106 (TTAB 2007).
	Added new cases to Note 10: *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); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008), and *Great Seats Ltd. v. Great Seats Inc*., 84 USPQ2d 1235, 1237 (TTAB 2007).
	Added new Note 12, citing: *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *McDermott v. San Francisco Women's Motorcycle Contingent,* 81 USPQ2d 1212 (TTAB 2006), *aff'd, unpubl'd,* 240 Fed. Appx. 865 (Fed. Cir. 2007), *cert. den'd,* 128 S.Ct. 893, 169 L.Ed.2d 746 (2008).
	Added new cases to Note 14: *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 (TTAB 2005); and *Great Seats Ltd. v. Great Seats Inc.,* 84 USPQ2d 1235, 1236 n.3 (TTAB 2007).
	Added new cases to Note 16: *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp. U.S. Music Corp. v. Fender Musical Instruments Corp.,* 94 USPQ2d 1549 (TTAB 2009); *Corporacion Habanos S.A. v. Anncas Inc.,* 88 USPQ2d 1785 (TTAB 2008); *Saint-Gobain Corp. v. 3M Co*., 90 USPQ2d 1425, 1428 (TTAB 2007); *Target Brands Inc. v.*

	Hughes, 85 USPQ2d 1676, 1679 (TTAB 2007); *Kellogg Co. v. General Mills Inc.,* 82 USPQ2d 1766, 1767 (TTAB 2007); and *Great Seats Ltd. v. Great Seats Inc*., 84 USPQ2d 1235, 1244 n.10 (TTAB 2007).
	Added new Note 17, citing: *Enbridge, Inc. v. Excelerate Energy LP,* 92 USPQ2d 1537, 1543 n.10 (TTAB 2009), citing *Liberty Trouser Co., Inc. v. Liberty & Co., Ltd.,* 222 USPQ 357, 358 (TTAB 1983).
309.03(c) Grounds	Amended section to inform readers of requirements for claim brought on dilution grounds; amended section to inform readers of need to plead registrations upon which plaintiff may rely; moved discussion regarding *de jure* functional claim to Trademark Act § 2(e), as this is where the statute references that ground; amended statement of ground under Trademark Act § 2(a) to include immoral and deceptive elements; amended discussion under Section 2(a) to add discussion regarding claim that mark is geographical indicator; amended heading "(8)" to include claim that mark is a non-distinctive sound; and amended heading “(11)” to clarify elements involved in claim of abandonment.
	Added new cases to Note 1: *Enbridge, Inc. v. Excelerate Energy LP,* 92 USPQ2d 1537, 1543 n.10 (TTAB 2009); and *Nextel Communications Inc. v. Motorola Inc*., 91 USPQ2d 1393, 1396 n.1 (TTAB 2009).
	Added new cases to Note 2: *McDermott v. San Francisco Womens Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006); *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); *Carano v. Vina Concha y Toro S.A.,* 67 USPQ2d 1149, 1152 (TTAB 2003); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.,* 41 USPQ2d 1030, 1034 n.3 (TTAB 1996); *Bayer Consumer Care AG v. Belmora LLC,* 90 USPQ2d 1587 (TTAB 2009); *Franpovi SA v. Wessin*, 89 USPQ2d 1637 (TTAB 2009);

	Demon International LC v. Lynch, 86 USPQ2d 1058 (TTAB 2008); and *Tea Board of India v. Republic of Tea Inc.,* 80 USPQ2d 1881, 1884 n.3 (TTAB 2006).
	Added new Note 3, citing: Trademark Act § 43(c), 15 U.S.C. § 1125(c); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1649 (TTAB 2010); *Demon International LC v. Lynch*, 86 USPQ2d 1058, 1059-1060 (TTAB 2008); *Trek Bicycle Corp. v. StyleTrek Ltd.,* 64 USPQ2d 1540, 1542 (TTAB 2001); *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1174 n.9 (TTAB 2001); and *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000).
	Added new Note 4, citing: *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.3 (TTAB 2009); and *Kohler Co. v. Baldwin Hardware Corp.,* 82 USPQ2d 1100, 1103 n.3 (TTAB 2007).
	Added new Note 5, citing: *B.V.D. Licensing Corp. v. Rodriguez,* 83 USPQ2d 1500, 1503 (TTAB 2007); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha,* 77 USPQ2d 1917, 1919-20 (TTAB 2006); and *Boston Red Sox Baseball Club LP v. Sherman,* 88 USPQ2d 1581, 1583, n.3 (TTAB 2008).
	Added new cases to Note 6: *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d 1689 (Fed. Cir. 2005); *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 73 USPQ2d 1350 (Fed. Cir. 2004); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.,* 81 USPQ2d 1375, 1378 (Fed. Cir. 2007); *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1756 (TTAB 2009); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1023 (TTAB 2009); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008); *Apple Computer v. TVNET.net Inc.*, 90 USPQ2d 1393 (TTAB 2007); *Life Zone Inc. v. Middleman Group*

	Inc., 87 USPQ2d 1953, 1959 (TTAB 2008); *Black & Decker Corp. v. Emerson Electric Co*., 84 USPQ2d 1482, 1490 (TTAB 2007); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007); *Christian Broadcasting Network Inc. v. ABS-CBN International,* 84 USPQ2d 1560, 1565 (TTAB 2007); *Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624 (TTAB 2007); *Miss Universe L.P., LLLP v. Community Marketing, Inc.,* 82 USPQ2d 1562 (TTAB 2007); *Kohler Co. v. Baldwin Hardware Corp*., 82 USPQ2d 1100, 1113 (TTAB 2007).
	Added new cases to Note 7: *Cold War Museum Inc. v. Cold War Air Museum Inc*., 92 USPQ2d 1626, 1629 (Fed. Cir. 2009); *Yamaha International Corp. v. Hoshino Gakki Co. Ltd*., 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1680 (TTAB 2007); *Kellogg Co. v. General Mills Inc*., 82 USPQ2d 1766, 1768 (TTAB 2007).
	Added new cases to Note 8: *Grand Canyon West Ranch LLC v. Hualapai Tribe,* 88 USPQ2d 1501, 1504 (TTAB 2008).
	Added new cases to Note 9: *Corporacion Habanos S.A. v. Anncas Inc.,* 88 USPQ2d 1785 (TTAB 2008); added parenthetical to *In re California Innovations, Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003).
	Added new cases to Note 10: *In re Rath,* 402 F.3d 1207, 74 USPQ2d 1174 (Fed.Cir. 2005); and *In re Piano Factory Group Inc.*, 85 USPQ2d 1522 (TTAB 2007). Deleted the following from Note 10: "*Kellogg Co. v. Pack'Em Enterprises Inc.,* 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991)."
	Added new Note 11, citing: *TrafFix Devices Inc. v. Marketing Displays Inc.*, 523 U.S. 23, 58 USPQ2d 1001, 1006 (2001); *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 115 S.Ct. 1300, 131 L.Ed.2d 248, 34 USPQ2d 1161 (1995); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009); *Duramax*

	Marine, LLC v. R.W. Fernstrum & Company, 80 USPQ2d 1780 (TTAB 2006).
	Added new cases to Note 12: *Corporacion Habanos S.A. v. Anncas Inc.,* 88 USPQ2d 1785 (TTAB 2008); *United States Playing Card Co., v. Harbro, LLC,* 81 USPQ2d 1537 (TTAB 2006); and *In re California Innovations Inc.,* 329 F.3d 1334, 66 USPQ2d 1853, 1856 (Fed. Cir. 2003).
	Added new cases to Note 13: *In re Lebanese Arak Corp.,* 94 USPQ2d 1215 (TTAB 2010); *In re Heeb Media, LLC*, 89 USPQ2d 1071 (TTAB 2008); *Boston Red Sox Baseball Club LP v. Sherman,* 88 USPQ2d 1581 (TTAB 2008); *In re Squaw Valley Development Co.*, 80 USPQ2d 1264 (TTAB 2006); *McDermott v. San Francisco Womens Motorcycle Contingent*, 81 USPQ2d 1212 (TTAB 2006); *aff'd.,* 240 Fed.Appx. 865 (Fed.Cir. 2007) (*not selected for publication in the Federal Reporter*, No. 07-1101); *cert. denied*, 128 S.Ct. 893, 169 L.Ed.2d 746 (2008)(No. 07-7126); updated citation to *Harjo v. Pro-Football Inc.,* 50 USPQ2d 1705, 1740-48 (TTAB 1999), *rev'd*, 284 F. Supp. 2d 96, 125, 68 USPQ2d 1225, 1248 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), and *aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009).
	Added new cases to Note 14: *Corporacion Habanos S.A. v. Anncas Inc.,* 88 USPQ2d 1785 (TTAB 2008); *Boston Red Sox Baseball Club Limited Partnership v. Sherman,* 88 USPQ2d 1581, 1588 (TTAB 2008); *Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *In re South Park Cigar, Inc.*, 82 USPQ2d 1507 (TTAB 2007); *In re Red Bull GmbH,* 78 USPQ2d 1375 (TTAB 2006); *In re Wilcher Corp.*, 40 USPQ2d 1929 (TTAB 1996); *In re Old Glory Condom Corp.*, 26 USPQ2d 1216, 1220 (TTAB 1993); *McDermott v. San Francisco Womens Motorcycle Contingent*, 81 USPQ2d 1212, 1214 (TTAB 2006), *aff'd. (unpub'd) ,* 240 Fed.Appx. 865 (Fed. Cir. 2007) (*not selected*

	for publication in the Federal Reporter, No. 07-1101), *cert. denied*, 128 S.Ct. 893, 169 L.Ed.2d 746 (2008) (No. 07-7126).
	Added new cases to Note 15: *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co. Inc*., 703 F.2d 1372, 217 USPQ 505 (Fed.Cir.1983); *Boston Red Sox Baseball Club Limited Partnership v. Sherman,* 88 USPQ2d 1581, 1593 (TTAB 2008); *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635 (TTAB 1988).
	Added new Note 16, citing: *See Tea Board of India v. Republic of Tea Inc.,* 80 USPQ2d 1881, 1899 (TTAB 2006); *In re Spirits International N.V.,* 86 USPQ2d 1078, 1080 n.2 (TTAB 2008); and *In re Wada*, 48 USPQ2d 1689, 1692 n.7 (TTAB 1998).
	Added new cases to Note 17: *Avakoff v. Southern Pacific Co*., 765 F.2d 1097, 226 USPQ 435 (Fed. Cir. 1985); *Nutrasweet Company v. K & S Foods Inc.,* 4 USPQ2d 1964 (TTAB 1987); *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1033 (TTAB 2007)
	Added new cases to Note 18: *Honda Motor Co., Ltd. v. Friedrich Winkelmann,* 90 USPQ2d 1660 (TTAB 2009); *Boston Red Sox Baseball Club LP v. Sherman,* 88 USPQ2d 1581, 1587 (TTAB 2008); and *Wet Seal Inc. v. FD Management Inc.,* 82 USPQ2d 1629, 1643 (TTAB 2007).
	Added new cases to Note 19: *In re Grande Cheese Co.,* 2 USPQ2d 1447 (TTAB 1986); and updated citation to *General Foods Corp. v. Ito Yokado Co., Ltd*., 219 USPQ 822, 825 (TTAB 1983), *aff'd (unpub'd),* 84-517 (Fed. Cir. 1984).
	Added new case to Note 20: *Ballet Tech Foundation, Inc. v. The Joyce Theater Foundation, Inc.*, 89 USPQ2d 1262 (TTAB 2008).
	Added new cases to Note 21: *Qualitex Co. v. Jacobson Prods. Co.,* 514 U.S. 159, 115 S.Ct. 1300, 131 L.Ed.2d 248 (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).
	Added new Note 22, citing: Trademark Act §§ 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127; *Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d 1393 (TTAB 2009); and *In re Vertex Group LLC,* 89 USPQ2d 1694, 1700 (TTAB 2009).
	Added parenthetical to case in Note 23: *Aycock Engineering, Inc. v. Airflite, Inc.,* 560 F.3d 1350, 90 USPQ2d 1301, 1309 n.12 (Fed. Cir. 2009); and updated citation for *Anheuser-Busch Inc. v. The Florists Association of Greater Cleveland, Inc.*, 29 USPQ2d 1146, 1160 (TTAB 1993).
	Added new case to Note 24: *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812-1813 (Fed. Cir. 2001).
	Added new cases to Note 25: *General Motors Corp. v. Aristide & Co., Antiquaire de Marques,* 87 USPQ2d 1179 (TTAB 2008); and *Otto International Inc. v. Otto Kern GmbH,* 83 USPQ2d 1861, 1863 (TTAB 2007).
	Added new cases to Note 26: *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp. U.S. Music Corporation v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009); *Ballet Tech Foundation, Inc. v. The Joyce Theater Foundation, Inc.*, 89 USPQ2d 1262 (TTAB 2008); and *Tea Board of India v. The Republic of Tea, Inc.* 80 USPQQ2d 1881 (TTAB 2006).
	Added new cases to Note 27: *Chester L. Krause v. Krause Publications, Inc.,* 76 USPQ2d 1904 (TTAB 2005); and *Societe Civile Des Domaines Dourthe Freres v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205 (TTAB 1988).
	Added new case to Note 28: *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp. U.S. Music Corporation v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009).

	Added new reference and cases to Note 29: Trademark Act § 43(c), 15 U.S.C. § 1125(c); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1649 (TTAB 2010); *Demon International LC v. Lynch*, 86 USPQ2d 1058, 1059-1060 (TTAB 2008); *Trek Bicycle Corp. v. StyleTrek Ltd.,* 64 USPQ2d 1540, 1542 (TTAB 2001); *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1174 n.9 (TTAB 2001); *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000). *But see*, *Fiat Group Automobiles, S.p.A. v. ISM, Inc.,* 94 USPQ2d 1111 (TTAB 2010).
	Added new Note 30, citing: *Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587 (TTAB 2009); *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007); *The E.E. Dickinson Co. v. The T.N. Dickinson Company,* 221 USPQ 713 (TTAB 1984).
	Added new Note 31, citing: *Copelands' Enterprises Inc. v. CNV Inc.*, 20 USPQ2d 1295 (Fed. Cir. 1991); *Brown Shoe Co. v. Robbins,* 90 USPQ2d 1752 (TTAB 2009); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1290 (TTAB 2007); *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 n.3 (TTAB 2008); and *Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 192 USPQ 24, 27 (CCPA 1976).
	Added new Note 32, citing: Fed. R. Civ. P. 9(b); *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009); *DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086 (TTAB 2010); *Enbridge, Inc. v. Excelerate Energy Limited Partnership*, 92 USPQ2d 1537 (TTAB 2009); *Exergen Corp. v. Wal-Mart Stores Inc.*, 91 USPQ2d 1656, 1670 (Fed. Cir. 2009), 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 (Fed. Cir. 1986); *King Auto., Inc. v. Speedy Muffler*

	King, Inc., 667 F.2d 1008, 212 USPQ 801, 803 (CCPA 1981); *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981); *G&W Laboratories Inc. v. GW Pharma Ltd.,* 89 USPQ2d 1571, 1574 (TTAB 2009); *Grand Canyon West Ranch LLC v. Hualapai Tribe,* 88 USPQ2d 1501, 1509 (TTAB 2008); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha,* 77 USPQ2d 1917 (TTAB 2006); *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478 (TTAB 2009); *Zanella Ltd. v. Nordstrom Inc.,* 90 USPQ2d 1758, 1762 (TTAB 2008); *University Games Corp. v. 20Q.net Inc.*, 87 USPQ2d 1465 (TTAB 2008); *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.,* 84 USPQ2d 1912, 1916 (TTAB 2007); and *Medinol Ltd. v. Neuro Vasx, Inc.,* 67 USPQ2d 1205 (TTAB 2003).
	Added new Note 33, citing: *British-American Tobacco Co. v. Phillip Morris Inc.,* 55 USPQ2d 1585 (TTAB 2000); and *Diaz v. Servicios De Franquicia Pardo's S.A.C.,* 83 USPQ2d 1320, 1322 (TTAB 2007).
	Added new Note 34, citing: *Nasalok Coating Corp. v. Nylok Corp.,* 522 F.3d 1320, 86 USPQ2d 1369 (Fed. Cir. 2008), by comparison; and *Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d 1393, 1398 (TTAB 2009).
	Added new Note 35, citing: Trademark Act § 2(d); *West Florida Seafood, Inc., v. Jet Restaurants, Inc.* 31 F.2d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994); *Life Zone Inc. v. Middleman Group Inc.,* 87 USPQ2d 1953, 1960 (TTAB 2008); *Media Online Inc. v. El Clasificado Inc.,* 88 USPQ2d 1285, 1287 (TTAB 2008); and *Kohler Co. v. Baldwin Hardware Corp.,* 82 USPQ2d 1100, 1108 (TTAB 2007).
	New cases added to Note 36: *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Syngenta Crop Protection Inc. v. Bio-Chek LLC,* 90 USPQ2d 1112, 1119 (TTAB 2009); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1852 (TTAB 2008);

	H.D. Lee Co. v. Maidenform Inc., 87 USPQ2d 1715, 1722 (TTAB 2008); *Media Online Inc. v. El Clasificado Inc*., 88 USPQ2d 1285 (TTAB 2008); *Kohler Co. v. Baldwin Hardware Corp*., 82 USPQ2d 1100, 1108 (TTAB 2007); *B.V.D. Licensing Corp. v. Rodriguez,* 83 USPQ2d 1500, 1505 (TTAB 2007); *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); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.,* 23 USPQ2d 1134 (TTAB 1992); *Diaz v. Servicios De Franquicia Pardo's S.A.C*., 83 USPQ2d 1320, 1322 (TTAB 2007); *CDS Inc. v. I.C.E.D. Management, Inc*., 80 USPQ2d 1572, 1580 (TTAB 2006); and *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 F3d 8, 86 USPQ2d 1527 (Fed. Cir. 2008).
	New cases added to Note 37: *Brown Shoe Co. v. Robbins,* 90 USPQ2d 1752, 1754 (TTAB 2009); *Christian Broadcasting Network Inc. v. ABS-CBN International,* 84 USPQ2d 1560, 1565 (TTAB 2007); *Tea Board of India v. Republic of Tea Inc.,* 80 USPQ2d 1881, 1897 (TTAB 2006); *Truescents LLC v. Ride Skin Care LLC,* 81 USPQ2d 1334 (TTAB 2006); and *Kohler Co. v. Baldwin Hardware Corp.,* 82 USPQ2d 1100, 1106 (TTAB 2007). Moved location of citation to *Kohler* C*. v. Baldwin Hardware Corp.,* 82 USPQ2d 1100 (TTAB 2007). Deleted from Note 37: "*Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998) (if the underlying application filing date of petitioner's pleaded registration was earlier than the filing date of respondent's underlying application, petitioner could take its chances and elect to make of record simply a copy of its registration as proof of first use as of the filing date of the underlying application); *American Standard Inc. v. AQM Corporation,* 208 USPQ 840, 842 (TTAB 1980); and *Gor-Ray Limited*

	v. Garay & Co., Inc., 167 USPQ 694 (TTAB 1970) (a cancellation petitioner is entitled to rely on the filing date of its pleaded registration as prima facie evidence of its first use of the mark).”
	New cases added to Note 38: *Syngenta Crop Protection Inc. v. Bio-Chek LLC,* 90 USPQ2d 1112, 1119 (TTAB 2009); *Giersch v. Scripps Networks Inc.,* 90 USPQ2d 1020, 1023 (TTAB 2009); *Mattel Inc. v. Funline Merchandise Co.,* 81 USPQ2d 1372, 1374 (TTAB 2006); *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.,* 86 USPQ2d 1283, 1284 (TTAB 2008); *General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179 (TTAB 2008); *Fair Indigo LLC v. Style Conscience,* 85 USPQ2d 1536 (TTAB 2007); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007); and *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718 (TTAB 2003).
	New cases added to Note 39: *West Florida Seafood, Inc., v. Jet Restaurants, Inc*., 31 F.2d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1539 (TTAB 2007); *L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956, 1965 (TTAB 2007); and *Westrex Corp. v. New Sensor Corp*., 83 USPQ2d 1215, 1218 (TTAB 2007).
	New cases added to Note 40: *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009); *L.C. Licensing Inc. v. Berman,* 86 USPQ2d 1883, 1887 (TTAB 2008); *Demon International LC v. Lynch*, 86 USPQ2d 1058, 1060 (TTAB 2008); *Fort James Operating Co. v. Royal Paper Converting Inc*., 83 USPQ2d 1624, 1626 (TTAB 2007); *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) *aff'd* unpub. op., Appeal Nos. 2006-1366, 1367 (Fed. Cir. Dec. 6, 2006); *DC Comics v. Pan American Grain Mfg. Co*., 77 USPQ2d 1220, 1225 (TTAB 2005); and *Bass*

	Pro Trademarks LLC v. Sportsman's Warehouse Inc., 89 USPQ2d 1844, 1851 (TTAB 2008).
	New cases added to Note 41: *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, n.6 (CCPA 1974); *Vitaline Corp. v. General Mills Inc.,* 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989); and *Fort James Operating Co. v. Royal Paper Converting Inc.,* 83 USPQ2d 1624, 1626 n.1 (TTAB 2007). Also added citation to 37 CFR § 2.106(b)(2)(ii).
	New cases added to Note 42: *Association pour la Defense et la Promotion de l'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838 (TTAB 2007) and *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221 (TTAB 1995). Also updated citation to *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).
	New cases added to Note 43: *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Hewlett-Packard Co. v. Packard Press Inc*., 62 USPQ2d 1001 (Fed. Cir. 2002); *Cunningham v. Laser Golf Corp*., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Brown Shoe Co. v. Robbins,* 90 USPQ2d 1752, 1756 (TTAB 2009); *Giersch v. Scripps Networks Inc*., 90 USPQ2d 1020 (TTAB 2009); *H.D. Lee Co. v. Maidenform Inc.,* 87 USPQ2d 1715, 1723 (TTAB 2008); *Fort James Operating Co. v. Royal Paper Converting Inc.,* 83 USPQ2d 1624 (TTAB 2007); *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1505 (TTAB 2007); *Truescents LLC v. Ride Skin Care LLC,* 81 USPQ2d 1334, 1342 (TTAB 2006); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1897 (TTAB 2006); *Teledyne Technologies Inc. v. Western Skyways Inc*., 78 USPQ2d 1203, 1206 (TTAB 2006) *aff'd*

	unpub'd op., Appeal Nos. 2006-1366, 1367 (Fed. Cir. Dec. 6, 2006); *DC Comics v. Pan American Grain Mfg. Co.,* 77 USPQ2d 1220, 1228 (TTAB 2005); *Alfacell Corp. v. Anticancer Inc.,* 71 USPQ2d 1301, 1306 (TTAB 2004); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002); and *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1052-1053 (TTAB 1992).
	New cases added to Note 44: *Odom's Tennessee Pride Sausage, Inc. v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010); *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004); *Kellogg Co. v. Pack'em Enterprises Inc.,* 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 21 USPQ2d 1142 (Fed. Cir. 1991); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008); *Mattel Inc. v. Funline Merchandise Co.,* 81 USPQ2d 1372, 1374 (TTAB 2006); and *Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1342 (TTAB 2006).
	Updated reference in Note 45 to show that Fed. R. Civ. P. 8(e)(2) has been replaced by 8(d)(2).
	New cases added to Note 46: *John T. Clark Company v. Colgate-Palmolive Company*, 176 USPQ 93 (TTAB 1972); *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154 (TTAB 1975); and *Lia Jene Inc. v. Vitabath, Inc.*, 162 USPQ 469, 470 (TTAB 1969).
	Updated citation in Note 47 for *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48 (TTAB 1971).
309.03(d) Remedy Under Trademark Act § 18, 15 U.S.C. § 1068 (Partial Opposition or Partial Cancellation) (new title)	Updated reference to Trademark Act § 18 and to 37 CFR § 2.133(b) to reflect statutory and rule changes.
	Added cross-reference to Chapter 1100 in first paragraph. Clarified, in second paragraph, that claim under Trademark Act § 18 may be sought separately and apart from, or in addition to, any other ground; that claim is

	equitable; and distinguishable from "straightforward" pleading of abandonment.
	Added new subheading to third paragraph regarding claims to restrict or limit goods or services in involved application or registration. Added new subheading to seventh paragraph regarding claims to restrict or rectify with respect to the register, and added new ninth paragraph regarding disclaimers for generic terms where registration less than five years old.
	Added new cases to Note 1: *Montecash LLC v. Anzar Enterprises, Inc*., 95 USPQ2d 1060, 1063 (TTAB 2010); and, by comparison, *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (TTAB 2007).
	Added new case to Note 2: *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1106 n.3 (TTAB 2007);
	Added new case to Note 3: *Montecash LLC v. Anzar Enterprises, Inc*. 95 USPQ2d 1060, 1063 (TTAB 2010).
	Added new Note 4, citing: *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1271 & 1271 n.3 (TTAB 1994); and, by "*see also," DAK Industries Inc. v. Daiichi Kosho Co*., 35 USPQ2d 1434, 1437 (TTAB 1995).
	Amended Note 5 by deleting the following from parenthetical to *Milliken & Co. v. Image Industries Inc.*, 39 USPQ2d 1192 (TTAB 1996): "a counterclaim to restrict an identification of goods, as opposed to a counterclaim to delete specific identified items, is not a proper claim of abandonment."
	Relocated Note 6, renumbered as new Note 5, citing: *DAK Industries Inc. v. Daiichi Kosho Co*., 35 USPQ2d 1434, 1437 (TTAB 1995) and "*see also," Milliken & Co. v. Image Industries Inc.*, 39 USPQ2d 1192 (TTAB 1996); amended parenthetical to *Dak Industries* by inserting "on the grounds that opposer was no longer using and had no intent to resume use of its mark on such goods," following "open reel audio tape."

	Added new case to Note 6: *IdeasOne Inc. v. Nationwide Better Health Inc*., 89 USPQ2d 1952 (TTAB 2009).
	In Notes 7 and 8, corrected pin cite to "*Eurostar Inc.*" from 1270 to 1271; and added parentheticals for both cases cited in Note 7, namely: *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, 1271 (TTAB 1994).
	Added new case to Note 12: *IdeasOne Inc. v. Nationwide Better Health Inc.,* 89 USPQ2d 1952, 1953 (TTAB 2009).
	Added new case to Note 14: *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351, 1353 (TTAB 2007); changed the parenthetical to *Milliken & Co. v. Image Industries Inc.,* 39 USPQ2d 1192 (TTAB 1996) to clarify reasons counterclaim therein was insufficient.
	Added new Note 15, citing: *Montecash LLC v. Anzar Enterprises, Inc*. 95 USPQ2d 1060, 1063 (TTAB 2010); and *Kellogg Co. v. Pack'em Enterprises, Inc.,* 14 USPQ2d 1545 (TTAB 1990).
	Added new case to Note 16, by comparison: *ProQuest Information and Learning Co. v. Island,* 83 USPQ2d 1351, 1353 (TTAB 2007).
	Added new Note 19, citing: 37 CFR § 2.106(b)(2)(ii).
309.04 Defects In Complaint That May Affect Institution Of Proceeding	Changed "misidentified by mistake" to "misidentified through mistake" in paragraph 1, to conform with 37 CFR § 2.102(b).
	Amended paragraphs 1 through 3 regarding circumstances where fees will be refunded, and amended paragraphs 1 through 4, regarding circumstances where fees will not be refunded, to compare effect of premature, late, or otherwise defective filings made through ESTTA with those made on paper.
	Further amended paragraph 1, regarding circumstances where fees will not be refunded, to indicate that insufficiency of pleading must be raised by motion.

	Added new paragraph 4, regarding circumstances where fees will not be refunded, to advise that fee will not be refunded if proceeding is instituted against the incorrect number due to filer's error.
	Added new Note 1, citing: *Records Inc. v. Vibe Media Group LLC,* 88 USPQ2d 1280 (TTAB 2008).
	Added new Note 2 to include citations to 37 CFR § 2.194(b)(1) and *Yahoo! Inc., v. Loufrani,* 70 UPSQ2d 1735, 1736 (TTAB 2004).
310 Notification To Parties Of Proceeding And Setting Time To Answer	Section Heading only.
310.01 Notification To Parties Of Proceeding	Amended references to 37 CFR section citations to reflect 2007 changes to Trademark Rules. Amended text throughout section by changing “notification” to “institution order.”
	Amended first and second paragraphs to indicate that proceeding will be instituted following filing of opposition or cancellation with proof of service and required fee; deleted references to Board's obtaining copies of paper files. Updated third paragraph to note that Board will check assignment records for petitions to cancel filed on paper and that petition should indicate current owner of record.
	Amended fourth paragraph by adding that institution order includes scheduling order pursuant to 2007 changes to trademark rules, which may be sent by e-mail where party has provided an e-mail address.
	Added new paragraph to inform readers that additional notice may be given where institution order is returned as being undeliverable. Amended sixth paragraph to conform subsection to rules changes regarding address of plaintiff to which notifications are sent and amended seventh paragraph to conform same regarding address of defendant. Deleted references to Board sending copies of complaint to defendants as this is no longer Board practice under the rules as amended in 2007.

	Amended final paragraph to indicate that in cancellation, Board will send current owner a courtesy copy of the notification and electronic link for viewing the petition through TTABVUE if defendant identified by plaintiff is not the record owner of mark.
	Added new Note 3, citing: 37 CFR § 2.113.
	Added new citations to Note 4: *Smart Inventions Inc. v. TMB Products LLC*, 81 USPQ2d 1383, 1384 (TTAB 2006); and 37 CFR § 3.73(b)(1).
	Added new Note 5, citing: 37 CFR §§ 2.112(a) and (b).
	Added new Note 6, citing Miscellaneous Changes to Trademark Trial and Appeal Board Rules 72, Fed. Reg. 42242, 42243 (August 1, 2007).
	Added new citation to Note 7: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).
	Added new Note 8, citing: 37 CFR § 2.105(a).
	Added new Note 9, citing: 37 CFR § 2.118; and Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243-4 (August 1, 2007).
	Added new Note 10, citing: 37 CFR § 2.105(b)(1); and 37 CFR § 2.113(b)(1).
	Added new Note 11, citing: 37 CFR § 2.105(b)(3); 37 CFR § 2.113(b)(3).
	Added new citation to Note 15: by comparison, Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007). Deleted “published in the Federal Register on August 22, 1989 at 54 FR 34886, 34891” from citation to Notice of Final Rulemaking, 54 Fed. Reg. 34886, 34891 (August 22, 1989).
310.02 Defendant's Copy Of Institution Order Returned As Undeliverable (new title)	Replaced "Complaint" in the Heading with "Institution Order."

	Added reference to 37 § CFR 2.118.
	Amended subsection to inform readers that notice of an opposition proceeding may be given by publication in the Official Gazette whenever Board's notification is returned as being undeliverable or where plaintiff advises Board that service copy was returned as being undeliverable and Board is unable to locate defendant.
	Added new Note 1, citing: 37 CFR § 2.118; added new reference in Note 2: 37 CFR § 2.118; Miscellaneous Changes to Trademark Trial and Appeal Board Rules 72 Fed. Reg. 42242, 42244 (August 1, 2007).
310.03 Setting Time For Filing Answer	Section Heading only.
310.03(a) In General	Amended references to 37 CFR §§ 2.105 and 2.113 to reflect recent changes; updated signal from *cf.* to *see* in citation in Note 1 to: *Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237, 1238 (TTAB 1993).
310.03(b) 37 CFR 2.119(c) Five-Day Addition Under 37 CFR § 2.119(c) Not Applicable to Deadlines Set by Board (new title)	Changed title by moving wording “Under 37 CFR § 2.119(c)” to middle of title and converting “5” to “Five.”
	Added new Note 1, citing: *Amazon Technologies, Inc. v. Jefferey S. Wax,* 95 USPQ2d 1865, 1867 n.4 (TTAB 2010).
	Added new Note 2, citing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules 72 Fed. Reg. 42242, 42250 (August 1, 2007).
310.03(c) Extension of Time to File Answer	Added new Note 1, citing: Fed. R. Civ. P. 6(b).
311 Form And Content Of Answer	Section Heading only.
311.01 Form Of Answer	Amended references to 37 CFR § 2.126 to reflect recent changes; amended second paragraph to inform readers that Board will no longer accept submission in CD-ROM format if the submission could otherwise have been submitted on paper; changed reference to 37

	CFR § 2.126(c) to § 2.126(b); added new Note 3, citing: 37 CFR §§ 2.126(a) and (b).
311.01(a) Format for Answer	Deleted reference to allowable filing on CD-ROM.
311.01(b) Signature of Answer	Replaced reference to 37 CFR § 2.193(c)(1)(iii) with reference to 37 CFR § 2.193(c); added information regarding electronic signatures in ESTTA.
	Added new Note 2, citing: *PPG Industries Inc. v. Guardian Industries Corp*., 73 USPQ2d 1926, 1928 (TTAB 2005); and *Schott AG v. Scott*, 88 USPQ2d 1862, 1863 n.3 (TTAB 2008).
	Added new Note 3, citing: *PPG Industries Inc. v. Guardian Industries Corp*., 73 USPQ2d 1926, 1928 (TTAB 2005).
	Added new Note 4, citing, by comparison: TBMP § 712.01(a)(i).
311.01(c) Filing and Service of Answer	No changes made.
311.02 Substance Of Answer	No changes made.
311.02(a) Admissions and Denials	Added "jurisdictional grounds" to allegations defendant may controvert by way of general denial and removed reference to "some of the allegations" in discussion of general denials; added new Note 3, citing: Fed. R. Civ. P. 8(b)(3).
311.02(b) Affirmative Defenses	Expanded discussion of restrictions by defendants to identification of goods as affirmative defenses.
	Added information about when affirmative defenses start to run in cancellation actions; added new fourth paragraph noting that fair use defense is inapplicable to Board proceedings; added new reference to TBMP Chapter 1100.
	New cases added to Note 2: *Giersch v. Scripps Networks Inc.,* 90 USPQ2d 1020, 1021 n.4 (TTAB 2009); *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd*., 86 USPQ2d 1283 (TTAB 2008); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008); *Tea Board of India v. Republic of Tea Inc.,* 80 USPQ2d

	1881, 1884 n.6 (TTAB 2006); *Textron, Inc. v. The Gillette Company,* 180 USPQ 152, 154 (TTAB 1973); *Land O' Lakes Inc. v. Hugunin,* 88 USPQ2d 1957, 1958 (TTAB 2008); *Teledyne Technologies Inc. v. Western Skyways Inc*., 78 USPQ2d 1203, 1209 (TTAB 2006) *aff'd* unpublished op., Appeal Nos. 2006-1366, -1367 (Fed. Cir. Dec. 6, 2006); *Nasalok Coating Corp. v. Nylok Corp.,* 522 F.3d 1320, 86 USPQ2d 1369 (Fed. Cir. 2008); *Mayer/Berkshire Corp. v. Berkshire Fashions Inc.,* 76 USPQ2d 1310 (Fed. Cir. 2005); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008); *B.V.D. Licensing Corp. v. Rodriguez,* 83 USPQ2d 1500 (TTAB 2007); *Herbaceuticals Inc. v. Xel Herbaceuticals Inc*., 86 USPQ2d 1572, 1575 n.3 (TTAB 2008); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1116 (TTAB 2007); *Christian Broadcasting Network Inc. v. ABS-CBN International,* 84 USPQ2d 1560, 1572 (TTAB 2007); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007); *Chester L. Krause v. Krause Publications, Inc*., 76 USPQ2d 1904 (TTAB 2005); *Diaz v. Servicios De Franquicia Pardo's S.A.C*., 83 USPQ2d 1320, 1322 (TTAB 2007); *Truescents LLC v. Ride Skin Care LLC,* 81 USPQ2d 1334, 1338; and *Great Seats Ltd. v. Great Seats Inc.,* 84 USPQ2d 1235, 1244 n.10 (TTAB 2007).
	New rules citations added to Note 4: 37 CFR §§ 2.99(h) and 2.133(c).
	Reference to new TBMP section added after Note 5: TBMP § 309.03(b).
	New cases added to Note 5: *Montecash LLC v. Anzar Enterprises, Inc*. 95 USPQ2d 1060 (TTAB 2010); *Finanz St. Honore B.V. v. Johnson & Johnson,* 85 USPQ2d 1478, 1480 (TTAB 2007); *IdeasOne Inc. v. Nationwide Better Health Inc.,* 89 USPQ2d 1952, 1954 (TTAB 2009); *ProQuest Information and Learning Co. v. Island,* 83 USPQ2d 1351, 1353 (TTAB 2007); *Tea Board of India v. Republic of Tea Inc.,* 80 USPQ2d 1881, 1898

	(TTAB 2006); and *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1846 (TTAB 2008).
	New cases added to Note 6: *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1531 (TTAB 2008); *Jansen Enterprises Inc. v. Rind,* 85 USPQ2d 1104, 1114 (TTAB 2007); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n. 14 (TTAB 2007). *But see, Fishking Processors Inc. v. Fisher King Seafoods Ltd.,* 83 USPQ2d 1762 (TTAB 2007).
	New cases added to Note 7: *Herbaceuticals Inc. v. Xel Herbaceuticals Inc.*, 86 USPQ2d 1572, 1575 n.3 (TTAB 2008); and *Hornby v. TJX Companies Inc.*, 87 USPQ2d 1411, 1419 (TTAB 2008).
	New case added to Note 9: *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.*, 86 USPQ2d 1283, 1285 (TTAB 2008).
	Updated citation in Note 10 to *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313-14 (TTAB 1989).
	Added new Note 11, citing: *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 72 USPQ2d 1833 (2004).
	Added new Note 12, citing: *Truescents LLC v. Ride Skin Care LLC,* 81 USPQ2d 1334, 1338 (TTAB 2006); and *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1454 (TTAB 1986).
	In Notes 13, 16 and 18: Amended Fed. R. Civ. P. 8(e)(1) to reflect that it is now Fed. R. Civ. P. 8(d)(1).
	New cases added to Note 14*: IdeasOne Inc. v. Nationwide Better Health Inc.,* 89 USPQ2d 1952, 1953 (TTAB 2009); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Otto International Inc. v. Otto Kern GmbH,* 83 USPQ2d 1861, 1864 (TTAB 2007); and *Wet Seal Inc. v. FD Management Inc.,* 82

	USPQ2d 1629, 1634 (TTAB 2007).
	New cases added to Note 15: *In re Bose Corp*., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009); *Enbridge, Inc. v. Excelerate Energy Limited Partnership*, 92 USPQ2d 1537 (TTAB 2009); and *Asian and Western Classics B.V. v. Selkow,* 92 USPQ2d 1478 (TTAB 2009).
	New cases added to Note 20: *Nasalok Coating Corp. v. Nylok Corp.,* 522 F.3d 1320, 86 USPQ2d 1369, 1373 n.3 (Fed. Cir. 2008); *Textron, Inc. v. The Gillette Company*, 180 USPQ 152, 153 (TTAB 1973); and *Tea Board of India v. Republic of Tea Inc.,* 80 USPQ2d 1881, 1884 n.5 and 12 (TTAB 2006).
311.02(c) Unpleaded Affirmative Defenses	New cases added to Note 1: *H.D. Lee Co. v. Maidenform Inc.,* 87 USPQ2d 1715, 1720 (TTAB 2008); *Diaz v. Servicios De Franquicia Pardo's S.A.C.,* 83 USPQ2d 1320, 1322 (TTAB 2007); and *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1290 (TTAB 2007).
311.02(d) Other Affirmative Pleadings - Amplifying Denials	Added *Morgan Creek Productions Inc. v. Foria International Inc*., 91 USPQ2d 1134, 1136 (TTAB 2009) to Note 1.
311.03 Reply To Answer Should Not Be Filed	Amended quotation from Fed. R. Civ. P. 7(a) to reflect recent changes.
312 Default	Section Heading only.
312.01 In General	Amended, in first paragraph, from 20 days to 30 days defendant's allowed time to show cause why default judgment should not be entered against it; amended example where defendant need not submit answer with response to notice of default to reflect 2007 rules changes that require plaintiff to serve copies of complaint on defendant; and added information for reader regarding stay of parties' obligations to conference and to make initial disclosures where defendant is in default.
	Added new Note 5, citing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

	Added new Note 6, citing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42255 (August 1, 2007).
312.02 Setting Aside Notice Of Default	No substantive changes made.
312.03 Setting Aside Default Judgment	Amended section to indicate that motions seeking relief from judgment under either Fed. R. Civ. P. 55(c) or 60(b) are treated with liberality; updated references to Wright, Miller & Kane from 1998 to 2010; new cases added to Note 6: *CTRL Systems Inc. v. Ultraphonics of North America Inc.,* 52 USPQ2d 1300, 1303 (TTAB 1999); and *Smart Inventions Inc. v. TMB Products LLC,* 81 USPQ2d 1383, 1384 (TTAB 2006).
313 Counterclaims	Section Heading only.
313.01 In General	Amended section discussing counterclaims to partially cancel a registration by deleting some of the goods or services therein, by explaining that counterclaimant must allege avoidance of likelihood of confusion unless based on abandonment.
	New cases added to Note 1: *Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624, 1626 n.1 (TTAB 2007); *Drive Trademark Holdings LP v. Inofin* , 83 USPQ2d 1433, 1437 (TTAB 2007); *Chicago Bears Football Club, Inc. and NFL Properties LLC v. 12th Man/Tennessee LLC*, 83 USPQ2d 1073, 1083 (TTAB 2007); and *Tea Board of India v. Republic of Tea Inc.,* 80 USPQ2d 1881, 1884 n.5 and n.12 (TTAB 2006).
	Deleted from Note 1: "*Clorox Co. v. State Chemical Manufacturing Co.,* 197 USPQ 840 (TTAB 1977); and *Sealed Air Corp. v. Scott Paper Co.,* 190 USPQ 106 (TTAB 1975)."
	New cases added to Note 7: *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, 1271 n.3 (TTAB 1995).
	Added new Notes 8 and 9, citing*: Eurostar Inc. v. "Euro-Star" Reitmoden Gmbh & Co.*, 34 USPQ2d 1266, 1271 n.3 (TTAB 1995);

	Montecash LLC v. Anzar Enterprises, Inc., 95 USPQ2d 1060, 1063 (TTAB 2010); and *DAK Industries Inc. v. Daiichi Kosho Co.,* 35 USPQ2d 1434, 1437 (TTAB 1995).
313.02 Fee For Counterclaim	New case added to Note 1: *Fred Beverages, Inc. v. Fred's Capital Management Company*, 605 F.3d 968, 94 USPQ2d 1958 (Fed. Cir. 2010).
313.03 Form And Substance Of Counterclaim; Service Of Counterclaim	Amended to inform readers that counterclaimant must serve copies of its counterclaim on every other party to the proceeding; amended citation in Note 1 from 37 CFR § 2.112(a) to § 2.111(a).
	New cases cited in Note 3: *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1479 (TTAB 2007); and *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492 (TTAB 2005).
	Added parenthetical in Note 4 to citation of *UMC Industries, Inc. v. UMC Electronics Co.,* 207 USPQ 861, 862 n.3 (TTAB 1980).
313.04 Compulsory Counterclaims	Amended Note 1 to inform readers that Fed. R. Civ. P. 13(f) has been abrogated.
	New cases added to Note 3: *Zanella Ltd. v. Nordstrom Inc.*, 90 USPQ2d 1758 (TTAB 2008); and *Turbo Sportswear Inc. v. Marmot Mountain Ltd.*, 77 USPQ2d 1152, 1155 (TTAB 2005).
	Deleted from Note 3: "*Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff,* 81 Trademark Rep. 302 (1991)."
313.05 Permissive Counterclaims	Amended to indicate when counterclaim receives filing date.
313.06 Answer To Counterclaim	Amended discussion of required elements for counterclaim to include proof of service; changed TBMP § 310.01 to § 311.01 to correct typographical error.
314 Unpleaded Matters	Expanded discussion of 37 CFR § 2.107; added reference to TBMP § 315.
	New cases added to Note 1: *Syngenta Crop Protection Inc. v. Bio-Chek LLC,* 90 USPQ2d 1112, 1115 n.3 (TTAB 2009); *Hornby v. TJX Companies Inc.*, 87 USPQ2d 1411, 1415 (TTAB 2008); and *Kohler Co. v. Baldwin*

	Hardware Corp., 82 USPQ2d 1100, 1103 n.3 (TTAB 2007). Changed order of cases to list in descending date order.
	Deleted from Note 1: "*See also Reflange Inc. v. R-Con International,* 17 USPQ2d 1125, 1128 (TTAB 1990); *United States Shoe Corp. v. Kiddie Kobbler Ltd.,* 231 USPQ 815 (TTAB 1986); *Giant Food, Inc. v. Standard Terry Mills, Inc*., 229 USPQ 955 (TTAB 1986); *Alliance Manufacturing Co. v. ABH Diversified Products, Inc.*, 226 USPQ 348 (TTAB 1985); *Long John Silver's, Inc. v. Lou Scharf Inc.,* 213 USPQ 263 (TTAB 1982); *Standard Brands Inc. v. Peters,* 191 USPQ 168 (TTAB 1975); *Dap, Inc. v. Litton Industries, Inc.*, 185 USPQ 177 (TTAB 1975); and *CCI Corp. v. Continental Communications, Inc*., 184 USPQ 445 (TTAB 1974). *Cf. The Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720, 1723 (Fed. Cir. 2001) (unpleaded issue will not be addressed for the first time on appeal)."
	Deleted from Note 3: "See also *Trans Union Corp. v. Trans Leasing International, Inc.,* 200 USPQ 748 (TTAB 1978); *United States Mineral Products Co. v. GAF Corp.,* 197 USPQ 301 (TTAB 1977); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585 (TTAB 1977); *Hershey Foods Corp. v. Cerreta,* 195 USPQ 246 (TTAB 1977); and *Taffy's of Cleveland, Inc. v. Taffy's, Inc.,* 189 USPQ 154 (TTAB 1975)."
	New case added to Note 4: *Sportswear Inc. v. Marmot Mountain Ltd.,* 77 USPQ2d 1152, 1155 (TTAB 2005).
	Added new Note 5, citing: *American Express Marketing & Development Corp. v. Gilad Development Corp.,* 94 USPQ2d 1294, 1296 (TTAB 2010); and *Consolidated Foods Corporation v. Berkshire Handkerchief Co., Inc*., 229 USPQ 619, 621 (TTAB 1986).
	New cases added to Note 6: *American Express Marketing & Development Corp. v. Gilad Development Corp.,* 94 USPQ2d 1294, 1297 (TTAB 2010); *Karsten Manufacturing Corp. v. Editoy AG,* 79 USPQ2d 1783, 1785-

	1786 (TTAB 2006); *Societe des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.,* 10 USPQ2d 1241, 1242 n.4 (TTAB 1989); *Drive Trademark Holdings LP v. Inofin* , 83 USPQ2d 1433, 1437 (TTAB 2007); and *Wet Seal Inc. v. FD Management Inc.,* 82 USPQ2d 1629, 1634 (TTAB 2007).
	Added new Note 7, citing: *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009).
	Added new Note 8, citing: *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 Mfg. Co*., 77 USPQ2d 1220, 1223 n.6 (TTAB 2005); and *M & T Chemicals Inc. v. Stepan Chemical Co.*, 150 USPQ 570, 571 (TTAB 1966).
315 Amendment Of Pleadings	Amended to indicate that an additional claimed registration cannot be added to a previously stated Trademark Act § 2(d) ground and that once an opposition is filed it may not be amended to add to the goods or services subject to opposition; added new Note 3, citing: 37 CFR §§ 2.107(a) and (b); *Drive Trademark Holdings LP v. Inofin ,* 83 USPQ2d 1433, 1436 (TTAB 2007).
	Added cross-reference to Fed. R. Civ. P. 15 and TBMP § 507.
	New citation added to Note 1: Fed. R. Civ. P. 15(a). Deleted from Note 1: "*Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff,* 81 Trademark Rep. 302 (1991)."
	Updated references to Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act in Notes 2 and 4.
316 Motions Relating To Pleadings	No changes made.
317 Exhibits To Pleadings	Amended references to 37 CFR §§ 2.122(c) and (d) to reflect rules changes; amended first paragraph to indicate that there are two exceptions to rule that exhibits are not evidence; amended paragraph 3 to describe first exception; added new paragraph 4 to

	explain second exception. Included cross-references to TBMP §§ 704.03(b)(1)(A) and 704.05(a) and TMEP § 504.
	New case added to Note 1: *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1846 n.6 (TTAB 2004).
	Added new Note 2, citing: *Equine Touch Foundation Inc. v. Equinology Inc.*, 91 USPQ2d 1943, 1945 (TTAB 2009); and *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008).
	Added new Note 4, citing: *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 n.4 (TTAB 2008).
	Added new Note 5, citing: *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1046 (TTAB 2009); and *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1485 n.4 (TTAB 2007).
318 Fed. R. Civ. P. 11 Applicable	Amended reference to Fed. R. Civ. P. 11 to reflect recent changes.
319 Amendment To Allege Use; Statement Of Use	No changes.

INDEX TO CHANGES IN THIRD EDITION
CHAPTER 400

TBMP SECTION	NATURE OF CHANGE
401 Introduction To Disclosures And Discovery (new title)	Updated title from "In General" to "Introduction To Disclosures And Discovery."
	Added reference to 37 CFR § 2.120(a)(1).
	Amended first paragraph to note use of discovery may further parties' entry into stipulations or ACR determinations.
	Amended second paragraph to indicate that Federal Rules relating to automatic disclosures and discovery conferences do not apply to cases filed before November 1, 2007 but do apply in a modified form to cases commenced after such date; deleted listing of Federal Rules that do not apply to Board proceedings.
	Added new paragraph 3 to inform reader of parties' obligations to conduct discovery conference and to make disclosures; of the purpose such obligations are required; and of presumption that parties are following regime in absence of contrary statement filed with the Board.
	New case added to Note 1: *Eveready Battery Co., Inc. v. Green Planet, Inc.* 91 USPQ2d 1511, 1513 (TTAB 2009).
	Deleted reference to 37 CFR § 2.120(a) from Note 2 and added: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (August 1, 2007).
	Deleted previous Note 3, reading as follows: "See "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994). See also, for example, Harjo v. Pro-Football, Inc., 50 USPQ2d 1705, 1715 (TTAB 1999) (petitioners need not prepare list of trial witnesses and documents), rev'd on other grounds, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003)."
	Added new Note 3, citing: Miscellaneous Changes to Trademark Trial and Appeal Board

	Rules, 72 Fed. Reg. 42242, 42244-7 (August 1, 2007); 37 CFR § 2.120; Fed. R. Civ. P. 26(a)(1)(A); Fed. R. Civ. P. 26(a)(1)(B); Fed. R. Civ. P. 26(a)(3); Fed. R. Civ. P. 26(a)(2); Fed. R. Civ. P. 26(f).
	Deleted Note 4, reading as follows: "*Yamaha International Corp. v. Hoshino Gakki Co.,* 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) (USPTO rules governing procedure in inter partes proceedings are adapted from the Federal Rules with modifications appropriate to the administrative process)."
	Added new Notes 4 and 5, each citing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 and 42246 (August 1, 2007).
	Added new Note 6, citing: *See Boston Red Sox Baseball Club LP v. Chaveriat,* 87 USPQ2d 1767-8 (TTAB 2008)
401.01 Discovery Conferences (new section)	This is a new section, referencing 37 CFR §§ 2.120(a)(1) and (2) and Fed. R. Civ. P. 26(f)(2), describing procedures for conducting discovery conferences; topics to be discussed; and timing of conference; and citing, in the Notes, to the Miscellaneous Changes to Trademark Trial and Appeal Board Rules of August 1, 2007; *Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (TTAB 2009) and *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, n.1 (TTAB 2008).
401.02 Initial Disclosures (new section)	This is a new section, referencing 37 CFR §§ 2.120(a)(2) and (3) and Fed. R. Civ. P. 26(a)(1); describing parties' mutual obligation to make initial disclosures; procedures for making disclosures; information to include in disclosures; and treatment of disclosures during trial; and citing, in the Notes, to 37 CFR § 2.210, Fed. R. Civ. P. 26; Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (August 1, 2007); and the following cases: *Amazon Technologies, Inc. v. Jeffrey S. Max,* 93 USPQ2d 1702 (TTAB 2009); *Influance Inc. v. Zuker,* 88 USPQ2d 1859, 1861 (TTAB 2008); *Jules Jurgensen/Rhapsody Inc. v. Baumberger,* 91 USPQ2d 1443, 1444 n.1

	(TTAB 2009); by comparison, *Byer California v. Clothing for Modern Times Ltd.,* 95 USPQ2d 1175 (TTAB 2010); and *Qualcomm, Inc. v. FLO Corp.,* 93 USPQ2d 1768, 1769-70 (TTAB 2010).
401.03 Expert Disclosures (new section)	This is a new section, referencing 37 CFR § 2.120(a)(2) and Fed. R. Civ. P. 26(a)(2); describing procedures and substance for expert disclosures; and citing, in the Notes, 37 CFR § 2.120(a); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (August 1, 2007); and *Jules Jurgenson/Rhapsody, Inc. v. Peter Baumberger,* 91 USPQ2d 1443 (TTAB 2009).
401.04 Modification Of Disclosure Obligations (new section)	This is a new section, referencing 37 CFR § 2.120(a)(2); describing procedures for modifying disclosure deadlines and obligations; when obligations will be stayed; and enforcement thereof; and citing, in the Notes, 37 CFR § 2.120; the Miscellaneous Changes to Trademark Trial and Appeal Board Rules of August 1, 2007; *Boston Red Sox Baseball Club LP v. Chaveriat,* 87 USPQ2d 1767-8 (TTAB 2008); *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1760 n.2 (TTAB 2009); and *Influance Inc. v. Zuker,* 88 USPQ2d 1859 (TTAB 2008).
401.05 Form Of Disclosures (new section)	This is a new section, referencing Fed. R. Civ. P. 26(a)(4); and (g)(1); describing formatting disclosures and signature requirements; and citing, in the Notes, Fed. R. Civ. P. 26 and *Influance Inc. v. Zuker,* 88 USPQ2d 1859, 1861 (TTAB 2008).
401.06 Other Requirements Under The Board's Disclosure Regime (new section)	This is a new section, informing the reader that service of initial disclosures is prerequisite to service of discovery of filing of motion for summary judgment or to compel; cross-referencing TBMP sections where reader may obtain further information on other requirements under disclosure regime; and citing, in the Notes, 37 CFR §§ 2.120 and 2.127, Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244-7 (August 1, 2007); *Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (TTAB 2009); *Qualcomm, Inc. v. FLO Corp.,* 93 USPQ2d 1768, 1769-70 (TTAB 2010);

	Compagnie Gervais Danone v. Precision Formulations LLC, 89 USPQ2d 1251, 1255-56 (TTAB 2009); *Boston Red Sox Baseball Club LP v. Chaveriat,* 87 USPQ2d 1767-8 (TTAB 2008); and *Dating DNA, LLC v. Imagini Holdings, LLC,* 94 USPQ2d 1889 (TTAB 2010).
402 Scope Of Discovery	Section Heading only.
402.01 In General	Added references to Fed. R. Civ. P. 26(b)(1) and 26(g); amended paragraph 2 to warn parties not to engage in fishing expedition and that guidelines for discovery apply to discovery in electronic form.
	Amended paragraph 3 to remind parties they are free to agree to limit scope of discovery.
	Added parenthetical to *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) in Note 1; to *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974) in Note 2 and to *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) in Note 7.
	Added new Note 5, citing 37 § CFR 2.120(a)(2).
	Amended parenthetical to *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) in Note 8.
402.02 Limitations On Right To Discovery And On Electronically Stored Information	Updated Heading; added reference to Fed. R. Civ. P. 26(b)(2)(A) and (B).
	Amended paragraph 4 to indicate that discovery of confidential information is subject to terms of Board's standard protective order; and added new paragraph 7 regarding discovery of electronically-stored information.
	Amended Note 4 to advise reader of application of Board's standard protective order.
	Added new cases to Note 5: *In re Seagate Technology LLC,* 497 F.3d 1360, 83 USPQ2d 1865, 1873 (Fed. Cir. 2007); and *Genentech Inc. v. U.S. International Trade Commission,* 122 F.3d 1409, 43 USPQ2d 1722, 1728 (Fed. Cir. 1997).
	Added new case to Note 6: *In re Seagate*

	Technology LLC, 497 F.3d 1360, 83 USPQ2d 1865, 1874 (Fed. Cir. 2007)
	Added new Notes 7-9, citing: Fed. R. Civ. P. 26(b)(2)(B); added new Note 10, citing: Fed. R. Civ. P. 26(b)(2)(B) and (C).
403 Timing Of Discovery	Section Heading only.
403.01 In General	Amended references to 37 CFR § 2.120(a).
	Amended first paragraph to include information on opening of discovery for cases commenced on or after November 1, 2007; added new second paragraph to inform reader of available modifications to discovery and trial obligations and scheduling. Also added information regarding obligation of party served with discovery prior to service of initial disclosures.
	Added reference to Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (August 1, 2007) in Note 2.
	Added new Notes 3 and 4, citing: 37 CFR § 2.120(a)(2) and *Boston Red Sox Baseball Club LP v. Chaveriat,* 87 USPQ2d 1767-8 (TTAB 2008).
	Added new Note 5, citing: 37 CFR § 2.120(a)(2) and *H.D. Lee Co. v. Maidenform, Inc.,* 87 USPQ2d 1715, 1720 n.55 (TTAB 2008).
	Added new Note 7, citing: *Dating DNA, LLC v. Imagini Holdings, LLC,* 94 USPQ2d 1889 (TTAB 2010); and *Amazon Technologies v. Wax,* 93 USPQ2d 1702 (TTAB 2009).
403.02 Time For Service Of Discovery Requests And Taking Of Depositions (new title)	Amended by deleting statement that discovery may be served from the day the discovery period opens, added explanation that discovery may not be served until after initial disclosures are served
	Added reference to 37 CFR § 2.120(a)(3) in Note 1; added new case to Note 1: *Dating DNA, LLC v. Imagini Holdings, LLC,* 94 USPQ2d 1889 (TTAB 2010); and noted that cases cited in Note 1 from earlier version of manual commenced prior to November 1, 2007.
	Added new Note 2, citing: 37 CFR § 2.120(a)(3).
	Added new case to Note 3: *National Football League v. DNH Management LLC,* 85 USPQ2d

	1852 (TTAB 2008).
403.03 Time For Service Of Discovery Responses	Updated reference of 37 CFR § 2.120 from 37 CFR § 2.120(a) to 37 CFR § 2.120(a)(3) and amended reference to conform to rules changes.
	Amended first paragraph to inform reader that 5-day grace period does not apply to service by facsimile or e-mail; and deleted statement that timely responses to discovery may be served after close thereof without forfeit of right to object from first paragraph; added new paragraph 3 addressing party's right to object to discovery served late in the discovery period.
	Amended second paragraph to explain sequence of discovery and to encourage early initiation of discovery.
	Amended paragraph 4 to clarify that motion to compel applies to failure to respond to interrogatories or document requests, and refers reader to TBMP § 407 for further information regarding requests for admissions.
	Added new cases to Note 1: *Amazon Technologies v. Wax,* 93 USPQ2d 1702, 1705 (TTAB 2009); and *MySpace Inc. v. Donnell Mitchell,* 91 USPQ2d 1060, 1061 n.2 (TTAB 2009).
	Added new Note 5, citing: *Dating DNA, LLC v. Imagini Holdings, Ltd.*, 94 USPQ2d 1889 (TTAB 2010) and *H.D. Lee Co. v. Maidenform, Inc.,* 87 USPQ2d 1715, 1720 n.13 (TTAB 2008).
	Added new Note 7, citing: *Giersch v. Scripps Networks, Inc.,* 85 USPQ2d 1306 (TTAB 2007); and *Hobie Designs, Inc. v. Fred Hayman Beverly Hills, Inc.,* 14 USPQ2d 2064 (TTAB 1990).
403.04 Extensions Of Discovery Period, Time To Respond To Discovery Requests And Disclosures (new title)	Updated title from prior title: "Extensions Of Discovery Period, And/Or Time To Respond To Discovery Requests"
	Updated reference to 37 CFR § 2.120(a) to include (a)(2) and (a)(3).
	Amended references to 37 CFR §§ 2.121(a) and (d) to conform to rules changes.

	Amended first paragraph to include information about resetting dates upon extension of discovery period.
	Amended paragraph 2 to include statement that where party waits to serve discovery near the end of the period, good cause may not be found.
	Amended paragraph 4 to clarify that extension of party's time to respond to discovery request does not automatically result in extension of deadlines for disclosures, discovery, or trial.
	Amended paragraph 5 to provide example of when a stipulation to extend party's time to respond to discovery should be filed with Board.
	Added new paragraph 6 to explain difference in procedure between request to extend time to make initial disclosures and request to extend time to make expert disclosures.
	Added new paragraph 7 cross-referencing TBMP § 401.04.
	Added new case to Note 3: *National Football League v. DNH Management LLC,* 85 USPQ2d 1852 (TTAB 2008); and deleted "Janet E. Rice, *TIPS FROM THE TTAB: The Timing of Discovery*, 68 Trademark Rep. 581 (1978)" from Note 3.
	Added new Note 7, referencing: Fed. R. Civ. P. 29(b); and citing *Boston Red Sox Baseball Club LP v. Chaveriat,* 87 USPQ2d 1767, n.2 (TTAB 2008).
403.05 Need For Early Initiation Of Discovery	Section Heading only.
403.05(a) To Allow Time for "Follow-up" Discovery	No substantive changes.
403.05(b) To Facilitate Introduction of Produced Documents	Updated reference to 37 CFR § 2.120(j)(3)(ii) to reflect rules changes.
	Amended first paragraph to inform reader that most straightforward way to introduce documents by notice of reliance that are not otherwise eligible is by stipulation of the parties; amended second paragraph to inform reader that party may request admission of genuineness of documents produced through disclosures as well as through a request for

	production of documents.
	Added new Note 1, citing: *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (TTAB 2007); and *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100 (TTAB 2007).
404 Discovery Depositions	Section Heading only.
404.01 When Permitted And By Whom (new title)	Updated section title from "When and By Whom Taken"
	Added new second paragraph, explaining that parties should schedule depositions by agreement to avoid conflicts.
	Added new case to Note 1: *National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008).
	Added new Note 2, citing: *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007); and *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 (TTAB 1987).
404.02 Who May Be Deposed	Updated reference to Fed. R. Civ. P. 30(a); clarified that limit of ten depositions refers to discovery depositions; and added new paragraph regarding deposition of nonparty witness.
404.03 Place Of Deposition; Oral Or Written Deposition; Securing Attendance Of Deponent	Section Heading only.
404.03(a) Person Residing in the United States – In General	Deleted reference to Fed. R. Civ. P. 26(a)(5) from Note 2.
404.03(a)(1) Person Residing in United States – Party	Amended first paragraph to add comment that proposed deponent who fails to appear for a noticed deposition may be subject to motion to compel.
	Deleted "Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296-297 (1985)" from Note 1.
404.03(a)(2) Person Residing in United States – Nonparty	Amended third paragraph to clarify that Board has no jurisdiction to enforce subpoena.
	Added new references to Fed. R. Civ. P. 30(a)(1) and Fed. R. Civ. P. 45 in Note 2; and deleted "Saul Lefkowitz and Janet E. Rice,

	*Adversary Proceedings Before the Trademark Trial and Appeal Boa*rd, 75 Trademark Rep. 323, 383-384 (1985); Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985)" from Note 2.
	Deleted "Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 383-384 (1985); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985)" from Note 4.
404.03(b) Person Residing in a Foreign Country – Party	Amended first paragraph to advise reader to consult with foreign local counsel or the Department of State to determine procedure for taking deposition in foreign country; amended third paragraph to cross-reference reader to TBMP § 703.01(g) for information on letter rogatory procedure under Hague convention.
	Added new paragraph 3 regarding discovery deposition of natural person in foreign country.
	Deleted from Note 1: "the testimony deposition of an adverse party, unless obtained voluntarily, may be taken in a foreign country, if at all, only by the letter rogatory procedure or by procedures provided under the Hague Convention or other applicable treaties."
	Deleted from Note 2: "*Fischer Gesellschaft m.b.H. v. Molnar and Company, Inc*., 203 USPQ 861, 866 (TTAB 1979) (by motion);" and "Saul Lefkowitz and Janet E. Rice*, Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 384 (1985); Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985); and Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules, 74 Trademark Rep*. 449 (1984)."
	Added, by comparison, *Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises, Ltd,* 511 F.3d 437, 85 USPQ2d 1385 (4th Cir. 2007) to Note 3, and deleted "Louise E. Fruge, *TIPS*

	FROM THE TTAB: Depositions Upon Written Questions, 70 Trademark Rep. 253 (1980); and *Jonergin Co. Inc. v. Jonergin Vermont Inc.*, 222 USPQ 337, 340 (Comm'r 1983)" from Note 3.
	Added new Note 4, citing, by comparison: *Societe Internationale Pour Participations Industrielles et Commerciales, S.A. v. Rogers,* 357 U.S. 197 (1958).
	Added new Note 5, citing, by comparison: *Cochran Consulting Inc. v. Uwatec USA Inc.,* 102 F.3d 1224, 41 USPQ2d 1161 (Fed. Cir. 1996).
404.03(c) Person Residing in a Foreign Country – Nonparty	Section Heading only.
404.03(c)(1) Willing Nonparty	Added information regarding protocol in foreign countries for taking depositions and to advise reader to consult with foreign local counsel or the Department of State to determine procedure for taking deposition in foreign country.
404.03(c)(2) Unwilling Nonparty -- The Hague Convention and Letter Rogatory Procedure (new title)	Added reference to 28 U.S.C. 1781; added citation from Black's Law Dictionary to define "letter rogatory" or "letter of request"; added address for U.S. Department of State's web site.
	Amended paragraph 9 to inform reader that letter rogatory is facilitated by any information requesting party is able to provide to the Board.
	Deleted from Note 1: "See, in general, Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985)."
	Deleted Note 6, citing: Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296, 299 (1985), and deleted reference to same from Note 8.
404.03(d) Foreign Person Present Within the United States – Party	Deleted Note 1, citing: Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323 (1985); Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985); and

	Janet E. Rice, *TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules*, 74 Trademark Rep. 449 (1984).
404.03(e) Foreign Person Present Within the United States – Nonparty	No changes.
404.04 Persons Before Whom Depositions May Be Taken	Updated references to Fed. R. Civ. P. 28 to reflect changes.
404.05 Notice Of Deposition	Updated references to Fed. R. Civ. P. 30 to reflect changes.
	Amended second paragraph to clarify that whether notice is reasonable is evaluated on a case-by-case basis and that the closing of a party's discovery period does not excuse failure to provide due notice.
	Amended paragraph 3 to provide additional information regarding production of documents at a deposition.
	Added new case to Note 2: *Gaudreau v. American Promotional Events Inc*., 82 USPQ2d 1692, 1696 (TTAB 2007).
	Added new Note 4, citing: *Gaudreau v. American Promotional Events Inc*., 82 USPQ2d 1692, 1696 (TTAB 2007).
	Added new Note 5, citing: Fed. R. Civ. P. 30(b)(2).
	Added new Note 6, citing: Fed. R. Civ. P. 30(b), Advisory Committee's notes, (1970 amendment).
	Added new Note 7, citing: Fed. R. Civ. P. 34(b)(2)(A).
	Added new Note 8, citing: *National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008).
	Deleted "*See* Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 383 (1985)" from Note 9.
404.06 Taking A Discovery Deposition	Added reference to Fed. R. Civ. P. 30(b)(4); amended paragraph 3 to inform reader that deposition may be taken by other remote means such as video conferencing, and that any deposition taken by video must be transcribed to be submitted as evidence.
	Amended Note 2 to update reference to Fed.

	R. Civ. P. 30(b)(4); and to add citation to *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007).
404.06(a) Fed. R. Civ. P. 30(b)(1) Deposition of a Natural Person (new section)	This is a new section, referencing Fed. R. Civ. P. 30(b)(1) and describing the difference between depositions taken of a natural person in individual capacity and as corporate representative.
	Added new Note 1, citing: 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE: Civil 3d § 2103 (2009).
	Added new Note 2, referencing: Fed. R. Civ. P. 30(b)(6) and citing: *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672 (TTAB 2005).
404.06(b) Fed. R. Civ. P. 30(b)(6) Deposition of a Corporation, Organization, Partnership, Association or Other Juristic Person (new section)	This is a new section, referencing Fed. R. Civ. P. 30(b)(6) and describing depositions taken of corporate representatives, including compelling attendance at deposition and available sanctions for failure to attend or answer questions on behalf of organization.
	Added new Note 1, citing: 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE: Civil 3d § 2103 (2009)**.**
	Added new Note 2, citing: Fed. R. Civ. P. 30(b)(6); 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE: Civil 3d § 2103 (2009)**.**
	Added new Note 3, citing: Fed. R. Civ. P. 30(b)(6).
	Added new Note 4, citing: *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2049 n.5 (TTAB 1988); and *Mattel Inc. v. Walking Mountain Productions*, 353 F3d 792, 69 USPQ2d 1257, 1260 n.4 (9th Cir. 2003).
	Added new Note 5, citing: *A&E Products Group L.P. v. Mainetti USA Inc.*, 70 USPQ2d 1080, 1086 (S.D.N.Y. 2004).
	Added new Note 6, citing: *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1605 (TTAB 2002).
	Added new Note 7, citing: *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1605 (TTAB 2002).
	Added new Note 8, citing: Fed. R. Civ. P. 30(b)(6).

	Added new Note 9, citing: *United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc.*, 50 USPQ2d 1060, 1062 (E.D. Mich. 1998).
	Added new Note 10, citing: *United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc.*, 50 USPQ2d 1060, 1062 (E.D. Mich. 1998); and *Tulip Computers International B.V. v. Dell Computer Corp.*, 63 USPQ2d 1527 (D. Del. 2002).
	Added new Note 11, referencing: 37 CFR § 2.120(e); and citing: *United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc.*, 50 USPQ2d 1060 (E.D. Mich. 1998); and *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293 (TTAB 1997).
	Added new Note 12, citing: 37 CFR § 2.120(g).
	Added new Note 13, citing: *United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc.*, 50 USPQ2d 1060, 1061 (E.D. Mich. 1998).
	Added new Note 14, citing: Fed. R. Civ. P. 30(b)(6) Advisory Committee's notes, (1993 amendment).
	Added new Note 15, citing: Fed. R. Civ. P. 30(d) Advisory Committee's notes, (2000 amendment).
	Added new Note 16, citing: *Foster-Miller Inc. v. Babcock & Wilcox Canada*, 210 F.3d 1, 54 USPQ2d 1193 (1st Cir. 2000).
404.06(c) Time for Deposition (new section)	This is a new section, referencing Fed. R. Civ. P. 30(d)(1) and describing presumptive time of 1 day, 7 hours for deposition and exceptions.
	Added new Notes 1-8, referencing: Fed. R. Civ. P. 30(d) Advisory Committee's notes, (2000 amendment).
	Also cited *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672 (TTAB 2005) in Note 8.
404.06(d) Re-Deposing Witness (new section)	This is a new section, referencing Fed. R. Civ. P. 30(a)(2)(A) and describing circumstances under which more than one deposition may be taken of a witness.
	Added new Notes 1 and 2, referencing: Fed. R. Civ. P. 30(a)(2)(A)(ii).

	Added new Note 3, referencing: Fed. R. Civ. P. 26(b)(2)(C)(i)-(iii) and citing: *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597 (TTAB 2002).
	Added new Note 4, referencing: Fed. R. Civ. P. 30(a)(2)(A)(ii) Advisory Committee's notes, (1993 amendment); and citing, by comparison, *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672 (TTAB 2005).
	Added new Note 5, referencing: Fed. R. Civ. P. 30(a)(2)(A)(ii) Advisory Committee's notes, (1993 amendment).
404.07 Discovery Depositions On Written Questions	No changes.
404.07(a) Depositions on Written Questions: Before Whom Taken	No substantive changes.
404.07(b) Depositions on Written Questions: When Taken	Updated reference to 37 CFR § 2.120(a)(3) to reflect rules changes
	Added text to inform reader that Board has discretion to suspend other discovery activities pending taking of deposition on written questions.
404.07(c) Depositions on Written Questions: Place of Deposition	No changes.
404.07(d) Depositions on Written Questions: Notice of Deposition	No substantive changes. Added new Note 3, citing: 37 CFR § 2.124(d)(1).
404.07(e) Depositions on Written Questions: Examination of Witness	No changes.
404.07(f) Depositions on Written Questions: Objections	Amended second paragraph to advise reader that objections may be considered waived if not maintained in a brief at final hearing and that Board should be apprised by objecting party of any objections that are resolved prior to final decision.
404.07(g) Depositions on Written Questions: Form of Deposition; Signature	No changes.
404.07(h) Depositions on Written Questions:	No substantive changes.

Certification of Deposition	
404.07(i) Depositions on Written Questions: Service, Correction, and Making the Deposition of Record	No substantive changes.
404.07(j) Deposition on Written Questions: Utility	Deleted "Louise E. Fruge, *TIPS FROM THE TTAB: Depositions Upon Written Questions*, 70 Trademark Rep. 253, 253 (1980)" and "Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 397 (1985)" from Note 1.
404.08 Discovery Deposition Objections	Added text to this section heading to explain types of objections that may be made to the taking of a discovery deposition. Added new Notes 1 and 2, citing: Fed. R. Civ. P. 30 and 32.
404.08(a) Objections to Notice	Added new case to Note 1 (by comparison): *Sunrider Corp. v. Raats*, 83 USPQ2d 1648 (TTAB 2007).
404.08(b) Objections as to Disqualification of Officer	No changes made.
404.08(c) Objections During Deposition	Added reference to Fed. R. Civ. P. 30(c)(2) and amended references to Fed. R. Civ. P. 32 to reflect rules changes.
	Amended fourth paragraph to clarify that objections should be limited to those permitted under Fed. R. Civ. P. 32(d)(3) and should be made concisely in a nonargumentative manner. Further amended paragraph to indicate that witness need not reveal any information subject to Board's standard protective order.
	Added new Note 3, citing: Fed. R. Civ. P. 30(c)(2).; added new Note 4, citing: Fed. R. Civ. P. 30(d) and Fed. R. Civ. P. 30(d) Advisory Committee's notes (1993 amendment).
	Added new reference to Note 5: 37 CFR § 2.116(g); Updated reference to "C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2213 (2009)" from "C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 2d § 2213 (2d ed. 1994)" in Note 5.
	Added new cases to Note 6 (by comparison):

	Wet Seal Inc. v. FD Management Inc., 82 USPQ2d 1629 (TTAB 2007); and *Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741 (TTAB 2006).
	Amended parenthetical to *Neville Chemical Co. v. Lubrizol Corp*., 183 USPQ 184, 189 (TTAB 1974) in Note 7.
404.09 Discovery Depositions Compared To Testimony Depositions	Amended paragraph 4 to clarify that party taking deposition under subpoena from federal district court may obtain immediate ruling from court as to propriety of question posed; and that witness need not reveal any information subject to Board's standard protective order.
	Amended reference in Note 1 from "Fed. R. Civ. P. 26(a)" to Fed. R. Civ. P. 30; added new reference to Fed. R. Civ. P. 31 in Note 1.
	Added new case to Note 2: *Bison Corporation v. Perfecta Chemie B.V*., 4 USPQ2d 1718 (TTAB 1987).
	Updated reference in Note 4 from "37 CFR § 2.121(a)(1)" to 37 CFR § 2.121(a).
	Updated reference in Note 7 from "Fed. R. Civ. P. 37 (a)(2)(B)" to Fed. R. Civ. P. 37 (a)(3)(B); and updated reference to "C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2213 (2009)" from "C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 2d § 2213 (2d ed. 1994)".
	Deleted from Note 8: "*See also S. Rudofker's Sons, Inc. v. "42" Products, Ltd*., 161 USPQ 499 (TTAB 1969); and *Bordenkircher v. Solis Entrialgo y Cia*, S. A., 100 USPQ 268, 276-278 (Comm'r 1953)."
	Added new cases to Note 12: *Galaxy Metal Gear Inc. v. Direct Access Technology Inc*., 91 USPQ2d 1859 (TTAB 2009); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc*., 89 USPQ2d 1844, 1847 n.5 (TTAB 2008); *Parfums de Coeur Ltd. v. Lazarus,* 83 USPQ2d 1012 (TTAB 2007); and, in contradiction, *Maids to Order of Ohio Inc. v. Maid-to-Order Inc*., 78 USPQ2d 1899 (TTAB 2006).
	Deleted from Notes 13 and 15: Gary Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).

405 Interrogatories	Section Heading only.
405.01 When Permitted And By Whom (new title)	Changed title from "When and By Whom Served"
	Added text to inform reader that interrogatories may only be served after or together with service of initial disclosures; that answers may be served after the close of discovery; and that interrogatories may not be served on a nonparty.
	Added new Note 1, citing: 37 CFR § 2.120(a)(3); and added new Note 2, citing: Fed. R. Civ. P. 33 and 37 CFR § 120(d)(1).
405.02 Scope	Added reference to Fed. R. Civ. P. 33(a)(2) to Note 2; and deleted Fed. R. Civ. P. 33(b) from Note 2.
405.03 Limit On Number	Section Heading only.
405.03(a) Description of Limit	Amended reference to 37 CFR § 2.120(d)(1) to reflect rules changes; added text to inform reader that parties may stipulate to reduce number of interrogatories; and added new Note 1, citing: *Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co.*, 16 USPQ2d 1466, 1467 n.5 (TTAB 1990).
405.03(b) Application of Limit: Sets of Interrogatories	Deleted "Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990)" from Note 1.
405.03(c) Application of Limit: Multiple Marks, Etc.	Deleted "Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990)" from Note 1.
405.03(d) Application of Limit: Counting Interrogatories	Corrected "state of facts" to "set of facts" in second paragraph; amended paragraph 3 to include that Board will count combined questions as a separate interrogatory; deleted "Carla Calcagno, *TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 Trademark Rep. 285 (1990)" from Notes 1-8; added new case to Note 6: *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); updated reference to Notice of Final Rulemaking, 54 Fed. Reg. 34,886 (August 22, 1989) in Note 7.
405.03(e) Remedy for Excessive Interrogatories	Amended paragraph 3 to clarify that when Board allows party opportunity to serve revised

	set of interrogatories, they are usually unrestricted in scope.
	Deleted final paragraph from this section, reading: "[Please Note: Although some of the cases cited in this TBMP section were decided under an earlier version of 37 CFR § 2.120(d)(1) governing the procedure for objecting to interrogatories on the basis of their excessive number, the decisions are otherwise applicable to the issues which may arise under Rule 2.120(d)(1)]."
	Added new case to Note 1, by comparison: *Amazon Technologies v. Wax,* 93 USPQ2d 1702, 1705 (TTAB 2009).
	Deleted "Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, 82 Trademark Rep. 89 (1992)" from Notes 1, 3, 4, and 5; deleted Notes 7 and 8, citing to the article.
405.04 Responses To Interrogatories	Section heading only.
405.04(a) Time for Service of Responses	Amended first paragraph to add that where service is by electronic means, five extra days are not added to time for responding to interrogatories.
	Amended second paragraph to add explanation that objections based on confidentiality are expected to be rare.
	Added new Note 2, citing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42250 (August 1, 2007).
	Added new Note 6, citing: 37 CFR § 2.116(g).
405.04(b) Nature of Responses	Added references to Fed. R. Civ. P. 33(b)(3); 33(b)(4); and 33(d).
	Amended third paragraph to inform reader regarding option to produce electronic information under Fed. R. Civ. P. 33(d), and its limitations.
	Amended reference to Fed. R. Civ. P. 33 from "33(b)" to "33(b)(2) in Note 1.
	Deleted Note 3, citing: G. Douglas Hohein, *TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163 (1981).

	Added new case to Note 3: *Johnson & Johnson v. Obschestvo s ogranitchennoy; otvetstvennostiu "WDS,"* 95 USPQ2d 1567 (TTAB 2010).
	Added new Notes 4 and 5, citing: Fed. R. Civ. P. 33 Advisory Committee's notes, (2006 Amendment, Rule 33(d)).
	Updated reference to "8B C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE: Civil 3d § 2178 (2009)" from "8B C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE: Civil 2d § 2178 (1994)" in Note 6.
405.04(c) Signature of Responses and Authority of Signer (new title)	Added "and Authority of Signer" to end of title of this section.
	Added references to Fed. R. Civ. P. 33(b)(1) and 33(b)(5).
	Amended paragraphs 1 and 2 to include reference to "partner" as eligible signatory of interrogatories; and changed "answers" to "responses" in paragraph 4.
	Deleted "Fed. R. Civ. P. 33(a)" from Note 1; and amended "Fed. R. Civ. P. 33(b)(2)" to "Fed. R. Civ. P. 33(b)(5)" in Note 4.
406 Requests For Production Of Documents And Things And Electronically Stored Information (new title)	Section Heading only. Amended title to add "and Electronically Stored Information."
406.01 When Permitted And By Whom (new title)	Updated title from "When and By Whom Served"
	Amended first paragraph to inform reader that discovery may only be served before or concurrently with, initial disclosures in proceedings commenced on or before November 1, 2007.
	Amended paragraph 2 to add that document requests may not be served on non-party.
	Added new third paragraph setting forth criteria for determining when Board may impose sanctions for non-compliance with discovery request on natural person residing in foreign country.
	Added new Note 4, citing: *Societe*

	Internationale Pour Participations Industrielles et Commerciales, S.A. v. Rogers, 357 U.S. 197 (1958).
	Added new Note 5, citing: *Cochran Consulting Inc. v. Uwatec USA Inc.,* 102 F3d 1224, 41 USPQ2d 1161 (Fed. Cir. 1996).
406.02 Scope	Amended references to Fed. R. Civ. P. 34(a)(1)(A) and (B) and 34(a)(2) to reflect rules changes.
	Amended second paragraph to admonish reader that party may not state it will produce documents and then claim it does not possess them; and to indicate that party is not under obligation to create or prepare documents that do not already exist.
	Added new Note 2, citing: *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1679 (TTAB 2005).
	Added new Note 3, citing: 8B C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2210 (2009).
406.03 Elements Of Request For Production (new title)	Updated title from "Elements Of Request For Production; Place Of Production."
	Amended reference to Fed. R. Civ. P. 34(b) to reflect rules changes.
	Amended text to add discussion of data formatting of production of electronically stored information.
	Added new Note 1, citing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 and 42252 (August 1, 2007); 37 CFR § 2.120(a)(2); and Fed. R. Civ. P. 26(f).
406.04 Responses To Requests For Production	Added reference to Fed. R. Civ. P. 34(b)(2)(A)-(E). Added text discussing production of electronically stored information. Added new Note 1, citing: Fed. R. Civ. P. 34(b)(2)(e); and *Amazon v. Wax,* 95 USPQ2d 1865, 1869 (TTAB 2010).
406.04(a) Time for Service of Responses	Added references to Fed. R. Civ. P. 34(b)(2)(A) and 37 CFR § 2.120(a)(3).
	Amended first paragraph to indicate that date for responding to document requests may be amended by stipulation of parties or by Board order; and that additional five days for

	response does not apply to electronic service of discovery requests.
	Added new Note 3, citing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42250 (August 1, 2007).
406.04(b) Place and Form of Production (new section)	This is a new section, referencing 37 CFR § 2.120(d)(2) and Fed. R. Civ. P. 34(b)(2)(E) and describing procedures for determining place of production of requested documents and things, including electronically stored information.
	Added new Note 1, citing: *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1777 (TTAB 1998); *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013, 1015 (TTAB 1983); and *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 195 (TTAB 1976).
	Added new Note 2, citing: *No Fear Inc. v. Rule*, 54 USPQ2d 1551 (TTAB 2000).
	Added new Note 3, referencing: Fed. R. Civ. P. 34(b)(2)(i).
	Added new Note 4, citing: *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000); and *Electronic Industries Association v. Potega*, 50 USPQ2d 1775 (TTAB 1998).
	Added new Note 5, citing: *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.)
	Added new Note 6, citing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 and 42252 (August 1, 2007); 37 CFR § 2.120(a)(2); and Fed. R. Civ. P. 26(f).
	Added new Note 7, referencing: Fed. R. Civ. P. 34(b)(2)(E)(ii); and Fed. R. Civ. P. 34 Advisory Committee's notes, 2006 Amendment (Rule 34, Subdivision (b)).
	Added new Note 8, referencing: Fed. R. Civ. P. 34 Advisory Committee's notes, 2006 Amendment (Rule 34, Subdivision (b)).
	Added new Note 9, referencing: Fed. R. Civ. P. 34 Advisory Committee's notes, 2006

	Amendment (Rule 34, Subdivision (b)).
	Added new Note 10, referencing: Fed. R. Civ. P. 34(b)(2)(E)(iii).
	Added new Note 11, citing: *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000); and *Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013 (TTAB 1983); and, by comparison, *Electronic Industries Association v. Potega*, 50 USPQ2d 1775 (TTAB 1998); deleted from Note 11: Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 385 (1985)
406.04(c) Nature of Responses (new title)	Updated section numbering from 406.04(b) to 406.04(c).
	Added references to Fed. R. Civ. P. 34(b)(2)(B)-(D).
	Amended first paragraph to elaborate on how to respond to requests for production of documents, including electronically stored information.
	Updated reference to Fed. R. Civ. P. 34(b) in Note 1, and moved citation of *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) from Note 1 to new Note 2.
	Added new Note 3, citing: *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1679 (TTAB 2005).
	Added new Note 4, citing: Fed. R. Civ. P. 34(b)(2)(D).
	Updated reference to "C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2213 (2009)" from "C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 2d § 2213 (2d ed. 1994)" in Note 5.
	Added new Note 6, referencing: Fed. R. Civ. P. 26(f)(3)(c); and Fed. R. Civ. P. 34 Advisory Committee's note, (2006 Amendment Rule 34, Subdivision (b)).
	Added new Note 7, referencing: Fed. R. Civ. P. 34(b)(2)(E)(ii).
407 Requests For Admissions	Section Heading only.
407.01 When Permitted And By Whom (new title)`	Updated title of this section from "When and By Whom Served".

	Amended text to inform reader that for cases commenced on or after November 1, 2007, initial disclosures must be served before or concurrently with requests for admissions.
	Added new Note 1, referencing: Fed. R. Civ. P. 36(a); and 37 CFR § 2.120(a).
407.02 Scope And Nature Of Requests For Admission	Updated reference to Fed. R. Civ. P. 36(a) to reflect rules changes.
	Deleted reference to "Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 385 (1985)" from Note 1 and added citation to *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (TTAB 2007); and *Kohler Co. v. Baldwin Hardware Corp*., 82 USPQ2d 1100 (TTAB 2007) in Note 1.
407.03 Responses To Requests For Admission	Section Heading only.
407.03(a) Time for Service of Responses	Added references to 37 CFR § 2.120(a)(3); Fed. R. Civ. P. 36(a); and Fed. R. Civ. P. 6(b) and 6(b)(1)(B).
	Amended first paragraph to inform reader that five additional days for responding to requests for admissions are not added to response time when service of requests is by electronic means.
	Added new second paragraph instructing reader that requests for admissions are deemed admitted if not responded to within thirty days or such other agreed-upon time.
	Amended third paragraph by editing the wording "automatically admitted" to "admitted by operation of law" and by adding that a motion to deem requests for admissions admitted is unnecessary.
	Added new Note 3, referencing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42250 (August 1, 2007).
	Added new Note 4, referencing: Fed. R. Civ. P. 36(a)(3).
	Added new Note 5, citing: *Fram Trak Industries,* 77 USPQ2d 2000, 2005 (TTAB

	2006); and *Pinnochio's Pizza Inc. v. Sandia Inc.*, 11 USPQ2d 1227, 1228 n.5 (TTAB 1989).
	Added new Note 6, referencing: Fed. R. Civ. P. 6(b)(1)(B); and citing: *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007).
	Amended Note 7 by deleting reference to Fed. R. Civ. P. 6(b); and changing reference from Fed. R. Civ. P. 36(a) to Fed. R. Civ. P. 36(b). Added citation to *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007) in Note 7. Changed signal to "*see also"* for *American Automobile Ass'n (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) in Note 7. Added pin cite and parenthetical to *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 361 n.2 (TTAB 1978), *aff'd,* 599 F.2d 1009, 202 USPQ 100 (CCPA 1979)
	Deleted from Note 7 reference to the following cases: *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448 (TTAB 1979); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, (TTAB 1979); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691 (TTAB 1975).
407.03(b) Nature of Responses	Added reference to Fed. R. Civ. P. 36(a).
	Deleted "G. Douglas Hohein, *TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163, 167 (1981)" from Note 2.
407.03(c) Signature of Responses	Updated reference to Fed. R. Civ. P. 36(a)(3) from Fed. R. Civ. P. 36(a).
	Added new Note 2, referencing: 37 CFR § 10.63; and adding, by comparison, *Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ2d 1663 n.4 (TTAB 1988).
407.04 Effect Of Admission	Amended first paragraph to include, as additional means for amending responses to requests for admissions that are deemed admitted, Board's grant of reopening of party's time to respond to admissions requests.

	Added new reference and cases to Note 1: Fed. R. Civ. P. 6(b)(1)(B); *Texas Department of Transportation v. Tucker,* 95 USPQ2d 1241 (TTAB 2010); *Sinclair Oil Corp. v. Kendrick,* 85 USPQ2d 1032, 1037 n.8 (TTAB 2007); *Baseball America Inc. v. Powerplay Sports Ltd*., 71 USPQ2d 1844, 1846 n.7 (TTAB 2004); and *Olin Corporation v. Hydrotreat, Inc.,* 210 USPQ 63, 65 n.4 (TTAB 1981).
408 Duties To Cooperate, Search Records, Supplement	Section Heading only.
408.01 Duty To Cooperate	Amended text to include statement that there is no concept of priority in discovery.
	Added new Note 1, citing: *Panda Travel Inc., v. Resort Option Enterprises, Inc.,* 94 USPQ2d 1789, 1791 (TTAB 2009); *Amazon Technologies Inc. v. Wax,* 93 USPQ2d 1702, 1705 (TTAB 2009); and *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007).
	In Note 2: Removed signal "*see, for example,*" before reference to Fed. R. Civ. P. 26(g). Added parentheticals to *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.,* 13 USPQ2d 1719, 1721 n.4 (TTAB 1989); to *C. H. Stuart Inc. v. Carolina Closet, Inc.,* 213 USPQ 506, 507 (TTAB 1980); to *C. H. Stuart Inc. v. S. S. Sarna, Inc.,* 212 USPQ 386, 387 (TTAB 1980); and to *Varian Associates v. Fairfield-Noble Corp.,* 188 USPQ 581, 584 (TTAB 1975). Amended parentheticals to *Sentrol, Inc. v. Sentex Systems, Inc.,* 231 USPQ 666, 667 (TTAB 1986); and to *Unicut Corp. v. Unicut, Inc.,* 222 USPQ 341, 344 (TTAB 1984).
	Added new Note 3, citing: *Miss America Pageant v. Petite Productions, Inc.,* 17 USPQ2d 1067 (TTAB 1990); and *Giant Food, Inc. v. Standard Terry Mills, Inc.,* 231 USPQ 626 (TTAB 1986).
	Deleted discussion regarding Fed. R. Civ. P. 26(g)(2).
408.01(a) Obligation to Conduct Discovery Conference (new section)	This is a new section describing parties' mutual obligation to conduct discovery conference, procedures to follow, topics to be discussed, and sanctions for failure to hold a discovery

	conference.
	Added new Note 1, citing: 37 CFR § 2.120(a)(2); Fed. R. Civ. P. 26(f); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007); and *Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (TTAB 2009).
	Added new Notes 2, 3, 4 and 6, citing: *Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (TTAB 2009).
	Added new Note 5, citing: *Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (TTAB 2009); *Guthy-Renker Corp. v. Michael Boyd,* 88 USPQ2d 1701, 1703 (TTAB 2008); and *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1860 n.2 (TTAB 2008).
	Added new Note 7, referencing: 37 CFR § 2.120(g)(1).
	Added new Note 8, citing: *Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (TTAB 2009); *Guthy-Renker Corp. v. Michael Boyd,* 88 USPQ2d 1701, 1703 (TTAB 2008).
408.01(b) Obligation to Make Initial and Expert Testimony Disclosures (new section)	This is a new section describing parties' mutual obligation to serve initial and expert disclosures, procedures to follow, reasons for requirements and cross-referencing TBMP §§ 401.02-04 for further information.
	Added new Notes 1 and 2, referencing Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 and 42246 (August 1, 2007).
	Added new Note 3, referencing 37 CFR § 2.120(a)(1); and Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).
	Added new Notes 4, 5, 7 and 8, referencing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).
	Added new Note 6, referencing 37 CFR § 2.120(a); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007); and *Jules Jurgenson/Rhapsody, Inc. v. Peter Baumberger,* 91 USPQ2d 1443 (TTAB 2009).
408.01(c) Duty to	This is a new section, referencing Fed. R. Civ.

Cooperate with Regard to Written Discovery and Disclosures (new section)	P. 26(g)(1) and 37 CFR § 2.120(e)(1), and describing certification by signature of discovery requests, responses, objections or disclosures.
	Moved the last two paragraphs of TBMP § 408.01 (Duty to Cooperate) from the 2004 version of the manual to this section, as paragraphs 1 and 2.
	Added new paragraph 3, regarding signature of a disclosure and cross-referencing TBMP § 401.06.
	Added new paragraph 4, to address requirement of good faith efforts with respect to motion to compel as extension of duty to cooperate.
	Added new Notes 2 and 4, citing Fed. R. Civ. P. 26 Advisory Committee's notes, (1983 Amendment Rule 26, Subdivision (g)).
	Added new Note 3, citing *Miss America Pageant v. Petite Productions, Inc.,* 17 USPQ2d 1067, 1069 (TTAB 1990).
	Added new Notes 5 and 6, referencing 37 CFR § 2.120(e).
	Added new Note 7, referencing 37 CFR § 2.120(e); and citing, by comparison, *International Finance Corp. v. Bravo Co.,* 64 USPQ2d 1597, 1605 (TTAB 2002).
408.02 Duty To Search Records	Amended first paragraph to inform reader how to properly respond to document production requests.
	Added cross-reference to TBMP § 527.01(e) in paragraph 2.
	Added new Note 1, citing: *No Fear Inc. v. Rule,* 54 USPQ2d 1551 (TTAB 2000).
	Added new Notes 2 and 4, citing: *No Fear Inc. v. Rule,* 54 USPQ2d 1551, 1556 (TTAB 2000).
	Added new Note 3, referencing Fed. R. Civ. P. 34(b)(2).
	Added new case to Note 5: *Panda Travel, Inc. v. Resort Option Enterprises, Inc.,* 94 USPQ2d 1789 (TTAB 2009).
408.03 Duty To Supplement Disclosures And Discovery Responses (new title)	Amended title from "Duty to Supplement Discovery Response"
	Amended reference to Fed. R. Civ. P. 26(e)

	and added reference to Fed. R. Civ. P. 26(e)(1)(A)-(B) and 26(e)(2).
	Amended text to describe requirements for supplementing disclosure and discovery responses as governed by Fed. R. Civ. P. 26(e)(1) and (2); treatment of information otherwise made known; possible sanctions for failure to supplement; and to inform reader that Fed. R. Civ. P. 37(c)(1)(A) and 37(c)(1)(B) do not apply in Board proceedings.
	Added new case to Note 2: *Vignette Corp. v. Marino,* 77 USPQ2d 1408 (TTAB 2005).
	Added new Note 3, citing *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.,* 91 USPQ2d 1859, 1861 (TTAB 2009); and, by comparison, *Byer California v. Clothing for Modern Times Ltd,* 95 USPQ2d 1175 (TTAB 2010) and referencing Fed. R. Civ. P. 26(e) Advisory Committee Notes (1993 amendment Rule 26(e)).
	Added new Note 4, citing *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.,* 91 USPQ2d 1859, 1861 (TTAB 2009).
	Added new Note 5, citing, by comparison: *Byer California v. Clothing for Modern Times Ltd.,* 95 USPQ2d 1175 (TTAB 2010); and *Vignette Corp. v. Marino,* 77 USPQ2d 1408, 1411 (TTAB 2005); and citing, under *"see also"* signal: *Galaxy Metal Gear Inc. v. Direct Access Technology Inc*., 91 USPQ2d 1859 (TTAB 2009).
	Added new cases to Note 7: *Byer California v. Clothing for Modern Times Ltd.,* 95 USPQ2d 1175 (TTAB 2010); and, by comparison, *Bison Corp. v. Perfecta Chemie B.V.,* 4 USPQ2d 1718 (TTAB 1987); *Andersen Corp. v. Therm-O-Shield Int'l, Inc.,* 226 USPQ 431 (TTAB 1985); and *JSB International, Inc. v. Auto Sound North, Inc.,* 215 USPQ 60 (TTAB 1982).
409 Filing Discovery Requests, Discovery Responses, And Disclosures With Board (new title)	Updated title from "Filing Discovery Requests and Responses With Board"
	Amended references to 37 CFR § 2.120(j) to reflect rules changes.

	Amended first paragraph to include initial and expert disclosures among materials that should not be filed with Board except under specified conditions; updated statement of conditions to include motion to challenge sufficiency of disclosures and notice of reliance on disclosures, where appropriate.
	Added new second paragraph to inform reader that notice of intention to use expert testimony should be filed with the Board.
	Added new paragraph 3 to inform reader that pretrial disclosures should not be filed with Board except with appropriate motion, and cross-referencing TBMP § 702.01 for further information.
	Amended paragraph 4 to include motion to strike witness testimony as circumstance wherein copies of pertinent discovery requests, responses, or disclosures should be submitted in support of motion.
	Deleted following sentence from end of this section: "Discovery papers or materials filed with the Board under circumstances other than those specified above may be returned to the party that filed them."
	Added new Note 1, citing: *Hiraga v. Arena,* 90 USPQ2d 1102 (TTAB 2009); *Life Zone Inc. v. Middleman Group Inc.,* 87 USPQ2d 1953 (TTAB 2008); *Ballet Tech Foundation Inc. v. Joyce Theater Foundation Inc.,* 89 USPQ2d 1262, 1265 n.2 (TTAB 2008); *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.,* 84 USPQ2d 1912 (TTAB 2007); *ProQuest Information and Learning Co. v. Island,* 83 USPQ2d 1351 (TTAB 2007); *Kohler Co. v. Baldwin Hardware Corp.,* 82 USPQ2d 1100 (TTAB 2007); *B.V.D. Licensing Corp. v. Rodriguez,* 83 USPQ2d 1500 (TTAB 2007); and *Genesco Inc. v. Martz,* 66 USPQ2d 1260 (TTAB 2003).
	Added new Note 2, referencing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007); and 37 CFR § 2.120(a)(2).
	Added new Note 3, referencing: Miscellaneous Changes to Trademark Trial and Appeal Board

	Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).
	Added new case to Note 4: *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC,* 88 USPQ2d 1541, 1542 n.2 (TTAB 2008); amended parenthetical to *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) from "(regarding a motion for summary judgment)"; amended parenthetical to *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.,* 5 USPQ2d 1067, 1070 (TTAB 1987) from "(respondent again reminded that discovery materials are not to be filed with the Board except under specified circumstances)"; deleted "G. Douglas Hohein, TIPS FROM THE TTAB: Potpourri, 71 Trademark Rep. 163, 166-167 (1981) (but note that this article was written prior to the rule changes noted above)."
410 Asserting Objections To Requests For Discovery; Motions Attacking Requests For Discovery, And Disclosures (new title)	Updated title from "Asserting Objections To Requests For Discovery; Motions Attacking Requests For Discovery."
	Added new paragraphs 3, 4, and 5 to inform reader that unexcused failure to respond to discovery requests during time allowed may result in forfeiture of right to object; that objections based on confidentiality are expected to be minimal in light of imposition of Board's standard protective order; and that for cases commenced on or after November 1, 2007, failure to serve initial disclosures is a valid ground for objecting to propounded discovery, but objection must be made on that basis.
	Amended paragraph 7 to provide example where request for discovery may constitute harassment.
	Amended paragraph 8 to explain that motion to quash or for protective order may be available to party on which a notice of deposition was served.
	Amended paragraph 9 to explain availability of

	motion to compel in order to object to or test sufficiency of disclosures.
	Added new Note 1, citing: *No Fear, Inc. v. Rule,* 54 USPQ2d 1551 (TTAB 2000); *Bison Corp. v. Perfecta Chemie B.V.,* 4 USPQ2d 1718 (TTAB 1987); *Luehrmann v. Kwick Kopy Corp.,* 2 USPQ2d 1303 (TTAB 1987); *Envirotech Corp. v. Compagnie Des Lampes,* 219 USPQ 448 (TTAB 1979); *McMillan Bloedel Ltd. v. Arrow-M Corp.,* 203 USPQ 952 (TTAB 1979); and *Crane Co. v. Shimano Industrial Co.,* 184 USPQ 691 (TTAB 1975).
	Added new Note 2, citing: *No Fear, Inc. v. Rule,* 54 USPQ2d 1551 (TTAB 2000).
	Added new Note 3, referencing: 37 CFR § 2.116(g).
	Added new Note 4, citing: *No Fear, Inc. v. Rule,* 54 USPQ2d 1551 (TTAB 2000).
	Added new Note 5, citing: *Dating DNA, LLC v. Imagini Holdings, LLC,* 94 USPQ2d 1889 (TTAB 2010).
	Added new Note 6, citing: *Amazon Technologies Inc. v. Wax,* 93 USPQ2d 1702, 1705 (TTAB 2009).
	Deleted citation to *Luemme Inc. V. D.B. Plus Inc.,* 53 USPQ2d 1758, 1761 (TTAB 1999) from Note 7.
	Amended parenthetical to *Medtronic, Inc. v. Pacesetter Systems, Inc.,* 222 USPQ 80, 83 (TTAB 1984) from "(party must articulate objections with particularity)" in Note 7; added parentheticals to citations for *Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc.,* 191 USPQ 127 (TTAB 1976); and *Volkswagenwerk Aktiengesellschaft v. Ridewell Corp.,* 188 USPQ 690 (TTAB 1975) in Note 7.
	Deleted "*See* Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1)*, 82 Trademark Rep. 89 (1992)" from Note 8.
	Deleted "*FMR Corp. v. Alliant Partners,* 51 USPQ2d 1759, 1764 (TTAB 1999) (protective order against taking deposition of high-level

	official granted); *Gold Eagle Products Co. v. National Dynamics Corp.,* 193 USPQ 109, 110 (TTAB 1976) (protective order granted since obligation to respond to discovery requests rests with assignee); and *Kellogg Co. v. New Generation Foods Inc.,* 6 USPQ2d 2045, 2049 (TTAB 1988) (motion to quash one notice to depose person who was no longer an employee and another notice to depose person with authority to negotiate settlement, granted)" from Note 9.
	Added new case to Note 10: *National Football League v. DNH Management LLC,* 85 USPQ2d 1852 (TTAB 2008).
	Added new Note 11, referencing 37 CFR § 2.120(e); and citing: *Influance v. Zuker,* 88 USPQ2d 1859 (TTAB 2008).
	Added new Note 12, referencing 37 CFR § 2.120(e).
	Added new Note 13, citing *Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC,* 88 USPQ2d 1541 (TTAB 2008).
411 Remedy For Failure To Provide Disclosures Or Discovery (new title)	Updated title from "Remedy For Failure To Provide Discovery"
411.01 Initial And Expert Testimony Disclosures (new section)	This is a new section, describing motions to compel service of initial and expert disclosures and availability of sanctions. Cross-references TBMP §§ 527.01 and 702.01.
	Added new Note 1, referencing 37 CFR § 2.120(e); and Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42256 (August 1, 2007); and citing: *Influance v. Zuker,* 88 USPQ2d 1859 (TTAB 2008).
	Added new Note 2, referencing 37 CFR § 2.120(e).
	Added new Note 3, referencing 37 CFR § 2.120(g)(1); and Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42256 (August 1, 2007); and citing: *Amazon Technologies v. Wax,* 93 USPQ2d 1702, 1706 (TTAB 2009); and under signal "*but see,"* 37 CFR § 2.120(g)(2); and *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC,* 88 USPQ2d 1541

	(TTAB 2008).
411.02 Interrogatories Or Requests For Production (new numbering)	Updated the numbering of this section from 411.01 to 411.02.
	Amended text to explain that motion to compel must precede motion for sanctions.
	Added new Note 1, referencing 37 CFR § 2.120(e).
	Added new Note 3, referencing 37 CFR § 2.120(g)(2) and citing, by comparison: *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC,* 88 USPQ2d 1541 (TTAB 2008) (regarding disclosures); and *HighBeam Marketing LLC v. Highbeam Research LLC,* 85 USPQ2d 1902, 1906 (TTAB 2008).
411.03 Requests For Admission (new numbering)	Updated the numbering of this section from 411.02 to 411.03.
	Amended second paragraph to indicate that sufficiency of response to request for admission should not be challenged as long as request is either admitted or denied, even if response includes objection to request.
	Added new Note 1, citing: *Giersch v. Scripps Networks Inc.,* 85 USPQ2d 1306 (TTAB 2007); and *Hobie Designs, Inc. v. Fred Hayman Beverly Hills, Inc.,* 14 USPQ2d 2064 (TTAB 1990).
	Added new Note 4, referencing Fed. R. Civ. P. 26(a).
411.04 Discovery Depositions (new numbering)	Updated the numbering of this section from 411.03 to 411.04.
	Amended first paragraph to include information regarding non-party witness depositions; and amended second paragraph to inform reader that witness should normally answer all questions, but that immediate court order to compel answer may be available.
	Added new Note 1, referencing 37 CFR § 2.120(e); and, by comparison, Fed. R. Civ. P. 37(a).
	Added new Note 2, referencing 37 CFR § 2.120(e); and adding parenthetical to *Neville Chemical Co. v. Lubrizol Corp.,* 183 USPQ 184, 189 (TTAB 1974). Deleted "*S. Rudofker's*

	Sons, Inc. v. "42" Products, Ltd., 161 USPQ 499 (TTAB 1969); and *Bordenkircher v. Solis Entrialgo y Cia., S. A.,* 100 USPQ 268, 276-278 (Comm'r 1953)" from Note 2.
411.05 Sanctions Related To Disclosures And Discovery (new title and new numbering)	Updated title from "Discovery Sanctions" and renumbered section from 411.04 to 411.05.
	Amended text to include discussion of sanctions available for party's failure to provide disclosures or participate in discovery conference.
	Added new Note 1, citing, by example: *Amazon v. Wax,* 95 USPQ2d 1865 (TTAB 2010).
	Added new Note 2, citing: *Promgirl, Inc. v. JPC Co.,* 94 USPQ2d 1759 (TTAB 2009); and *Guthy-Renker Corp. v. Michael Boyd,* 88 USPQ2d 1701, 1704 (TTAB 2008).
412 Protective Orders	Added references to 37 CFR § 2.116(g); Fed. R. Civ. P. 26(c)(1)(A)-(H); Fed. R. Civ. P. 26(c)(2); and excerpts from the Board's standard protective order. Updated reference to 37 CFR § 2.120(f) to reflect rules changes.
	Added new first paragraph to inform reader of two types of protective orders available from the Board.
412.01 In General -- Board Standard Protective Order (new title)	Updated title from "In General."
	Added paragraphs 1-5 to advise reader of automatic imposition of Board's standard protective order; to discuss effect of protective order in Board proceeding; Board's authority to enforce order during proceeding; and parties' obligation to designate information as confidential, cross-referencing TBMP § 703.01(p) and parties' ability to modify terms of order cross-referencing TBMP § 412.02(a).
	Amended paragraph 6 to expand discussion regarding issuance of protective order to protect party from harassment; updated reference to Fed. R. Civ. P. 26(c) from Fed. R. Civ. P. 26(c)(1)-(8) to Fed. R. Civ. P. 26(c)(A)-(H) in paragraph 6.
	Added new Note 1, referencing 37 CFR §

	2.116(g); and Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 (August 1, 2007); and citing, by example: *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC,* 88 USPQ2d 1541, 1544 (TTAB 2009).
	Added new Note 2, referencing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 (August 1, 2007).
	Added new Notes 3, 4, and 5, referencing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42251 (August 1, 2007).
	Added new Notes 6 and 7, referencing: 37 CFR § 2.116(g); and Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 (August 1, 2007).
	Added new Note 8, citing, by example: *Wet Seal, Inc. v. FD Management, Inc.,* 82 USPQ2d 1629, 1633 n.6 (TTAB 2007).
	Added new Note 9, citing, by example: *Georgia Pacific Corp. v. Solo Cup Co*., 80 USPQ2d 1950, 1954 (TTAB 2006); and *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.,* 77 USPQ2d 1492, 1495, n.5 (TTAB 2005).
	Added new Note 10, citing, by example: *Amazon Technologies, Inc. v. Wax,* 93 USPQ2d 1702, 1706 n.6 (TTAB 2009).
	Added new Note 11, referencing: 37 CFR § 2.120(g).
	Added new Note 12, referencing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 (August 1, 2007).
	Added new reference and new case to Note 13: Fed. R. Civ. P. 26(c)(1) and, by example, *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.,* 74 USPQ2d 1672 (TTAB 2005).
	Added new Note 14, citing: *FMR Corp. v. Alliant Partners,* 51 USPQ2d 1759, 1761 (TTAB 1999).
	Added new Note 15, citing: *A. Hirsh, Inc. v. United States,* 657 F. Supp. 1297, 1305 (C.I.T.

	1987).
	Added new Note 16, citing, by example: *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.,* 74 USPQ2d 1672 (TTAB 2005).
	Added new Note 17, referencing Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 (August 1, 2007).
412.02 Modification Of Board's Standard Protective Order Governing The Exchange Of Confidential, Highly Confidential And Trade Secret/Commercially Sensitive Information (new title)	Updated title from: "Protective Order Regarding Confidential and Trade Secret Information"
	Added new first paragraph to inform reader that Board's standard protective order may be modified; amended reference to 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2043 (2009) in Note 1 by deleting "Wright & Miller, Federal Practice & Procedure, Chap. 6" and updating date from "2006."
412.02(a) Modification of Board's Standard Protective Order Upon Stipulation (new title)	Updated title from "Upon Motion" and combined with former TBMP § 412.02(b) "Upon Stipulation" to form single section.
	Deleted former TBMP §§ 412.02(a) (Upon Motion) and 412.02(b) (Upon Stipulation) in light of current rule making Board's standard protective order applicable in all proceedings. Added text regarding procedure for modifying terms of order pursuant to parties' agreement. Added new Note 1, citing: *Duke University v. Haggar Clothing Co.,* 54 USPQ2d 1443, 1445 (TTAB 2000).
412.02(b) Pro Se Litigants and In-House Legal Counsel (new section)	This is a new section regarding the exchange and disclosure of information during discovery in cases involving pro se litigants and in-house legal counsel.
	Added new Note 1, citing *A. Hirsh, Inc. v. United States,* 657 F. Supp. 1297, 1305 (C.I.T. 1987).

	Added new Note 2, citing: *U.S. Steel Corp. v. United States,* 730 F.2d 1465 (Fed. Cir. 1984); and *Georgia Pacific Corp. v. Solo Cup Co.,* 80 USPQ2d 1950, 1953 (TTAB 2006).
412.02(c) In Camera Inspection	No changes to text. Added new Note 1, citing *Amazon v. Wax,* 95 USPQ2d 1865, 1869 n.8 (TTAB 2010). Deleted: "*See* Rany L. Simms, *TIPS FROM THE TTAB*: Stipulated Protective Agreements, 71 Trademark Rep. 653 (1981)" from Note 1.
412.02(d) Contents of Protective Order	Amended text to indicate that modifications may be made to Board's standard protective order and to list typical terms that revised protective order may encompass. Expanded explanation of procedure at subsection 12 for filing confidential material with the Board to include ESTTA filing and to clarify that two versions of each confidential submission are required.
	Amended penultimate paragraph to update location where Board's standard protective order may be found from "Appendix of Forms in this manual" to the USPTO website.
	Deleted: "S*ee* Rany L. Simms, TIPS FROM THE TTAB: Stipulated Protective Agreements, 71 Trademark Rep. 653 (1981). *See also Duke University v. Haggar Clothing Co.,* 54 USPQ2d 1443, 1445 (TTAB 2000) (stipulated protective agreement should include provision that it may be amended without leave of Board)" from Note 1. Added clarification that remaining cases cited were decided before automatic imposition of Board's standard protective order.
412.03 Duration Of Protective Order (new title)	Updated from "Signature of Protective Order".
	Amended section to include reference to excerpt from Board's standard protective order. Amended first paragraph to delete the following: "Stipulated protective orders may be signed either by the parties thereto, or by their attorneys, or by both; and to add information about treatment of material disclosed during Board proceeding.
	Amended second paragraph to clarify that Board may not order parties to sign protective

	order and that Board's jurisdiction does not extend to enforcement of protective order following termination of proceeding.
	Amended section by deleting discussion Board imposition of the standard protective order on parties.
	Added new Notes 1 and 3, referencing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42251 (August 1, 2007).
412.04 Filing Confidential Materials With Board	Updated references to 37 CFR § 2.126(c) from 37 CFR § 2.126(d); and added excerpt from section 12 of Board's standard protective order.
	Amended first paragraph to describe method for designating submissions as confidential and to advise reader that absent designation, submissions will be placed in the Board's public record. Further amended first paragraph to indicate that two versions of confidential submission are required; that redactions are determined under rule of reason; and that confidentiality may be considered waived if redacted version not submitted.
	Deleted from section: "Confidential materials filed in the absence of a protective order are not regarded as confidential and are not kept confidential by the Board. [Note 219.] The mere stamping of "confidential" on documents does not operate in lieu of a protective order or agreement." Also deleted from section: "*See, e.g., 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, 68 USPQ2d 1225 (D.D.C. 2003)."
	Added new second paragraph regarding use of ESTTA for filing confidential material; cross-referenced TBMP § 120.02 for further information.
	Amended paragraph 4 to clarify procedure for paper submission of confidential material.
	Added new Note 1, referencing: 37 CFR § 2.116(g).

	Amended Note 2 by deleting: "Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981)."
	Added new Note 3, citing, by example: *Morgan Creek Productions Inc. v. Foria International Inc.,* 91 USPQ2d 1134, 1136 n.9 (TTAB 2009); and *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.,* 77 USPQ2d 1492, 1495, n.5 (TTAB 2005).
	Added new Note 4, citing, by example: *Wet Seal, Inc. v. FD Management, Inc.,* 82 USPQ2d 1629, 1633 n.6 (TTAB 2007).
	Amended Note 5 by adding: http://estta.uspto.gov/filing-type.jsp; and by deleting: "See Harjo v. Pro-Football, Inc., supra (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)."
412.05 Handling Of Confidential Materials By Board	Updated section to inform reader of current procedures for handling of confidential materials during proceeding and following termination.
	Deleted: "*See* Rany L. Simms, TIPS FROM THE TTAB: Stipulated Protective Agreements, 71 Trademark Rep. 653 (1981)" from Note 1.
	Added new Note 2, citing, by example: *Schering Plough HealthCare Products Inc. v. Ing-Jing Huang,* 84 USPQ2d 1323, 1324 (TTAB 2007); and *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha,* 77 USPQ2d 1917, 1930 n.22 (TTAB 2006).
412.06 Protective Orders Limiting Discovery (new section)	This is a new section, referencing 37 CFR § 2.120(f) and Fed. R. Civ. P. 26(c)(1)(A)-(H); and discussing motions for protective order that discovery not be had or be limited; including requirement for good cause showing; and cross-referencing TBMP §§ 410 and 526 for additional information.
	Added new Note 1, citing, by example: *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1764 (TTAB 1999); and *Gold Eagle Products Co. v. National Dynamics Corp*., 193 USPQ 109, 110 (TTAB 1976).
	Added new Note 2, citing: 37 CFR § 2.120(f);

	and Fed. R. Civ. P. 26(c)(1).
	Added new Note 3, citing: *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999).
	Added new Note 4, citing: *A. Hirsh, Inc. v. United States,* 657 F. Supp. 1297, 1305 (C.I.T. 1987).
	Added new Note 5, citing, by example: *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.,* 13 USPQ2d 1719 (TTAB 1989); and *Neville Chemical Co. v. Lubrizol Corp.,* 183 USPQ 184 (TTAB 1974).
	Added new Note 6, referencing: Fed. R. Civ. P. 26(c)(1).
412.06(a) Depositions (new section)	This is a new section, describing conditions under which motions to protect a witness from a deposition may be entertained; including discussion of requisite showing of good cause and where burden of proof lies.
	Added new Note 1, referencing: Fed. R. Civ. P. 26(c)(1); and 37 CFR § 2.120(f); and citing: *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc*., 74 USPQ2d 1672, 1674 (TTAB 2005).
	Added new Note 2, referencing: Fed. R. Civ. P. 26(c)(1); and 37 CFR § 2.120(f).
	Added new Note 3, citing: *FMR Corp. v. Alliant Partners,* 51 USPQ2d 1759, 1761 (TTAB 1999).
	Added new Note 4, referencing: 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2037 (2009).
	Added new Note 5, citing: *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc*., 74 USPQ2d 1672, 1675 (TTAB 2005).
	Added new Note 6, citing: *FMR Corp. v. Alliant Partners,* 51 USPQ2d 1759, 1762 (TTAB 1999).
	Added new Notes 7-11, citing: *FMR Corp. v. Alliant Partners,* 51 USPQ2d 1759, 1763 (TTAB 1999).
	Added new Note 12, citing, by comparison: *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc*., 74 USPQ2d 1672, 1677 (TTAB 2005).

	Added new Note 13, referencing: 8A C. WRIGHT, A. MILLER & R. MARCUS, FEDERAL PRACTICE AND PROCEDURE Civil 3d § 2037 (2009).
412.06(b) Other Discovery (new section)	This is a new section, describing conditions under which motions for protection from oppressive discovery may be had; and cross-referencing TBMP §§ 402, 405, 406, 408, 410 and 526.
	Added new Note 1, citing: *Medtronic, Inc. v. Pacesetter Systems, Inc*., 222 USPQ 80, 83 (TTAB 1984).
	Added new Note 2, citing: *Fort Howard Paper Co. v. G.V. Gambina Inc*., 4 USPQ2d 1552, 1553 (TTAB 1987).
	Added new Note 3, referencing: 37 CFR § 2.120(d).
	Added new Note 4, referencing, by example: Fed. R. Civ. P. 36 Advisory Committee notes (1970 amendment).
	Added new Note 5, citing: *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609 (TTAB 1991); *Fort Howard Paper Co. v. G.V. Gambina Inc*., 4 USPQ2d 1552 (TTAB 1987); *C. H. Stuart Inc. v. S.S. Sarna, Inc*., 212 USPQ 386 (TTAB 1980); and *Gold Eagle Products Co. v. National Dynamics Corp*., 193 USPQ 109, 110 (TTAB 1976).
413 Telephone And Pretrial Conferences	Section Heading only.
413.01 Telephone Conferences For Motions (new section)	Amended section by adding references to 37 CFR §§ 2.120(i)(1) and 2.127(a); and describing typical situations where parties may be involved in telephone conference with Board attorney or judge. Deleted reference indicating that conferences involve "the parties or their attorneys and an Attorney-Advisor, or a Member, or the Board." Cross-referenced TBMP § 502.06.
	Added new Note 1, citing, by example: *Byer California v. Clothing for Modern Times Ltd.,* 95 USPQ2d 1174 (TTAB 2010).
	Added new Note 2, referencing; 37 CFR § 2.127(a); and citing, by example: *Byer California v. Clothing for Modern Times Ltd.,* 95 USPQ2d 1174 (TTAB 2010).

	Added new Note 3, referencing: 37 CFR § 2.120(i); and citing *International Finance Corporation v. Bravo Co.,* 64 USPQ2d 1597, 1603 n.24 (TTAB 2002).
413.02 Pretrial Conferences (new section)	This is a new section, referencing 37 CFR § 2.120(i)(2); describing Board's authority to order parties to meet in person; and cross-referencing TBMP § 502.06(b).
	Added new Note 1, citing: *Amazon v. Wax,* 95 USPQ2d 1865, 1869 (TTAB 2010).
414 Selected Discovery Guidelines	Amended subsection (3) to indicate that names of dealers are typically considered confidential information.
	Amended subsection (7) to include information about discovery of witnesses in pretrial disclosures.
	Amended subsection (11) to clarify when information about goods or services sold under a different mark may be discoverable.
	Added new Notes 8, 9 and 10, referencing 37 CFR § 2.121(e).
	Added new Note 11, citing: *Byer California v. Clothing for Modern Times Ltd.,* 95 USPQ2d 1175 (TTAB 2010).
	Added new Note 12, referencing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245-6 (August 1, 2007); and citing: *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.,* 91 USPQ2d 1859, 1861 (TTAB 2009).
	Added new Note 14, referencing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).
	Updated Fed. R. Civ. P. 33(a)(2) in Note 29 from Fed. R. Civ. P. 33(c); and deleted reference to Fed. R. Civ. P. 36(a) in Note 29.

INDEX TO CHANGES IN THIRD EDITION
CHAPTER 500

TBMP SECTION	NATURE OF CHANGE
501.01 Stipulations: In General	Added more examples of type of stipulations available to parties.
	Added new case to Note 2: *Target Brands Inc. v. Hughes,* 85 USPQ2d 1676, 1678 (TTAB 2007)
501.02 Filing Stipulations	Added an excerpt from 37 CFR § 2.120(a)(2) regarding stipulations to shorten or extend discovery as well as disclosure deadlines; added additional examples of types of stipulations that must be filed with the Board.
	Added an excerpt from 37 CFR § 2.120(a)(3) regarding the requirement to make initial disclosures prior to seeking discovery.
	Amended 37 CFR § 2.121(d) to reflect rules changes.
	Added text regarding stipulations to alter the length of discovery or disclosure obligations, or to reschedule pretrial disclosures and subsequent trial dates to reflect the rules change.
	Added to Note 1: 37 CFR § 2.120(a)(2) and 37 CFR § 2.120(a)(3).
501.03 Form of Stipulations	Deleted *Jan Bell Marketing Inc. v. Centennial Jewelers Inc.,* 19 USPQ2d 1636 (TTAB 1990) from Note 1.
	In the text, deleted references to former practices, added references to current practices, and noted that when party files to reset dates through ESTTA's "consent motions option," that the system will prompt the user to generate a properly formatted schedule, but that if such a filing does not result in an order that comports with the parties' intentions regarding dates, the filing party should use the "general filings" option instead.
502 Motions – In General	Section Heading only
502.01 Available Motions	Added 37 CFR § 2.123(a) to Note 1.
	Added to Note 2: *Genesco Inc. v. Martz,* 66 USPQ2d 1260, 1263 (TTAB 2003) and *Weyerhauser Co. v. Katz,* 24 USPQ2d 1230, 1233 (TTAB 1992).

	Added to Note 3: *Genesco Inc. v. Martz,* 66 USPQ2d 1260, 1263 (TTAB 2003).
	Added to Note 4: *Byer California v. Clothing for Modern Times Ltd*., 95 USPQ2d 1175, 1178 (TTAB 2010) and *Greenhouse Systems Inc. v. Carson,* 37 USPQ2d 1748, 1750-1751 (TTAB 1995).
	Deleted Gary D. Krugman, *TIPS FROM THE TTAB: Motions for Judgment after Commencement of Testimony Periods,* 73 Trademark Rep. 76 (1983) from Note 4.
	In the text added motions in limine as a type of motion not available in Board proceedings.
502.02 Form of Motions and Briefs on Motions	Amended 37 CFR § 2.126 to reflect rules changes.
	Amended 37 CFR § 2.127 to reflect rules changes.
502.02(a) Form of Motions	In first paragraph, added reference to website as source of information on ESTTA.
	Amended to delete reference to filings by CD-ROM and to amend rules to reflect changes, including renumbering 37 CFR §§ 2.126(b), (c) and (d).
	Deleted the word “file” because the Board no longer maintains physical files.
	In the certificate of mailing paragraph, added an instruction that parties are not permitted to file motions via e-mail except at the request of the Board attorney or judge.
	Added a paragraph explaining that when a party files a motion electronically, the filing is time-stamped with the official filing date when the motion is received by the Office server. Also, included information regarding what to do when the filer does not receive an electronic filing receipt, when ESTTA filings are optional, and that filer should submit filings on paper if ESTTA filing not possible prior to a deadline.
	In last paragraph, added instruction not to file paper copy when motion has been filed electronically and added “fax” as an electronic means of service to which the parties may agree.
	Added discussion regarding service by e-mail, including new Note 5 citing 37 CFR § 2.119(b)(6) and referencing 37 CFR § 2.119(c) in the text of the subsection.

	Added *Sinclair Oil Corp. v. Kendrick,* 85 USPQ2d 2032, 1033 n.3 (TTAB 2007) to Note 1 to emphasize the importance of a proper caption.
502.02(b) Briefs on Motions	Deleted references to filing briefs by CD-ROM and former Note 22.
	Added to Note 3: *Cooper Technologies Co. v. Denier Electric Co.,* 89 USPQ2d 1478, 1479 (TTAB 2008).
	Added an explanation that because 37 CFR § 2.127(a) does not require a table of contents or a table of cases and authorities, that if a party includes them in its brief, the additional pages are included in the page count. Added new Note 4 citing *Saint-Gobain Corp. v. Minnesota Mining and Manufacturing Co.,* 66 USPQ2d 1220, 1222 (TTAB 2003).
	Amended text and deleted former Notes 30 and 34 to reflect rules changes permitting the filing of reply briefs for motions as a matter of right.
	Added to Note 10: 37 CFR § 2.127(a) and *Pioneer Kabushiki Kaisha v. Hitachi High Technologies,* 73 USPQ2d 1672, 1677 (TTAB 2005).
502.02(c) Confidential Information	Amended text to inform reader that Board's standard protective order is in place for inter partes proceedings pending or commenced August 31, 2007. Amended text to add "materials designated as confidential in ESTTA" to excepted material not available for public inspection; and to indicate treatment of material filed without appropriate "confidential" designation.
	Added new Note 1, citing: 37 CFR § 2.116(g).
	Added to Note 2: 37 CFR §§ 2.27(d) and (e) and 2.126(c); added *Duke University v. Haggar Clothing Co*., 54 USPQ2d 1443, 1445 (TTAB 2000); and deleted *Harjo v. Pro-Football, Inc*., 50 USPQ2d 1705, 1714 (TTAB 1999).
	Deleted 37 CFR § 2.27(d); amended 2.126(d) to (c); and deleted Rany L. Simms, *Tips from the TTAB; Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981) in Note 3.
	Changed "see" reference to "cf." for Harjo v. Pro-Football, Inc., 50 USPQ2d 1705, 1714 (TTAB 1999).

	Added to Note 5: *Duke University v. Haggar Clothing Co*., 54 USPQ2d 1443, 1445 (TTAB 2000).
	In the penultimate paragraph, added an explanation regarding how to file "confidential" documents electronically; and in the last paragraph, added qualifier relating to private personal information.
502.03 Oral Hearings on Motions	The language in this subsection was modified to distinguish a formal oral hearing on a motion from a telephone conference regarding a motion.
	Added new Note 3, citing: 37 CFR § 2.127(a); and *Byer California v. Clothing for Modern Times*, 95 USPQ2d 1175 (TTAB 2010).
502.04 Determination of Motions	Amended 37 CFR § 2.127 to reflect rules changes.
	Amended the third paragraph to note that the Board does not grant uncontested motions as conceded until after sufficient time has been allowed for the filing of an opposition brief, and that Board will decide motion on its merits if a responsive argument is presented by written submission or in a telephone conference.
	Amended text to clarify that discovery, disclosures, and trial dates will not automatically be reset upon the filing of a motion; and that a party may incorporate a motion to extend as part of another motion. Added Note 4, citing 37 CFR § 2.120(a)(3) to support the practice that the party wishing that a deadline be reset should expressly request what dates it wishes to have reset.
	Added to Note 2: *International Finance Corp. v. Bravo Co.,* 64 USPQ2d 1597, 1599 (TTAB 2002).
502.05 Attorney's Fees, etc., on Motions	Added *Kairos Institute of Sound Healing, LLC v. Doolittle Gardens,* LLC, 88 USPQ2d 1541, 1544 n.6 (2008) to Note 1.
502.06 Telephone and Pretrial Conferences	Section Heading only
502.06(a) Telephone Conferences	Amended 37 CFR § 2.120(i)(1) to reflect the rules changes.
	Noted that the issuance of an order may be deferred if the issues raised in the telephone conference require additional research or briefing.

	Added an excerpt from 37 CFR § 2.127(a) that is referenced later as authority for the Board to exercise its discretion to decide a motion by telephone conference.
	Noted that Board retains discretion to decide whether matter may be heard by telephone conference.
	In paragraph 2, amended to explain that telephone conferences could be appropriate to decide discovery motions and added a reference to TBMP § 413.
	In paragraph 2, noted that telephone conferences could be useful for providing progress reports regarding settlement or requests to further suspend proceedings.
	At the end of the third paragraph, amended the last paragraph to read that "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 or written motions unless requested by the Board."
	In the "Requesting a telephone conference" section, changed "responsible" to "assigned;" indicated that party served with written motion should act promptly to request a telephone conference; and split the third paragraph of that section into two paragraphs. In the third paragraph, added a sentence noting the requirement for the parties to provide a telephone number and email address.
	At the beginning of the fourth paragraph: noted that the Board may require additional briefing and that the Board could decide the motion in a telephone conference prior to the end of the briefing period citing 37 CFR § 2.127(a) and *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175 (TTAB 2010) in a new Note 4. Added the following sentence: "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."
	Amended the information regarding expediting matters by explaining that practitioners should file motions through ESTTA and telephone the

	attorney rather than by hand-delivery. Also, added Note 5 citing 37 CFR § 2.195(d)(3) prohibiting filings by facsimile.
	Added a sentence noting the Board has the discretion to hear new issues.
	Noted who may attend and that the Board has the inherent authority to impose sanctions for failure to attend. Added a reference to TBMP § 527.03.
	Noted that decisions would be made available through TTABVUE. Added "e-mail" and removed "fax" as a method of communicating the Board's decision to the parties.
	Deleted former Notes 49-51 and 53-55.
502.06(b) Pretrial Conferences	Amended 37 CFR § 2.120(i)(2) to reflect rules changes.
	In Note 1, deleted the citation to Abraham Bogorad, The Impact of the Amended Rules Upon Discovery Practice Before the Trademark Trial and Appeal Board, 66 Trademark Rep., 28 (1976) and added 37 CFR § 2.120(i)(2).
	Added a cross reference to discovery conferences in TBMP §§ 408 and 413.
502.07 Fed. R. Civ. P. 11 Applicable	No changes.
503 Motion to Dismiss for Failure to State a Claim	Section Heading only; added quotation of Fed. R. Civ. P. 12(b)(6)
503.01 Time for Filing	In the second paragraph, added a statement explaining that a motion to dismiss tolls not only the time to answer, but also the time for the discovery conference citing new Note 4 referencing 37 CFR §§ 2.120(a)(2) and 2.127(d); 72 Fed. Reg. 42242, 42245 (August 1, 2007).
	In the third paragraph, added a statement that the defense of failure to state a claim upon which relief can be granted may be raised at trial.
503.02 Nature of Motion	References plausibility standard for evaluating motions to dismiss and deleted language that "dismissal for insufficiency 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." Deletes citations to *Syndicat de la Parfumerie Francaise v. Scaglia*, 173 USPQ 383, 383 (TTAB 1972); *Flatley v. Trump*, 11 USPQ2d 1284, 1286 (TTAB 1989);

	Caron Corp. v. Helena Rubinstein, Inc., 193 USPQ 113, 115 (TTAB 1976); *Anheuser-Busch, Inc. v. Martinez,* 185 USPQ 434, 435 (TTAB 1975); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1027 (Fed. Cir. 1999); *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420, 422 (CCPA 1976); and *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1205 (TTAB 1997); and *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1462 (TTAB 1992).
	Added *Bayer Consumer Care Ag v. Belmora LLC,* 90 USPQ2d 1587, 1590 (TTAB 2009) to Notes 1 and 2.
	Added new Note 3, citing: *Bell Atlantic Corp. v. Twombly,* 550 U.S. 554, 570, 127 S.Ct. 1955 (2007); *Ashcroft v. Iqbal,* 556 U.S. __, 129 S.Ct. 1937 (2009).
	Added *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.,* 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993) to Note 4.
	At the end of the third paragraph of text, added an explanation that the Board may consider certain objective facts outside the pleading (e.g., the filing date, filing basis, priority date, publication date and applicant's name in an application subject to an opposition). Added new Note 5 citing *Compagnie Gervais Danone v. Precision Formulations LLC,* 89 USPQ2d 1251, 1256 (TTAB 2009) as support.
	Added *IdeasOne Inc. v. Nationwide Better Health,* 89 USPQ2d 1952, 1953 (TTAB 2009) and *Fair Indigo LLC v. Style Conscience,* 85 USPQ2d 1536, 1539 (TTAB 2007) to Note 6.
	In the last paragraph in the body of the subsection, changed Fed. R. Civ. P. 8(f) to 8(e) to reflect the rules changes and changed "liberally" to "so as to do justice" to reflect the rules change.
503.03 Leave to Amend Defective Pleading	Deleted 37 CFR §§ 2.107 and 2.115 to Note 1 and added Fed. R. Civ. P. 15(a)(1)(B) to Note 1.

	Added new Note 2 citing *Fair Indigo LLC v. Style Conscience,* 85 USPQ2d 1536, 1537 (TTAB 2007).
	Added *Bayer Consumer Care AG v. Belmora LLC,* 90 USPQ2d 1587, 1590-1591 (TTAB 2009) to Note 4.
503.04 Matters Outside the Pleading Submitted on Motion to Dismiss	Added a new first paragraph to this subsection and new Note 1, citing 37 CFR § 2.127(e)(1) and *Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010), to explain that under amended Board rules a motion to dismiss accompanied by matters outside the pleading generally will not be converted into a motion for summary judgment.
	Added new Note 2, citing: 37 CFR § 2.127(e)(1); and *Compagnie Gervais Danone v. Precision Formulations, LLC,* 89 USPQ2d 1251, 1255-56 (TTAB 2009).
	Moved the discussion regarding pre-2007 rules change cases from the text to Note 3. Deleted Notes 4 and 5 and moved authorities cited therein into the text of the revised Note 3.
	In the revised Note 3, in the first series of authorities added Fed. R. Civ. P. 12(d), *Missouri Silver Pages Directory Publishing Corp., Inc. v. Southwestern Bell Media, Inc.,* 6 USPQ2d 1028, 1029 (TTAB 1988).
	In the revised Note 2, in the second series of authorities, Fed. R. Civ. P. 12(b) corrected to 12(d).
504 Motion for Judgment on the Pleadings	Section Heading only
504.01 Time for Filing	Added Fed. R. Civ. P. 12(h)(2)(B) to Note 4.
504.02 Nature of Motion	Added *Kraft Group LLC v. Harpole,* 90 USPQ2d 1837, 1840 (TTAB 2009); *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) to Note 1.
	Added *Kraft Group LLC v. Harpole,* 90 USPQ2d 1837, 1840 (TTAB 2009); *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) to Note 2; and updated Wright & Miller, Federal Practice and Procedure: Civil 3d § 1367 et seq. (2009) in Note 2 by changing "2d" to "3d" and 1990 to 2009.
	Added *Kraft Group LLC v. Harpole,* 90 USPQ2d 1837, 1840 (TTAB 2009); *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) to Note 3; and updated Wright & Miller, Federal Practice and Procedure: Civil 3d § 1367 et seq. (2009) in Note 3 by changing "2d" to "3d."
	Added *Kraft Group LLC v. Harpole,* 90 USPQ2d 1837, 1840 (TTAB 2009); *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) to Note 4; and updated Wright & Miller, Federal Practice and Procedure: Civil 3d § 1367 et seq. (2009) in Note 4 by changing "2d" to "3d."
	Added *International Telephone and Telegraph Corp. v. International Mobile Machines Corp*., 218 USPQ 1024, 1026 (TTAB 1983) to Note 5; and updated Wright & Miller, Federal Practice and Procedure: Civil 3d § 1367 et seq. (2009) in Note 5 by changing "2d" to "3d" and 1990 to 2009.
504.03 Matters Outside the Pleadings Submitted on Motion for Judgment on Pleadings	Added a new first paragraph to this subsection and new Note 1, citing 37 CFR § 2.127(e)(1) and *Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009), to explain that under amended Board rules a motion for judgment on the pleadings accompanied by matters outside the pleading filed prior to the serving party's service of initial disclosures generally will not be converted into a motion for summary judgment.
	Added *Western Worldwide Enterprises Group, Inc. v. Qinqudao Brewery*, 17 USPQ2d 1137, 1139 n.5 (TTAB 1990) to Note 2.
	Changed Fed. R. Civ. P. 12(c) to 12(d) in Note 3.
	Added *Institut National Des Appellations d' Origine v. Brown-Forman Corp*., 47 USPQ2d 1875, 1876 n.1 (TTAB 1998) to Note 4.

505 Motion for a More Definite Statement	Added reference to Fed. R. Civ. P. 12(e).
505.01 Nature of Motion	Udpated citation to Wright & Miller, Federal Practice and Procedure: Civil 3d § 13776 (2009) in Notes 1-5 by changing "2d" to "3d" and 1990 to 2009.
505.02 Time for Filing	Added a new second paragraph indicating that when a motion for more definite statement regarding the complaint is filed, times for conducting the parties' discovery conference and subsequent dates are effectively stayed.
	Added new Note 2, citing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007)
505.03 Failure to Obey Order for More Definite Statement	No changes.
506 Motion to Strike Matter From Pleading	Added reference to Fed. R. Civ. P. 12(f)
506.01 Nature of Motion	Added *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999) and *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1438 (TTAB 1996) to Note1.
	Added *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999) to Note 4 and deleted "*See also* Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302, 302 (1991)."
	Updated citation to Wright & Miller, Federal Practice and Procedure: Civil 3d § 1381 (2009) by changing "2d" to "3d" in Note 3.
	Deleted from Note 7: "*Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 154 (TTAB 1973) (allegations in answer which merely reiterated denial of likelihood of confusion without adding anything of substance thereto stricken as redundant); *Gould Inc. v. Sanyo Electric Co.,* 179 USPQ 313, 314 (TTAB 1973) (affirmative defense attacking validity of plaintiff's pleaded registration stricken); *S. C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720, 720 (TTAB 1973) (affirmative defense of failure to state a claim upon which relief can be granted stricken since complaint did state such a claim); *McCormick &*

	Co. v. Hygrade Food Products Corp., 124 USPQ 16 (TTAB 1959) (recital of evidentiary material, namely, list in defendant's pleading of asserted third-party registrants and users, stricken). *Compare Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 USPQ 401, 402 (TTAB 1973) (allegations pertinent to the issues in the case not stricken).”
506.02 Time for Filing	Added *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 UPSQ2d 1221, 1222 (TTAB 1995) to Note 1.
	Added an explanation in the first paragraph implementing a new procedure: when a motion to strike matter from a pleading is filed before the discovery conference is held, the issues raised in the motion may be one of the subjects of the discovery conference, if the parties request Board participation therein, and the assigned attorney will participate in the conference to ensure the resolution of the matter, including potentially striking matter from a pleading during a discovery conference.
	Added *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 UPSQ2d 1221, 1222 (TTAB 1995) to Note 2.
	Added *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 UPSQ2d 1221, 1222 (TTAB 1995) to Note 3.
	Updated citation to Wright & Miller, Federal Practice and Procedure: Civil 3d § 13776 (2009) in Note 4 by changing “2d” to “3d” and 1990 to 2009.
506.03 Exhibits Attached to Pleadings	Noted that current printouts of information from the electronic records of the Office of a plaintiff’s registrations filed by the plaintiff with its complaint may be considered in connection with a motion to strike.
507.01 Motion to Amend Pleading	Section Heading only
	Amended Fed. R. Civ. P. 15(a) and (b) to reflect the April 30, 2007 amendment.
	In the third paragraph of text, noted that in Board proceedings, there are two exceptions to the general rule that pleadings may be liberally amended: (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; and (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.
	Amended Note 1 to add *Fair Indigo LLC v. Style Conscience,* 85 USPQ2d 1536, 1539 (TTAB 2007) and to delete Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff,* 81 Trademark Rep. 302, 302 (1991).
	Amended Note 3 to reference the entirety of 37 CFR § 2.107.
	Amended Note 4 to add 37 CFR § 2.107(b) and to delete Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act; Final Rule, published in the Federal Register on September 26, 2003 at 68 FR 55748, specifically, summary of amendments at 55757.
507.02 Amendments – General Rule – Fed. R. Civ. P. 15(a)	In the first paragraph, deleted "at any time before a responsive pleading is served" to "within 21 days after serving it"; and amended dates for amending pleadings to which no responsive pleading is permitted to reflect 2007 changes in Fed. R. Civ. P. 15.
	In the second paragraph of the text added the statement that after the time for filing an opposition expires, the notice of opposition to a Trademark Act § 66 application may not be amended to add any goods or services. In the supporting Note 7, inserted 37 CFR § 2.107(b) and deleted the reference to Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act; Final Rule, published in the Federal Register on September 26, 2003 at 68 FR 55748, 55757.
	At the end of the third paragraph of the text, added the statement that the non-moving party should not argue against a motion for leave to amend because the non-moving party does not believe that the moving party will be able to prove the additional claim or allegations at trial.
	Added *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); *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) to Note 4.
	Deleted from Note 4: "*American Hygienic Labs, Inc. v. Tiffany & Co.,* 228 USPQ 855 (TTAB 1986); *Buffett v. Chi-Chi's, Inc*., 226 USPQ 428 (TTAB 1985); *Caron Corp. v. Helena Rubenstein, Inc.*, 193 USPQ 113 (TTAB 1976); *Anheuser-Busch, Inc. v. Martinez,* 185 USPQ 434 (TTAB 1975); *Cool-Ray, Inc. v. Eye Care, Inc.,* 183 USPQ 618 (TTAB 1974); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.,* 182 USPQ 511 (TTAB 1974); *Johnson & Johnson v. Cenco Medical/Health Supply Corp.,* 177 USPQ 586 (Comm'r 1973); *American Optical Corp. v. American Olean Tile Co*., 168 USPQ 471 (TTAB 1971). *See also* Beth A. Chapman*, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302, 305 (1991)."
	Added *Hurley International L.L.C. v. Volta,* 82 USPQ2d 1339, 1341 (TTAB 2007); and *Karsten Manufacturing Corp. v. Editoy AG,* 79 USPQ2d 1783, 1786 (TTAB 2006) to Note 5.
	Deleted "*Mack Trucks, Inc. v. Monroe Auto Equipment Co.,* 182 USPQ 511, 511-512 (TTAB 1974); and *Johnson & Johnson v. Cenco Medical/Health Supply Corp.,* 177 USPQ 586, 588 (Comm'r 1973)" from Note 5.
	Added at the end of Note 6 the following case citation: *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).
	Deleted from Note 8: "*See also, Microsoft Corp. v. Qantel Business Systems Inc*., 16 USPQ2d 1732, 1734 (TTAB 1990) (petitioner permitted to add allegation concerning respondent's assertion of infringement to support standing). [NOTE: This case was overruled by *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266 (TTAB 1994), to the extent that it held that Trademark Act § 18, 15 U.S.C. § 1068,

	may be invoked only when tied to a properly pleaded ground for opposition or cancellation.]".
507.02 Motion to Amend Pleading: Amendments – General Rule – Fed. R. Civ. P. 15(a)	Added *Giersch v. Scripps Networks Inc.,* 85 UPSQ2d 1306, 1309 (TTAB 2007); *Hurley International L.L.C. v. Volta,* 82 USPQ2d 1339, 1341 (TTAB 2007) to Note 9.
507.02 Motion to Amend Pleading: Amendments – General Rule – Fed. R. Civ. P. 15(a)	Deleted from Note 9: "*Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987) (defense of unclean hands insufficient because allegations were either unclear, non-specific, irrelevant to the defense or merely conclusory; defense of laches not available where ground is failure to control use of a certification mark); *American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855, 859 (TTAB 1986) (proposed amendment to add 2(d) claim denied as legally insufficient); and *W.R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670 (Comm'r 1977)."
	Deleted "*See also* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302, 307 (1991)" from Note 11.
507.02(a) Timing of Motion to Amend Pleading – In General	At the end of the second paragraph of text, added an explanation that the reopening of discovery pursuant to motion to amend the pleading may not be necessary when the information regarding the claim or allegation is within the knowledge or possession of the non-moving party.
	Added *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) to Note 1.
507.02(a) Timing of Motion to Amend Pleading – In General	Deleted "*Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267 (TTAB 1989), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (where plaintiff moved to amend after close of its testimony period, motion denied as untimely to extent it sought amendment under Rule 15(a)); *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989) (proceedings still in the discovery stage); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985) (no substantial prejudice to applicant by allowance of amendment where proceeding remained in a

	fairly early stage); *Long John Silver's, Inc. v. Lou Scharf Inc.*, 213 USPQ 263 (TTAB 1982) (opposer's motion to amend to rely on eight additional marks, shortly after the close of the discovery period, denied where opposer knew, or should have known, of the existence of the marks at the time the opposition was filed, and the discovery period had already been extended several times at opposer's request); *Caron Corp. v. Helena Rubenstein, Inc.*, 193 USPQ 113 (TTAB 1976) (neither party had as yet taken testimony); *Anheuser-Busch, Inc. v. Martinez,* 185 USPQ 434 (TTAB 1975) (proceeding was still in the pre-trial stage); *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974) (trial period had not yet commenced and no prejudice to applicant); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 182 USPQ 511 (TTAB 1974) (no testimony had as yet been taken); *American Optical Corp. v. American Olean Tile Co.,* 168 USPQ 471 (TTAB 1971) (applicant's motion to amend its pleading after the close of opposer's testimony period, but before the opening of applicant's testimony period, permitted); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302, 305 (1991)" from Note 1.
507.02(a) Timing of Motion to Amend Pleading – In General	Added *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); *Karsten Manufacturing Corp. v. Editoy AG,* 79 USPQ2d 1783, 1786 (TTAB 2006) to Note 2.
	Added *Black & Decker Corp. v. Emerson Electric Co.,* 84 USPQ2d 1482, 1486 (TTAB 2007) to Note 3 and deleted Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302, 305 (1991) from Note 3.
507.02(b) Timing of Motion to Add Counterclaim	Added *Zanella Ltd. v. Nordstrom Inc.,* 90 USPQ2d 1758, 1759 (TTAB 2008); *Turbo Sportswear Inc. v. Marmot Mountain Ltd.,* 77 USPQ2d 1152, 1154 (TTAB 2005) to Note 2 and deleted Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302, 306 (1991) from Note 2.

507.03 Amendments to Conform to the Evidence – Fed. R. Civ. P. 15(b)	Added reference to Fed. R. Civ. P. 15(b)(1) and (2).
507.03(a) During Trial After Objection to Trial Evidence	Clarified that motion for leave to amend should be promptly filed by party offering the evidence after objection is made by an adverse party.
507.03(b) To Add Issues Tried by Express or Implied Consent	At the end of the second paragraph of text, added the following: "Fairness dictates whether an issue has been tried by consent – there must be an absence of doubt that the non-moving party must be aware that the issue is being tried."
	Added *Morgan Creek Productions Inc. v. Foria International Inc.,* 91 USPQ2d 1134, 1138 (TTAB 2009) in Note 1.
	Added *Citigroup Inc. v. Capital City Bank Group, Inc.,* 94 USPQ2d 1645 (TTAB 2010); *Nextel Communications, Inc. v. Motorola, Inc.,* 91 USPQ2d 1393, 1399 (TTAB 2009); and *DC Comics v. Pan American Grain Mfg. Co.,* 77 USPQ2d 1220, 1223 (TTAB 2005) to Note 2.
	Deleted *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 (TTAB 1993) (no express or implied consent to try certain issues); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125 (TTAB 1990) (permitted to amend answer after trial to add an affirmative defense that was in fact tried); *Laboratoires du Dr. N.G. Payot Etablissement v. Southwestern Classics Collection Ltd.*, 3 USPQ2d 1600 (TTAB 1987) (motion to amend at time of final briefing granted); and *Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302, 309 (1991) from Note 2.
	Added *Morgan Creek Productions Inc. v. Foria International Inc.,* 91 USPQ2d 1134, 1138 (TTAB 2009) and *H.D. Lee Co. v. Maidenform Inc.,* 87 USPQ2d 1715, 1720-1721 (TTAB 2008) in Note 3 and deleted *Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302, 308 (1991) from Note 3.
	Added New Note 4, citing: *Safer Inc. v. OMS Investments Inc.,* 94 USPQ2d 1031 (TTAB 2010); and *Morgan Creek Productions Inc. v. Foria International Inc.,* 91 USPQ2d 1134, 1139 (TTAB

	2009).
	Deleted *Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302, 309 (1991) from Note 5.
508 Motion for Default Judgment for Failure to Answer	In the first paragraph, changed 20 days to "time to show cause" to conform with Board practice which is 30 days.
	Added a new penultimate paragraph explaining that defendant's entry into default stays the time for the parties to conduct a discovery conference and that in instances where an order to show cause is discharged, the Board will reset the appropriate dates. Added Note 4 citing Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. R. 42242, 42245 (August 1, 2007) in support.
509 Motion to Extend Time; Motion to Reopen Time	Amended Fed. R. Civ. P. 6(b) to reflect the April 30, 2007 amendment.
	Amended 37 CFR § 2.120(a) to reflect rules changes.
	Amended 37 CFR § 2.121 to reflect the rules changes.
	Amended 37 CFR § 2.127(a) to reflect rules changes.
509.01 Nature of Motions	At the end of the text, added an explanation noting that "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."
	In Note 1, added 37 CFR § 2.127(a) noting that the time for filing a reply brief will not be extended.
509.01(a) Motions to Extend Time	In the fourth paragraph of text, added a sentence explaining that if a defendant's motion to extend its time to answer is granted, the Board will reset all of the relevant deadlines, including the time for the discovery conference, disclosures, discovery and trial.
	Added a new fifth paragraph of text noting that after answer has been filed, Board is unlikely to find good cause for a 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. Added a new Note 6 citing *Boston Red Sox Baseball Club LP v. Chaveriat,* 87 USPQ2d 1767, 1767 n.1 (TTAB 2008), citing Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007) as authority.
	Added a new sixth paragraph of text noting that the time for filing a reply brief will not be extended. Added Note 7 citing 37 CFR § 2.127(a) as authority.
	Added *SFW Licensing Corp. v. Di Pardo Packing Ltd.,* 60 USPQ2d 1372, 1373 (TTAB 2001) and *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducali SCRL,* 59 USPQ2d 1383, (TTAB 2001) to Note 1.
	Added *National Football League v. DNH Management LLC,* 85 USPQ2d 1852, 1854 (TTAB 2008) to Note 2.
	Deleted "*Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1676 (TTAB 1988); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987) (desire to conduct follow-up discovery is not good cause for extension of discovery period where party seeking extension did not serve initial discovery requests until late in discovery period) and *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985) (opposer's motion to compel having been granted, it was reasonable to allow additional time, albeit less than requested, for opposer to complete discovery before proceeding with testimony); *Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582 (TTAB 1976); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975); and *Ortho Pharmaceutical Corp. v. Schattner*, 184 USPQ 556 (TTAB 1975)" from Note 4.
	Added *National Football League v. DNH Management LLC,* 85 USPQ2d 1852, 1854 (TTAB 2008) to Note 5.
509.01(b) Motions to Reopen Time	Section Heading only

509.01(b)(1) In General	In first paragraph of text, added a cross reference to TBMP § 508 regarding the requirement to show good cause to file a late answer.
	Added *Dating DNA LLC v. Imagini Holdings Ltd.,* 94 USPQ2d 1889, 1892-3 (TTAB 2010).
	Added *Old Nutfield Brewing Co. v. Hudson Valley Brewing Co*., 65 USPQ2d 1701, 1702 (TTAB 2002) and *Giersch v. Scripps Networks Inc.,* 85 USPQ2d 1306, 1307-1308 (TTAB 2007) to Note 3.
	Deleted *"Cf. Netcore Technologies, Inc. v. Firstwave Technologies, Inc.*, ___ USPQ2d ___, 2001 WL 243440 (TTAB 2001) (attorney's unwarranted and untimely request to withdraw from representation of party may not be used as subterfuge to obtain a reopening of time to which the party is not otherwise entitled)" from Note 6.
	Added with the *Cf.* signal *General Motors Corp. v. Cadillac Club Fashions Inc.,* 22 USPQ2d 1933, 1936 (TTAB 1992) to Note 6.
509.01(b)(2) To Introduce Newly Discovered Evidence	Added *Harjo v. Pro-Football, Inc.,* 45 USPQ2d 1789, 1790 (TTAB 1998) to Note 1.
	Added *L.C. Licensing Inc. v. Berman,* 86 USPQ2d 1883, 1886-1887 (TTAB 2008) to Note 2.
509.02 Form and Determination of Motions to Extend or Reopen	At the end of the first paragraph of text, added a statement explaining that after answer has been filed, the Board is unlikely to grant a consented motion to extend the time for the discovery conference based on settlement negotiations. Added Note 1 citing Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007) as authority.
	Added a new second paragraph in the text noting that when the parties file a stipulation or consented motion to extend or reopen the defendant's time to file an answer, they should include the times for all the subsequent dates.
	Amended to indicate that disclosure deadlines will be reset when testimony or discovery periods are reset.
	Added a new paragraph noting that when the parties agree to a new schedule of dates and file for approval using ESTTA, the system will prompt the filer to enter new deadlines that will allow the

	system to generate a new trial order.
	Deleted the original third paragraph of text because it no longer reflects current practice.
	Amended text to indicate that Board has discretion to suspend proceedings, sua sponte, for up to six months, and added statement that Board may request a progress report on the status of the parties' settlement discussions and periodically thereafter, citing, by comparison, *Shen Manufacturing Co. v. Ritz Hotel Ltd*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 n.2 (Fed. Cir. 2004) in new Note 4.
	Explained that a motion will not be granted as conceded until after the passage of sufficient time for the filing of a responsive brief, except that responding party may be excused from filing a responsive brief in the case of a telephone conference, and that if the motion is contested, the Board will decide the motion on its merits.
	Clarified that party must not assume a motion to extend or reopen will be granted as a matter of course. Also added disclosures to periods that may be requested be reset.
	Explained that the resetting of the closing date for discovery will reset the date for expert disclosure, pretrial disclosures and testimony periods.
	Amended text to reference the resetting of discovery as well as trial dates and added text to inform practitioners that requests to reset dates may be included in a pending motion. Added new Note 10 citing 37 CFR § 2.120(a)(3) as illustrative.
510 Motion to Suspend; Motion to Resume	Amended 37 CFR § 2.120(e)(2) to reflect rules changes.
510.01 In General	Added *Schering-Plough Animal Health Corp. v. Aqua Gen AS*, 90 USPQ2d 1184, 1185 (TTAB 2009); and *Carrini, Inc. v. Carla Carini, S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000) to Note 1.
510.02 Suspension Pending Outcome of Another Proceeding; Resumption	Section Heading only.
510.02(a) Suspension	Added reference to filing of civil action via ESTTA, and that ESTTA form requires filer to certify that the adverse party has consented to suspension of Board proceedings pending the outcome of the civil action.

	Deleted David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act*, 74 Trademark Rep. 180 (1984) from Note 1.
	Deleted Marc A. Bergsman, *TIPS FROM THE TTAB: The Effect of Board Decisions in Civil Actions; Claim Preclusion and Issue Preclusion in Board Proceedings,* 80 Trademark Rep. 540 (1990); and David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act*, 74 Trademark Rep. 180 (1984) from Note 2.
	Clarified parenthetical to *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) in Note 3.
	Deleted old Note 10, citing David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act*, 74 Trademark Rep. 180 (1984).
	Deleted old Note 13, citing David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act*, 74 Trademark Rep. 180 (1984).
510.02(b) Resumption	Language added that after decision in civil action, if one party moves for judgment on basis of the final decision in the civil action, the Board will issue a show cause order. Also changed date that Board will check on the status of pending civil action from two years to one year after suspension.
510.03 Suspension for Other Reasons; Resumption	Section Heading only
510.03(a) Suspension	In the section captioned "Upon motion or upon stipulation," added information on suspension after answer under new rules, to advise reader that mere desire to engage in settlement discussions is unlikely to constitute good cause for suspension filed after answer but because discovery conference. Added new paragraph advising that indefinite suspensions will not be granted, that Board may require parties to submit a detailed progress report, and that Board may deny suspension requests, together with new Note 4 citing by comparison, *Shen Manufacturing Co. v. Ritz Hotel Ltd*, 393 F.3d 1238, 73 USPQ2d

	1350, 1353 n. 2 (Fed. Cir. 2004).
	In the section captioned "Bankruptcy," added a statement that the Board may suspend a proceeding based on a plaintiff's bankruptcy for good cause shown.
	In the section captioned "Motion to compel," added "initial disclosures" and "expert testimony disclosures" to types of motions to compel that will invoke a Board suspension order. Also explained when the time period for making pretrial disclosures will be suspended.
	Changed the word "Testimony" in section captioned "Testimony depositions on written questions" to "Testimonial" and added a new section captioned "Discovery depositions on written questions" to indicate that upon notification, the Board will suspend proceedings or extend relevant dates to allow for the orderly completion of a deposition upon written questions.
	Added new Note 3, citing *Boston Red Sox Baseball Club LP v. Chaveriat*, 87 USPQ2d 1767, 1767 n.1 (TTAB 2008). *See also* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).
	In the section captioned "Settlement negotiations," explained that at the time the Board suspends a case for settlement, the Board will normally provide a trial schedule that will automatically go into effect upon resumption. Deleted statements that reflect former practice of indefinite suspension.
	Added citation to *Super Bakery Inc. v. Benedict,* 96 USPQ2d 1134, 1135 (TTAB 2010) in Notes 9, 10, and 11.
510.03(b) Resumption	In the section captioned "Bankruptcy," changed date that Board will check on the status of pending bankruptcy from "every two years" to "once a year."
	In the section captioned "Withdrawal of counsel," clarified that where proceedings have been suspended and a party appoints new counsel or advises the Board that it will represent itself pro se, the Board will resume proceedings.
	In the section captioned "Potentially dispositive

	motion," added that Board will reset appropriate dates in order resuming proceeding, following decision on motion that does not dispose of the case.
511 Motion to Consolidate	Amended Fed. R. Civ. P. 42(a) to reflect rules changes.
	Amended third paragraph to delete "The oldest (i.e., first-filed) of the consolidated cases is treated as the "parent" case."
	Amended fourth paragraph to add that parties represented by more than one attorney should provide one point of contact with the Board.
	Amended fifth paragraph to indicate that pleadings and judgment are entered separately in each consolidated proceeding and that Board will reset all dates (not just trial dates) upon consolidation.
	Added information on consolidation of cases instituted after November 1, 2007 with those filed prior thereto.
	Added *M.C.I. Foods Inc. v. Bunte,* 86 USPQ2d 1044, 1046 (TTAB 2008) to Note 1.
	Added *Dating DNA LLC v. Imagini Holdings Ltd.,* 94 USPQ2d 1889 (TTAB 2010) to Note 2 and deleted Wright & Miller, *Federal Practice and Procedure*: Civil 3d § 2383 (2009) from Note 2.
	Added to Note 5: *Dating DNA LLC v. Imagini Holdings Ltd.,* 94 USPQ2d 1889 (TTAB 2010) (motion to consolidate granted); *Venture Out Properties LLC v. Wynn Resorts Holdings LLC,* 81 USPQ2d 1887, 1889 (TTAB 2007).
	Deleted from Note 5: Wright & Miller, Federal Practice and Procedure: Civil 3d § 2383 (2009); *Bigfoot 4x4 Inc. v. Bear Foot Inc.,* 5 USPQ2d 1444 (TTAB 1987) (joint motion); *Federated Department Stores, Inc. v. Gold Circle Insurance Co.,* 226 USPQ 262 (TTAB 1985) (motion); and *Plus Products v. Medical Modalities Associates, Inc.,* 211 USPQ 1199 (TTAB 1981), set aside on other grounds and new decision entered, 217 USPQ 464 (TTAB 1983).
511 Motion to Consolidate	Added *Dating DNA LLC v. Imagini Holdings Ltd.,* 94 USPQ2d 1889 (TTAB 2010) to Note 9. Deleted Wright & Miller, *Federal Practice and Procedure*: Civil 3d § 2382 (2009) from Note 9.
512 Motion to Join or	Section Heading only.

Substitute	
512.01 Assignment of Mark	In the second paragraph, inserted “with the USPTO” and “in the Board proceeding record” to indicate that proof of assignment must be noticed to the Board.
	Added *Life Zone Inc. v. Middleman Group Inc.,* 87 USPQ2d 1953, 1955 n.1 (TTAB 2008) to Note 1; added new Note 8, citing *Drive Trademark Holdings LP v. Inofin,* 83 USPQ2d 1433, 1434 n.1 (TTAB 2007); and added *Drive Trademark Holdings LP v. Inofin,* 83 USPQ2d 1433, 1434 n.2 (TTAB 2007) to Note 9.
	Added new Note 15, citing: *Amazon Technologies Inc. v. Wax,* 95 USPQ2d 1865, 1871 (TTAB 2010).
512.02 Change of Name	No changes made.
512.03 Issuance of Registration to Assignee, or in New Name	Corrected “Assignment Division” to “Assignment Services Division” in paragraph three; added new Note 1, citing: *Smart Inventions Inc. v. TMB Products LLC*, 81 USPQ2d 1383, 1384 n.3 (TTAB 2006).
512.04 Misidentification	Added references to Fed. R. Civ. P. 15(a)(1) and (2); added reference to 15 U.S.C.§ 1063(a).
	Clarified statement in first paragraph indicating that Board may allow amendment of complaint where plaintiff can establish misidentification through mistake, by deleting “When it is shown to the satisfaction of the Board that a party in whose name a Board proceeding complaint was filed was misidentified therein by mistake” and replacing it with statement identifying plaintiff as the party that has made the mistake.
	Deleted original paragraph two, which did not identify which party misidentified applicant in an application (or registration) which is the subject of a Board proceeding, and replaced the paragraph with new paragraph two, identifying plaintiff as the mistaken party and clarifying that plaintiff may only correct a misidentification within the time for filing an opposition (in the case of an opposition) and within the time for petitioning to cancel the intended registration (in a cancellation action).
	Added a new paragraph three explaining when an applicant may correct a defect in identifying itself in the application.
	Added *Great Seats Ltd. v. Great Seats Inc.*, 84

	USPQ2d 1235, 1240 (TTAB 2007) to Note 4.
513 Motion to Withdraw as Representative; Petition to Disqualify	Section Heading only.
513.01 Motion to Withdraw as Representative	Deleted "*Netcore Technologies, Inc. v. Firstwave Technologies, Inc*., ___ USPQ2d ___, 2001 WL 243440 (TTAB 2001) from Note 1.
	Deleted "*Netcore Technologies, Inc. v. Firstwave Technologies, Inc*., *supra"* from Note 3
	Deleted "*Netcore Technologies, Inc. v. Firstwave Technologies, Inc*., *supra"* from Note 4.
	Added *CTRL Systems Inc. v. Ultraphonics of North America Inc.,* 52 USPQ2d 1300 (TTAB 1999) to Note 5.
513.02 Petition to Disqualify	Replaced reference to 37 CFR § 10.130(b) with reference to 37 CFR § 11.19(c) (formerly 10.19(c)); and replaced reference in second paragraph to "37 CFR §§ 10.130-10.170" with reference to 37 CFR §§ 11.19-11.60; also replaced reference to "37 CFR § 10.130(b)" with 37 § CFR 11.19(c).
	Amended text to indicate that Chief Administrative Trademark Judge may delegate his/her responsibility to decide petitions to a Board judge or attorney for signature by the Chief Administrative Trademark Judge.
514.01 In General	Added information in the first paragraph to advise reader that while an unconsented substantive amendment is generally deferred to final decision or summary judgment, if applicant consents to entry of judgment with respect to the broader scope of goods/services, an amendment to delete goods/services from the application may be approved on motion prior to trial. Added new Note 2 in support, citing *Enbridge Inc. v. Excelerate Energy Ltd. Partnership,* 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 (TTAB 1990) (motion to amend identification of goods deferred); *Fort Howard Paper Co. v. C.V. Gambina Inc*., 4 USPQ2d 1552 (TTAB 1987) (motion to amend dates of use deferred); and *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB 1985); added new

	Note 3, citing *Drive Trademark Holdings LP v. Inofin,* 83 USPQ2d 1433, 1435 (TTAB 2007) in Note 3.
	In the fourth paragraph, deleted references to Trademark Act § 66(a) registrations.
	Amended seventh paragraph to include further explanation regarding amendments made through WIPO to Trademark Act § 66(a) applications and registrations, and added a new Note 9 citing 37 CFR § 2.134(b) in support.
	In paragraph eight, deleted references to Trademark Act § 66(a) registrations, including the statement that Requests to record changes to a Trademark Act § 66(a) registration must be filed with the International Bureau
	Deleted old footnote 250, which read as follows: "Amendments to 66(a) registrations are not made under Section 7 of the Trademark Act. Requests to record changes to 66(a) registrations must be filed with the International Bureau. See 37 CFR §§ 7.22 and 7.25. Although Trademark Rule 7.25 specifically exempts only a "request for extension of protection" (a 66(a) application) from application of certain rules in part 2 of 37 CFR, including Rules 2.172 (surrender for cancellation), 2.160-2.166 (Section 8 affidavits), and 2.173 (amendment of registrations), it is clear from the nature of the excepted provisions that Rule 7.25 is intended to apply to a 66(a) registration as well as a 66(a) application."
	Deleted old footnote 251, which read as follows: "The mark in a 66(a) application or registration cannot be amended. See 37 CFR § 2.72 providing only for amendments to the mark in Section 1 and 44 applications and the International Bureau's Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol, Para. B.II.69.02 (2002) at www.wip.int/madrid/en/guide. See also Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act; Final Rule, published in the Federal Register on September 26, 2003 at 68 FR 55748, 55756."
	Added *Drive Trademark Holdings LP v. Inofin,* 83 USPQ2d 1433, 1435 (TTAB 2007) to Note 5 and

	deleted Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today,* 81 Trademark Rep. 408 (1991) from Note 5.
	Deleted old footnote 255, which read as follows: "Requests to record amendments to 66(a) registrations are filed with the International Bureau, not with Post Registration. See 37 CFR § 7.22 and Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act; Final Rule, published in the Federal Register on September 26, 2003 at 68 FR 55748, 55756."
	Added *Drive Trademark Holdings LP v. Inofin,* 83 USPQ2d 1433, 1435 (TTAB 2007) to Note 7.
	Added *Hachette Filipacchi Presse v. Elle Belle LLC,* 85 USPQ2d 1090, 1095 (TTAB 2007) to Note 8; changed "examining operation" to "Trademark Examining Operation."
514.02 Amendment With Consent	Clarified parenthetical to *Vaughn Russell Candy Co. and Toymax Inc. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635 (TTAB 1998) in Note 1 to indicate that proposed amendment not approved when other parties' consent was not obtained.
514.03 Amendment Without Consent	Added *Drive Trademark Holdings LLC v. Inofin,* 83 USPQ2d 1433, 1435 (TTAB 2007) to Note 1, and *Drive Trademark Holdings LLC v. Inofin,* 83 USPQ2d 1433, 1435-46 (TTAB 2007) to Note 2.
	Deleted Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today,* 81 Trademark Rep. 408 (1991) from Notes 2, 3, 4, and 7. Deleted old footnote 266, citing to "Louise E. Rooney, TIPS FROM THE TTAB: Rule 2.133 Today, supra."
	Added *Enbridge Inc. v. Excelerate Energy Ltd. Partnership,* 92 USPQ2d 1537, 1539 n.3 (TTAB 2009) to Note 3.
	Deleted "See also Exam Guide No. 2-03, Guide to Implementation of Madrid Protocol in the United States, (part IV.N.) (October 28, 2003)" from Note 6 and added "*See also* TMEP § 1904.06" to Note 6.
	Added *Jansen Enterprises Inc. v. Rind,* 85 USPQ2d 1104, 1106 n.3 (TTAB 2007) to Note 8 and corrected grammatical expression "is an insufficient pleading" to "constitute an insufficient pleading" in Note 8.
514.03 Amendment Without	Deleted Louise E. Rooney, *TIPS FROM THE*

Consent	*TTAB: Rule 2.133 Today*, 81 Trademark Rep. 408 (1991); and Janet E. Rice, *TIPS FROM THE TTAB: Newest TTAB Rule Changes; More Tips on Concurrent Use Proceeding*s, 76 Trademark Rep. 252 (1986) from Note 10.
514.04 Amendment to Allege Use; Statement of Use	No changes.
515 Motion to Remand Application to Examining Attorney	In the third paragraph, changed "may, in addition to determining the pleaded matters, include a recommendation that in the event applicant ultimately prevails in the inter partes proceeding, the examining attorney reexamine" to "will, in addition to determining the pleaded matters, include a recommendation that in the event applicant ultimately prevails in the inter partes proceeding, the examining attorney shall reexamine…"
516 Motion to Divide Application or Registration	Changed fourth paragraph to reflect electronic environment; added statement in fifth paragraph regarding rarity of denials of requests to divide; added new Note 4, citing *Drive Trademark Holdings LP v. Inofin,* 83 USPQ2d 1433, 1436 n.10 (TTAB 2007).
517 Motion to Strike Brief on Motion	Deleted reference to papers filed in violation of the rules as being returned to filing party in first paragraph; added statement about parties' options for filing evidentiary objections and added statement to inform reader that Board will not strike an entire brief based on evidentiary objections.
	In third paragraph, added statements to inform reader that decision whether to grant a motion as conceded is within Board's discretion, that surreply briefs will be given no consideration, and that parties should not file motions to strike surreply or later-filed briefs. Also, added information for practitioner regarding Board's authority to sua sponte strike or give no consideration to overly long briefs.
	Added new Note 2, citing *Corporacion Habanos S.A. v. Guantanamera Cigars*, 86 USPQ2d 1473, 1474 (TTAB 2008).
	Added new Note 3, citing 37 CFR § 2.127(a).
518 Motion for Reconsideration of Decision	Changed references "administrative trademark judge" to "judge" and "Interlocutory attorney" to

on Motion	"attorney"; added new Note 7, citing *See Vignette Corp. v. Marino,* 77 USPQ2d 1408, 1411 (TTAB 2005*).*
519 Motion for Leave to Serve Additional Interrogatories	Added statement to inform practitioners that motion for leave to serve additional interrogatories is disfavored.
	Deleted Helen R. Wendel, *TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1),* 82 Trademark Rep. 89 (1992) from Note 1.
520 Motion to Take Foreign Deposition Orally	Added statements regarding the procedures through which parties may invoke the Hague Convention to obtain evidence in another country; added new Note 3 regarding procedure set forth in Hague Convention, citing *Hewlett-Packard Co. v. Healthcare Personnel, Inc.,* 21 USPQ2d 1552 (TTAB 1991); and added *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998) to Note 6.
	Added the following: "which is to be in compliance with local laws" to the end of the sentence comprising paragraph four in the text.
521 Motion to Quash Notice of Deposition	Added ground for quashing testimonial deposition based on insufficient pretrial disclosure, and added new Note 9 in support, citing by comparison *Jules Jurgenson/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443 (TTAB 2009).
	In fourth paragraph, added practice tip for practitioners to file motion to quash rather than motion to strike where insufficient pretrial disclosures are involved; added language about Board's discretion to conduct telephone conferences.
	Added *National Football League v. DNH Management LLC,* 85 USPQ2d 1852, 1855 (TTAB 2008) to Note 1.
	In Note 2, changed signal introducing *Gold Eagle Products Co. v. National Dynamics Corp*., 193 USPQ 109 (TTAB 1976) from "Compare" to "see."
	Deleted "as a party is not required to discuss settlement" from Note 2 and changed "was baseless" to "was found baseless."
	Added *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 (TTAB 2007) to Note 6.

522 Motion for Order re Manner or Place of Document Production	Added discussion regarding place of production, to inform reader that responding party's obligation is to make documents and things available for inspection but that in Board proceedings, responding party generally copies and sends documents to the requesting party. Added new Note 1 and new Note 2 in support, citing *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) in each.
	Added *M.C.I. Foods Inc. v. Bunte,* 86 USPQ2d 1044, 1048 (TTAB 2008) *citing No Fear v. Rule,* 54 USPQ2d 1551 (TTAB 2000) to Note 3.
	Deleted from Note 4: Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 385 (1985); and Janet E. Rice, TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules, 74 Trademark Rep. 449, 451 (1984).
523 Motion to Compel Disclosure or Discovery (new title)	Amended 37 CFR § 2.120(e) to reflect 2007 changes.
	In the first paragraph, added information about availability of motions to compel or supplement disclosures and attendance at a discovery conference.
	Deleted second paragraph in its entirety, which read as follows: "Alternatively, if a witness objects to, and refuses to answer (or answer adequately), a question propounded during a discovery deposition, the propounding party may obtain an immediate ruling on the propriety of the objection by 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 answer." Also deleted old footnote 311, citing to TBMP §§ 404.09 and 411.03 in support.
	Added new second paragraph to the text, explaining procedures for objecting to questions propounded during discovery deposition and procedures where witness refuses to answer questions propounded during deposition taken under subpoena.
	Added new third paragraph to text to inform reader that failure to propound initial disclosures

	will bar party from serving traditional forms of discovery or from filing a motion to compel.
	Amended paragraph four to indicate that proceedings will be suspended upon the filing of a motion to compel disclosures, and that when the motion is filed after the close of discovery but prior to the opening of the first testimony period, the time for making pretrial disclosures will be reset.
	Amended paragraph five to add references to timing of motion to compel initial disclosures or expert testimony disclosure under 37 CFR § 2.120(e)(1).
	Deleted notice that opening of the first testimony period is increased from thirty days to sixty days, and substituted statement that the period is sixty days.
	Added statement to end of paragraph five to inform reader that motion to compel discovery is untimely if filed after the first testimony period commences, even if subsequently reset.
	Added *Johnson and Johnson and Roc International S.A.R.L. v. Obschestvo s Oranitchennoy; Otvetstvenn Ostiu "Wds,"* 95 USPQ2d 1567 (TTAB 2010) to Note 1.
	Added new Note 2, citing *Promgirl Inc. v. JPC Co.,* 94 USPQ2d 1759 (TTAB 2009). Also noted that motion to compel party to participate in discovery conference is not prerequisite to motion for sanctions.
	Added new Note 3, citing *Influance Inc. v. Zuker*, 88 USPQ2d 1859, 1860 n.3 (TTAB 2008).
	Added new Note 4, citing 37 CFR § 2.120(e); and *Neville Chemical Co. v. Lubrizol Corp*, 183 USPQ 184, 189 (TTAB 1974).
	Added new Note 5, citing 37 CFR § 2.120(a)(3); *Dating DNA LLC v. Imagini Holdings Ltd.,* 94 USPQ2d 1889 (TTAB 2010); *Amazon Technologies v. Jeffrey S. Wax,* 93 USPQ2d 1702 (TTAB 2009); and *MySpace, Inc. v. Donnell Mitchell,* 91 USPQ2d 1060, 1060 (TTAB 2009).
	Added *HighBeam Marketing LLC v. Highbeam Research LLC,* 85 USPQ2d 1902, 1907 (TTAB 2008) to Note 6.
	Added *H.D. Lee Co. v. Maidenform Inc.,* 87 USPQ2d 1715, 1719 n.10 (TTAB 2008) to Note

	7.
	Added new Note 8, citing, in comparison. *La Maur, Inc. v. Bagwells Enterprises, Inc.,* 193 USPQ 234 (Comm'r 1976).
523.02 Special Requirements for Motion	Amended quoted portion of 37 CFR § 2.120(e) to reflect 2007 changes.
	In second paragraph, added reference to "disclosures or discovery" to inform reader that motion to compel both must be supported by written statement.
	In the third paragraph, indicated that ESTTA was the preferable method for notifying the Board of resolution of any issues pertaining to the motion to compel.
	Added a reference to TBMP § 526 to fourth paragraph.
	Added *Amazon Technologies, Inc. v. Jeffrey S. Wax,* 93 USPQ2d 1702, 1705 (TTAB 2009); and *Pioneer Kabushiki Kaisha v. Hitachi,* 74 USPQ2d 1672, 1679 n.1 (TTAB 2005) to Note 2.
	Deleted: "*See also Ford Motor Co. v. Shelby International, Inc.*, 193 USPQ 236 (TTAB 1976); *Daimler-Benz Aktiengesellschaft v. Hibner Products Mfg., Inc.*, 189 USPQ 479 (TTAB 1976); *Varian Associates v. Fairfield Nobel Corp.*, 188 USPQ 581 (TTAB 1975*); J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 581 (TTAB 1975); *Penthouse International Ltd. v. Dyn Electronics, Inc.*, 184 USPQ 117 (TTAB 1974); and *Angelica Corp. v. Collins & Aikman Corp.*, 183 USPQ 378 (TTAB 1974)" from Note 2.
	Clarified parenthetical to *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984)in Note 2 by changing "it was clear from the nature …" to "the nature … clearly demonstrated."
523.03 Time for Filing Motion	Amended 37 CFR § 2.120(e) to reflect 2007 changes.
	Added discussion of timing for motion to compel disclosures and added new Note 1 in support of rule that motion to compel disclosures must be filed prior to close of discovery period, citing 37 CFR § 2.120(e). Also added explanation of timing regarding "as last reset" with respect to the opening of plaintiff's testimony period acting as

	deadline for filing motion to compel, and added new Note 5 in support, citing, by comparison, *La Maur, Inc. v. Bagwells Enterprises, Inc.,* 193 USPQ 234 (Comm'r 1976).
	Added *H.D. Lee Co. v. Maidenform, Inc.,* 87 USPQ2d 1715, 1719 n.10 (TTAB 2008) to Note 2.
	Added new Note 3, citing 37 CFR § 2.120(e).
	Added *MySpace, Inc. v. Donnell Mitchell,* 91 USPQ2d 1060, 1061 n.2 (TTAB 2009) to Note 4.
523.04 Failure to File Motion to Compel	Replaced the word "test" with the word "challenge" in the text.
	Added *H.D. Lee Co. v. Maidenform Inc.,* 87 USPQ2d 1715, 1719 (TTAB 2008) to Note 1.
	Clarified parenthetical to *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383 (TTAB 2001) in Note 1.
	Deleted the following from Note 1: "In addition, *see Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co*., 204 USPQ 76 (TTAB 1979); *Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468 (TTAB 1976); and *Comserv Corp. v. Comserv*, 179 USPQ 124 (TTAB 1973)."
524 Motion to Test Sufficiency of Response to Requests for Admission (new title)	Section Heading only.
524.01 In General	Edited Fed. R. Civ. P. 36(a) to reflect amendments, inserting Fed. R. Civ. P. 36(a)(3) and 36(a)(6) in place of "old" 36(a); amended 37 CFR § 2.120(h) to reflect rule changes.
	Added new paragraph regarding improper responses and deemed admissions, and added new Notes 3 and 4 in support, citing, by comparison, comments to Fed. R. Civ. P. 36(a)(4 – 6) in new Note 3, and citing Fed. R. Civ. P. 36(a)(3) in new Note 4.
524.02 Special Requirements for Motion	Deleted the signal "see" from Notes 1, 2, and 3 before the reference to 37 CFR § 2.120(h). Also added *Amazon Technologies v. Wax,* 93 USPQ2d 1702 (TTAB 2009) (TTAB 2009) to Note 2.
	In the third paragraph, added instruction that moving party should immediately inform Board,

	through ESTTA, if any issues raised in the motion to test are resolved before adjudication of the motion.
524.03 Time for Filing Motion	Amended quoted portion of 37 CFR § 2.120(h)(2).
	Added further explanation of rule that motion to test may not be filed once plaintiff's trial period opens, even if reset to reopen at later date.
	Added new Note 1, citing 37 CFR § 2.120(h)(1).
524.04 Failure to File Motion	Deleted from Note 1: "*See Watercare Corp. v. Midwesco-Enterprise, Inc.,* 171 USPQ 696 (TTAB 1971).
	Deleted from Note 1: "*Cf. also* TBMP § 527.04 (regarding effect of failure to timely respond to requests for admission)."
	Added to Note 1: 37 CFR § 2.120(h)(1).
525 Motion to Withdraw or Amend Admission	Added Fed. R. Civ. P. 6(b)(2); edited Fed. R. Civ. P. 36(b) to reflect amendments.
	Amended first paragraph to inform reader that if party fails to respond to requests for admissions, serving party need not file a motion to deem matter admitted.
	Added new second paragraph, explaining the two avenues for relief from having matter deemed admitted for failure to respond to a requests for admissions. Added new Note 3 in support, citing *Giersch v. Scripps,* 85 USPQ2d 1306, 1307 (TTAB 2007).
	Added *Giersch v. Scripps Networks, Inc.,* 85 USPQ2d 1306, 1308-09 (TTAB 2007) to Note 4.
	Amended parentheticals to *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989) in Note 5.
526 Motion for a Protective Order	Amended quoted portion of 37 CFR § 2.120(f); added discussion about Board's standard protective order.
	At the end of the third paragraph, added reference, by comparison, to TBMP § 523.02.
	Amended the fourth paragraph to indicate that motion for protective order that discovery not be had is appropriate when party has not provided its initial disclosures.
	Deleted sixth paragraph in its entirety, which read

	as follows: "When the Board grants a request for a protective order with respect to confidential or trade secret information, it may direct either the disclosing party, or the parties together, to prepare an order with terms that are mutually agreeable to them. Other alternatives involve accepting a protective agreement proffered by a party or ordering parties to adhere to Board's standard agreement. Parties are encouraged, however, to stipulate to a protective agreement governing the handling of confidential or trade secret information rather than filing a motion for a protective order."
526 Motion for a Protective Order	Deleted "old" footnote 336, which read as follows: "*See, for example, Johnston Pump/General Valve Inc. v. Chromalloy American Corp., supra;* and *Neville Chemical Co. v. Lubrizol Corp., supra.*"
	Added a new paragraph of text to inform the reader about imposition of Board's standard protective order in all proceedings, and alternatives available to parties; added new Note 5 in support, citing 37 CFR § 2.116(g) and added new Note 6 in support, citing *Bausch & Lomb v. Karl Storz GmbH*, 87 USPQ2d 1526, 1532 (TTAB 2008). *See also Red Wing Co. v. Smucker Co.*, 59 USPQ2d 1861, 1862 (TTAB 2001).
	Added *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.,* 74 USPQ2d 1672 (TTAB 2004) to Note 3 and deleted "*See also* TBMP § 412 (Protective Orders)" from Note 3.
	Deleted *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975); and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 387-388 (1985) from Note 4.
527 Motion for Sanctions	Section Heading only.
527.01 Motion for Discovery Sanctions	Section Heading only.
527.01(a) For Failure to Comply With Board Discovery Order	Amended reference to 37 CFR 2.120(g) to reflect recent rule changes.
	Added new second paragraph to inform reader that sanctions may be appropriate for a party's refusal to participate in a discovery conference

	and that motion to compel participation in discovery conference is not prerequisite to sanctions, but that good faith efforts must be shown.
	Amended fourth paragraph to advise reader that there is no good faith effort requirement for motion for discovery sanctions, but that sanctions for failure to serve initial disclosures not available until party is in noncompliance with a motion to compel that has been granted.
	Deleted the "see" signal before reference to 37 CFR § 2.120(g)(1) in Note 1; changed signal from "see" to "cf." before reference to *Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448 (Fed. Cir. 1988) in Note 1; and added *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC,* 88 USPQ2d 1541, 1543 (TTAB 2008); and *Nobelle.com LLC v. Qwest Communications Int'l Inc.,* 66 USPQ2d 1300, 1303 (TTAB 2003) to Note 1.
	Deleted the "see" signal before reference to 37 CFR § 2.120(g)(1) in Note 2.
	Added new Note 3, citing, by comparison, *Promgirl, Inc. v. JPC Co., Ltd.,* 94 USPQ2d 1759 (TTAB 2009).
	Added new Note 4, citing 37 CFR § 2.120(g)(1); *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC,* 88 USPQ2d 1541, 1543 (TTAB 2008); and *HighBeam Marketing LLC v. HighBeam Research LLC,* 85 USPQ2d 1902, 1904 (TTAB 2008).
	Added new Note 5, citing, as by example, *Promgirl, Inc. v. JPC Co., Ltd.,* 94 USPQ2d 1759 (TTAB 2009); and *Guthy-Renker Corp. v. Boyd,* 88 USPQ2d 1701, 1704 (TTAB 2008).
	Amended Note 6 to add *M.C.I. Foods Inc. v. Bunte,* 86 USPQ2d 1044, 1048 (TTAB 2008); and *HighBeam Marketing LLC v. HighBeam Research LLC,* 85 USPQ2d 1902, 1905 (TTAB 2008); also amended Note 6 to add *Nobelle.com LLC v. Qwest Communications Int'l Inc., 6*6 USPQ2d 1300, 1303 (TTAB 2003). Deleted "*Ingalls Shipbuilding, Inc. v. United States, supra"* from Note 6.
	Added new Note 10, citing *HighBeam Marketing LLC v. HighBeam Research LLC,* 85 USPQ2d

	1902 (TTAB 2008).
	Added new Note 11, citing *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC,* 88 USPQ2d 1541, 1543 (TTAB 2008).
	Added new Note 12, citing *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC,* 88 USPQ2d 1541, 1543 (TTAB 2008).
527.01(b) If Party Says it will not Respond to Discovery Request or Make Required Disclosures (new title)	Amended reference to 37 CFR § 2.120(g)(2) to reflect recent rule changes.
	Amended first paragraph to add information regarding motions for sanctions for failure to provided initial disclosures or expert disclosures.
	Amended first paragraph to inform parties when to file motion for sanctions under 37 CFR § 2.120(g)(2) and when to file under 37 CFR § 2.120(g)(1)
	Added new Note 1, citing *Kairos Institute of Sound Healing LLC v. Doolittle Gardens, LLC,* 88 USPQ2d 1541, 1542-43 (TTAB 2008).
527.01(c) Untimely Response to Discovery Requests	In Note 3, changed the parenthetical to *No Fear Inc. v. Rule,* 54 USPQ2d 1551, 1554 (TTAB 2000) from "(party will generally not be found to have waived the right to make these objections)" to "(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	Amended second paragraph to instruct practitioners against filing a motion to deem requests admitted when no responses to requests for admission have been served.
527.01(e) Estoppel Sanction	Amended to caution reader that unless refusal is "unequivocal," estoppel sanction may not apply.
	Added new Note 1, citing *Panda Travel, Inc. v. Resort Option Enterprises, Inc.,* 94 USPQ2d 1789 (TTAB 2009).
	Deleted from Note 2: "Additional cases: *Sunkist Growers, Inc. v. Benjamin Ansehl Co*., 229 USPQ 147 (TTAB 1985); *Era Corp. v. Electronic Realty Associates, Inc*., 211 USPQ 734 (TTAB 1981); *Visual Information Institute, Inc. v. Vicon Industries Inc*., 209 USPQ 179 (TTAB 1980); *Shoe Factory Supplies Co. v. Thermal*

	Engineering Co., 207 USPQ 517 (TTAB 1980); *Refreshment Machinery Inc. v. Reed Industries, Inc.*, 196 USPQ 840 (TTAB 1977); *Autac Inc. v. Walco Systems, Inc.,* 195 USPQ 11 (TTAB 1977); and *Georgia-Pacific Corp. v. Great Plains Bag Co*., 190 USPQ 193 (TTAB 1976). *Cf. Nestle Foods Corp. v. Kellogg Co*., 6 USPQ2d 1145 (TTAB 1988); *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444 (TTAB 1987); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co*., 204 USPQ 76 (TTAB 1979); and *Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468 (TTAB 1976)."
	Added new Note 3, citing *Vignette Corp. v. Marino,* 77 USPQ2d 1408, 1411 (TTAB 2005)
527.01(f) Motions in Limine (New)	Added new section discussing Board's practice regarding prospective rulings on evidence. Includes addition of new Note 1, citing *Greenhouse Systems Inc. v. Carson,* 37 USPQ2d 1748, 1750 (TTAB 1995); and new Note 2, citing *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.,* 77 USPQ2d 1492 (TTAB 2005); and *JSB Int'l Inc. v. Auto Sound North Inc.,* 215 USPQ 60 (TTAB 1982).
527.02 Motion for Fed. R. Civ. P. 11 Sanctions	Amended references to Fed. R. Civ. P. 11(b), (c) and (d) and 37 CFR § 11.18 (formerly 10.18) to reflect rules changes.
527.02 Motion for Fed. R. Civ. P. 11 Sanctions	Added new fourth paragraph on "safe harbor" provisions under Fed. R. Civ. P. 11(c)(2) and informs reader that Board will not grant Rule 11 motions which fail to comply with this requirement.
	Amended sixth paragraph by amending former 37 CFR § 10.18 to § 11.18, and added, to the end of the last sentence in this paragraph, the following: "and any appropriate complaint should be brought to the attention of the Office of Enrollment and Discipline."
	Added new Note 6, citing *Carrini Inc. v. Carla Carini, Srl,* 57 USPQ2d 1067, 1071 (TTAB 2000).
	Changed reference from "37 CFR § 10.18" to "37 CFR § 11.18" in Note 7; added reference to 37 CFR part 11 in Note 7; and changed "See 37 CFR §§ 10.18(d) and 10.20, et.seq." to "*See* 37 CFR §§ 11.18(d) and 11.20, et.seq." in Note 7.

527.03 Inherent Authority to Sanction	Deleted parallel references from *Chambers v. NASCO, Inc.*, 501 U.S. 32 (1991) in Note 1, which read: "111 S.Ct. 2123, 115 L.Ed.2d 27, rehearing denied, 501 U.S. 1269, 112 S.Ct. 12, 115 L.Ed.2d 1097."
	Added *HighBeam Marketing LLC v. HighBeam Research LLC,* 85 USPQ2d 1902, 1906-07 (TTAB 2008) in Note 2 and changed "insured" to "ensured."
528 Motion for Summary Judgment and Accelerated Case Resolution (ACR)	Deleted old Fed. R. Civ. P. 56 and inserted new Rule 56, but prior to December 1, 2010 amendment.
528.01 General Nature of Motion	Amended first paragraph to replace "depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any" with "discovery and disclosure materials on file, and any affidavits." Added language in eleventh paragraph to clarify length of briefs. Added new paragraph twelve clarifying time for appeal of summary judgment determination. Added new paragraph thirteen to indicate that partial summary judgment may be appropriate. Updated footnotes with new cites and deleted outdated TIPS articles from footnotes 3 and 14.
	Added new parenthetical to *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1390-91 (TTAB 1994) in Note 2.
	Deleted from Note 3: "See also T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413, 413-414 (1990); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: Inter Partes Summary Judgment Revisited*, 76 Trademark Rep. 73, 77-78 (1986)."
	Added reference to *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) in Note 3.
	Added pin cite and parenthetical to *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1479 (TTAB 1998) in Note 4.
	Added parenthetical to *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986) in Note 6.
	Added *Enbridge, Inc. v. Excelerate Energy Limited Partnership*, 92 USPQ2d 1537, 1540

	(TTAB 2009); and *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1860 (TTAB 2007) to Note 6.
	Added *Venture Out Properties LLC v. Wynn Resort Holdings LLC*, 81 USPQ2d 1887, 1890 (TTAB 2007) to Note 7.
	Added "nonmovant" in parenthetical to *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992) in Note 8; added parenthetical to *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001) in Note 8.
	Added parenthetical to *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992) in Note 10.
	Added, by comparison, *Honda Motor Co., Ltd. v. Friedrich Winkelmann*, 90 USPQ2d 1660, 1662 (TTAB 2009) to Note 10.
	Added parenthetical to *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992) in Note 11.
	Reversed order of citation of *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986); and *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1879 (TTAB 1998) in Note 12.
	Added references to *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433 (TTAB 2007); and *Fishking Processors Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1764 (TTAB 2007) in Note 14.
	Deleted "old" footnote 377, citing "See T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990)."
	Added *Cooper Technologies Co. v. Denier Electric Co.*, 89 USPQ2d 1478, 1479 (TTAB 2008) to Note 16.
	Added new Note 17, citing *Copelands' Enterprises, Inc. v. CNV, Inc.*, 887 F.2d 1065, 12 USPQ2d 1563 (Fed. Cir. 1989); *Hewlett-Packard Development Co., L.P. v. Vudu, Inc.* 92 USPQ2d

	1630, 1632 n.5 (TTAB 2009); and *Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc.*, 86 USPQ2d 1572, 1579, n.6 (TTAB 2008).
	Added new Note 18, citing *Hewlett-Packard Development Co. v. Vudu, Inc.,* 92 USPQ2d 1630, 1634 (TTAB 2009).
528.02 Time For Filing Motions	Replaced old 37 CFR § 2.127(e)(1) with amended rule; amended language in body of section to conform to amended rule and current practice and to provide for submission of motions under provision of Accelerated Case Resolution (ACR). Also added text to inform reader that untimely motions may be decided before responsive brief filed and that time for filing reply briefs will not be extended.
	Added new Note 1, citing 37 CFR § 2.127(e)(1); and *Qualcomm, Inc. v. FLO Corp.,* 93 USPQ2d 1768, 1769-70 (TTAB 2010).
	Added new Note 2, citing 37 CFR § 2.127(e)(1); *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255 n1. (TTAB 2009); 37 CFR § 2.120(a); *Nasalok Coating Corp. v. Nylok Corp.*, 86 USPQ2d 1369, 1375-77 (Fed. Cir. 2008); and *Mayer/Berkshire Corp. v. Berkshire Fashions*, 76 USPQ2d 1310, 1312 (Fed. Cir. 2005).
	Deleted reference to TBMP § 528.01 from Note 3; added *Celotex Corp. v. Catrett*, 477 U.S. 317, 327 (1986); and *Hewlett-Packard Development Co. v. Vudu Inc.*, 92 USPQ2d 1630, 1631 (TTAB 2009) to Note 3.
	Deleted "David J. Kera, *TIPS FROM THE TTAB: Summary Judgment*, 71 Trademark Rep. 59, 62 (1981); and T. Jeffrey Quinn, *TIPS FROM THE TTAB: Inter Partes Summary Judgment Revisited*, 76 Trademark Rep. 73, at 73-74 (1986)" from Note 5.
	Added 37 CFR § 2.127(e)(1) to Note 6 and deleted "*Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 1 USPQ2d 1497, 1498 n.2 (TTAB 1986) (untimely cross-motions decided where parties acknowledged that both were untimely but wanted a ruling thereon); *Lukens Inc. v. Vesper Corp.*, 1 USPQ2d 1299, 1300 n.2 (TTAB 1986), aff'd, 831 F.2d 306 (Fed. Cir. 1987) (untimely motion decided where non-moving party did not

	object to timeliness and responded on merits and, moreover, motion was based on collateral estoppel); and *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985) (untimely motion decided where no objection to timeliness was raised and delay was relatively insignificant)" from Note 6.
	Added new Note 9, citing 37 CFR § 2.127(e)(1).
528.03 Suspension Pending Determination of Motion	In first paragraph, added text to inform reader that filing of untimely motion for summary judgment will generally not be grounds for suspension.
	Added new third paragraph to indicate that disclosures are tolled due to suspension.
	Deleted *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 965-66 (TTAB 1986) (pendency of applicant's summary judgment motion did not under the circumstances constitute good cause for not responding to outstanding discovery requests) in Note 3.
	Deleted *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040 (TTAB 1985) (motion to suspend for civil action not considered) in Note 4.
	Removed "see" signal from reference to 37 CFR § 2.127(d) in Note 7.
	Added citation to *Super Bakery Inc. v. Benedict,* 96 USPQ2d 1134, 1135 (TTAB 2010) in Notes 2 and 4.
528.04 Miscaptioned Motion	Redrafted first paragraph with new body text and new footnotes to reflect change in practice resulting from changes in Trademark Rules regarding motions to dismiss or for judgment on the pleadings filed prior to service of initial disclosures.
	Added new Note 1, citing 37 CFR § 2.127(e)(1); and *Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009).
	Deleted "old" footnote 395, which read: "*See, for example, Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 n.2 (TTAB 1998) (third-party registrations submitted, but excluded). See also TBMP § 503.04 (regarding motions to dismiss for failure to state a claim) and TBMP § 504.03 (regarding motions for judgment on the pleadings)."

	Deleted "old" footnote 396, which read: "*See, for example*, *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ 1030, 1031 (TTAB 1996) (12(b)(6) motion treated in its entirety as one for summary judgment). See also TBMP § 503.04 (Matters Outside the Pleading for Motion to Dismiss) and TBMP § 504.03 (Matters Outside the Pleadings for Judgment on Pleadings) and authorities cited therein."
	Deleted "old" footnote 397, which read: "See TBMP § 503.04 and TBMP § 504.03; *Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1876 n.1 (TTAB 1998) (motion under 12(b)(6) and/or for summary judgment treated as a motion for summary judgment where both parties submitted evidentiary materials outside pleadings); and *Parker Brothers v. Tuxedo Monopoly, Inc.*, 225 USPQ 1222 (TTAB 1984) (motion to dismiss treated as one for summary judgment where matters outside the pleadings submitted and cross-motion for summary judgment filed in response). *Cf. Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983) (Board improperly treated motion to dismiss as a motion for summary judgment by rendering a decision on the merits without giving plaintiff notice it would treat the motion as such)."
528.04 Miscaptioned Motion	Updated citation to Wright, Miller and Kane, *Federal Practice and Procedure: Civil 3d* § 2722 (2009) in Note 2.
528.05 Summary Judgment Evidence	Section Heading only
528.05(a) In General	Split (old) Section 528.05(a) into Section 528.05(a)(1) In General and Section 528.05(a)(2) Accelerated Case Resolution (ACR).
	Added new third paragraph explaining circumstances when judicial notice may be taken or supplemental legal authority submitted.
	Added new fifth paragraph noting that the Board does not entertain motions in limine.
	Added new Note 2, citing *The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009).
	Added new Note 4, citing *University of Notre*

	Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *Enbridge Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1542 (TTAB 2009); and *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1515 (TTAB 2009).
	Added new Note 5, citing *The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009).
	Added new Note 7, citing *Greenhouse Systems Inc. v. Carson,* 37 USPQ2d 1748 (TTAB 1995).
	Added *Land O' Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1960 n.7 (TTAB 2008); and *University Games Corp. v. 20Q.net Inc.*, 87 USPQ2d 1465, 1468 n.4 (TTAB 2008) to Note 8 and deleted "*See also Oxy Metal Industries Corp. v. Technic, Inc.*, 189 USPQ 57 (TTAB 1975), summ. judgment granted, 191 USPQ 50 (TTAB 1976); and *Clairol Inc. v. Holland Hall Products, Inc.*, 165 USPQ 214 (TTAB 1970)" from Note 8.
	Added *Eveready Battery Co., Inc. v. Green Planet, Inc.,* 91 USPQ2d 1511, 1513 (TTAB 2009) to Note 9.
	Amended language in body of section to conform to amended 37 CFR § 2.127(e); added language and footnote 4 regarding evidentiary rulings; moved cite to TBMP in footnote 401 into body of section and deleted footnote; updated footnotes with new cites.
528.05(a)(2) Accelerated Case Resolution (ACR) (new section)	Added new section and corresponding Notes addressing the availability and mechanics of ACR.
528.05(b) Affidavits and Accompanying Exhibits	Updated Note 1 with cites to *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1864 n.8 (TTAB 2007); and *Westrex Corp. v. New Sensor Corp.*, 83 USPQ 1215, 1217 (TTAB 2007).
528.05(c) Discovery Responses and Disclosures (new title)	Replaced old 37 CFR § 2.127(e)(2) reference with amended rule and added reference to 37 CFR § 2.120(j)(8).
528.05(d) Registrations	Replaced old 37 CFR § 2.122(d)(1) cite with amended rule; amended language in body of section to conform to amended rule.

	Added information on making registration of record for purposes of ACR; added parenthetical to *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993) in Note 3.
528.05(e) Printed Publications and Official Records	Deleted paragraph headed "Internet evidence and other materials that are not self-authenticating" and added new fourth paragraph, headed "Internet evidence," to reflect recent case law on admissibility of properly identified Internet materials. Also added new heading to sixth paragraph to identify discussion of materials that are not self-authenticating.
	Added new sixth paragraph to inform reader that printed publications are not admissible as proof of any facts asserted therein but only for what they show on their face.
	Added *Paris Glove of Canada Ltd. V. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1857 (TTAB 2007) to Note 1.
	Added new Note 2, citing *Christopher Brooks v. Creative Arts by Calloway*, 93 USPQ2d 1823, 1825-6 (TTAB 2009) [appeal pending] *Creative Arts by Calloway, LLC v. Christopher Brooks*, Civ. No. 09-10488 (SDNY filed Dec. 28, 2009).
	Deleted *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998) from Note 3; deleted *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1369 (TTAB 1998) from Note 4.
	Added new Note 6, citing *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010); and *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1857 (TTAB 2007).
	Added new Note 7, citing *Int'l Assn. 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); *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) and *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 918 n.3 (TTAB 1983).
	Added new Note 8, citing *Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2020 n.8 (TTAB 2008); and *Exxon Corp. v. Fill-R-Up*

	Systems, Inc. 182 USPQ 443, 445 (TTAB 1974).
	Deleted "old" footnote 419, which read: "See Raccioppi v. Apogee Inc., supra at 1370. See also In re Total Quality Group Inc., 51 USPQ2d 1474, 1476 (TTAB 1999)."
	Deleted "old" footnote 420, which read: *Weyerhaeuser v. Katz, supra* at 1232 (TTAB 1992) citing *Glamorene Products Corporation v. Earl Grissmer Company, Inc.,* 203 USPQ 1090, 1092 n.5 (TTAB 1979). *See Raccioppi v. Apogee Inc., supra* at 1370. *Cf. Michael S. Sachs Inc. v. Cordon Art B.V.,* 56 USPQ2d 1132, 1134 (TTAB 2000) (introduction of telephone listings retrieved from Internet was improper); and *Plyboo America Inc. v. Smith & Fong Co.,* 51 USPQ2d 1633, 1634 n.3 (TTAB 1999) (printout of page of website is not proper subject matter for a notice of reliance).
	Deleted "old" footnote 421, which read: "*See Raccioppi v. Apogee Inc., supra* at 1370. *See also In re Total Quality Group Inc., supra* (examining attorney's request for judicial notice of on-line dictionary definitions denied because the definitions were not available in printed format)."
	Added Fed. R. Civ. P. 56(e); Fed. R. Civ. P. 56(c); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1864 n.8 (TTAB 2007); and *Westrex Corp. v. New Sensor Corp.*, 83 USPQ 1215, 1217 (TTAB 2007) to Note 9 and deleted "*See, e.g., Raccioppi v. Apogee Inc., supra* at 1369" from Note 9.
	Added *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010) to Note 10 and deleted *Raccioppi v. Apogee Inc., supra* at 1370 from Note 10.
528.05(f) Testimony from Another Proceeding	Added text to second paragraph to indicate that testimony from another proceeding that was introduced in connection with a summary judgment motion may, upon stipulation, be used at trial.
	Added *Eveready Battery Co., Inc. v. Green Planet, Inc.,* 91 USPQ2d 1511, 1513 (TTAB 2009); and *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) to Note 2.
528.06 Request for Discovery to Respond to Summary Judgment	Deleted former Fed. R. Civ. P. 56(f) and inserted amended Rule 56(f) (prior to the December 1, 2010 amendment); deleted former 37 CFR

	§ 2.127(e)(1) and inserted amended rule.
	Amended second paragraph to advise practitioners that motions under Rule 56(f) generally will be denied if not supported by an affidavit; added language to sixth paragraph regarding combined responses to summary judgment motions and requests for Rule 56(f) discovery.
	Added *Paris Glove of Canada Ltd. V. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1860 (TTAB 2007) to Note 1.
528.07(a) Unpleaded Issue Not Basis for Entering Summary Judgment	Added language regarding Board treatment of new allegations in amended pleading when amended answer not filed prior to consideration of summary judgment motion.
	Added *Asian and Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009); *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); and *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1309 n.3 (TTAB 2007) to Note 1.
	Added *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1309 n.3 (TTAB 2007); *Fishking Processors Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1766 n.4 (TTAB 20007) to Note 3.
528.07(b) Not Defense Against Summary Judgment	Changed signal for *Blansett Pharmacal Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992) from “cf.” to “see” in Note 1.
528.08 Entry of Summary Judgment in Favor of Nonmoving Party	No changes made.
529 Motion to Offer Discovery Deposition of Self or Nonparty	Amended title of reference to 37 CFR § 2.120(j) to conform to amended Rule
	Added new Note 2, citing *Galaxy Metal Gear Inc. v. Direct Access Technology, Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009); and *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1426 (TTAB 1993).
	Added, by comparison, *Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons, Inc.,* 55 USPQ2d 1298, 1302 n. 11 (TTAB 2000) to Note 3.

530 Motion to Use Testimony From Another Proceeding	Clarified language second paragraph to inform reader that motion for leave to use testimony may be filed during discovery, or thereafter but that better practice is to file the motion early in the proceeding, and that such motion will not normally result in suspension.
	Deleted *See Phillip Morris Inc. v. Brown & Williamson Tobacco Corp.,* 230 USPQ 172 (TTAB 1986 from Note 4 and added *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992) to Note 4.
531 Motion That Deposition Upon Written Questions Be Taken Orally	Updated reference to 37 CFR § 2.23(a)(1) to include title of rule.
532 Motion to Strike Notice of Reliance	Included "written disclosures" among types of discovery that may be introduced as evidence by notice of reliance.
	Added *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) to Note 1.
	Added *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007); *The Ritz Hotel Limited v. Ritz Closet Seat Corp*., 17 USPQ2d 1466 (TTAB 1990); *Seaguard Corp. v. Seaward Int'l, Inc.*, 223 USPQ 58, 59 n.4 (TTAB 1984); and *Otis Elevator Co. v. Echlin Mfg. Co.*, 187 USPQ 310, 313 n.4 (TTAB 1975) to Note 3.
	Added *M-Tek Inc. v. CVP Systems Inc*., 17 USPQ2d 1070 (TTAB 1990) to Note 5.
533 Motion to Strike Trial Testimony Deposition	Chapter Heading only.
533.01 On Ground of Untimeliness	Deleted old 37 CFR § 2.121(a)(1) and inserted updated rule.
	Added parenthetical to *Harjo v. Pro-Football Inc*., 45 USPQ2d 1789, 1790 (TTAB 1998) in Note 2.
	Added "cf." signal in front of citation to *Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555 (TTAB 1991) in Note 3.
533.02(a) On Ground of Improper or Inadequate Notice (new title)	Renamed as 533.02(a); deleted old 37 CFR § 2.123(e)(3) and inserted update rule.
	Added language cross-referencing motions to quash in new third paragraph, and added language advising parties on avoiding deposition scheduling disputes.
	Added *Sunrider Corp. v. Raats*, 83 USPQ2d

	1648, 1652-3, (TTAB 2007); and *Gaudreau v. American Promotional Events, Inc.,* 82 USPQ2d 1692 (TTAB 2007) to Note 1.
	Added new Note 3, citing 37 CFR § 2.123(c); Fed. R. Civ. P. 30(b) and 31(a); and *Duke University v. Haggar Clothing Co*., 54 USPQ2d 1443, 1444 (TTAB 2000).
533.02(b) On Ground of Failure to Disclose Witness in Expert or Pretrial Disclosures (new section)	Added new section referencing 37 CFR §§ 2.120(a)(1), 2.121(e), and 2.123(e)(3), and corresponding footnotes addressing new ground for striking testimony depositions under amended rules and cross-referencing motions to quash.
	Added information for reader addressing new ground for striking testimony depositions under amended rules and cross-referencing motions to quash.
	Added new Note 1, citing Fed. R. Civ. P. 26(a)(1); 37 CFR § 2.116(a); *Byer California v. Clothing for Modern Times Ltd.,* 95 USPQ2d 1175 (TTAB 2010); and *Jules Jurgensen/Rhapsody, Inc.,* 91 USPQ2d 1443, n.1 (TTAB 2009).
	Added new Note 2, citing Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).
	Added new Note 3, citing 37 CFR § 2.120(a)(2).
	Added new Note 4, citing 37 CFR § 2.121(e); and *Jules Jurgensen/Rhapsody, Inc.,* 91 USPQ2d 1443, 1444 (TTAB 2009).
	Added new Note 5, citing 37 CFR § 2.123(e)(3); and *Jules Jurgensen/Rhapsody, Inc.,* 91 USPQ2d 1443 (TTAB 2009).
533.03 When Motion to Strike Should Not Be Filed	Added new Note 1, citing *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); and *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.4 (TTAB 1990).
534 Motion For Judgment For Plaintiff's Failure to Prove Case	Section Heading only.
534.01 In General	Added reference, by comparison, to TBMP § 527.03.
534.02 Motion For Judgment Under 37 CFR § 2.132(a)	In fifth paragraph, added language regarding resetting appropriate trial dates if timely motion for judgment under 37 CFR § 2.132(a) is denied.

	In sixth paragraph, included reference to pretrial disclosure dates.
	Added parenthetical and pin cite to *Hewlett-Packard Co. v. Olympus Corp*., 931 F.2d 1551, 18 USPQ2d 1710, 1712 (Fed. Cir. 1991) in Note 1.
	Added parenthetical to *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc*., 61 USPQ2d 1860-61 (TTAB 2002); and *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1157 (TTAB 1998) in Note 4.
	Added *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993); and *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997) to Note 5.
	Deleted two paragraphs containing cases decided prior to *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993). These paragraphs read as follows: "See also the following cases [NOTE: These cases were decided prior to *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership,* 507 U.S. 380 (1993) which changed the excusable neglect standard. For a discussion of the effect of this change on the Board's analysis, see TBMP § 509.01(b) regarding motions to reopen.] *Hewlett-Packard Co. v. Olympus Corp.,* 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991) (mere request from adversary for extension of time is not sufficient and plaintiff cannot rely on inaction of defendant to establish that its own neglect was excusable); *Grobet File Co. of America Inc. v. Associated Distributors Inc.,* 12 USPQ2d 1649 (TTAB 1989) (no excusable neglect where plaintiff mistakenly assumed extension of time to respond to discovery would result in extension of discovery period); and *Fort Howard Paper Co. v. Kimberly-Clark Corp.,* 216 USPQ 617 (TTAB 1982) (opposer's good faith interpretation of parties' long-standing agreement to cooperate in extending or resetting dates constituted excusable neglect). *Cf. Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.,*

	5 USPQ2d 1067 (TTAB 1987) (plaintiff entitled to know disposition of defendant's pending motion to amend its answer before proceeding to trial); and *Proctor & Gamble Co. v. Johnson & Johnson Inc.,* 485 F. Supp. 1185, 205 USPQ 697 (S.D.N.Y. 1979), aff'd without opinion, 636 F.2d 1203 (2d Cir. 1980). Additional cases: *Allegro High Fidelity, Inc. v. Zenith Radio Corp.,* 197 USPQ 550 (TTAB 1977) (civil action filed by plaintiff after close of its testimony period); *Tel-E-Gift Corp. v. Teleflora Inc.,* 193 USPQ 254 (TTAB 1976) (communication problem between plaintiff and its counsel); *Litton Business Systems, Inc. v. J. G. Furniture Co.,* 190 USPQ 428 (TTAB 1976), recon. denied, 190 USPQ 431 (TTAB 1976) (inadequate docket system and heavy work load of plaintiff's counsel; request filed by plaintiff, after close of its testimony period, that Board take judicial notice of certain matters); *Litton Business Systems, Inc. v. JG Furniture Co.,* 188 USPQ 509 (TTAB 1976) (answer to complaint contained certain admissions); *A.R.A. Manufacturing Co. v. Equipment Co.,* 183 USPQ 558 (TTAB 1974) (unfamiliarity with current rule governing introduction of plaintiff's registration); *Pierce Foods Corp. v. Mountain Mamma, Inc.,* 183 USPQ 380 (TTAB 1974) (applicant assertedly guilty of unclean hands); *Other Telephone Co. v. Connecticut National Telephone Co.,* 181 USPQ 125 (TTAB 1974), petition denied, 181 USPQ 779 (Comm'r 1974) (during its testimony period, plaintiff had moved to suspend pending outcome of recently filed civil action); *W. R. Grace & Co. v. Red Owl Stores, Inc.,* 181 USPQ 118 (TTAB 1973) (unfamiliarity with current rule governing introduction of plaintiff's registration); and *Perfect Film & Chemical Corp. v. Society Ordinastral,* 172 USPQ 696 (TTAB 1972) (allegations in pleading, and exhibits attached thereto, not evidence in plaintiff's behalf).”
534.03 Motion For Judgment Under 37 CFR § 2.132(b)	In first paragraph, added language regarding sufficiency of records submitted from USPTO database; added text to third paragraph to clarify that Board has discretion to defer consideration of motion and decide case on its merits; and added text to fourth paragraph to include

	reference to pretrial disclosures.
	Added parenthetical and pin cite to *Pfaltzgraf v. William Davies Co.*, 175 USPQ 620, 621 (TTAB 1972) in Note 7.
534.04 Motion Under Fed. R. Civ. P. 41(b) or 50(a) Not Available	Added new Note 1, citing: *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007). Also added new Note 2, citing: *Kasco Corp. v. Southern Saw Service, Inc.*, 27 USPQ2d 1501, 1504 n.2 (TTAB 1993); and *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502, 506 n.2 (TTAB 1985).
535 Motion For Order to Show Cause Under 37 CFR § 2.134(b)	Conformed references to Trademark Act to stylistic standard. In third paragraph, added language explaining effect of abandonment of registered mark prior to proceeding.
	Added new Note 2, citing *C.H. Guenther & Son, Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450, 1452 n.4 (TTAB 1988).
536 Motion For Order to Show Cause Under 37 CFR § 2.128(a)(3)	Revised to reflect current Board practice that even if order to show cause under 37 CFR § 2.128(a)(3) is discharged, plaintiff must file a motion to reopen time to submit a main brief.
537 Motion For Leave to Exceed Page Limit For Brief On Case	Added new seventh paragraph contrasting brief lengths applicable to motions. Added *First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 77 USPQ2d 1334, 1336 n.4 (TTAB 2005), *rev'd on other grounds,* 81 USPQ2d 1375 (Fed. Cir. 2007) to Note 1.
538 Motion For Leave to File Amicus Brief	Changed "defendant" to "a party to the proceeding" in fourth paragraph.
539 Motion to Strike Brief On Case	Amended second paragraph to clarify that objections to contents of brief should be stated in responsive brief, if allowed.
	Amended fourth paragraph to indicate that rules to not provide for surreply as well as rejoinder brief and that any such brief filed will be stricken.
	Amended fifth paragraph to add that, with one exception, evidence may not be submitted with a brief; added new Note 4 in support, citing: *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008).
	In Note 3, added parenthetical to *Fortunoff Silver Sales, Inc. v. Norman Press, Inc.*, 225 USPQ 863, 863 n.3 (TTAB 1985), and changed "reply" to "surreply."
540 Motion For Augmented	Clarified composition of Board and titles of Board

Panel Hearing	professionals in first paragraph and added new Note 1 in support, citing: Trademark Act § 17(b), 15 U.S.C. § 1067(b).
	Added *In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010); *Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG,* 34 USPQ2d 1266 (TTAB 1995); and *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545, 1547 (Fed. Cir. 1994) to Note 3.
	Added *In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010); *In re Active Ankle Systems, Inc.*, 83 USPQ2d 1532, 1534 (TTAB 2007); and *Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG,* 34 USPQ2d 1266 (TTAB 1995) to Note 4; deleted "*In re Alappat,* 33 F.3d 1526, 31 USPQ2d 1545, 1547 (Fed. Cir. 1994) (Section 7 grants Director authority to designate the members of a panel and expanded panel)" from Note 4.
541 Motion To Change Oral Hearing Date; For Additional Time	Section Heading only.
541.01 Motion to Change Oral Hearing Date	Amended first paragraph to add ACR language.
	Amended third paragraph to update preferred means of filing motion to reset hearing and amended fourth paragraph to advise the reader that in most cases repeated requests to reset an oral hearing will be denied.
541.02 Motion For Additional Time For Oral Argument	Amended first paragraph to include statement advising reader that motions for additional time are disfavored.
	Amended second paragraph regarding extension of time sua sponte by panel.
542 Motion For Leave to Audiotape, Videotape, or Otherwise Electronically Record Oral Hearing (new title)	Amended first paragraph regarding other electronic recordings of hearings; relocated information regarding court reporter usage to first paragraph from fourth paragraph. Also added new fifth paragraph regarding remote attendance at oral hearing.
543 Motion For Reconsideration of Final Decision	Amended third paragraph clarifying time to file reply brief.
	Added new sixth paragraph addressing multiple requests for reconsideration.
	Amended parenthetical to *Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126 (TTAB 1978) in

	Note 4.
	Changed “different results reached on reh’g” to “reh’g granted” within citation to *Steiger Tractor Inc. v. Steiner Corp*., 221 USPQ 165 (TTAB 1984) *reh’g granted*, 3 USPQ2d 1708 (TTAB 1984) in Note 5.
544 Motion For Relief From Final Judgment	Deleted reference to old Fed. R. Civ. P. 60(b) and added amended Fed. R. Civ. P. 60(b); added reference to Fed. R. Civ. P. 60(c)(1) and Fed. R. Civ. P. 6(b)(2).
	Amended second paragraph clarifying that procedure is available only for grants of summary judgment, not denials.
	Amended fourth paragraph to clarify that time to file motion will not be extended.
	Added *Pramil S.R.L. v. Michael Farah*, 93 USPQ2d 1093 (TTAB 2009); and *Kraft Foods, Inc. v. Desnoes & Geddes Ltd.,* 64 USPQ2d 1154 (TTAB 2002) to Note 2.
	Deleted following from Note 2: “*See also Marriott Corp. v. Pappy's Enterprises, Inc.,* 192 USPQ 735 (TTAB 1976) (reasons (1) and (6) denied; opposer's failure to maintain communication between its staff counsel due to inattention and carelessness is not excusable neglect and does not constitute "inadvertence") and *Williams v. Five Platters, Inc.,* 181 USPQ 409 (TTAB 1974), aff'd, 510 F.2d 963, 184 USPQ 744 (CCPA 1975) (reason (1) denied; petitioner's arguments that its neglect resulted from docketing errors and the absence of petitioner's counsel from its office do not constitute excusable neglect). In addition, see *Syosset Laboratories, Inc. v. TI Pharmaceuticals,* 216 USPQ 330 (TTAB 1982) (reasons (1), (3), and (6)); *Lee Byron Corp. v. H.D. Lee Co.,* 203 USPQ 1097 (TTAB 1979) (reason (2)); *Amoco Oil Co. v. Amerco, Inc.,* 201 USPQ 126 (TTAB 1978) (reason (2)); *Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc.,* 200 USPQ 819 (TTAB 1978) (reason (1)); and *Columbia Broadcasting System, Inc. v. De Costa,* 165 USPQ 95 (TTAB 1970) (reason (6)).”
544 Motion For Relief From Final Judgment	Added Fed. R. Civ. P. 6(b)(2); and *Pramil S.R.L. v. Michael Farah*, 93 USPQ2d 1093 (TTAB 2009) to Note 3.

INDEX TO CHANGES IN THIRD EDITION
CHAPTER 600

TBMP SECTION	NATURE OF CHANGE
601 Withdrawal by Opposition or Cancellation Plaintiff	Section Heading only.
601.01 Withdrawal by Opposer	Amended paragraph 3 by adding a sentence about the signature requirement for "written consent."
	Amended Note 1 by adding parenthetical (the title) to 37 CFR § 2.114(c).
	Amended Note 2 by rearranging order of cases.
	Added new Note 3, referencing: 37 CFR § 2.193(c)(1).
601.02 Withdrawal by Petitioner	Amended paragraph 3 by adding a sentence about the signature requirement for "written consent." Added a reference to TBMP § 113 to be consistent with similar paragraph in TBMP § 601.01.
	Amended Note 1 by adding parenthetical (the title) to 37 CFR § 2.106(c).
	Amended Note 2 by rearranging order of cases and added new case moved from Note 3: *Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 175 F.3d 1322, 50 USPQ2d 1532, 1536 (Fed. Cir. 1999).
	Amended Note 3 by moving reference to *Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 175 F.3d 1322, 50 USPQ2d 1532, 1536 (Fed. Cir. 1999) to Note 2 and adding reference to 37 CFR § 2.193(c)(1).
601.03 Effect of Motion for Judgment	Deleted reference to "judgment on the pleadings" and substituted "more definite statement."
602 Withdrawal by Opposition or Cancellation Defendant	Section Heading only.
	Added new paragraphs 1 and 2 to highlight the different bases for applications and

	registrations under the Trademark Act and to clarify differences between applications filed under Trademark Act § 66(a) and §§ 1 and 44.
	Amended paragraph 4 to add a sentence about the signature requirement for "written consent."
	Amended paragraph 5 to add parenthetical (the title) to 37 CFR § 2.135.
	Amended paragraph 6 by adding the words "in its entirety" after "… delete an opposed class."
	Added new paragraph 7 to address the situation where multiple oppositions are brought against a single application.
	Amended paragraph 8 to address use of the ESTTA filing system when filing an abandonment of an opposed application, and cautioning not to use the TEAS system when filing an abandonment of an opposed application.
	Amended paragraph 9 to add reference to TBMP § 218.
	Amended paragraph 10 to delete phrases which appeared to limit abandonment prior to publication only to a "failure to respond to Office Action." Deleted "revive" and substituted "Director" in reference to petitions; and referred to both 37 CFR §§ 2.66 and 2.146 "as appropriate."
	Added reference to TBMP § 602.02(b) in paragraph 11.
	Revised paragraph 12 to address Trademark Act § 66(a) ("Madrid") registrations.
	Added a caption, "Other exemplary situations involving applicant's abandonment of its application," after paragraph 12 and before paragraph 13.
	Added new Note 1, citing: 37 CFR §§ 2.34(b)(3) and 2.35; TMEP §§ 806.01(e) and 1904.01(a), and, by comparison, TMEP §1904.09.
	Amended Note 3 by adding parenthetical to *Goodway Corp. v. International Marketing Group Inc.,*15 USPQ2d 1749, 1750 (TTAB 1990). Moved and added "see also" to *Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1453 (TTAB 1991), *aff'd*, 26

	USPQ2d 1551 (S.D. Ohio 1992); added *Kraft Foods, Inc. v. Desnoes & Geddes Ltd.,* 64 USPQ2d 1154, 1157 (TTAB 2002) with "*cf*" and explanatory parenthetical.
	Added new Note 5, citing: 37 CFR § 2.193(c)(1).
	In Note 6, moved *Aromatique Inc. v. Lang*, 25 USPQ2d 1359, 1361 (TTAB 1992) to first in string cite. Added *Sharp Kabushiki Kaisha v. ThinkSharp Inc.,* 448 F.3d 1368, 79 USPQ2d 1376 (Fed. Cir. 2006) with "*But cf*" and explanatory parenthetical; amended parenthetical and added pin cite to *Johnson & Johnson v. Bio-Medical Sciences, Inc.*, 179 USPQ 765, 766 (TTAB 1973).
	Added new Note 7, citing: 37 CFR § 2.135.
	Added "cf." to Note 9.
	Added parenthetical to *First National Bank of Boston,* 199 USPQ 296, 301 (TTAB 1978) in Note 10; deleted reference to TBMP § 218.
	Added reference to TMEP § 1505.04(a) in Note 13.
	Added reference to TMEP § 1904.08 in Note 14.
	Added new Note 15 to explain the difference between a "cancellation" and "renunciation" for Madrid registrations.
	Added new Note 17 citing, by comparison: *Montana v. United States,* 440 U.S. 147 (1979); *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.,* 424 F.3d 1229, 76 USPQ2d 1310 (Fed. Cir. 2005); *Bingaman v. Dept. of the Treasury,* 127 F.3d 1431 (Fed. Cir. 1997); and, under preface "see generally," 6 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION: *Res Judicata and Changes in the Facts,* § 32:88 (2010).
602.02 Withdrawal by Respondent	Subsection Heading only.
	Added new paragraph 1 to clarify that a Trademark Act § 66(a) registration ("Madrid") is actually a registered extension of protection of an international registration.
	Deleted wording in paragraph 2 about the requirement to submit either an original

	certificate or a statement it was lost. Added information that it is acceptable to file a surrender of a Trademark Act § 66(a) registration either with the USPTO or the International Bureau ("IB"). Deleted sentence indicating the surrender must be filed with IB.
	In Paragraph 4, added sentence concerning the effect of deleting less than all the goods and/or services from a single class for Trademark Act §§ 1 and 44 registrations. Deleted language in sentence concerning a request for cancellation as to some of the goods and services in a Trademark Act § 66(a) registration.
	In Paragraph 5, deleted sentence that 37 CFR § 2.134 is not applicable to Trademark Act § 66(a) registrations; revised to address Trademark Act § 66(a) registrations.
	Added new paragraph 6 to address partial restriction of Trademark Act § 66(a) registrations.
	In paragraph 7, explained the use of the ESTTA filing system when filing a surrender of a registration that is the subject of a petition to cancel and cautions practitioners not to use the TEAS system when filing a surrender of a registration that is the subject of a petition to cancel. Also deleted the following: "In the case of a voluntary cancellation of a 66(a) registration, the registrant should file with the Board and serve upon every other party to the proceeding, a copy of the appropriate notice or request for cancellation that has been filed with the International Bureau."
	In Note 3, added reference to TMEP § 1906.01(e).
	Added new Note 6, citing: *G&W Labs., Inc. v. GW Pharma Ltd.,* 89 USPQ2d 1571, 1574 (TTAB 2009).
	Added new Note 7, referencing: 37 CFR § 2.172 and TMEP §§ 1403.07 and 1609.03.
	Added new Note 8, referencing: TMEP §§ 1904.13(a), 1904.02(c) and 1904.02(c)(ii).
	Added new Note 9, referencing TMEP § 1904.13(a).
	Added new Note 10, referencing TMEP

	§ 1904.15.
	Added new Note 11, referencing 15 U.S.C. § 1114j(a) and citing, by comparison, *G&W Labs., Inc. v. GW Pharma Ltd.,* 89 USPQ2d 1571, 1574 (TTAB 2009).
	Added new Note 12, referencing TMEP § 1904.09.
	Added new Note 13, referencing 37 CFR § 2.134(a).
	Added new Note 15, citing, by comparison: *Cf. Montana v. United States,* 440 U.S. 147 (1979); *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.,* 424 F.3d 1229, 76 USPQ2d 1310 (Fed. Cir. 2005); *Bingaman v. Dept. of the Treasury*, 127 F.3d 1431 (Fed. Cir. 1997); and citing, under preface "*See generally*," 6 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION: Res Judicata and Changes in the Facts, § 32:88 (2010).
602.02(b) Cancellation Under Section 8 or 71; Expiration Under Section 9 or 70	Updated reference to 37 CFR § 7.36(b)(3) and (c) to reflect rules changes.
	In paragraph 1, added a preamble referring to Trademark Act §§ 1 and 44 registration to differentiate from paragraph 2 referring to § 66(a) registrations.
	Revised section to emphasize the differences between Trademark Act §§ 8, 9, 70, and 71 and to include information about registered extensions of protection of Trademark Act § 66(a) (Madrid) registrations.
	Added new paragraph 12 to include information about notice of registration where respondent demonstrates lack of intent to moot proceedings and petitioner elects to proceed.
	Deleted final paragraph, advising reader that while 37 CFR § 2.134 is not applicable to Trademark Act § 66(a) (Madrid) registrations, "policy considerations underlying the rule are applicable," because this information has been included in amendments to previous paragraphs in this subsection.
	Added information that a § 71 affidavit is to be filed with the USPTO in Note 2. Added

	references to 15 U.S.C. § 1114k and TMEP §§ 1613 and 1904.10.
	Added new references to TMEP §§ 1614 and 1905 in Note 3.
	In Note 5, added pin cite to *Marshall Field & Co. v. Mrs. Fields Cookies,* 11 USPQ2d 1154, 1156 (TTAB 1989); deleted "T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 277 (1984)."
	In Note 6, deleted reference to "Notice of Final Rulemaking, 48 Fed. Reg. 23,122, 23,133 (May 23, 1983), 1031 TMOG 13, 23 (June 21, 1983)"; added citation information for *Marshall Field & Co. v. Mrs. Fields Cookies,* 11 USPQ2d 1154, 1156 (TTAB 1989); deleted "T. Jeffrey Quinn, TIPS FROM THE TTAB: The Rules Are Changing, *supra.*"
	Added pin cite to *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989) in Note 8.
	Corrected cite to *Abraham's Seed v. John One Ten*, 1 USPQ2d 1230 (TTAB 1986) in Note 9.
	In Note 10, changed pin cite to *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154 (TTAB 1989) (replacing "1156" with "1154."
	Added new Note 12, citing *Fishking Processors, Inc. v. Fisher King Seafoods Ltd.,* 83 USPQ2d 1762, 1765 (TTAB 2007).
603 Withdrawal by Interference or Concurrent Use Applicant	Updated reference to 37 CFR § 2.68 to reflect rules changes.
	In paragraph 2, added a reference to TMEP § 1106.05, and deleted sentence about republication of a Trademark Act § 66(a) application.
	Revised paragraph 4 to encourage use of the ESTTA system for filing of abandonments and caution against using the TEAS system for filing abandonments.
	Add new paragraph 6 to explain that applications based solely on Trademark Act §§ 44 or 66(a) are not subject to concurrent use proceedings and cannot have more than one basis.

	Deleted from Note 4: Trademark Act §§ 68 and 69; substituted a reference to 37 CFR § 2.119(a).
	Added new Note 6, referencing: 37 CFR § 2.99(g) and TMEP § 1207.04(b).
	Added new Note 7, referencing: 37 CFR § 2.34(b)(3) and TMEP § 1904.01(a).
604 Consent to Judgment	No substantive changes.
605 Settlement	Chapter Heading only.
605.01 In General	Revised to explain that Board willing to suspend “for reasonable times”; and deleted "generous" from statement of Board’s discovery practice.
605.02 Suspension for Settlement Negotiations	In paragraph 1, added a sentence encouraging use of ESTTA to file "consent motions."
	In paragraph 2, clarified that a 6-month suspension may be granted upon a motion or be imposed sua sponte; clarified that a progress report need not disclose confidential information or matter; changed "firm" to "anticipated" timetable for resolution; clarified that consented suspension requests may be denied even if a status report provided; added reference to TBMP § 510.
	Added new Paragraph 3 to inform reader about unavailability of suspension or extension following answer until discovery conference held.
	Added new Notes 2 and 3 referencing Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42245 (August 1, 2007).
605.03 Settlement Agreements	Subsection Heading only.
605.03(a) In General	Added new Note 1 citing: 37 CFR §§ 2.134 and 2.135.
605.03(b) With Amendment of Subject Application or Registration	Paragraph 3: added "in its entirety" to differentiate deletion of an entire class instead of deletion of some goods or services within a single class; added references to TBMP §§ 602.01 and 602.02.
	Deleted from paragraph 4 that 37 CFR § 2.134 is not applicable to Trademark Act § 66(a) (Madrid) registrations; added a transition to the

	introduction of the paragraph; added additional information about the deletion of only some of the goods and services in a single class Trademark Act § 66(a) registration.
	Added references in Note 3 to TMEP §§ 1609.02(a) and 1904.02(j).
	Deleted from Note 4: "Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, 81 Trademark Rep. 408 (1991)."
	Added new Note 5 referencing, by comparison: Trademark Act § 70 and 37 CFR § 2.172.
	Added new Note 6 referencing: TMEP § 1904.15.
605.03(c) With Amendment of Plaintiff's Pending Application	No substantive changes.
605.03(d) Breach of Settlement Agreement	Added new case to Note 1: *Bausch & Lomb, Inc. v. Karl Storz GmbH & Co. KG,* 87 USPQ2d 1526, 1528 (TTAB 2008).
605.03(e) Effect of Judgment Based Upon Agreement	Deleted from Note 1: "Marc A. Bergsman, *TIPS FROM THE TTAB: The Effect of Board Decisions in Civil Actions; Claim Preclusion and Issue Preclusion in Board Proceedings*, 80 Trademark Rep. 540 (1990)."
605.03(f) Consent Orders	Deleted the following: "That is, the Board does not, based simply upon a joint request by the parties that it does so, enter, approve, or otherwise adopt as its own findings, as if on the merits, stipulated findings of fact and/or conclusions of law, without any consideration by the Board of evidence properly adduced during the course of the proceeding. Rather, the Board makes findings of fact, and conclusions of law, on the merits of the case only as warranted by the evidence of record upon motion for summary judgment or at final hearing."
606 Effect on Counterclaim	No substantive changes.

INDEX TO CHANGES IN THIRD EDITION
CHAPTER 700

TBMP SECTION	NATURE OF CHANGE
701 Time of Trial	Amended reference to 37 CFR §§ 2.121(a) and (d) to conform to rule changes. Added new reference to 37 CFR § 2.121(e).
	Amended first paragraph to more closely discuss contents of 37 CFR §§ 2.116(b) and 2.121, as amended.
	Amended second paragraph to discuss pretrial disclosures.
	Amended paragraph 5 to address pretrial disclosures and expert disclosures.
	Amended paragraph 6 to address pretrial disclosures and expert disclosures.
	Added new Note 5, referencing: 37 CFR § 2.121(e).
	Added new case to Note 7: *Baseball America Inc. v. Powerplay Sports*, 71 USPQ2d 1844, 1846 n.8 (TTAB 2004).
	Amended parenthetical to *PolyJohn Enterprises Corp. v. 1-800-Toilets, Inc.*, 61 USPQ2d 1860, 1861 (TTAB 2002) in Note 10 by changing "to reopen" to "periods not reopened."
702 Pretrial Disclosures; Manner Of Trial; And Introduction Of Evidence (new title)	Updated title from "Manner of Trial and Introduction of Evidence – In General" and created new subsections 702.01 – 702.04 under Section 702.
	Added new references to 37 CFR §§ 2.121(e) and Fed. R. Civ. P. 26(a)(3) regarding pretrial disclosures.
702.01 Pretrial Disclosures (new section)	This is a new subsection discussing pretrial disclosures, objections thereto, and failure to make disclosures.
	Added new Note 1, referencing: 37 CFR § 2.121(e); and Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).
	Added new Note 2, citing: *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009).
	Added new Note 3, referencing: Miscellaneous

	Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).
	Added new Note 4, referencing: 37 CFR § 2.121(e); and Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).
	Added new Note 5, referencing: 37 CFR § 2.121(e); and citing: *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 - 45 (TTAB 2009).
	Added new Notes 6-9, referencing: 37 CFR § 2.121(e).
	Added new Note 10, referencing: 37 CFR § 2.123(e)(3); 37 CFR § 2.118; and Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).
	Added new Note 11, citing: *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009).
	Added new Note 12, referencing: 37 CFR § 2.118; and Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007).
	Added new Note 13, referencing: 37 CFR § 2.118; and Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42247 (August 1, 2007).
	Added new Note 14, referencing: 37 CFR § 2.123(e)(3) and citing: *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009).
702.02 Introduction of Evidence (new subsection)	This is a new subsection, covering that portion of the text in original Section 702 dealing with the introduction of evidence. Added new Note 3, referencing *Coach Services Inc. v. Triumph Learning LLC,* 96 USPQ2d 1600 (TTAB 2010).
702.03 – Manner of Trial	This is a new subsection, covering the last three paragraphs of text from the original Section 702. Added references to TBMP §§ 102.03 and 502.01 in first paragraph.
	Amended second paragraph to include clarification that hearings are at the Board.
	Amended paragraph 3 to account for electronic filings. Deleted the following from paragraph 3:

	"The papers and other materials filed with the Board during the course of an inter partes proceeding are kept, during the course of the proceeding, in the physical possession of the Board."
	Added new paragraph 4, referencing: TBMP § 121.
	Added new paragraph 5 noting that parties may consider ACR as an alternative to trial and referencing TBMP §§ 528.05(a)(2); 702.04; and 705.
	Added new Note 5, referencing: 37 CFR § 2.129(a).
702.04 Accelerated Case Resolution (new section)	New section heading only regarding ACR.
702.04(a) In General (new subsection)	This is a new subsection, introducing ACR as an alternative to a traditional Board proceeding. Paragraph 1 outlines the typical ACR case; paragraph 2 explains the purpose of ACR; paragraph 3 addresses the most appropriate cases for ACR; and paragraphs 4 and 5 discuss implementation of ACR. Paragraphs 6 and 7 of this subsection address limitations to discovery and trial under ACR; paragraphs 8 and 9 note standards of proof and appeals, and paragraph 10 references the website at which the Board maintains a list of ACR cases.
	Added new Note 1, citing: *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675 (TTAB 1986); and *Acuff-Rose Music, Inc. v. Jostens, Inc.*, 47 USPQ2d 1953, 1954-55 (2d Cir. 1998).
	Added new Note 2, citing: *Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007).
	Added new Note 3, citing: *Ballet Tech Foundation Inc. v. Joyce Theater Foundation Inc.*, 89 USPQ2d 1262, 1226 n.9 (TTAB 2008).
	Added new Note 4, citing: *Hewlett-Packard Development Co. v. Vudu Inc.*, 92 USPQ2d 1630, 1634 n.6 (TTAB 2009).
	Added new Note 5, citing: *Promgirl, Inc. v. JPC Co.,* 94 UPSQ2d 1759, 1762 (TTAB 2009).
	Added new Note 6, citing: *Dan Robbins & Associates, Inc. v. Questor Corporation*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979).
	Added new Note 7, citing: *See* 37 CFR § 2.145.

702.04(b) ACR Using Summary Judgment Briefs (new subsection)	This is a new subsection, referencing TBMP § 528.05(a)(2); and describing in paragraph 1 an ACR case using summary judgment briefs and accompanying evidentiary submissions during a combined trial and briefing period; discussing stipulations in paragraph 2; and the procedure for submission of summary judgment briefs in paragraph 3. Paragraph 4 informs reader that the parties to an ACR proceeding using summary judgment briefs must stipulate to the Board's resolution of disputed facts; and paragraph 5 encourages reader to submit stipulation in event ACR is agreed-upon early in the case.
	Added new Note 1, citing: *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2009).
	Added new Notes 2 and 3, referencing: 37 CFR §§ 2.127(a) and 2.127(e)(1).
	Added new Notes 4 and 5, referencing 37 CFR § 2.127(a).
702.04(c) ACR Conversion - Summary Judgment Briefs (new subsection)	This is a new subsection, referencing TBMP § 528.05(a)(2); and informing reader in paragraph 1 that in appropriate cases, Board may treat parties' summary judgment briefs and evidence under ACR; and in paragraph 2 that parties must stipulate to Board's resolution of any disputed facts.
	Added new Note 1, citing: *Freeman v. National Association of Realtors*, 64 USPQ2d 1700 (TTAB 2002); and *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675 (TTAB 1986).
702.04(d) ACR using Stipulated Record and Trial Briefs (new subsection)	This is a new subsection, referencing TBMP § 705; and explaining in paragraphs 1 and 2 that the parties under the stipulated record and trial briefs ACR model stipulate to the admissibility of most of the record and agree to have the Board decide disputed facts; noting in paragraph 3 that this method is highly effective; and noting in paragraphs 4, 5, and 6 that while testimony depositions are still available, parties willing to forgo testimony should file a stipulation to that effect with the Board and that parties may not object to admissibility of evidence stipulated into the record. Paragraph 7 describes formatting limitations on ACR trial briefs and that only plaintiff may file a reply brief.

	Added new Note 1, citing: *Eveready Battery Co. v. Green Planet Inc*., 91 USPQ2d 1511 (TTAB 2009); and *Target Brands, Inc. v. Shaun N.G. Hughes,* 85 USPQ2d 1676 (TTAB 2007).
	Added new Note 2, citing: *Eveready Battery Co. v. Green Planet Inc*., 91 USPQ2d 1511 (TTAB 2009); *Target Brands, Inc. v. Shaun N.G. Hughes,* 85 USPQ2d 1676 (TTAB 2007); *Zimmerman v. National Association of Realtors*, 70 USPQ2d 1425 (TTAB 2004); and *Devries v. NCC Corporation,* 227 USPQ 705 (TTAB 1985).
	Added new Note 3, citing: *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007).
	Added new Note 4, citing: *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2009).
	Added new Notes 5 and 6, referencing: 37 CFR § 2.128(b).
702.04(e) Utilizing Stipulations in Non-ACR Board cases (new subsection)	This is a new subsection to advise reader that ACR-type stipulations are available in any Board proceeding and to provide the website address where a list of Board ACR cases may be found.
	Added new Note 1, citing: *Brooks v. Creative Arts by Calloway*, LLC, 93 USPQ2d 1823 (TTAB 2010); *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042 (TTAB 2009); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc*., 89 USPQ2d 1844 (TTAB 2008); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628 (TTAB 1998); *Domino's Pizza Inc. v. Little Caesar Enterprises Inc*., 7 USPQ2d 1359 (TTAB 1988); *Wilderness Group, Inc. v. Western Recreational Vehicles, Inc*., 222 USPQ 1012 (TTAB 1984); and *Hayes Microcomputer Products, Inc. v. Business Computer Corporation*, 219 USPQ 634 (TTAB 1983).
702.05 Overly Large Records	This is a new section cautioning parties that the Board views with disfavor the submission of cumulative, irrelevant evidence at trial.
	Added new Note 1, citing: *Stuart Spector Designs Ltd. v. Fender Musical Instruments, Corp.,* 94 USPQ2d 1549 (TTAB 2009); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.,* 77 USPQ2d 1492, 1495 (TTAB 2005); *Blue Man Productions v. Tarmann,* 75 USPQ2d 1811, 1814

	(TTAB 2005), *rev'd on other grounds*, No. 05-2037, slip op. (D.D.C. Apr. 3, 2008).
	Added new Note 2, citing: *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.,* 77 USPQ2d 1492, 1495 (TTAB 2005).
	Added new Note 3, citing: *Safer, Inc. v. OMS Investments, Inc*., 94 USPQ2d 1031, 1040 n.19 (TTAB 2010); *Blue Man Productions v. Tarmann,* 75 USPQ2d 1811, 1814 (TTAB 2005), *rev'd on other grounds*, No. 05-2037, slip op. (D.D.C. Apr. 3, 2008).
	Added new Note 4, citing: *Sports Authority Michigan Inc. v. PC Authority Inc*., 63 USPQ2d 1782, 1787 (TTAB 2001), *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).
	Added new Note 5, citing: *Blue Man Productions v. Tarmann,* 75 USPQ2d 1811, 1814 (TTAB 2005), *rev'd on other grounds*, No. 05-2037, slip op. (D.D.C. Apr. 3, 2008).
	Added new Note 6, citing: *Safer, Inc. v. OMS Investments, Inc*., 94 USPQ2d 1031 (TTAB 2010).
703 Taking And Introducing Testimony	Section Heading only.
703.01 Oral Testimony Depositions	Subsection Heading only.
703.01(a) In General	Deleted reference to TBMP § 404.02 in paragraph 1.
703.01(b) Form of Testimony	Amended paragraph 4 to inform reader that party may cross-examine a witness in person, where the witness's testimony has been submitted on affidavit or by declaration.
	Added new case to Note 5: *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L*., 84 USPQ2d 1912, 1914 (TTAB 2007); and changed parenthetical to *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1425 n.8 (TTAB 1993) in Note 5 by replacing the word "considered" with the word "treated.".
	Added new Note 6, citing: *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1044 (TTAB 2009).
	Added new case to Note 7: *Galaxy Metal Gear Inc. v. Direct Access Technology Inc*., 91 USPQ2d 1859, 1862 (TTAB 2009).

703.01(c) Time for Taking Testimony	Corrected citation to 37 CFR § 2.121(a) from "37 CFR § 2.121(a)(1)" and added new cases to Note 1: *Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451, 1454 n.1 (TTAB 1998); and, by comparison, *Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991).
703.01(d) Time and Place of Deposition	No substantive changes.
703.01(e) Notice of Deposition	Amended first paragraph to add sentence regarding manner in which Board counts days in the context of noticing depositions. Amended second paragraph to clarify that notice of oral deposition need not be filed with the Board.
	Added new cases to Note 1: *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 (TTAB 2007); *Gaudreau v. American Promotional Events, Inc.*, 82 USPQ2d 1692, 1696 (TTAB 2007).
	Added new Note 2, citing: *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 (TTAB 2007).
	Deleted the following from Note 5 to: "Rany L. Simms*, TIPS FROM THE TTAB: Whether and When to File Papers During Trademark Proceedings*, 67 Trademark Rep. 175 (1977)."
703.01(f) Securing Attendance of Unwilling Adverse Party or Nonparty	Subsection Heading only.
703.01(f)(1) In General	Deleted the following from Note 1: "Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 396-397 (1985); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985)."
703.01(f)(2) Unwilling Witness Residing in United States	Added new case to Note 1: *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009); deleted the following from Notes 1 and 3: "Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board,* 75 Trademark Rep. 323 (1985); and Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board,* 75 Trademark Rep. 29 (1985)."
	Added new paragraph 3 regarding subpoena for deposition of foreign corporate party in Fourth

	Circuit.
	Added new case to Note 1: *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009); and deleted the following from Note 1: "Rany L. Simms, *TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board*, 75 Trademark Rep. 296 (1985)."
	Added new Note 2, citing: *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).
703.01(g) Persons Before Whom Depositions May be Taken	Amended recitation of Fed. R. Civ. P. 28 to reflect current wording.
	Updated reference to 8a, C. Wright, A. Miller & R. Marcus, *Federal Practice and Procedure: Civil 2d § 2083* (3d ed. 2010) from "1994" in Note 3.
	Added new Note 4, citing: *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 n.5 (TTAB 2009).
703.01(h) Examination of Witnesses	Amended recitation of 37 CFR § 2.123(e)(3) and Fed. R. Civ. P. 30(b)(4) [formerly Fed. R. Civ. P. 30(b)(7)] to reflect current wording.
	Amended paragraph 4 to specify that deposition may be taken by other remote means, not just telephone.
	Expanded paragraph 6 to include pretrial disclosures and added citation to TBMP § 707.03(b)(3).
	Amended paragraph 8 to clarify what type of information a witness may refuse to divulge in a deposition.
	Added new case to Note 4: *Sunrider Corp. v. Raats,* 83 USPQ2d 1648, 1654 (TTAB 2007).
	Added new Note 5, referencing: Fed. R. Civ. P. 30(b)(4).
	Amended parenthetical to *Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835, 1838 n.4 (TTAB 1989) in Note 6.
703.01(i) Form of Deposition and Exhibits	Amended recitation of 37 CFR § 2.126 to reflect rule change regarding submissions made on CD-ROM.
	Amended paragraph 3 to conform to change in 37 CFR § 2.126; and to point out Board preference for ESTTA filings.

	Amended paragraph 6 by updating reference from "37 CFR § 2.126(c)" to "37 CFR § 2.126(b);" and by deleting the following: "CD-ROM submissions are governed by 37 CFR § 2.126(b);" also simplified reference to ESTTA.
	Amended paragraph 7 to delete references to CD-ROM submissions and moved information regarding how to format exhibits to depositions for scanning, from paragraph 10 to paragraph 7.
	Amended paragraph 8 to include information for formatting exhibits to depositions submitted via ESTTA.
	Amended paragraph 9 to clarify that CD-ROM may be submitted electronically, as a means of filing an exhibit originally formatted on videotape or audio tape.
	Added new paragraph 10 to alert reader to possible degradation of quality of scanned documents and to advise how to minimize same.
	Amended paragraph 11 to recommend that confidential filings through ESTTA utilize the "confidential" filing option.
	Added new Note 7, defining various formats available for filing documents through ESTTA.
	Deleted the following from Note 8: "G. Douglas Hohein*, TIPS FROM THE TTAB: Potpourri*, 71 Trademark Rep. 163 (1981)."
703.01(j) Signature of Deposition by Witness	In first paragraph, changed "signature" to "signing;" and deleted the following from Note 1: "Gary D. Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980)."
703.01(k) Certification and Filing of Deposition	In first paragraph, amended paragraph to reflect new address for USPTO and raised the option of filing under ESTTA. In second paragraph, inserted text clarifying meaning of "promptly forward" in 37 CFR § 2.123(f)(2) by moving it to body of text from footnote, where it originally appeared.
	Added new Note 2, referencing *Notice of Final Rulemaking,* 63 Fed. Reg. 48,081 (September 9, 1998).
	Added new case to Notes 3 and 4: *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009)
703.01(l) Testimony Deposition Must be Filed	Added new case to Note 2: *Motion Picture Ass'n of America Inc. v. Respect Sportswear Inc.*, 83 USPQ2d 1555, 1558 (TTAB 2007).

703.01(m) Service of Deposition	Amended paragraph 2 to add phrase regarding compelling service of the transcript and added *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009) to Notes 1 and 3 and new Note 4.
703.01(n) Correction of Errors in Deposition	In second paragraph, changed "made" to "corrected." In final paragraph, deleted the following: "send a representative to the offices of the Board to make the listed corrections by writing them above the original text in the transcript" and replaced with: "file a substitute, corrected transcript with the Board." Also deleted the footnote referencing Gary D. Krugman, *TIPS FROM THE TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980)" from Notes.
703.01(o) Objections to Testimony Depositions	No substantive changes.
703.01(p) Confidential or Trade Secret Material	Added reference to 37 CFR § 2.116(g) and renumbered 2.126(c) from "2.126(d)" to conform to rule change.
	Reformatted section to move statement of rules regarding treatment of redacted material to first paragraph of subsection; added new paragraph 2 to instruct reader on making confidential filings using ESTTA and regarding redacting confidential information from Board submissions filed via ESTTA; added new paragraph 3 to inform reader that 37 CFR § 2.116(g) provides for imposition of Board's standard protective order and deleted the following from paragraph 3: "Confidential materials filed in the absence of a protective order are not regarded as confidential and are not kept confidential by the Board."
	Deleted reference from paragraph 4 to the "files of applications and registrations that are the subject matter of pending proceedings before the Board" in discussion of materials available for public inspection and copying. Added information regarding over-designation of material as confidential.
	Added new Note 2, referencing: 37 CFR § 2.120(f).
	Added new Note 3, citing: *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.,* 77 USPQ2d 1492, 1495, n.5 (TTAB 2005).
	Added new Note 4, citing: *Wet Seal, Inc. v. FD*

	Management, Inc., 82 USPQ2d 1629, 1633 n.6 (TTAB 2007).
	Added new Note 5, referencing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42248 (August 1, 2007).
	Deleted the following from Note 6: "Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981)."
	Added new Note 7, citing: *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); and *General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179, 1181 (TTAB 2008).
	Added new Note 8, citing: *Morgan Creek Productions Inc. v. Foria International Inc*., 91 USPQ2d 1134, 1136 n.9 (TTAB 2009).
	Deleted the following footnote: "91. *See 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)."
	Deleted the following footnote: "93. *Cf*. 37 CFR § 2.120(f)."
703.02 Testimony Depositions on Written Questions	Section Heading only.
703.02(a) Depositions on Written Questions: When Available	No substantive changes.
703.02(b) Depositions on Written Questions: Before Whom Taken	Added new case, by example, to Note 1: *Corporacion Habanos S.A. v. Anncas, Inc.,* 88 USPQ2d 1785 (TTAB 2008)
703.02(c) Depositions on Written Questions: When Taken	Amended recitation of 37 CFR § 2.121(a) to reflect rule change; and updated reference from "37 CFR § 2.121(a)(1)" to "37 CFR § 2.121(a)." Amended

	parenthetical to *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652, 1652 (TTAB 1990) in Note 2 by changing "10 days of testimony" to "10 days of 'opening' of testimony."
703.02(d) Depositions on Written Questions: Place of Deposition	No substantive changes.
703.02(e) Depositions on Written Questions: Notice of Deposition	Deleted reference to 37 CFR § 2.123(b) in Note 1.
703.02(f) Depositions on Written Questions: Securing Attendance of Unwilling Witness	No substantive changes.
703.02(g) Depositions on Written Questions: Examination of Witness	Amended paragraph 7 to address attempts to engage witnesses in deposition.
703.02(h) Depositions on Written Questions: Form, Signature and Certification of Deposition	No substantive changes.
703.02(i) Depositions on Written Questions: Service, Correction and Filing of Deposition	Clarified, in second paragraph, that reference to deposition is testimony deposition upon written questions.
703.02(j) Testimony Depositions on Written Questions Must be Filed	No substantive changes.
703.02(k) Depositions on Written Questions: Objections to Deposition	No substantive changes.
703.02(l) Depositions on Written Questions: Confidential or Trade Secret Material	No substantive changes.
703.02(m) Depositions on Written Questions: Utility	Deleted the following from Note 1: "Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 397 (1985)."
	Added new case, by comparison, to Note 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).
704 Introducing Other Evidence	Section Heading only.

704.01 In General	Deleted reference to TBMP § 702.
704.02 Notice of Reliance – Generally	No changes made.
704.03 Applications and Registrations	Subsection Heading only.
704.03(a) Subject of Proceeding	Amended first paragraph to instruct reader not to file copy of the subject application or registration.
	Amended second paragraph to clarify that alleged date of use of the mark and the specimens in an application or registration file are not automatically evidence on behalf of the applicant or registrant. Deleted references in paragraph 2 to "documents, exhibits, etc." as not forming evidence; clarified "evidence" by deleting "properly adduced" therefrom; and deleted the following from paragraph 2: "Allegations must be established by competent evidence properly adduced at trial."
	Added new paragraph 3 to advise reader that evidence submitted during the prosecution of an application with respect to acquired distinctiveness is evidence on behalf of the applicant or registrant.
	Added new cases to Note 1: *The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009); *Venture Out Properties LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1889 n.8 (TTAB 2007); and *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1106 n.4 (TTAB 2007).
	Added new Note 2, citing: *Anthony's Pizza & Pasta International Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1274 n.6 (TTAB 2009), *aff'd,* No. 2010-1191, slip op. (Fed. Cir. Nov. 18, 2010); *Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009); *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1106 n.4 (TTAB 2007); and *Venture Out Properties LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1889 n.8 (TTAB 2007).
	Added new cases to Note 3: *UMG Recordings, Inc. v. O'Rourke,* 92 USPQ2d 1042, 1047 (TTAB 2009); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1960 (TTAB 2008); *Baseball America, Inc. v. Powerplay Sports, Ltd.*, 71 USPQ2d 1844, 1848 n.10 (TTAB 2004); and *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993), *recon. denied*,

	36 USPQ2d 1328 (TTAB 1994). Deleted the following from Note 3: "*Specialty Brands, Inc. v. Coffee Bean Distributors, Inc*., 748 F.2d 9, 223 USPQ 1281 at 1283 (Fed. Cir. 1984) (evidence in application file considered by court, but little weight given to applicant's statements before examining attorney)" and "*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)."
	Added new Note 4, citing: *The Cold War Museum, Inc. v. Cold War Air Museum, Inc*., 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009).
704.03(b) Not Subject of Proceeding – In General	No changes made.
704.03(b)(1) Registration Not Subject of Proceeding	Subsection Heading only.
704.03(b)(1)(A) Registration Owned by Party	Amended reference to 37 CFR § 2.122(d) to conform to rule changes.
	Amended paragraph 2 to conform to revision of 37 CFR § 2.122(d) allowing submission of single original or photocopy of registration from TARR or TESS database; notes that Board does not take judicial notice of registrations.
	Added new paragraph 3 regarding pleading of applications that mature into registrations during the proceeding and two new footnotes
	Amended paragraph 5 to conform to revision of 37 CFR § 2.122(d) allowing submission of single original or photocopy of registration from TARR or TESS database.
	Amended paragraph 6 by adding clause clarifying that paragraph concerns the situation when a party chooses to make its registration of record by submitting a status and title copy of registration.
	Deleted the following statement in paragraph 7 regarding insufficiency of electronic records: "and the electronic equivalent thereof, such as printouts of the registration from the electronic records of the Office's trademark automated search system."
	Moved paragraph 8 into Note 3.
	Deleted the following from paragraph 9: "The fact that there have been no changes in the status and title of a party's registration since the date of its issuance does not mean that a plain photocopy

	thereof may be used by the party as a substitute for the status and title copy."
	Added new paragraph 11 regarding using TARR or TESS copies of registrations as an alternative to submitting status and title copies of registrations.
	Amended paragraph 13 to clarify that admission must concern existence and ownership of registration.
	Amended paragraph 22 to clarify that registration file or portion of registration file may be taken from the Office's electronic records.
	Added new cases to Note 2: *Citigroup Inc. v. Capital City Bank Group Inc*., 94 USPQ2d 1645, 1654 (TTAB 2010); and *Research In Motion Ltd. v. NBOR Corp*., 92 USPQ2d 1926, 1928 (TTAB 2009).
	Deleted the following cases from Note 2: *Vita-Pakt Citrus Products Co. v. Cerro,* 195 USPQ 78 (TTAB 1977); *Maybelline Co. v. Matney,* 194 USPQ 438, 440 (TTAB 1977); *Marriott Corp. v. Pappy's Enterprises, Inc.,* 192 USPQ 735 (TTAB 1976); *American Manufacturing Co., v. Phase Industries, Inc.,* 192 USPQ 498 (TTAB 1976); *West Point-Pepperell, Inc. v. Borlan Industries Inc.,* 191 USPQ 53 (TTAB 1976); *O. M. Scott & Sons Co. v. Ferry-Morse Seed Co.,* 190 USPQ 352 (TTAB 1976); *Fort Howard Paper Co. v. Georgia-Pacific Corp.,* 189 USPQ 537 (TTAB 1975); *Peters Sportswear Co. v. Peter's Bag Corp.,* 187 USPQ 647, 647 (TTAB 1975); and *A.R.A. Manufacturing Co. v. Equipment Co.,* 183 USPQ 558 (TTAB 1974). *Cf. Hollister Inc. v. Downey,* 565 F.2d 1208, 196 USPQ 118 (CCPA 1977)."
	Added new Note 3, citing: *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); and *Black & Decker Corp. v. Emerson Electric Co*., 84 USPQ2d 1482, 1485 n.4 (TTAB 2007) and discussing in *In re Chippendales USA, Inc.,* Appeal No. 2009-1370 (Fed. Cir. October 1, 2010).
	Added new Note 4, citing: *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 Mfg. Co.*, 77 USPQ2d 1220, 1223 n.6 (TTAB 2005); and *M & T Chemicals Inc. v. Stepan Chemical Co.*, 150 USPQ 570, 571 (TTAB 1966).
	Added new Note 5, citing: *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009).
	Deleted the following from Note 7: "Exam Guide No. 2-03, Guide to Implementation of Madrid Protocol in the United States, (part IV.F.) (October 28, 2003) on the Office web site at www.uspto.gov."
	Added new cases to Note 8: *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1654 (TTAB 2010); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009); and *UMG Recordings, Inc. v. O'Rourke,* 92 USPQ2d 1042, 1045 (TTAB 2009). Deleted the following from Note 8: "In addition, see note to this section for information on recording assignments of 66(a) registrations."
	Added new case and new references to Note 11: *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983); 37 CFR § 2.122(e); and 37 CFR § 2.6(b)(4).
	Added new cases to Note 14: *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009); and, by example, *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116-17 (TTAB 2009).
	Deleted the following footnote from between Notes 14 and 15: "138. *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)."
	Added new parenthetical to *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 146 (TTAB 1979) in Note 15.
	Deleted the following footnote from between Notes 15 and 16: "140. *See Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 949 (TTAB 1983) (it is not sufficient that status and title copies might have shown the same facts indicated by a photocopy of an original registration which had recently issued or even if time for filing Sections 8 and 15 affidavits had not yet occurred since

	ownership could have changed or other events affecting ownership may have occurred); *Acme Boot Co. v. Tony and Susan Alamo Foundation Inc*., 213 USPQ 591, 592 (TTAB 1980); *Maybelline Co. v. Matney*, 194 USPQ 438 (TTAB 1977); and *Marriott Corp. v. Pappy's Enterprises, Inc*., 192 USPQ 735, 736 (TTAB 1976)."
	Deleted the following from Note 16: "*See also NOTE* to this section for information on recording assignments of 66(a) registrations."
	Added new cases to Note 17: *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1192 n.9 (TTAB 2007); *Black & Decker Corp. v. Emerson Electric Co*., 84 USPQ2d 1482, 1487-88 n.10-12 (TTAB 2007); *Parfums de Coeur, Ltd. v. Lazarus*, 83 USPQ2d 1012, 1014 n.4 (TTAB 2007); and *Tea Board of India v. Republic of Tea, Inc*., 80 USPQ2d 1881, 1896 n.25 (TTAB 2006).
	Added new case to Note 18: *Citigroup Inc. v. Capital City Bank Group Inc*., 94 USPQ2d 1645, 1654 (TTAB 2010); and added "see" signal before citation to *Hewlett-Packard Co. v. Olympus Corp*., 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) in Note 18.
	Added new cases, by comparison, to Note 19: *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009); and *Demon International LC v. Lynch*, 86 USPQ2d 1058, 1060 (TTAB 2008).
	Added Federal Reporter citation to *Action Temporary Services Inc. v. Labor Force Inc.,* 870 F.2d 1563, 10 USPQ2d 1307 (Fed. Cir. 1989) in Note 24.
704.03(b)(1)(B) Third-Party Registration	Amended paragraph 2 to indicate that a printout of a registration from the Office's electronic database records may be made of record under notice of reliance.
	Amended paragraph 5 to inform reader that printout showing current status and title copy is acceptable alternative to same prepared by Office.
	Amended paragraph 10 to inform reader of the option of obtaining records from the Office's electronic database records.
	Added new Note 1, citing: *Kohler Co. v. Baldwin Hardware Corp*., 82 USPQ2d 1100, 1110 (TTAB 2007).

	Deleted the following from Note 2: "J. David Sams, *TIPS FROM THE TTAB*: *Third Party Registrations in TTAB Proceedings,* 72 Trademark Rep. 297, 301 (1982)."
	Deleted the following from Note 3: "J. David Sams, *TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings*, 72 Trademark Reporter 297 (1982); and Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977)."
	Amended parenthetical to *In re H & H Products*, 228 USPQ 771, 773 (TTAB 1986) in Note 4.
	Added new case to Note 5: *Merritt Foods Company v. Americana Submarine*, 209 USPQ 591, 593 n.16 (TTAB 1980); and deleted the following from Note 5: "Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977)."
	Added new cases to Note 6: *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007); and *Truescents, LLC v. Ride Skin Care, LLC*, 81 USPQ2d 1334, 1337 (TTAB 2006); and *In re Chippendales USA, Inc.,* Appeal No. 2009-1370 (Fed. Cir. October 1, 2010); deleted the following from Note 6: "Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977)."
	Added new case to Note 7: *Nike, Inc. v. WNBA Enterprises, LLC,* 85 USPQ2d 1187, 1200 (TTAB 2007); and deleted the following from Note 7: "*See also* in addition J. David Sams, *TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings*, 72 Trademark Rep. 297, 301 (1982)."
704.03(b)(2) Application Not Subject of Proceeding	Amended first paragraph to inform reader that copy of application can be obtained from the Office's electronic records.
704.04 Statements and Things in Application or Registration	Amended first paragraph to indicate that file of involved application or registration is, rather than "may be," of record; and deleted reference to TBMP § 704.03(b) in first paragraph.
	Amended second paragraph to indicate that allegation of date of use of a mark and specimen in application are not evidence, replacing "documents

	and other things filed." Further noted that date of use must be established at trial and that specimen must be introduced to be considered evidence. Deleted the following from second paragraph: "This is because the adverse party has a right to confront and cross-examine the person making the allegations, and to question the authenticity of the specimens, documents, exhibits, etc. Thus, for example, the allegation in an application or registration of a date of use is not evidence on behalf of the applicant or registrant in an inter partes proceeding; to be relied on by the applicant or registrant, a claimed date of use of a mark must be established by competent evidence. [Note 173.]."
	Deleted the following from paragraph 3: "The specimens in the file of an application or registration are not evidence on behalf of the applicant or registrant, in an inter partes proceeding, unless they are identified and introduced in evidence as exhibits during the testimony period. [Note 175.] Affidavits or declarations in an application or registration file cannot be relied on by the applicant or registrant, in an inter partes proceeding, as evidence of the truth of the statements contained therein; the statements must be established by competent evidence at trial. [Note 176.] Similarly, statements made by counsel, and exhibits filed, in an application or registration do not constitute admissible evidence in the applicant's or registrant's behalf in an inter partes proceeding; the statements must be established by competent evidence, and the exhibits must be properly identified and introduced in evidence, at trial. [Note 177.] Further, the fact that the file of an application or registration that is the subject of a Board inter partes proceeding is automatically of record in that proceeding, does not mean that a registration claimed by applicant or registrant in the application or registration is also automatically of record. [Note 178.]"
	Updated paragraph 4 from: "Although the allegations made and documents and things filed in an application or registration are not evidence, in a Board inter partes proceeding, on *behalf* of the

	applicant or registrant (unless they are properly proved at trial), they may be used as evidence *against* the applicant or registrant, that is, as admissions against interest and the like."
	Added new Note 1, citing: *The Cold War Museum, Inc. v. Cold War Air Museum, Inc*., 586 F.3d 1352, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009).
	Added new cases to Note 2: *UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1047 (TTAB 2009); and *The Cold War Museum, Inc. v. Cold War Air Museum, Inc*., 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009).
	Added new Note 3, citing: *Baseball America, Inc. v. Powerplay Sports, Ltd*., 71 USPQ2d 1844, 1848, n.10 (TTAB 2004); *Levi Strauss & Co. v. R. Josephs Sportswear Inc*., 28 USPQ2d 1464, 1467 (TTAB 1993); *Omega SA v. Compucorp*, 229 USPQ 191, 193 n.10 (TTAB 1985); *Osage Oil & Transportation, Inc. v. Standard Oil Co*., 226 USPQ 905, 906 n.4 (TTAB 1985); and *Textron Inc. v. Arctic Enterprises, Inc*., 178 USPQ 315 (TTAB 1973).
	Deleted the following cases from Note 4: "*British Seagull Ltd. v. Brunswick Corp*., 28 USPQ2d 1197, 1200 (TTAB 1993) (exhibits, affidavits and market survey which had been submitted by applicant in connection with the prosecution of its application are not evidence in subsequent opposition proceeding to establish acquired distinctiveness unless properly introduced), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Kellogg Co. v. Pack'Em Enterprises Inc*., 14 USPQ2d 1545, 1547 n.6 (TTAB 1990) (reliance in brief on unproven statements in application), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1897 n.4 (TTAB 1989) (notice of reliance referring to declaration signed by applicant in applying for registration); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 531 n.7 (TTAB 1986) (claim of ownership of registration in application does not make registration of record); *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); *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 but 2(f) affidavit in application not admissible evidence of the truth of statements therein in inter partes proceeding)."
	Deleted the following cases from Note 4: "*Copperweld Corp. v. Arcair Co*., 200 USPQ 470, 474 n.3 (TTAB 1978) (claim of ownership of registration in application does not make registration of record)."
	Deleted the following cases from Note 4: "*Textron Inc. v. Arctic Enterprises, Inc*., 178 USPQ 315, 316 n.2 (TTAB 1973) (applicant cannot rely on dates of use alleged in application); *ILC Products Co. v. ILC, Inc*., 175 USPQ 722, 723 n.3 (TTAB 1972); and *Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc*., 174 USPQ 473, 476 (TTAB 1972) (self-serving statements made during prosecution of application are not admissible in cancellation proceeding). *See also W. T. Grant Co. v. Grant Avenue Fashions, Inc*., 135 USPQ 273 (TTAB 1962)."
	Deleted the following footnote between Note 4 and Note 5: "172. *See ILC Products Co. v. ILC, Inc*., 175 USPQ 722 (TTAB 1972); and *Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc*., 174 USPQ 473 (TTAB 1972). See also *W. T. Grant Co. v. Grant Avenue Fashions, Inc*., 135 USPQ 273 (TTAB 1962)."
	Deleted the following footnote from between Note 4 and Note 5: "173. 37 CFR § 2.122(b)(2). *See Levi Strauss & Co. v. R. Josephs Sportswear Inc*., 28 USPQ2d 1464, 1467 (TTAB 1993); *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); and *Textron Inc. v. Arctic Enterprises, Inc*., 178 USPQ 315 (TTAB 1973)."
	Deleted the following footnote from between Note 5 and Note 6: "175. 37 CFR § 2.122(b)(2). See

	Mason Engineering & Design Corp. v. Mateson Chemical Corp., 225 USPQ 956, 961 n.11 (TTAB 1985); and *Eikonix Corp. v. CGR Medical Corp*., 209 USPQ 607, 613 n.7 (TTAB 1981). *See also, Dap, Inc. v. Century Industries Corp*., 183 USPQ 122 (TTAB 1974)."
	Deleted the following footnote between Note 5 and Note 6: "176. *See British Seagull Ltd. v. Brunswick Corp*., 28 USPQ2d 1197, 1200 (TTAB 1993) (2(f) affidavits submitted during prosecution of application), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1897 n.4 (TTAB 1989) (declaration in support of application), and *Sunbeam Corp. v. Battle Creek Equipment Co*., 216 USPQ 1101, 1102 n.3 (TTAB 1982) (2(f) affidavit in application)."
	Deleted the following footnote between Note 5 and Note 6: "177. *See British Seagull Ltd. v. Brunswick Corp*., 28 USPQ2d 1197, 1200 (TTAB 1993) (exhibits and market surveys to show acquired distinctiveness during prosecution were not competent evidence in subsequent opposition proceeding), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *W. T. Grant Co. v. Grant Avenue Fashions, Inc*., 135 USPQ 273, 275 (TTAB 1962) (explanation of applicant's operations by applicant's counsel during ex parte prosecution was not admissible evidence in subsequent opposition)."
	Deleted the following footnote between Note 5 and Note 6: "178. *See Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc*., 185 USPQ 61, *recon. denied*, 185 USPQ 176 (TTAB 1975), *aff'd*,530 F.2d 1396, 189 USPQ 138, 140 (CCPA 1976); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 531 n. 7 (TTAB 1986); *Allied Mills, Inc. v. Kal Kan Foods, Inc*., 203 USPQ 390, 396 n.10 (TTAB 1979); and *Copperweld Corp. v. Arcair Co*., 200 USPQ 470, 474 n.3 (TTAB 1978)."
	Added new case to Note 5: *Bass Pro Trademarks, LLC v. Sportsman's Warehouse, Inc*., 89 USPQ2d 1844, 1851 (TTAB 2008). Deleted the following from parenthetical to *Sunbeam Corp. v. Battle Creek Equipment Co*., 216 USPQ 1101, 1102 n.3

	(TTAB 1982) in Note 6: "but 2(f) affidavit in application not admissible evidence of the truth of statements therein in inter partes proceeding."
704.05 Exhibits to Pleadings or Briefs	Subsection Heading only.
704.05(a) Exhibits to Pleadings	Amended recitation of 37 CFR § 2.122(d) to reflect rule change.
	Changed "one exception" to "two exceptions" in first paragraph.
	In second paragraph, changed "one exception" to "first exception;" clarified meaning of "such" in second sentence; indicated that under first exception, Office must issue the status and title copy.
	Added new third paragraph regarding second exception of filing printouts as allowed by change in 37 CFR § 2.122(d); added reference to TBMP § 704.03(b)(1)(A).
	Added new Note 3, citing: *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 n.4 (TTAB 2008).
	Deleted reference to TBMP § 317 in view of rule change.
	Deleted reference to TBMP § 704.03(b)(1)(A).
704.05(b) Exhibits to Briefs	Added new second paragraph to advise reader not to file evidence with party's brief.
	Added new cases to Note 1: *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).
	Added new Note 2, citing: *Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ 2d 1112, 1116 (TTAB 2009); and *Life Zone, Inc. v. Middleman Group, Inc.*, 87 USPQ2d 1953, 1955 n.4 (TTAB 2008).
704.06 Statements in Pleadings or Briefs	Subsection Heading only.
704.06(a) Statements in Pleadings	Added new case to Notes 1 and 2: *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010).
	Amended parenthetical to *Kellogg Co. v. Pack'Em Enterprises Inc.,* 14 USPQ2d 1545, 1548 n.6

	(TTAB 1990) in Note 2.
704.06(b) Statements in Briefs	Added new cases to Note 1: *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008); *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007); *Schering-Plough HealthCare Products, Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1328 (TTAB 2007); *DC Comics v. Pan American Grain Mfg. Co*., 77 USPQ2d 1220, 1224 n.5 (TTAB 2005); and *Baseball America, Inc. v. Powerplay Sports, Ltd*., 71 USPQ2d 1847, 1847 (TTAB 2004).
704.07 Official Records	Added new case to Note 1: *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1920 (TTAB 2006).
	Updated *Black's Law Dictionary* citation from "Fifth Edition, 1979" to "Sixth Edition, 1990)" in Note 2.
	Added new cases to Note 2: *Research In Motion Ltd. v. NBOR Corp*., 92 USPQ2d 1926, 1929 (TTAB 2009); *Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009); and *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.3 (TTAB 2007).
	Added new cases to Note 4: *Coach Services Inc. v. Triumph Learning LLC,* 96 USPQ2d 1600 (TTAB 2010); *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1826 (TTAB 2010); *Research In Motion Ltd. v. NBOR Corp*., 92 USPQ2d 1926, 1929 (TTAB 2009); *UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009); *Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009); *Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009)*; Black & Decker Corp. v. Emerson Electric Co*., 84 USPQ2d 1482, 1485 (TTAB 2007); *Wet Seal, Inc. v. FD Management, Inc*., 82 USPQ2d 1629, 1632 (TTAB 2007).
704.08 Printed Publications	Section heading only. This section has now been divided into three new subsections, one dealing with traditional printed publications (704.08(a)), one dealing with Internet materials (704.08(b)), and the third with other printed materials (704.08(c)).
704.08(a) Traditional Printed Publications	This is a new subsection addressing how to make traditional printed publications (i.e. books) of record by notice of reliance.
	Amended third paragraph to inform reader that

	party offering publications under notice of reliance need make showing of admissibility only upon challenge.
	Added new cases to Note 2: *Panda Travel Inc. v. Resort Option Enterprises Inc.*, 94 USPQ2d 1789, 1793 (TTAB 2009); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1857 (TTAB 2007); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1813 (TTAB 2005), *rev'd on other grounds*, No. 05-2037, slip op. (D.D.C. Apr. 3, 2008).
	Deleted reference to TBMP § 707 in Note 3.
	Added new cases to Note 5: *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1929 (TTAB 2009); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009); *Hiraga v. Arena*, 90 USPQ2d 1102, 1104 (TTAB 2009)*; Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1956-59 (TTAB 2008); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886, n.6 (TTAB 2008); *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1914 (TTAB 2007); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1500 (TTAB 2005).
	Added new cases to Note 6: *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2010); *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); *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).
	Added new cases to Note 9: *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886 n.6 (TTAB 2008); and *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1485 (TTAB 2007).
	Changed parenthetical to *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) in Note 9 from "improper subject matter and improper rebuttal considered" to "matter improper for notice of reliance and for rebuttal considered."

	Changed parenthetical to *Jeanne-Marc, Inc. v. Cluett, Peabody & Co*., 221 USPQ 58 (TTAB 1984) in Note 9 from "annual reports improper subject matter considered" to "annual reports and responses to document production request considered."
704.08(b) Internet Materials	This is a new subsection explaining the Board's current policy regarding submission of evidence obtained from the Internet, citing *Safer, Inc. v. OMS Investments, Inc*., 94 USPQ2d 1031 (TTAB 2010).
	Deleted subheading "Internet evidence and other materials that are not self authenticating."
	Amended to inform reader that Board considers Internet documents that display date and source to be presumptively true and genuine. Deleted the following from paragraph 1: "The element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed out from the Internet. [Note 207.] Internet postings are transitory in nature as they may be modified or deleted at any time without notice and thus are not 'subject to the safeguard that the party against whom the evidence is offered is readily able to corroborate or refute the authenticity of what is proffered.' [Note 208.] For this reason, Internet printouts cannot be considered the equivalent of printouts from a NEXIS search where printouts are the electronic equivalents of the printed publications and permanent sources for the publications are identified. [Note 209.]"
	Added new Note 1, citing: *Safer, Inc. v. OMS Investments, Inc*., 94 USPQ2d 1031 (TTAB 2010) and *Coach Services Inc. v. Triumph Learning LLC,* 96 USPQ2d 1600 (TTAB 2010).
	Added new Note 2, citing: *Safer, Inc. v. OMS Investments, Inc*., 94 USPQ2d 1031 (TTAB 2010).
704.08(c) Other Printed Materials	This is a new subsection which previously fell under the subheading "other materials that are not self-authenticating."
	Added new case to Note 1: *Paris Glove of Canada Ltd. v. SBC/Sporto Corp*., 84 USPQ2d 1856, 1857 (TTAB 2007).
	Added new Note 3, citing: *Safer, Inc. v. OMS Investments, Inc*., 94 USPQ2d 1031, 1039 (TTAB 2010).

	Deleted the following footnote from between Note 2 and new Note 3: "207. *See Raccioppi v. Apogee Inc*., 47 USPQ2d 1368, 1370 (TTAB 1998). *See also In re Total Quality Group Inc*., 51 USPQ2d 1474, 1476 (TTAB 1999)."
	Deleted the following footnote from between Note 2 and new Note 3: "208. *Weyerhaeuser v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992) citing *Glamorene Products Corporation v. Earl Grissmer Company, Inc*., 203 USPQ 1090, 1092 n.5 (TTAB 1979). *See also Raccioppi v. Apogee Inc*., 47 USPQ2d 1368, 1370 (TTAB 1998); *Michael S. Sachs Inc. v. Cordon Art B.V*., 56 USPQ2d 1132, 1134 (TTAB 2000) (introduction of telephone listings retrieved from Internet was improper); and *Plyboo America Inc. v. Smith & Fong Co*., 51 USPQ2d 1633, 1634 n.3 (TTAB 1999) (printout of page of website is not proper subject matter for a notice of reliance)."
	Deleted the following footnote from between Note 2 and new Note 3: "209. *See Raccioppi v. Apogee Inc*., 47 USPQ2d 1368, 1370 (TTAB 1998). *See also In re Total Quality Group Inc*., 51 USPQ2d 1474, 1476 (TTAB 1999) (examining attorney's request for judicial notice of on-line dictionary definitions denied because the definitions were not available in printed format). *Cf. In re CyberFinancial.Net Inc*., 65 USPQ2d 1789, 1791 n.3 (TTAB 2002) (judicial notice taken of online dictionary definition where resource was also available in book form)."
	Added new case to Note 4: *Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741, 1748 (TTAB 2006); and deleted the following from Note 15: "*Raccioppi v. Apogee Inc*., 47 USPQ2d 1368, 1371 (TTAB 1998) with respect to introducing Internet evidence in connection with a summary judgment motion."
	Added new cases to Note 5: *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009); *Tea Board of India v. Republic of Tea Inc*., 80 USPQ2d 1881, 1884 n.8 (TTAB 2006); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1931 n.26 (TTAB 2006); and *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1813 (TTAB 2005),

	rev'd on other grounds, No. 05-2037, slip op. (D.D.C. Apr. 3, 2008).
	Deleted the following cases from Note 5: "*Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1371 (TTAB 1998) (the reliability of the information becomes a matter of weight or probative value to be given the Internet evidence). *See also In re Remacle*, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002) (involving Internet articles from sources outside the United States)."
704.09 Discovery Depositions	Amended recitation of 37 CFR § 2.120(j) to reflect rule change.
	Amended paragraph 8 to advise reader that introduction of discovery deposition of witness not necessarily precluded by failure to identify witness in initial disclosures.
	Amended paragraph 9 to inform reader that written disclosures and disclosed documents should not be filed with the Board except under enumerated situations; and to delete the following: "The Board may return discovery papers or materials filed under other circumstances."
	Deleted the following case from Note 1: *Ethicon, Inc. v. American Cyanamid Co.*, 192 USPQ 647, 651 n.11 (TTAB 1976) (deposed party may not rely on statements made in discovery deposition if the deposition is not made of record).
	Added new case to Notes 3 and 5: *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1862 (TTAB 2009). Deleted the following case from Note 3: *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321 (TTAB 1992).
	Added new Note 8, citing: *See Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2001)
	Added new case to Note 11: *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 n.6 (TTAB 2008).
	Added new case to Note 12: *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009).
704.10 Interrogatory Answers; Admissions	Amended reference to 37 CFR § 2.120(j) to reflect rules changes.
	Amended paragraph 4 from: "Offering interrogatory answers, or admissions, on the

	record during the taking of a testimony deposition is the equivalent of serving and filing a notice of reliance by mail" to: "Interrogatory answers, or admissions, may be admitted into evidence through the testimony deposition of a witness as an alternative to the notice of reliance procedure."
	Amended paragraph 8 to include materials obtained through the disclosure process in category of materials that should not be filed with Board except under specified conditions. Deleted the following from paragraph 8: "The Board may return discovery papers or materials filed under other circumstances." Added statement to paragraph 8 to inform reader that not all documents produced in response to document production request may be submitted under notice of reliance.
	Amended paragraph 10 to include reference to TBMP § 407 for the information regarding effect of not responding to a request for admission.
	Added new case to Note 3: *Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009).
	Added new Note 4, citing, by comparison: *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957 n.10 (TTAB 2008).
	Added new case to Note 5: *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1503 (TTAB 2007).
	Added new case, by example, to Note 10: *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1848 n.6 (TTAB 2008). Added new case, by comparison, to Note 10: *Hiraga v. Arena*, 90 USPQ2d 1102, 1106 (TTAB 2009).
	Deleted reference to TBMP § 409.
704.11 Produced Documents	Amended 37 CFR § 2.120(j)(3)(ii) to reflect rules changes.
	Amended second paragraph to include documents obtained through disclosure in list of documents that may not be made of record by notice of reliance alone; and included "Internet documents" in list of produced documents that may be made of record by notice of reliance. Added references to TBMP §§ 704.07 and 704.08 in second paragraph.
	Amended third paragraph, including subparts (1)-(8), to include documents obtained through

	disclosure in list of methods by which such documents may be made of record. Clarified subpart (2) in third paragraph to address need to serve request for production of Fed. R. Civ. P. 34 documents early in discovery. Clarified subpart (5) to include "Internet materials" in list of produced documents that may be made of record by notice of reliance.
	Included "initial disclosures" in fourth paragraph, as subject for which further information may be found in TBMP §§ 401 and 406.
	Added new paragraph 5, noting that party may make of record its response that no responsive documents exist.
	Added new case to Note 1: *Kohler Co. v. Baldwin Hardware Corp*., 82 USPQ2d 1100, 1103-1104 (TTAB 2007).
	Added new cases to Note 2: *Safer, Inc. v. OMS Investments, Inc*., 94 USPQ2d 1031, 1039 (TTAB 2010); *Giersch v. Scripps Networks Inc*., 90 USPQ2d 1020, 1022 (TTAB 2009); and *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886 n.5 (TTAB 2008).
	Deleted the following from Note 2: "Janet E. Rice, *TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record*, 67 Trademark Rep. 54 (1977)."
	Added new reference and case to Note 5: 37 CFR § 2.122(e); and *Safer, Inc. v. OMS Investments, Inc*., 94 USPQ2d 1031, 1039 (TTAB 2010).
	Added new Note 6, citing: *Ballet Tech Foundation Inc. v. Joyce Theater Foundation Inc*., 89 USPQ2d 1262, 1265 n.8 (TTAB 2008); and, by comparison, *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).
	Added new Note 8, citing: *L.C. Licensing Inc. v. Berman,* 86 USPQ2d 1883, n.5 (TTAB 2008).
704.12 Judicial Notice	No substantive changes.
704.12(a) Kind of Fact That May be Judicially Noticed	Added new reference to TBMP § 1208.04 in second paragraph.
	Added new cases to Note 2: *Enbridge Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1542 n.9 (TTAB 2009); *UMG Recordings, Inc. v. Charles*

	O'Rourke, 92 USPQ2d 1042, 1046 (TTAB 2009); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 (TTAB 2009); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590 n.8 (TTAB 2008); *H.D. Lee Co. v. Maidenform Inc*., 87 USPQ2d 1715, 1723 (TTAB 2008); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1889 (TTAB 2008); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007); *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1192 n.9 (TTAB 2007); *Black & Decker Corp. v. Emerson Electric Co*., 84 USPQ2d 1482, 1485 (TTAB 2007); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1379 n.7 (TTAB 2006); *Motion Picture Association of America Inc. v. Respect Sportswear Inc*., 83 USPQ2d 1555, 1558 (TTAB 2007); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1931 n.26 (TTAB 2006); and *Omega SA v. Compucorp*, 229 USPQ 191 (TTAB 1985).
	Deleted the following from Note 2: *Quaker Oats Co. v. Acme Feed Mills, Inc*., 192 USPQ 653 (TTAB 1976) (law of any jurisdiction, when a copy thereof is submitted under notice of reliance--yes).
	Added parenthetical to citation of *Boswell v. Mavety Media Group Ltd*., 52 USPQ2d 1600, 1605 (TTAB 1999) in Note 2.
704.12(b) When Taken	No changes made.
704.12(c) Opportunity to be Heard	No changes made.
704.12(d) Time of Taking Notice	No changes made.
704.13 Testimony From Another Proceeding	Corrected typographical error (extra word "have") in Note 1.
	Changed "n.15" to "n.13" in parenthetical to *Philip Morris Inc. v. Brown & Williamson Tobacco Corp*., 230 USPQ 172, 182 (TTAB 1986) in Note 2.
704.14 Initial Disclosures and Disclosed Documents (new subsection)	This is a new subsection, referencing 37 CFR § 2.120(j); and TBMP §§ 704.07 and 704.08 (in paragraph 2). This subsection addresses how to make written disclosures and disclosed documents of record in Board proceeding; and informs reader that same may be used during examination of witness but may not be filed with Board except under specified circumstances.
	Added new Note 1, referencing: 37 CFR

	§ 2.120(j)(3)(i); and citing: *Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1117 (TTAB 2005); and *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1956 (TTAB 2008).
	Added new Note 2, referencing: 37 CFR § 2.120(j)(3)(i).
	Added new Note 3, referencing: 37 CFR § 2.120(j)(3)(ii).
	Added new Note 4, citing: *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008); and referencing: Notice of Final Rulemaking, Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (Aug. 1, 2007).
	Added new Note 5, referencing: 37 CFR § 2.120(j)(5).
	Added new Note 6, referencing: 37 CFR § 2.120(j)(6).
	Added new Note 7, referencing: 37 CFR § 2.120(j)(7).
	Added new Note 8, referencing 37 CFR § 2.120(j)(8); and citing: *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) (new title)	Updated Section Heading from "Stipulated Evidence"
	Amended first paragraph to indicate that parties may agree to stipulate to entire trial record; and that later objections may not be raised where party has failed to reserve right to object.
	Added new paragraph 3 to inform reader that ACR may be available; referencing TBMP §§ 528.05(a)(2) and 702.04.
	Added new Notes 1 and 2, citing: *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007).
	Deleted the following from between new Note 2 and new Note 3: "See Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 397-398 (1985)."

	Added new Note 3, citing: *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2009).
	Added new Note 5, citing: *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1824 (TTAB 2009); *Eveready Battery Co., Inc. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676 (TTAB 2007); *Ballet Tech Foundation Inc .v. Joyce Theater Foundation Inc.*, 89 USPQ2d 1262, 1265 n.8 (TTAB 2008); and *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998).
706 Noncomplying Evidence	Added new cases to Note 1: *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1846 n.8 (TTAB 2004); and *The Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 748 (TTAB 1986). Deleted the following from Note 1: "Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board,* 75 Trademark Rep. 323, 393 (1985)."
707 Objections to Evidence	Section Heading only.
707.01 In General	No substantive changes made.
707.02 Objections to Notices of Reliance	Subsection Heading only.
707.02(a) In General	No substantive changes made.
707.02(b) On Procedural Grounds	Amended first paragraph to inform reader that procedural objections that could be cured but which are not timely raised are deemed waived.
	Deleted the following from Note 3: "*Johnson & Johnson v. American Hospital Supply Corp.*, 187 USPQ 478, 479 (TTAB 1975) (Board, on reconsideration, reversed its decision to treat defendant's objection to notice of reliance as motion to strike since opposer did not file a brief in response to objections but instead intended to argue against the objections in its trial brief)."
707.02(b)(1) On Ground of Untimeliness	Added new case to Note 1: *Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1902 (TTAB 2006).
707.02(b)(2) On Other Procedural Grounds	Added new case to Note 2: *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009).
707.02(c) On Substantive Grounds	Deleted the following from Note 2: "Louise E. Frugé, *TIPS FROM THE TTAB: An 'Object' Lesson*, 72 Trademark Rep. 211 (1982)."

707.03 Objections to Trial Testimony Depositions	Subsection Heading only.
707.03(a) In General	Amended statement that objection must be raised promptly or it is waived to indicate that statement is "deemed waived."
	Added new Note 1, citing: *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.,* 77 USPQ2d 1492, 1495 (TTAB 2005).
707.03(b) On Procedural Grounds	Subsection Heading only.
707.03(b)(1) On Ground of Untimeliness	No substantive changes made.
707.03(b)(2) On Ground of Improper or Inadequate Notice	Amended recitation of 37 CFR § 2.123(e)(3) to reflect rules changes.
707.03(b)(3) On Ground of Failure to Disclose (new subsection)	This is a new subsection, referencing 37 CFR § 2.121(e) and 37 CFR § 2.123(e)(3); and addressing a party's right to object to improper or inadequate pretrial disclosures.
	Added new Note 1, referencing 37 CFR § 2.123(e)(3); 37 CFR § 2.118; and Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007); and citing: *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009).
	Added new Note 2, referencing 37 CFR § 2.121(e); and citing: *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009).
707.03(c) On Other Procedural Grounds and on Substantive Grounds	Amended recitation of 37 CFR § 2.123(e) and Fed. R. Civ. P. 32(d) to reflect recent amendments to rules.
	Changed citation from TBMP § 707.03 to 707.03(a) in second paragraph.
	Added new subheading (4), regarding signatures to testimonial deposition transcripts.
	Amended third-to-last paragraph to advise reader to preserve objections raised at trial by including same as an appendix or statement filed with brief.
	Added new Note 1, citing: *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116 (TTAB 2009).
	Added new case to Note 2: *Hornby v. TJX Companies, Inc.*, 87 USPQ2d 1411, 1417 (TTAB 2008).

	Added new case to Note 4: *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009).
	Deleted the following from Note 5: "*Beech Aircraft Corp. v. Lightning Aircraft Co., supra.*"
	Deleted the following from Note 7: *See* Louise E. Frugé, *TIPS FROM THE TTAB: An 'Object' Lesson*, 72 Trademark Rep. 211 (1982)."
	Added new case, by example, to Note 8: *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005).
	Added new cases to Note 12: *Anthony's Pizza & Pasta International, Inc. v. Anthony's Pizza Holding Co., Inc.*, 95 USPQ2d 1271, 1273 n.4 (TTAB 2009), *aff'd,* No. 2010-1191, slip op. (Fed. Cir. Nov. 18, 2010); *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1718 n.25 (TTAB 2007)*; Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007); *Duramax Marine LLC v. R.W. Fernstrum & Co.,* 80 USPQ2d 1780, 1785 (TTAB 2006); *First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 77 USPQ2d 1334, 1340 n.14 (TTAB 2005), *rev'd on other grounds*, 476 F.3d 867, 81 USPQ2d 1375 (Fed. Cir. 2007).
	Added new Note 13, citing: *Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741, 1747 (TTAB 2006).
707.03(d) Refusal to Answer Deposition Question	Amended first paragraph to clarify what information may be withheld by witness.
	Amended second paragraph to clarify that a party may seek the assistance of a court when the deposition is being taken pursuant to subpoena.
707.04 Waiver of Objection	Amended paragraph 7 to include failure to make objections in an appendix to brief or statement of objections filed with brief as waiver of objections raised at trial.
	Added new case to Note 1: *Coach Services Inc. v. Triumph Learning LLC,* 96 USPQ2d 1600 (TTAB 2010).
	Added new Note 2, citing: *Hornby v. TJX Companies, Inc.*, 87 USPQ2d 1411, 1417 (TTAB 2008).
	Deleted the following from Note 4: "*Official Gazette* of June 21, 1983 at 1031 TMOG 13, at

	22;" and "T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 274 (1984)."
	Added new cases to Note 5: *Anthony's Pizza & Pasta International, Inc. v. Anthony's Pizza Holding Co., Inc.*, 95 USPQ2d 1271, 1273 n.4 (TTAB 2009), *aff'd,* No. 2010-1191, slip op. (Fed. Cir. Nov. 18, 2010); *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1718 n.25 (TTAB 2007)*; Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007); *Duramax Marine LLC v. R.W. Fernstrum & Co.,* 80 USPQ2d 1780, 1785 (TTAB 2006); *First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 77 USPQ2d 1334, 1340 n.14 (TTAB 2005), *rev'd on other grounds*, 476 F.3d 867, 81 USPQ2d 1375 (Fed. Cir. 2007).

INDEX TO CHANGES IN THIRD EDITION
CHAPTER 800

TBMP SECTION	NATURE OF CHANGE
801 Briefs on the Case	Section Heading only.
801.01 Briefs on the Case: In General	Amended paragraph 2 to add that exhibits to briefs are generally unnecessary and are discouraged.
	Amended paragraph 3 to add that Board will deem claim or affirmative defense waived if not referenced in brief.
	Added new Note 1, citing: *Life Zone Inc. v. Middleman Group Inc.,* 87 USPQ2d 1953, 1955 (TTAB 2008) and *ITC Entertainment Group Ltd v. Nintendo of America Inc.,* 45 USPQ2d 2021, 2022 (TTAB 1998).
	Added new Note 2, citing: *Barbara's Bakery Inc. v. Landesman,* 82 USPQ2d 1283, 1292 (TTAB 2007) and *Knight Textile Corp. v. Jones Investment Co.,* 75 USPQ2d 1313, 1314 n.4 (TTAB 2005).
801.02 Time for Filing	No substantive changes.
801.02(a) Plaintiff's Main Brief	No substantive changes.
801.02(b) Briefs on the Case: Defendant's Main Brief	Deleted "T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 275 (1984)" from Note 1.
801.02(c) Briefs on the Case: Plaintiff's Reply Brief	Deleted "T. Jeffrey Quinn, *TIPS FROM THE TTAB: The Rules Are Changing*, 74 Trademark Rep. 269, 275 (1984)" from Note 1.
801.02(d) Reply Brief for Defendant Not Permitted	Amended first paragraph to advise reader that defendant may counter arguments raised by plaintiff in its reply brief during oral argument. Added new Note 1, citing: *United Foods Inc. v. United Airlines, Inc.,* 33 USPQ2d 1542 (TTAB 1994).
801.02(e) Special Situations	At the end of the second paragraph, amended the citation to the TBMP to specifically identify the relevant form in the Appendix of Forms.
	At the end of the third paragraph, deleted the reference to TBMP § 1109 (example of a briefing schedule in a concurrent use proceeding) because the briefing schedule has been deleted.

801.03 Form and Contents of Brief	Amended reference to 37 CFR § 2.126 to reflect rules changes.
	Amended first paragraph to inform reader that briefs may not be filed on CD-ROM. Deleted instruction to file paper copy of brief together with CD-ROM format, as latter format is no longer permitted.
	Added sentence in paragraph 3 that appendices to a brief may not be used to avoid the page limitation.
	Amended paragraph 5 to advise reader that non-precedential cases may be cited in motions and briefs.
	Added a new sixth paragraph, explaining that parties may cite cases from any jurisdiction, but that the Board relies primarily on precedent from the Court of Appeals for the Federal Circuit because that court is the Board's reviewing court and because its cases address registration issues more specifically.
	Amended paragraph 9 to add a statement clarifying that the reply brief should be limited to the key points in defendant's brief which plaintiff believes require clarification or response.
	In the subsection titled "Confidential information" amended available for public "inspection and copying" to "viewing via TTABVUE" and provided website address; further amended first paragraph of the subsection to explain how to file confidential information in paper form or via ESTTA and advised reader that majority of TTAB records since 2001 have been stored electronically.
	In the penultimate paragraph of this subsection, deleted "Confidential materials filed in the absence of a protective order are not regarded as confidential and will not be kept confidential by the Board," and inserted "The Board's standard protective order is applicable during disclosure, discovery and trial in all proceedings, unless modified by the parties." Further amended the paragraph to indicate that ESTTA filing is strongly encouraged and that material designated as confidential must be filed in paper under separate cover or designated in ESTTA as confidential using the separate filing option.

	Added new Note 1, referencing 37 CFR § 2.126, to explain that a brief filed by CD-ROM may not be considered and that the only time a party may file a CD-ROM is as an exhibit to a deposition introducing audio and/or video evidence.
	Deleted from Note 4: *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894 (TTAB 1992).
	Added new Note 5, citing: *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998).
	Added new Note 6, citing: *In re Carlson,* 91 USPQ2d 1198, 1199 n.2 (TTAB 2009).
	Added new Note 7, citing: "Citation of Opinions to the Trademark Trial and Appeal Board," OG Notices: 23 January 2007.
	Added new Note 8, citing: *Grand Canyon West Ranch LLC v. Hualapai Tribe,* 88 USPQ2d 1501, 1506 n.2 (TTAB 2008).
	Added new reference to Note 9: 37 CFR § 2.27(d).
	Amended Notes 10 and 11 to update the reference to 37 CFR § 2.126(c) from former 37 CFR § 2.126(d). Deleted from Note 10: "Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 Trademark Rep. 653 (1981)."
	Deleted from Note 12: "*Harjo v. Pro-Football, Inc.,* 50 USPQ2d at 1713-1714 (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)."
	Deleted what was formerly Note 13, referencing: "David J. Kera, *TIPS FROM THE TTAB: Preparing and Filing Briefs with the Trademark Trial and Appeal Board,* 66 Trademark Rep. 141 (1976)."
801.04 Amicus Briefs	No substantive changes.
801.05 Motion to Strike Brief on Case	No substantive changes.
802 Oral Hearing	Amended reference to 37 CFR § 2.129(a) to reflect August 31, 2007 rules changes.
802.01 Oral Hearing: In General	At the end of the second paragraph, added the following sentence: "If neither party requests an

	oral hearing, the case will be decided on the evidence made of record during the testimony periods."
	Deleted from Note 2: "Saul Lefkowitz*, TIPS FROM THE TTAB: Presentation of an Oral Hearing Before the Trademark Trial and Appeal Board*, 67 Trademark Rep. 283 (1977)."
802.02 Request for Oral Hearing	No substantive changes.
802.03 Time and Place of Hearing	Amended first paragraph to clarify that hearings are only scheduled on Tuesday, Wednesday or Thursday and that they are scheduled between 10:00 and 3:00 (Eastern Standard Time).
	Revised the process detailed in second paragraph of subsection for requesting attendance at an oral hearing via video conferencing.
	Deleted, as no longer applicable, discussion of off-site video conference centers available for use for oral hearings located in Sunnyvale, California and Detroit, Michigan.
	In Note 4, changed 37 CFR § 2.129(a) to (b).
802.04 Before Whom Held	Changed references to Board members to judges.
	In Note 1, deleted reference to 37 CFR § 2.142(e)(1) and added comment to advise reader that judges no longer provide handwritten signature on decisions.
	In Note 2, amended parenthetical to *Ronson Corp. v. Ronco Teleproducts, Inc.,* 197 USPQ 492, 494 (Comm'r 1978) to change reference to judges to Board members.
	Added new references to Note 3: *In re Lebanese Arak Corp.,* 94 USPQ2d 1215 (TTAB 2010) and *In re Active Ankle Systems Inc.,* 83 USPQ2d 1532 (TTAB 2007).
802.05 Length of Oral Argument	In the first paragraph, added the clarification that no additional time for oral argument is allotted for counterclaims or consolidated proceedings.
802.06 Audio Recording and Video Recording	Changed title and section to delete "taping" and replace with "recording."
802.07 Visual Aids, etc.	Amended section to refer to video "recording" instead of video "tape."
802.08 Nature of Hearing	Changed "Board members" to "judges."
	Deleted reference to: "Saul Lefkowitz, *TIPS*

	FROM THE TTAB: Presentation of an Oral Hearing Before the Trademark Trial and Appeal Board, 67 Trademark Rep. 283 (1977)."
803 Final Decision	Changed "Board members" and "panel members" to "judges."
	Amended paragraph 5 to add the fact that final decisions are available for public viewing via TTABVUE and the USPTO e-FOIA database, and provided web address for accessing same.
	Deleted the following from penultimate paragraph: "decisions are grouped first by year decided and then by issues. Within the groupings of issues, the decisions are listed by proceeding number."
	Added new Note 2, citing, by example: *In re Lebanese Arak Corp.,* 94 USPQ2d 1215 (TTAB 2010).
804 Request for Rehearing, Reconsideration, or Modification of Final Decision	No substantive changes.
805 Final Decision Remand to Examining Attorney	No substantive changes.
806 Termination of proceeding	Replaced former step-by-step listing of operating procedures taken upon termination of proceeding with new listing to reflect electronic workflow; deleted the former listing of operating procedures as obsolete.
	Added new Note 1, citing: 37 CFR § 2.145(c).
807 Status of Application After Proceeding	Amended second paragraph to reflect the electronic workflow.

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CHAPTER 900

TBMP SECTION	NATURE OF CHANGE
901 Appeals--In General	Amended reference to Trademark Act § 21 to reflect changes to statute.
901.01 Avenues of Appeal	Added sentence to inform reader that Federal Circuit is often referred to in Board decisions as "our primary reviewing court."
	Updated reference to Trademark Act § 21(a)(1) by including "(a)(1)" in parallel reference.
	Added new Note 4, citing: *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); and *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	Section heading only.
901.01(A) Final Decision Versus Interlocutory Decision	Amended parenthetical to *Hewlett Packard v. Vudu, Inc.,* 92 USPQ2d 1630, n.5 (TTAB 2009) in Note 2.
901.02(b) Judgment Subject to Establishment of Constructive Use	No substantive changes.
902 Appeal To Court Of Appeals For The Federal Circuit	Section Heading only.
902.01 Notice Of Appeal	Amended reference to 37 CFR § 104.2 to reflect rule changes; updated USPTO address in second paragraph to correct address to use for mailing notice of appeal and updated contact information in fourth paragraph from Office of the General Counsel to Office of the Solicitor.
	Updated Notes 1 and 8 to display correct website address for Federal Circuit court.
902.02 Time for Filing Notice of Appeal; Cross Appeal	Amended first paragraph to clarify filing deadlines for filing appeal when period falls on February 28, or on a Saturday, Sunday, or Federal holiday.
	Amended paragraph 3 to explain how to calculate time to file appeal following request for rehearing, reconsideration, or modification; and explained

	that Board rules do not permit second or subsequent request for reconsideration.
	Updated paragraphs 5 and 6 to advise correct address at which to file request for extension of time to file an appeal and that the Director acts through the Office of the Solicitor to determine timeliness of request.
	Added new Notes 2, 3, 6, and 7, referencing: 37 CFR § 2.129(d)(2).
902.03 Appeal To Federal Circuit Waives Appeal By Civil Action	No substantive changes.
902.04 Notice of Election to Have Review By Civil Action	Amended first paragraph to update contact information for filing notice of election by mail.
902.05 Information Concerning Times Specified In 37 CFR § 2.145	No substantive changes.
902.06 Certified List	Amended first paragraph to clarify that it is the Director, acting through the Office of the Solicitor, who handles preparation of the certified list.
902.07 Appeal Briefs, Appendix, Etc.	Updated contact information for Federal Circuit to include current website address; deleted reference to "Federal Circuit Rules and Appeals to the Federal Circuit From PTO, 1120 TMOG 22 (November 13, 1990)" as redundant.
902.08 Special Provisions for Ex Parte Cases	Amended first paragraph to indicate that the Director acts through the Office of the Solicitor; added new paragraph 3 to advise reader that questions regarding contents of the appendix should be directed to the Office of the Solicitor; and added new paragraph 4 to advise reader that USPTO may move to participate as appellee in *inter partes* case.
	Added new Note 3, citing: *In re Bose Corp.*, 580 F.3d. 1240, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009)
903 Appeal By Civil Action	Section Heading only.
903.01 Notice of Civil Action	Clarified that Board may treat its own decision as final in event party fails to notify Board of commencement of civil action.
903.02 Parties To And Service Of Civil Action	No substantive changes.
903.03 Place Of Civil Action	Added paragraph to indicate USPTO resides in Eastern District of Virginia.

	Added new Note 2, referencing 35 U.S.C. § 1(b).
903.04 Time For Filing Civil Action, Cross-Action	Added reference to 37 CFR § 2.145(d)(2); amended first and second paragraphs to clarify calculation of filing deadlines when period falls on February 28, or on a Saturday, Sunday, or Federal holiday and calculation following request for rehearing, reconsideration, or modification; explained that Board rules do not permit second or subsequent request for reconsideration.
	Added address of Office of the Solicitor for mailing purposes to paragraph 4.
	Added new Notes 2, 3, 7, and 8, referencing: 37 CFR § 2.145(d)(2).
903.05 Information Concerning Times Specified In 37 CFR § 2.145	No substantive changes.
903.06 Civil Action Precluded By Appeal To Federal Circuit	No substantive changes.
903.07 Special Provisions For Ex Parte Cases	No substantive changes.
904 Access To Record During Appeal	Section Heading only.
904.01 Access During Appeal To Federal Circuit	Added new paragraph to inform reader about TTABVUE and inspection of files.
904.02 Access During Appeal By Civil Action	Added new paragraph to inform reader about TTABVUE and inspection of files.
	Added new Note 1, referencing: 15 U.S.C. § 1071(b)(3).
905 Petition To The Director	Amended reference to 37 CFR § 2.146(c) to reflect rules changes.
	Amended paragraph 6 to clarify that petition must be filed with “two months,” not “60 days.”
	Amended paragraph 7 to inform reader that Board may exercise discretion to suspend inter partes proceeding pending Director’s decision on petition.
906 Standards Of Review Of Board Decisions	Amended text to clarify party’s options to seek review of Board’s decision by either appeal to U.S. Court of Appeals for the Federal Circuit or by filing a civil action in a federal district court.
906.01 Appeal To Federal Circuit Or By Civil Action	Amended paragraph 5 to explain that under substantial evidence standard, Board’s decision must be sustained where it represented one of two different conclusions, each warranted by the

	record.
	Amended statement, in paragraph 6, setting forth examples of findings of fact to delete reference to review thereof under “substantial deference” standard.
	Amended subsection headed “Conclusions of law” to delete “without deference to the Board” in explaining that conclusions of law are reviewed de novo.
	Added two new paragraphs to subsection headed “Conclusions of law” to provide examples for the reader of conclusions of law and further information regarding “substantial deference” standard.
	Added new case to Note 8: *Aycock Engineering Inc. v. Airflite Inc.*, 90 USPQ2d 1301, 1304 (Fed. Cir. 2009); added parenthetical to citation of *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000) in Note 8.
	Added new note 14, citing: *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).
	Added new note 15, citing: *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000).
	Added new note 16 citing: *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002).
	Added new note 17 citing: *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1040 (Fed. Cir. 1990); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004); *In re Compagnie Generale Maritime*, 993 F.2d 841, 845, 26 USPQ2d 1652, 1654 (Fed.Cir.1993); and *In re Chippendales USA,* 2009-1370, slip op. at 6 (Fed. Cir. 2010).
	Added new note 18 citing: *In re Slokevage,* 441 F.3d 957, 78 USPQ2d 1395, 1397 (Fed. Cir. 2006).
	Added new note 19 citing: *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Glendale*

	Int'l. Corp. v. USPTO, 374 F. Supp. 2d 479, 75 USPQ2d 1139, 1143 (E.D. Va. 2005).
	Added new note 20 citing: *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002); *Spraying Systems Co. v. Delavan Inc.*, 975 F.2d 387, 24 USPQ2d 1181, 1184 (7th Cir. 1992); *Sunrise Jewelry Mfg. Corp. v. Fred, S.A.*, 175 F.3d 1322, 50 USPQ2d 1532, 1534 (Fed. Cir. 1999).
	Added new note 21, citing: *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010); *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).
	Added new note 22, citing: *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 159, 82 USPQ2d 1414 (2nd Cir. 2007); *Star Industries Inc. v. Bacardi & Co. Ltd.,* 412 F.3d 373, 75 USPQ2d 1098, 1102, n.2 (2nd Cir. 2005); *Int'l Bancorp, LLC, Int'l Services, Inc.; Int'l Lotteries, LLC; Las Vegas Sportsbook, Inc.; Britannia Finance Corp. v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco,* 329 F.3d 359, 66 USPQ2d 1705 (4th Cir. 2003); *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997); *Eastman Kodak Co. v. Bell & Howell Document Management Prods., Co.*, 994 F.2d 1569, 26 USPQ2d 1912, 1915-16 (Fed.Cir.1993); *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 634 (7th Cir. 1993); and, by signal "but see:" *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1781 (Fed. Cir. 2001); *In re International Flavors & Fragrances, Inc.*, 183 F.3d 1361, 51 USPQ2d 1513, 1515 (Fed. Cir. 1999).
	Added new note 23, citing: *Custom Computer Services Inc. v. Paychex Properties Inc.*, 337 F.3d 1334, 67 USPQ2d 1638, 1639 (Fed. Cir. 2003).
906.02 Petition To Director	No substantive changes.

INDEX TO CHANGES IN THIRD EDITION
CHAPTER 1000

TBMP SECTION	NATURE OF CHANGE
1001 In General	Amended Note 2 by changing "TMEP § 1208.01(a)" to "TMEP § 1208.03(a) et seq. and 1507."
	Amended Note 3 by changing "TMEP §1208.01" to "TMEP § 1208.02(c)."
1002 Declaration of Interference	Amended Note 4 by deleting "[note]" in citation of 15 U.S.C. § 1051.
	Amended Note 7 by changing "TMEP § 1208.03(a)" to "TMEP § 1208.03."
1003 Institution of Interference	Amended paragraph 4 to expand listing of dates that may be set by the Board in a notice instituting an interference, and to note that dates are set that are deemed appropriate for the particular case.
	Amended Note 1 by changing "TMEP § 1208.02(c)" to "TMEP § 1208.03(c)."
1004 Issues in Interference	Amended Note 1 to delete reference to "Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 325 (1985)." Updated reference to "Rules of Practice in Trademark Cases, Final Rule, 48 Fed. Reg. 23122 (May 23, 1983)" by changing it from "Notice of Final Rulemaking published in the Federal Register on May 23, 1983 at 48 FR 23122, and in the Official Gazette of June 2, 1983 at 1031 TMOG 13."
1005 Burden of Proof	No substantive changes.
1006 Addition of Party	No substantive changes.
1007 Conduct of Proceeding	Amended paragraph 2 by adding: "including dates for a discovery conference, initial and expert disclosures, an opening and closing date for discovery, and pretrial disclosures and rebuttal disclosures" to listing of what is in a notice of interference; and by indicating that Board will set dates deemed appropriate for the particular case.
	Amended paragraph 2 by deleting reference to thirty-day separation between discovery and testimony periods and added statement to inform reader that scheduling order includes time for

	pretrial disclosures of witnesses.
	Amended paragraph 2 by advising reader about the availability of ACR, and referencing TBMP §§ 528.05(a)(2) and 702.04."
	Deleted sample trial and briefing schedule under the former Trademark Rules.
	Added new reference to Note 1: 37 CFR § 2.115.
	Added new Note 2, citing: *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1662 n.2 (TTAB 1998); and *Eveready Battery Co., Inc. v. Green Planet, Inc.* 91 USPQ2d 1511 (TTAB 2009).
	Added new Note 3, referencing: 37 CFR § 2.121(e).

INDEX TO CHANGES IN THIRD EDITION
CHAPTER 1100

TBMP SECTION	NATURE OF CHANGE
1101 In General	Amended reference to 15 U.S.C. §§ 1052, 1067, and 1068 to reflect statutory amendments.
1101.01 Nature of Proceeding	Amended to inform reader that a concurrent use application is a restricted application; that restrictions are generally to claimed geographic areas of use; that applicant must show that no likelihood of confusion will result; that concurrent use registration not provided for in dilution context; and that disclosure and conferencing regime has been adopted.
	Added new references and cases to Note 1: 37 CFR § 2.133(c); *Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300, 1307 (TTAB 2003).
	Added new Note 2, citing: Trademark Act § 17, 15 U.S.C. § 1067.
	Added new case to Note 4: *Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300, 1307 (TTAB 2003); deleted text in Note 4 citing TBMP § 1103.01(b) for information on dates and jurisdictional requirement.
	Added new Note 5, citing: *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 330 F.3d 1333, 66 USPQ2d 1811, 1819 (Fed. Cir. 2003).
	Added new Note 6, citing: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244-7 (August 1, 2007).
1101.02 Context for USPTO Determination of Concurrent Rights	Amended "concurrent rights" to "concurrent registration rights;" amended second paragraph to inform reader that while registration may not be amended to include territorial restrictions in order to settle a cancellation action, registrant may agree to entry of judgment against itself or surrender its registration; and that cancellation action may be suspended; added reference to TBMP § 1113.02.
	Added new cases to Note 2: *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 330 F.3d 1333, 66 USPQ2d 1811, 1815 (Fed. Cir. 2003); and *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1106 n.3 (TTAB 2007).
	Added new Note 5, citing: *Chichi's, Inc. v. Chi-*

	Chi's, Inc., 222 USPQ 831, 832 (Comm'r 1984).
1102 Generation of Proceeding	Section Heading only.
1102.01 Means of Generation	Amended to add reference to Trademark Act § 17, 15 U.S.C. 1067; to quote directly from 15 U.S.C. 1041(a)(3)(D) instead of paraphrasing the statute; and to include statement of additional requirements for concurrent use application.
	Added new case to Note 1: *J&D Home Improvement Inc. v. Basement Doctor Inc.*, 65 USPQ2d 1958 (D. Del. 2003); added parenthetical to *Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831, 832 (Comm'r 1984).
	Deleted reference to Rany L. Simms, *TIPS FROM THE TTAB: The Concurrent User as Opposer*, 67 Trademark Rep. 654 (1977); and Janet E. Rice, *TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings*, 72 Trademark Rep. 403, 406 (1982).
	Added new references to Note 2: Trademark Act §§ 1(a)(3)(D)(i), and 1(a)(3)(D)(ii)(I-IV), §§ 1051(a)(3)(D)(i) and 1051(a)(3)(D)(ii)(I-IV).
	Added new Note 3, citing: 37 CFR § 2.42.
1102.02 Bases for Concurrent Registration Board Determination; Court Determination	Amended to clarify statement that concurrent registration may be based on prior Board decision; added reference to TBMP § 1103.01.
1103 Requirements for Concurrent Use Application	Amended references to 15 U.S.C. §§ 1051(a)(1) and 1052 and to 37 CFR §§ 2.42, 2.73, and 2.99 to reflect statutory and rule changes.
1103.01 Application Based on Board Determination	Amended to add list of requirements for concurrent use applicants; added references to TBMP §§ 1103.01(a), (b) and (c); amended to inform reader of concurrent use applicant's obligation to serve copies of the application, specimens and drawing on each excepted user.
	Added new Note 1, citing: Trademark Act § 2(d), 15 U.S.C. § 1052(d); and 37 CFR § 2.99(g).
	Added new Note 2, citing: Trademark Act § 2(d), 15 U.S.C. § 1052(d).
	Added new Note 3, citing: 37 CFR § 2.42; and Trademark Act § 1(a)(3)(D), 15 U.S.C. § 1051(a)(3)(D).
	Added new Note 4, citing: 37 CFR § 2.42.
	Added new Note 5, citing: 37 CFR §§ 2.32-2.41.
	Added new Note 6, citing: 37 CFR § 2.99(b) and

	37 CFR § 2.99(c).
1103.01(a) Application Must Assert Use in Commerce	Deleted extraneous text modifying "a Board determination;" amended to add information as to when applicant may seek concurrent use registration, citing TMEP § 1207.04(b).
	Amended "amendment to allege use or statement of use" to "allegation of use."
	Amended to inform reader that applications based solely on Trademark Act § 44 or § 66(a) are not subject to concurrent use registrations; and that where the sole basis is § 1(b), the allegation of use must be filed prior to any amendment to seek concurrent use registration.
	Added new case and reference to Note 1: Trademark Act § 2(d), 15 U.S.C. § 1052(d); and *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989).
	Added new Note 4, citing: 37 CFR § 2.99(g); TMEP § 1207.04(b); and Miscellaneous Changes to Trademark Rules of Practice, 73 Fed. Reg. 67759 (Nov. 17, 2008).
	Added new Note 5, citing: 37 CFR § 2.73.
1103.01(b) Jurisdictional Requirement	Amended "seeking…registration based on a Board determination through a concurrent use proceeding" to "seeking…registration through a concurrent use proceeding before the Board;" clarified meaning of jurisdictional requirement; amended text to enumerate the two circumstances where concurrent use applicant need not meet jurisdictional requirement.
	New cases added to Note 2: *CDS Inc. v. I.C.E.D. Management, Inc.*, 80 USPQ2d 1572, 1580 n.12 (TTAB 2006); *Ole' Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 915 (TTAB 1984); *The Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133, 1136 (TTAB 1982); and *Fleming Companies v. Thriftway Inc.*, 21 USPQ 1451 (TTAB 1991), *aff'd*, 26 USPQ2d 1551, 1553 (S.D. Ohio 1992).
1103.01(c) Application Must Meet Requirements Applicable to Non-Restricted Application	Deleted "those of" from "elements required by those of the rules of practice."
1103.01(d) Application Must Identify Nature and	Section Heading only.

Extent of Restriction Sought	
1103.01(d)(1) In General	Amended to add citations to 37 CFR § 2.42; 15 U.S.C. § 1051(a)(3)(D); and TBMP § 1103.01(e).
	Added new second paragraph listing elements for statement required of concurrent use applicant and amended third paragraph to inform reader of reason for statement.
1103.01(d)(2) Geographic Restrictions	Amended section to move information as to how concurrent rights generally arise to first paragraph of section.
	Corrected reference to "subsequent user's" to "applicant's" in second paragraph; amended to expand upon information regarding circumstances under which subsequent user may seek concurrent use registration.
	Added *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1307 (Fed. Cir. 1987) to Note 1.
	Amended Note 2 to change "later" to "subsequent;" "senior" to "prior;" and "second" to "subsequent."
	Added new case to Note 3: *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307-8 (TTAB 1984).
1103.01(d)(3) Mode of Use Restrictions	Added new Note 1, citing: *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1589 n.4 (TTAB 1995).
	Added new case to Note 3: *Nobelle.com LLC v. Qwest Communications Int'l Inc.*, 66 USPQ2d 1300, 1302 n.4 (TTAB 2003).
	Added parenthetical to *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 (CCPA 1976) in Note 4.
	Added parenthetical to *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1589 (TTAB 1995) in Note 5; added new case to Note 5: *Ex parte Crossett Lumber Co.*, 89 USPQ 29 (USPTO 1951).
	Added parenthetical to *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1590-91 (TTAB 1995) in Note 6.
	Added parenthetical to *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1591 n.7 (TTAB 1995) in Note 7.
1103.01(e) Application	Amended first paragraph to cite TBMP

Must Identify Excepted Users and Their Asserted Rights	§§ 1103.01(d)(1)-(3); edited second paragraph for clarity.
	Added new citation to Note 1: Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).
1103.01(f) Other Requirements	Amended references to 37 CFR §§ 2.99(b), 2.80, and 2.99(c) to reflect changes.
	Amended second paragraph to indicate that concurrent use applicant must serve copies of the application, specimens and drawing on each excepted user; deleted requirement that applicant furnish copies to the Board and that Board utilizes the copies when instituting a concurrent use proceeding; added citation to TBMP § 1106. Also amended statement as to marking of file by examining attorney to reflect other possible limitations that would be included in the application.
	Amended Note 1 to include reference to 37 CFR §§ 2.99(c) and (d).
1103.02 Application Based on Prior Board Decision	Amended first paragraph to delete general reference that applicant must follow "other rules of practice in trademark cases" in favor of remaining specific statement; further amended first paragraph to add statement that while Board may obtain a copy of its prior decision, this is not always possible; and edited for clarity of writing style.
	Amended eighth paragraph to inform reader that Board's institution order will order concurrent use applicant to serve on involved registrant copies of its application, specimens and drawing.
	Amended fourth paragraph to inform reader that where no new concurrent use proceeding is necessary, concurrent use applicant need not serve copies; and updated reference to 37 CFR § 2.99 by replacing "37 CFR § 2.99(b)" with "37 CFR § 2.99(d)(1)."
	Amended to inform readers of concurrent use applicant's service requirement.
	Updated reference in Note 4 to 37 CFR § 2.99 by replacing "37 CFR § 2.99(b)" with "37 CFR § 2.99(d)(1)."
1103.03 Application Based on Court Determination	Amended reference to 37 CFR § 2.99 to reflect rules changes; amended to inform reader that application must comply with all elements required

	for an unrestricted registration; amended to add statement that while Board may attempt to obtain a copy of court decision, this is not always possible.
	Amended to inform reader that concurrent use applicant must serve copies of its application, specimens and drawing on excepted users if institution of concurrent use proceeding is required, but not if institution of proceeding is unnecessary.
	Amended to add new Note 1, citing 37 CFR § 2.42 (described in TBMP §§ 1103.01(c) – (f)) and 37 CFR § 2.32 et. al.
	Updated reference in Note 5 to 37 CFR §2.99(d)(1) by replacing "(b)" with "(d)."
1104 Parties to Proceeding; Involved Applications, Registrations	Edited for clarity; amended to inform reader that concurrent use proceeding may be suspended pending clearance of amended application; and brought informational text from Note 1 regarding rights of common law users into body of section; added references to TBMP § 1103.01(b) and § 1108.
	Added new cases to Note 1: *Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB 1991); *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 n.5 (TTAB 1990); and *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1308 (TTAB 1984).
	Changed signal reference to *Gallagher's Restaurants Inc. v. Gallagher's Farms Inc.*, 3 USPQ2d 1864, 1866 (TTAB 1986) in Note 2 from "*see*" to "*cf.*"
	Added new Note 3, citing *Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1453 (TTAB 1991) and *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307-8 (TTAB 1984).
	Deleted reference to *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 n.5 (TTAB 1990) in Note 5; added parenthetical to *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 n.5 (TTAB 1990) in Note 6.
1105 Applications and Registrations Not Subject to Proceeding	Updated references to 37 CFR § 2.73 and 2.99(g) to reflect rules changes; added new second paragraph to clarify that applications based solely on § 44 or § 66 cannot be subject to concurrent use proceeding; amended third paragraph to inform reader that applications arising under Trademark Act § 1(b) may not be amended to assert

	concurrent use during opposition period; added reference to TBMP § 1113.01.
	Added new Note 2, citing 37 CFR § 2.99(g).
	Added new Note 5, citing TMEP § 1104.03(b).
	Added new Note 6, citing 37 CFR § 2.135.
1106 Commencement of Proceeding	Section heading only.
1106.01 Marking of Concurrent Use Application	No changes made.
1106.02 Publication of Concurrent Use Application; Opposition Period	Amended first paragraph to inform reader of processing through Board's electronic system; edited section throughout for clarity; amended fourth paragraph to delete reference to physical file being transmitted to Board.
1106.03 Preparing the Record for the Involved Application and Registration Files (new title)	Changed title from "Obtaining Included Application and Registration Files" to "Preparing the Record for the Involved Application and Registration Files;" updated section to delete reference to Board's obtaining physical files to reflect current Board practice.
1106.04 Preparing Concurrent Use Notices	Amended first paragraph to inform reader that Board electronically tracks concurrent use application following publication and sends notices; added new second paragraph that explains service rules whereby applicant is given time to serve on each excepted user copies of application, specimen and drawing and to file proof of service with the Board; and amended third paragraph to explain nature of institution order and trial scheduling.
	Added new sixth paragraph to include information regarding notice via e-mail and by publication in the Official Gazette.
	Amended seventh paragraph to inform reader that Board no longer serves copy of involved application and that applicant need not provide Board with copies of same.
	Amended eighth paragraph to indicate that Board does not set trial schedule when sole purpose of concurrent use proceeding is to issue show cause order to registrant.
	Added new Note 1, citing 37 CFR §§ 2.99(d)(1) and 2.119(a).
	Added new Note 2, citing 37 CFR § 2.99(d)(1).
	Added new Note 3, citing 37 CFR § 2.119.
	Added new Note 4, citing 15 U.S.C. § 1052(d) and

	defining "excepted user."
	Inserted "*cf.*" signal in Note 7 before citation to 37 CFR § 2.113(c).
	Added new Note 8, citing 37 CFR § 2.99(c); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007); and 37 CFR § 2.119(b). Also informs reader regarding utilizing fax and e-mail for meeting service obligations.
	Added new Note 9, citing Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42244 (August 1, 2007).
	Added new Note 11, citing Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42243 (August 1, 2007).
1106.05 Locating Excepted Users	Amended first paragraph to include information about notice of action by publication in Official Gazette.
	Amended second paragraph to include information about motions to delete reference to excepted users; and amended third paragraph to include information about motions to delete reference to registrant.
	Added new Note 2, citing 37 CFR § 2.118 and advising that time to respond to notice is typically thirty days.
	Added new Note 3, citing, by comparison, 37 CFR § 2.99(d)(1).
	Added new Note 4, citing 37 CFR § 2.118.
1107 Answer; Default	Amended first paragraph to reference situation where Board sends no scheduling order to excepted user.
	Added new second paragraph to inform reader of applicant's service obligations and that copies of application may be viewed on Board's website.
	Edited section throughout for clarity of writing; moved text on proof of entitlement by applicant to subsection 1108
	Added new Note 1, citing 37 CFR §§ 2.99(d)(1) and 2.119.
	Added parenthetical in Note 3 to: *Newsday, Inc. v. Paddock Publications, Inc.*, 223 USPQ 1305, 1307 (TTAB 1984).
1108 Issue in Concurrent Use Proceeding; Burden of Proof	Amended first paragraph to explain that rights of common law users are not before the Board; amended third paragraph to clarify that any

	grounds that may be asserted against an unrestricted application may be asserted as a basis for refusal in concurrent use proceeding.
	Added new fifth and sixth paragraphs to include information from (old) subsection 1107 regarding *ex parte* showing of entitlement.
	Added parenthetical in Note 1 to: *Fleming Companies v. Thriftway Inc*., 21 USPQ2d 1451 (TTAB 1991), aff'd, 26 USPQ2d 1551 (S.D.Ohio 1992); and *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 n. 5 (TTAB 1990); added new case to Note 1: *The Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc*., 215 USPQ 1133, 1136 (TTAB 1982).
	Added new Note 2, citing 37 CFR § 2.99(e); *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1309 (Fed. Cir. 1987); *CDS Inc. v. I.C.E.D. Management Inc*., 80 USPQ2d 1572, 1583-4 (TTAB 2006); *Terrific Promotions Inc. v. Vantex Inc*., 36 USPQ2d 1349, 1352 (TTAB 1995); *Big M. Inc. v. United States Shoe Corp*., 228 USPQ 614, 616 (TTAB 1985); *Ole' Taco Inc. v. Tacos Ole, Inc*., 221 USPQ 912, 917 (TTAB 1984); *Handy Spot Inc. v. J. D. Williams Co*., 181 USPQ 351, 352 (TTAB 1974); *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); and *Pinocchio's Pizza Inc. v. Sandra Inc*., 11 USPQ2d 1227, 1229 (TTAB 1989).
	Added new cases to Note 3: *Weiner King, Inc. v. Wiener King Corp*., 615 F.2d 512, 204 USPQ 820, 832 (CCPA 1980); *CDS, Inc. v. I.C.E.D. Management, Inc*., 80 USPQ2d 1572, 1581 (TTAB 2006); and *Pinocchio's Pizza Inc. v. Sandra Inc*., 11 USPQ2d 1227, 1229 (TTAB 1989). Added parenthetical in Note 3 to: *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987)
	Deleted references from Note 3: *Inland Oil & Transport Co. v. IOT Corp.,* 197 USPQ 562 (TTAB 1977); *Handy Spot Inc. v. J. D. Williams Co.,* 181 USPQ 351 (TTAB 1974); and TBMP § 103.01(d)(2).
	Amended to insert new Notes 7, 8, and 9 from (old) subsection 1107.
1109 Conduct of	Amended first paragraph to delete reference to

Proceeding	TBMP § 1106, to indicate that parties may be subject to disclosure and conferencing obligations, that the issue in concurrent use proceedings is applicant's entitlement to registration; and that in certain cases, entitlement may be proven by less formal procedures.
	Added new second paragraph regarding the Board's ACR procedure.
	Amended third paragraph to include reference to "conferencing, disclosure" as part of schedule.
1109.01 (New) Sample Trial Schedules - Cases Commenced On or After November 1, 2007	Sets forth three sample trial schedules for cases commenced on or after November 1, 2007.
1109.02 (New) Sample Trial Schedules - Cases Commenced Before November 1, 2007	Sets forth two sample trial schedules for cases filed before November 1, 2007 (from (old) subsection 1109); adds new Note 1, citing Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (August 1, 2007).
1110 Settlement Providing for Concurrent Registration	Amended second paragraph to inform reader that parties will generally be afforded opportunity to submit revised settlement agreement. Added new second paragraph illustrating terms that may be included in settlement agreements. Added new third paragraph to indicate relevance of Internet advertising and listing measures to take to avoid confusion due to Internet advertising.
	Moved location of cases in Note 1: *In re Beatrice Foods Co.*, 166 USPQ 431, 437 (CCPA 1970); *Fleming Companies Inc. v. Thriftway Inc.*, 21 USPQ2d 1451, 1454 (TTAB 1991), *aff'd,* 26 USPQ2d 1551 (S.D.Ohio 1992); *Precision Tune Inc. v. Precision Auto-Tune Inc.*, 4 USPQ2d 1095, 1096 (TTAB 1987); and *The Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.*, 215 USPQ 1133, 1136 (TTAB 1982).
1110 Settlement Providing for Concurrent Registration	Added new Note 2, citing *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 6 USPQ2d 1305 (Fed. Cir. 1988); *In re Beatrice Foods Co.; In re Fairway Foods, Inc.,* 166 USPQ 431, 437 (C.C.P.A. 1970); *Precision Tune Inc. v. Precision Auto-Tune Inc.,* 4 USPQ2d 1095 (TTAB 1987); *The Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc.,* 215 USPQ 1133 (TTAB 1982); and, by comparison, *Newsday, Inc. v. Paddock Publications, Inc.,* 223 USPQ 1305 (TTAB

	1984).
	Added new Note 3, citing *CDS Inc. v. I.C.E.D. Management Inc.*, 80 USPQ2d 1572, 1583-4 (TTAB 2006).
	Added new case to Note 4: *Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451, 1456 (TTAB 1991), *aff'd*, 26 USPQ2d 1551 (S.D. Ohio 1992).
1111 Effect of Abandonment of Involved Application	Amended to include information from TBMP § 603; deleting mere reference to that section.
	Added new Note 1, citing: *Cf. Fleming Companies Inc. v. Thriftway Inc.,* 21 USPQ2d 1451, 1453 (TTAB 1991), *aff'd*., 26 USPQ2d 1551 (S.D. Ohio 1992); *Newsday, Inc. v. Paddock Publications, Inc.,* 223 USPQ 1305, 1307-8 (TTAB 1984).
1112 Effect of Adverse Decision in Opposition or Cancellation	Edited for clarity of writing; added new case to Note 1: *Rosso and Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 219 USPQ 1050, 1053 (Fed. Cir. 1983); changed signal reference from *see* to *cf.* before: *U.S. Soil, Inc. v. Colovic*, 214 USPQ 471 (TTAB 1982).
1113 "Conversion" of Opposition or Cancellation Proceeding to Concurrent Use Proceeding	Section Heading only
1113.01 Conversion of Opposition Proceeding	Amended first paragraph to inform reader that parties change positions when opposition “converted” to concurrent use proceeding; amended to clarify that Board may add opposer as excepted user in concurrent use proceeding and dismiss opposition in single order, where opposer does not file its own concurrent use application.
	Amended fifth paragraph to add advisory comment regarding modifications to procedures since publication of articles.
1113.02 Conversion of Cancellation Proceeding	Amended to add reference to TBMP § 1112.
1114 Alteration of Restrictions on Concurrent Registrations	Edited for clarity of writing; amended to add reference to TBMP § 1104 in fourth paragraph.
	Added parentheticals in Note 2 to citations of: *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); and *In re Forbo*, 4 USPQ2d 1415, 1416 (Comm'r 1984).

	Added parenthetical in Note 3 to *In re Alfred Dunhill Ltd*., 4 USPQ2d 1383, 1384 (Comm'r 1987).
	Added new Note 5, citing: *Fleming Companies Inc. v. Thriftway Inc*., 21 USPQ2d 1451, 1453 (TTAB 1991), *aff'd,* 26 USPQ2d 1551 (S.D.Ohio 1992); and *Newsday, Inc. v. Paddock Publications, Inc*., 223 USPQ 1305, 1307-8 (TTAB 1984).

INDEX TO CHANGES IN THIRD EDITION
CHAPTER 1200

TBMP SECTION	NATURE OF CHANGE
1201.01 Readiness of Case for Appeal	Amended reference to 37 CFR § 2.141.
	Amended citation in Note 3 from TMEP § 713 to § 714.
	Added new case to Notes 4 and 6: *In re Roberts*, 87 USPQ2d 1474, 1478 (TTAB 2008).
1201.02 Premature Final	Added clarification that new rationale is not a new refusal or requirement; added that if applicant files a notice of appeal but believes the final refusal is premature, applicant should advise the Board; added that if premature appeal filed and instituted, Board will vacate the institution order.
	Added *In re Dietrich*, 91 USPQ2d 1622, 1624 (TTAB 2009) to Note 3.
	Added new Note 4, citing: *See In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Paper Doll Promotions Inc.*, 84 USPQ2d 1660, 1665 (TTAB 2007).
1201.04 Compliance with Requirements Not Subject of Appeal	Deleted reference to an alternative approach suggested in a 1980 decision, which was superseded by amendment to 37 CFR § 2.142(c).
1201.05 Appeal Versus Petition	Clarified that Board will consider only correctness of substantive refusals, and not whether the procedural issue of whether issuance of or failure to issue substantive refusal is clear error.
	Deleted *In re Sambado & Son, Inc.,* 45 USPQ2d 1312 (TTAB 1997) from Note 4.
	Added *In re Dermahose Inc.*, 82 USPQ2d 1793, 1796 n.5 (TTAB 2007 to Note 12.
	Added new Note 13, citing: *In re Jump Designs LLC*, 80 USPQ2d 1370, 1373-74 (TTAB 2006); *In re Sambado & Son Inc.*, 45 USPQ2d 1312, 1314 (TTAB 1997).
1202.01 In General	Clarifies that if a refusal does not pertain to all of the goods or services in a class, the application can divided to sever those goods or services; clarifies that if there is a multiple class application, and applicant does not wish to appeal the refusal for all classes, it should indicate in the notice of appeal the classes for which it is appealing.

	Added new Note 4, citing: *In re MGA Entertainment Inc.*, 84 USPQ2d 1743, 1745 n.1 (TTAB 2007).
1202.02 Time for Appeal	Points out that unintentional delay standard for petition to revive procedure is not applicable if applicant files a request for reconsideration but fails to file a notice of appeal; notes that notice of appeal is the only paper that can be filed with the Board by facsimile transmission; cites sections of TMEP regarding notice of appeal, requests for reconsideration and situations where unintentional delay standard does not apply.
1202.03 Notice of Appeal	Explains ESTTA procedure for filing notice of appeal, including if request for reconsideration or other paper filed with notice of appeal; states that electronic signature will be accepted; explains Board policy on accepting signatures for notice of appeal, and how it differs from TMEO policy for application papers; explains procedure if applicant believes final refusal is premature; deletes suggested format for paper copy of notice of appeal.
1202.04 Appeal Fee	Adds that deposit account must contain sufficient funds for general authorization to charge account to be accepted.
	Deleted reference to 37 CFR § 2.85(e) and amended reference to 37 CFR § 2.141.
	In Note 4, deleted reference to *In re Sky is the Ltd.,* 42 USPQ2d 1799 (Comm'r 1996) and added reference to 37 CFR § 2.208(b).
1202.05 Multiple Class Applications	Adds that for multiple class application, if appeal is filed for fewer than all classes, applicant should indicate the classes to which the appeal applies, and that if refusal applies to fewer than all goods or services in a class, applicant may request to divide the class into two applications so that the goods or services for which there is no refusal may proceed to publication or registration.
1203.01 Form of Brief	Adds that appendices or exhibits to brief may not be used to avoid page limitation; clarifies that if table of contents and description of record are included in brief, they count toward the page limitation; suggests that applicant and examining attorney should highlight in briefs the most probative evidence if a great deal of evidence is in the record; notes rule change that briefs are

	not accepted on CD-ROM.
	Added new Note 1, citing: *In re Psygnosis Ltd.*, 51 USPQ2d 1594, 1596 (TTAB 1999) and *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998).
	Added new Note 2, citing: *In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1220 n.9 (TTAB 2008).
	Added new Note 4, citing: *See In re Thomas,* 79 USPQ2d 1021 (TTAB 2006).
	Added new Note 10, citing: *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 (TTAB 2010)
1203.02(a) Applicant's Main Brief	Adds what applicant is to do if filing appeal through ESTTA and also filing request for reconsideration; changes method of notification of approval of application by examining attorney from mail to email.
1203.02(b) Trademark Examining Attorney's Brief	Clarifies that examining attorney's failure to file brief does not result in approval of application; if examining attorney is persuaded by applicant's appeal brief, add that notification of approval of application may be made by email; clarifies that if an examining attorney adds or changes argument or rationale for refusal that is not a new issue for which remand in required.
	Adds cross-reference to TBMP § 1209.02 clarifying that it is general practice of Board to grant examining attorneys' requests for remand to make new refusal or requirement.
	Adds references to 37 CFR § 2.142(f)(6) and by analogy, *In re Dietrich*, 91 USPQ2d 1622, 1624 (TTAB 2009) in Note 6.
	Added new Note 7, citing *In re Paper Doll Promotions Inc.*, 84 USPQ2d 1660, 1665 (TTAB 2007).
1203.02(c) Applicant's Reply Brief	Deletes requirement that examining attorney notify Board if applicant's reply brief persuades examining attorney to approve the application.
1203.02(d) Extension of Time for Filing Brief	No change.
1203.02(e) Material Submitted with Briefs	Adds that it is not necessary to attach as exhibits to appeal brief papers or evidence that is already in the file.
	Added new cases to Note 2: *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 (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).
1203.02(f) Cases Which May Be Cited	Sets out Board policy on citation of "not precedential" decisions; adds that case citations should include citation to *United States Patent Quarterly* if case appears in that publication.
	Added new case to Note 1: *General Mills Inc. v. Health Valley Foods,* 24 USPQ2d 1270 (TTAB 1992).
	Added new Note 2, citing *Citation of Opinions to the Trademark Trial and Appeal Board*, O.G. Notice (Jan. 23, 2007) and new Note 3, citing *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009).
1203.02(g) Waiver of Claim or Requirement in Brief	Added references to TBMP §§ 1203.02(b) and 1205.
1204 Effect of Request for	Adds reference to how to indicate a request for

Reconsideration of Final Action	reconsideration is filed when appeal is filed through ESTTA in text and in new Note 10; deletes references to paper application files; clarifies that a request for reconsideration filed after the filing of appeal, even if filed within 6 months of final refusal, is treated as a request for remand, if examining attorney had previously acted on request for reconsideration after filing of appeal; deletes citation to 1984 *Trademark Reporter* article and updates TMEP references.
	Added new case to Note 1: *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332 (TTAB 2009).
	Added new Note 6, explaining procedure if applicant files an appeal brief when its request for reconsideration is pending and citation to *In re Husqvarna Aktiebolag*, 91 USPQ2d 1436 (TTAB 2009).
	Added new Notes 15 and 16, citing *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 (TTAB 2010); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198 (TTAB 2009).
1205.01 In General	Adds reference of how to indicate an amendment is filed when appeal is filed through ESTTA; deletes references to paper application files; clarifies that examining attorney may submit evidence with respect to issues relevant to amendment; clarifies that an amendment filed after the filing of appeal, even if filed within 6 months of final refusal, is treated as a request for remand, if examining attorney had previously acted on request for reconsideration or amendment after filing of appeal; clarifies that a showing of good cause for remanding application to consider amendment will depend on the stage of the appeal and reasons given for the delay; adds example of situation in which Board will grant limited remand; clarifies what examining attorney should do if amendment is contained in applicant's brief instead of a separate request for remand; updates references to TMEP.
	Added new Note 4, citing *In re Big Pig Inc.*, 81 USPQ2d 1436 (TTAB 2006).
	Added new Note 5, citing *In re HerbalScience Group LLC*, 96 USPQ2d 1321 (TTAB 2010).
1205.02 Request to Divide	Amended to clarify procedures on request to divide.

1205.02(a) Request to Divide When Notice of Appeal is Submitted Electronically (New)	This new subsection explains procedures when request to divide is filed with notice of appeal filed via ESTTA.
1205.02(b) Request to Divide When Notice of Appeal is Submitted on Paper (New)	This new subsection explains procedures when request to divide is filed with notice of appeal filed on paper.
1206.01 Amendment to Allege Use	Deletes references to paper application files; adds reference to how to indicate an AAU is filed when appeal is filed through ESTTA; clarifies that examining attorney may issue new refusal based on information in AAU.
1206.02 Statement of Use	No changes made.
1207.01 General Rule – Evidence Submitted After Appeal Untimely	Clarifies that applicant may submit entire articles with brief if portions of the articles were submitted by examining attorney during examination.
	Added new Note 4, citing *In re Max Capital Group Ltd.*, 93 USPQ2d 1243 (TTAB 2010).
1207.02 Request to Remand for Additional Evidence	Clarifies that the Board may direct that evidence submitted in response to evidence submitted with a request for remand be submitted with a supplemental appeal brief; deletes citations to 1983 and 1984 *Trademark Reporter* articles.
	Added new case to Note 4: *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332 (TTAB 2009).
	Added new Note 8, citing *In re HerbalScience Group LLC*, 96 USPQ2d 1321 (TTAB 2010).
1207.03 Evidence Considered Due to Actions of Nonoffering Party	Clarifies that copies of third-party registrations submitted with a reply brief will be considered if the examining attorney did not object to a listing of registrations at a point that the insufficiency could be cured.
	Adds new cases to Note 1: *In re Heeb Media LLC*, 89 USPQ2d 1071, 1072 (TTAB 2008); *In re Litehouse Inc.*, 82 USPQ2d 1471, 1475, n.2 (TTAB 2007); *In re Homeland Vinyl Products Inc.*, 81 USPQ2d 1378, 1381 n.5 (TTAB 2006); *In re Rodale Inc.*, 80 USPQ2d 1696, 1699 n.4 (TTAB 2006); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372 (TTAB 2006).
	Adds new cases to Note 3: *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Hayes*, 62 USPQ2d 1443, 1445 n.3 (TTAB 2002).
1207.04 Evidence Filed With	Clarifies that if the examining attorney denies a

Timely Request for Reconsideration	request for reconsideration after an appeal is filed, a second request for reconsideration will be treated as a request for remand even if filed within six months of a final Office action; adds cross-references to TBMP sections.
	Added new Note 1, citing *Petroglyph Games, Inc.*, 91 USPQ2d 1332 (TTAB 2009).
	Added new Note 2, citing *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198 (TTAB 2009).
	Added case to Note 3: *In re HerbalScience Group LLC*, 96 USPQ2d 1321 (TTAB 2010).
1207.05 Submission of Evidence upon Remand for New Refusal	No changes made.
1207.06 Letter of Protest Evidence	Reflects that Office of the Deputy Commissioner for Trademark Examining Policy determines letters of protest.
	Adds new Note 1, citing *In re Candy Bouquet International Inc.*, 73 USPQ2d 1883 (TTAB 2004); TMEP § 1715 *et seq*.
1208 Treatment of Evidence	Deletes citation to 1983 *Trademark Reporter* article; adds case to Note 5: *In re First Craft Inc.*, 76 USPQ2d 1183 (TTAB 2005).
	Adds cases to Note 6: *In re Hotels.com, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009); *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1984 (TTAB 2009); *In re Pharmavite LLC,* 91 USPQ2d 1778 (TTAB 2009).
1208.01 Evidence from Nexis Database or Publications	Clarifies that probative value of newswire stories varies, and that probative value of articles from foreign publications is evaluated on case-by-case basis; clarifies that samples of articles submitted by examining attorney should be representative of the articles retrieved, and that if a limited number of articles is submitted without an indication that they are representative, they will be deemed to be the only articles that support the examining attorney's position.
	Adds new case to Note 2: *In re Viventia Biotech Inc.*, 80 USPQ2d 1376, 1379 (TTAB 2006).
	Adds new cases to Note 3: *In re International Business Machines Corp.*, 81 USPQ2d 1677 (TTAB 2006); *In re Classic Media Inc.*, 78 USPQ2d 1699 (TTAB 2006).
	Added new Note 4, citing *In re Toshiba Medical Systems Corp.*, 91 USPQ2d 1266 (TTAB 2009);

	In re Cell Therapeutics Inc., 67 USPQ2d 1795 (TTAB 2003).
	Added new case to Note 7: *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332 (TTAB 2009).
	Added new case to Note 8: *In re Homes & Land Publishing Corp.*, 24 USPQ2d 1717 (TTAB 1992).
	Added new Note 9, citing *In re The Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989) and *In re Federated Department Stores Inc.*, 3 USPQ2d 1541 (TTAB 1987).
1208.02 Third Party Registrations	Explains Board policy with regard to judicial notice of third party registrations; clarifies that copies of third-party registrations submitted with applicant's appeal brief or reply brief will be considered if the examining attorney did not object to a listing of registrations at a point that the insufficiency could be cured; clarifies that expired or cancelled registrations are evidence only of the fact that the registrations issued.
	Added new Note 1, citing *In re Chippendales USA, Inc.,* 622 F.3d 1346, 96 USPQ2d 1681 (Fed. Cir. 2010).
	Added new case to Note 2: *In re Jump Designs LLC*, 80 USPQ2d 1370 (TTAB 2006).
	Added new case to Note 4: *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007).
	Added new Note 6, citing *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581 (TTAB 2007); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511 (TTAB 2001).
	Added new Note 7, citing *In re Eagle Crest Inc.*, 96 USPQ2d 1227 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375 (TTAB 2006).
	Added new case to Note 8: *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581 (TTAB 2007).
	Added new cases to Note 9: *In re Toshiba Medical Systems Corporation*, 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).
	Added new Note 10, citing *In re Binion*, 93

	USPQ2d 1531, 1535 n.3 (TTAB 2009).
	Added new Note 11, citing *In re Brown-Forman Corp.*, 81 USPQ 1284, 1286 n.3 (TTAB 2006).
1208.03 Internet Material	Adds that URL should be used in identifying website evidence, that Internet evidence can be used to show translation of a term; clarifies that evidence from foreign website may have probative value, depending on circumstances; adds that search summary from search engine may have insufficient text to show context for term; that the fact that search engine search retrieves large number of hits doesn't have probative value; that applicant and examining attorney should submit only relevant materials retrieved by Internet search, and Board discourages submissions that are redundant or not probative; that if a large number of web pages are submitted, applicant and examining attorney should highlight in their briefs the most probative evidence; that Board will not take judicial notice of internet searches; that definitions from online resources that are readily available are acceptable; Board's policy on taking judicial notice of online dictionary definitions; and Board's policy on considering Wikipedia evidence.
	Added new Note 1, citing *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).
	Added new Note 3, citing *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 n.3 (TTAB 2008); *In re Brown-Forman Corp.*, 81 USPQ 1284, 1286 (TTAB 2006).
	Added new Note 4, citing *In re International Business Machines Corp.*, 81 USPQ2d 1677, 1681 n.7 (TTAB 2006); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1050 (TTAB 2006); *In re Remacle*, 66 USPQ2d 1222, 1224, n.5 (TTAB 2002).
	Added new Note 5, citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007); *In re Innovative Companies LLC*, 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); *In re International Business Machines Corp.*, 81 USPQ2d 1677, 1679 n.3 (TTAB 2006); *In re Remacle*, 66 USPQ2d 1222, 1223, n.2 (TTAB 2002); *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).
	Added new Note 7, citing *In re BetaBatt Inc.*, 89 USPQ2d 1152, 1153, n.1 (TTAB 2008).
	Added new Note 8, citing *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010).
	Added new Note 9, citing *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010).
	Added new Note 10, citing *In re Viventia Biotech Inc.*, 80 USPQ2d 1376, 1377 (TTAB 2006).
	Added new Note 11, citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007); *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153 (TTAB 2009).
	Added new cases to Note 12: *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198 (TTAB 2009); *In re Carlson*, 91 USPQ2d 1198, 1199, n.2 (TTAB 2009).
	Added new Note 13, citing *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).
	Added new Note 14, citing *In re Carrier Consulting Group*, 84 USPQ2d 1028, 1032-33 (TTAB 2007); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 n.4, 6, 7 (TTAB 2009); *In re Grand Forest Holdings Inc.*, 78 USPQ2d 1152, 1153, 1154 n.3 (TTAB 2006).
1208.04 Judicial Notice	Clarifies the types of dictionaries containing definitions that Board will take judicial notice of; that Board will consider definitions from on-line dictionaries if made of record during examination; and that Board will not take judicial notice if source of definition is not clear.
	Added new cases to Note 1: *In re Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1338 (TTAB 2009); *In re Hotels.com, L.P.*, 87 USPQ2d 1100, 1103 (TTAB 2007), *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); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1285 n.2 (TTAB 2006); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1957 (TTAB 2006); *In re Reed Elsevier Properties Inc.*, 77 USPQ2d 1649, 1653 n.8 (TTAB 2005), *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).
	Added new cases to Note 3: *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1338 (TTAB 2009); *In re Tokutake Industry Co.*, 87 USPQ2d 1697, 1700, n.1 (TTAB 2008); *In re Yeley*, 85 USPQ2d 1150, 1153, n.10, n.11 (TTAB 2007); *In re Thermo LabSystems Inc.*, 85 USPQ2d 1285, 1291 (TTAB 2007); *In re Joint-Stock Co. "Baik"*, 84 USPQ2d 1921, 1923 n.2 (TTAB 2007); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 (TTAB 2006); *In re Isabella Fiore LLC*, 75 USPQ2d 1564, 1566 n.5 (TTAB 2005); *In re Eddie Z's Blinds and Drapery Inc.*, 74 USPQ2d 1037, 1038 n.3 (TTAB 2005); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 (TTAB 2006); *In re Viventia Biotech Inc.*, 80 USPQ2d 1376, 1377 (TTAB 2006); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1379 n.7 (TTAB 2006).
	Added new case to Note 4: *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 n.5 (TTAB 2007).
	Added new Note 5, citing *In re Dietrich*, 91 USPQ2d 1622, 1631 n.15 (TTAB 2009); *In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1334 n.1 (TTAB 2009); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008).
	Added new Note 6, citing *In re Gregory*, 70 USPQ2d 1792, 1793 (TTAB 2004).
1208.05 Applicant's Own Materials	Subsection added to clarify that applicant's own materials will be considered even if application based on intent-to-use.
	Added new Note 1, citing *In re Hunter Fan Co.*, 78 USPQ2d 1474, 1476, n.2 (TTAB 2006); *In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006).
1209.01 Remand – Upon Board's Own Initiative	Includes references to requirements as well as refusals; adds new case to Note 2: *In re Consolidated Specialty Restaurants Inc.*, 71

	USPQ2d 1921, 1922 (TTAB 2004) and to Note 15: *In re W.W. Henry Co.*, 82 USPQ2d 1213, 1213 (TTAB 2007).
1209.02 Remand – Upon Request by Trademark Examining Attorney	Includes references to requirements as well as refusals; deletes citation of three 1986 cases that were decided prior to adoption of 37 C.F.R. § 2.142(f)(6).
1209.03 Remand – Upon Granted Letter of Protest	Changes name of office that decides Letters of Protest, and title of person who makes that determination.
1209.04 Remand – Upon Request by Applicant	Clarifies that if examining attorney denies a request for reconsideration after appeal is filed, a second request for reconsideration is treated as a request for remand even if filed within 6 months of final Office action.
1210 Approval for Publication During Appeal	Adds that examining attorney may notify application by email that application has been approved.
1211 Abandonment During Appeal	No changes made.
1212 Cancellation or Assignment of Cited Registration	No changes made.
1213 Suspension of Appeal	Deletes references to registrations that issued prior to November 16, 1989 and have not yet been renewed; adds that if examining attorney approves application the applicant should be notified by telephone or email; adds that if the appropriate affidavit or renewal application is accepted for the cited registration the examining attorney should notify the Board, which will then resume proceedings in the appeal.
1214 Consolidation	Adds new cases to Note 1: *In re America Online Inc.*, 77 USPQ2d 1618 (TTAB 2006) and deletes citations to older cases.
	Adds new cases to Note 2: *In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009); *In re Vertex Group LLC*, 89 USPQ2d 1694, 1695 (TTAB 2009); *In re Supply Guys Inc.*, 86 USPQ2d 1488, 1490 (TTAB 2008).
1215 Alternative Positions	Clarifies that applicant should state that its claim is "in the alternative;" adds references to TMEP in new Notes 4 and 5.
	Adds new cases to Note 1: *In re Brouwerij Bosteels*, 96 USPQ2d 1414 (TTAB 2010); *In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992);

	In re Binion, 93 USPQ2d 1531 (TTAB 2009); *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).
	Adds new cases to Note 2: *In re Brouwerij Bosteels*, 96 USPQ2d 1414, n.7 (TTAB 2010); *In re Binion*, 93 USPQ2d 1531 (TTAB 2009).
	Added new Note 3, citing *In re Chippendales USA, Inc.,* 622 F.3d 1346, 96 USPQ2d 1681, n.8 (Fed. Cir. 2010).
1216 Oral Hearing	Adds that when applicant requests an oral hearing the Board contacts the applicant with possible dates; that hearings are generally held between 10:00 and 3:00; that an applicant may request that it attend by video conference, and provides details of what is required; clarifies that contact information appears on the scheduling order, and that documents offered at the hearing not previously made of record will not be considered unless consented to by non-offering party, in which case they will be deemed stipulated into the record; deletes references to videoconferencing facilities only in California and Michigan.
1217 Final Decision	Clarifies that although the Board normally considers all refusals and requirements, if Board affirms a refusal or requirement it may elect not to reach any further refusals or requirements; clarifies that in a multi-class application the Board may affirm a refusal as to one class and reverse the refusal with respect to another; clarifies that even if the Board reverses a refusal for an intent-to-use application, the examining attorney may still issue a new refusal or requirement arising from examination of the statement of use.
	Added new Note 3, citing *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009); *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1984 (TTAB 2009); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009); *In re Cheezwhse.com Inc.*, 85 USPQ2d 1917 (TTAB 2008); *In re MGA Entertainment Inc.*, 84 USPQ2d 1743, 1747 (TTAB 2007); *In re Howard Leight Industries LLC*, 80 USPQ2d 1507 (TTAB 2006).

	Added new Note 4, citing *In re Max Capital Group Ltd.*, 93 USPQ2d 1243 (TTAB 2010); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198 (TTAB 2009); *In re DTI Partnership LLP*, 67 USPQ2d 1699, 1072 (TTAB 2003).
	Added new Note 5, citing *In re Wielinski*, 49 USPQ2d 1754 (TTAB 1998); *In re Harry N. Abrams, Inc.*, 223 USPQ 832 (TTAB 1984).
	Added new case to Note 11: *In re W.W. Henry Co.*, 82 USPQ2d 1213, 1213 (TTAB 2007).
	Added new Note 12, citing TMEP § 1109.07 *et seq.*; *In re Husqvarna Aktiebolag*, 91 USPQ2d 1436, 1439 (TTAB 2009).
1218 Reopening	Added new cases to Note 2: *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1288 (TTAB 2006); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1958 (TTAB 2006); *In re Crystal Geyser Water Co.*, 85 USPQ2d 1374, 1379 (TTAB 2007).
	Added new case to Note 4: *In re Spirits International N.V.*, 563 F.3d 1347, 90 USPQ2d 1489 (Fed. Cir. 2009).
1219.01 Review of Final Decision—By Request for Reconsideration	Adds new case to Note 2: *In re Squaw Valley Development Co.*, 80 USPQ2d 1264, 1266 (TTAB 2006) and TMEP reference.

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