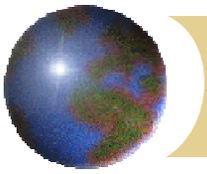


Overview of the Trademark Trial and Appeal Board

*(The U.S. Opposition Proceeding:
Transparent and Efficient)*

Global Intellectual Property Academy

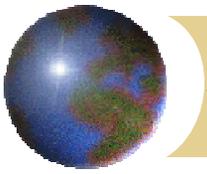
Nancy Omelko—Attorney-Advisor (Trademarks)
Office of Intellectual Property Policy and Enforcement
United States Patent and Trademark Office



What is transparency?

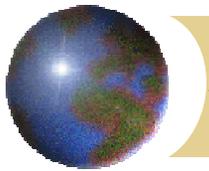
Article 63—TRIPs

- WTO members must make publicly available:
 - laws and regulations and final decisions and administrative rulings
 - pertaining to the availability, scope, acquisition, enforcement and prevention of the abuse of intellectual property rights
 - in a national language,
 - in such manner as to enable governments and right holders to become acquainted with them.
- But need not disclose confidential information which:
 - would impede law enforcement
 - or otherwise be contrary to the public interest
 - or would prejudice the legitimate commercial interest of particular



What is Efficiency?

- Electronic means to file papers
- Electronic means to accept papers and fees
- Electronic means to issue decisions
- Electronic means to access all papers in a proceeding—and even those submitted during examination
- Electronic accessibility to view all laws, regulations, decisions, and explanatory manuals used to determine procedural matters.
- Providing a work-flow platform that eliminates the need for paper.



Trademark Flowchart

Supreme Court of the United States

U.S. Court of Appeals for the Federal Circuit

Civil Courts

Civil action in U.S. District Court

TTAB

Ex Parte Appeal

Opposition

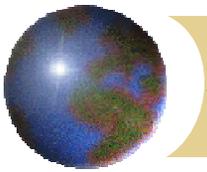
Cancellation

Application

Examination

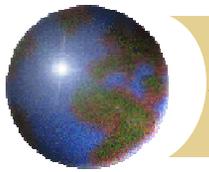
Publication

Registration



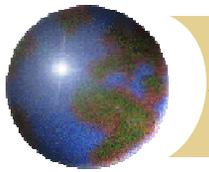
3 Potential Obstacles for Obtaining/Maintaining Registration

- ❖ Refusal resulting from problems found during examination of the application.
- ❖ Possible filing of objection to registration by third party. (The opposition.)
- ❖ Possibility of cancellation of registration.



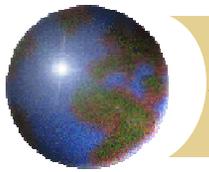
The application has been approved by the examiner—what now?

- The mark is published for opposition in the Trademark Official Gazette—which is available on-line.
- If no one opposes registration within 30 days (or requests an extension of time to oppose) the mark may go on to registration.



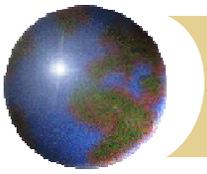
Why is the extension period of value?

- Additional extension requests may be filed, but in no case may an opposition be filed beyond 180 days of the date the mark was published in the Official Gazette.
- The period before the actual opposition is filed is often used by the parties to determine whether their dispute can be resolved without the need to go forward with the proceeding.



What is an Opposition?

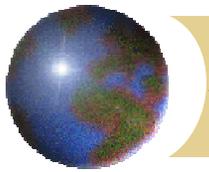
- ✿ A means to object before the registration of a mark in the United States Patent and Trademark Office (USPTO)...
- ✿ Before a tribunal (Trademark Trial and Appeal Board) within the USPTO...
- ✿ Comprised of judges who are experts in trademark law...
- ✿ After the examining attorney has already examined the application for compliance with legal requirements.



Why is it important to determine rights in a mark before the mark is registered?

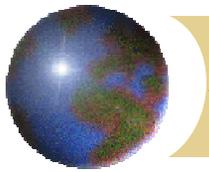
Federal registration provides:

- constructive notice to the public of the registrant's claim of ownership of the mark;
- a legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide on or in connection with the goods and/or services listed in the registration;



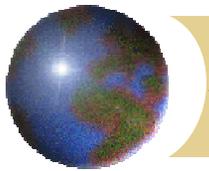
Registration rights—continued

- ✚ the ability to bring an action concerning the mark in federal court;
- ✚ the use of the U.S registration as a basis to obtain registration in foreign countries; and
- ✚ the ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods.



Early determination of rights benefits both sides.

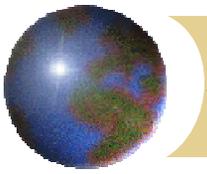
- ❖ The US adopted the pre-registration opposition proceeding because it is important for parties to ascertain rights in a mark before registration rights vest—especially with regard to bad-faith applicants.
- ❖ Determining rights early in the process also minimizes time and money spent in a trademark that is not valid.



Opposition or Court?

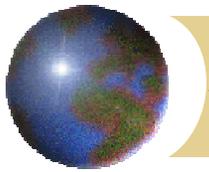
An opposition proceeding is similar to a court proceeding in many respects except that

- ✿ it is filed with the administrative tribunal of the USPTO—the Trademark Trial and Appeal Board;
- ✿ it is less expensive;
- ✿ it is based on a written record; and
- ✿ jurisdiction is limited to the issue of registrability.



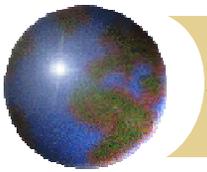
Fees

- ❖ No fees are required for filing requests to extend the opposition period, but the fee for filing a notice of opposition is \$300 per class for each opposer. The opposition may be filed electronically.
- ❖ If the opposition is filed electronically, the computer program will prompt the opposer when insufficient fees are submitted, and permit the opposer to correct the error if the omission was not intended.



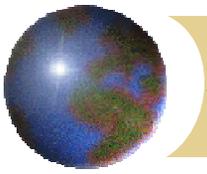
Efficiencies of Electronic filing

- ❖ For the most part, this process of granting or denying extension requests can be handled without human intervention. Currently, about 91% of extension requests are filed electronically.
- ❖ This has virtually eliminated the need for personnel to review these submissions; has made it virtually impossible to lose documents; and has reduced the processing time to virtually nothing.



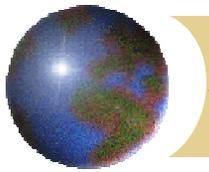
Jurisdiction of the Board

- ❖ The Board has limited jurisdiction related only to determining registrability of a mark.
- ❖ The Board may not issue injunctions against a party's use of a mark. If a party is interested in enjoining use of a mark, the party must file suit in a court, which can also decide registrability issues.
- ❖ The parties may request suspension of Board proceedings pending a decision by the court.



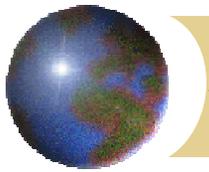
Examiner's decision—not binding on Board

- ⊕ The Board is not bound by the decision of the examining attorney during examination.
- ⊕ The issues are resolved based on the evidence presented in the opposition proceeding by the parties.



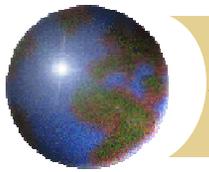
Grounds

- ✿ In addition to grounds for refusal used in the initial examination of the application by the examining attorney, there are other grounds for opposition, including:
 - ✿ abandonment of the mark;
 - ✿ fraud; and
 - ✿ dilution: (A lessening of the distinctive quality of the mark—opposer must prove that its mark was famous prior to the applicant’s first use.)



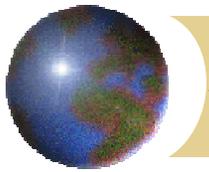
Standing

- ❖ Any person (natural or legal) who believes that it would be damaged by the registration of a mark upon the principal register may file an opposition.
- ❖ The opposer must have standing.
- ❖ Whether a party has standing to oppose depends on the grounds asserted in the opposition.



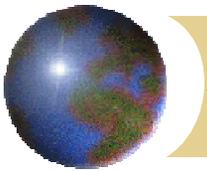
Standing for Likelihood of Confusion/ Descriptiveness

- ❖ To have standing to oppose an application based on likelihood of confusion, you must plead and subsequently prove that you have earlier rights in the mark.
- ❖ To have standing to oppose an application based on descriptiveness, you must plead and subsequently prove you are a competitor who needs to use the descriptive term in business.



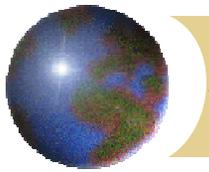
The Pleadings

- The pleadings comprise:
 - the notice of opposition (the complaint) filed by the opposer;
 - the answer and any affirmative defenses and/or counterclaims (to be discussed below) filed by the applicant; and
 - any answer to a counterclaim (if filed) filed by opposer.



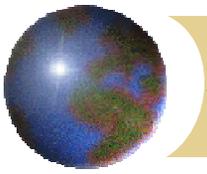
The Notice of Opposition

- The notice of opposition sets out (usually in numbered paragraphs) identifying information
 - about the opposer
 - its allegations for standing
 - grounds for opposition.



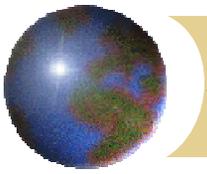
Institution Order

- When the opposition is filed, the Board issues an institution order—electronically, if
 - the opposer filed electronically and
 - the applicant provided an email address in its application.



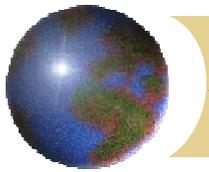
continued

- ❖ The order sets out the time frame for the applicant to file its
 - ❖ answer (40 days);
 - ❖ the time for discovery (6 months);
 - ❖ the time set for testimony (30 days for opposer; 30 days for applicant; and 15 days for opposer's rebuttal); and
 - ❖ the times allotted for opposer and applicant to file their briefs on the case and for opposer to file a rebuttal brief, if necessary.



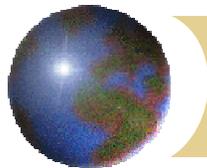
These periods can be extended

- ⊕ These time frames may be extended on consent of the parties or by order of the Board.
- ⊕ These extensions are usually granted, unless a party has been thwarting progress in the case.



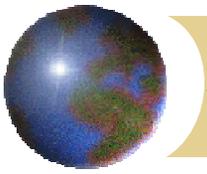
Answer and Affirmative Defenses

- ❖ In its answer the applicant is required to admit or deny the allegations in the notice of opposition.
- ❖ The applicant can also assert affirmative defenses.
- ❖ Affirmative defenses may include unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior registration defense, prior judgment, or any other matter constituting an avoidance or affirmative defense.



Counterclaim

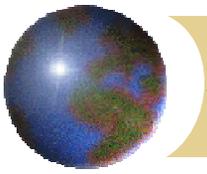
- Another efficiency—rather than file a separate complaint, the applicant may also file a counterclaim to cancel the registration pleaded by opposer with a fee for each class in the registration it wishes to cancel.
- The opposer will be required to file an answer to the counterclaim.



Discovery

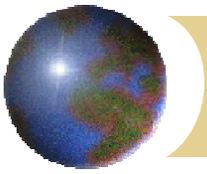
The discovery period allows the parties to request and receive relevant information from each other necessary to evaluate their claims and defenses. Means by which discoverable information can be obtained are:

- ✚ written interrogatories (75 including sub-parts)
- ✚ requests for production of documents
- ✚ depositions
- ✚ requests for admissions



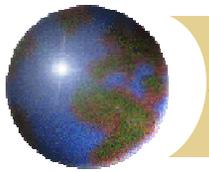
Testimony

- The assignment of testimony periods corresponds to setting a case for trial in court proceedings.
- The taking of depositions during the assigned testimony periods corresponds to the trial in court proceedings.
- 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.



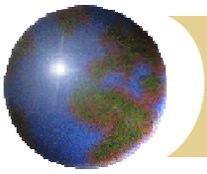
Briefs

- ❖ As the party bringing the case, the opposer is responsible for submitting a brief on the case.
- ❖ The applicant may file a brief, or choose not to.
- ❖ If the applicant files a brief, opposer may file a rebuttal brief, or choose not to.
- ❖ There are time frames and page limits associated with the filing of these briefs.



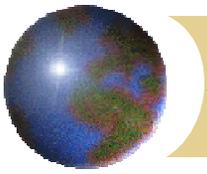
Oral Hearing

- ✿ An oral hearing is held only if requested by a party to the proceeding.
- ✿ No new evidence can be introduced.
- ✿ Oftentimes, the judges take this time to ask questions about facts and arguments that were not clear in the parties' briefs.
- ✿ The non-requesting party need not attend.
- ✿ Board judges can attend remotely.



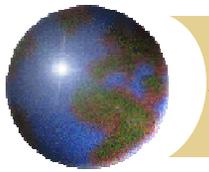
Responsibilities of the Board

- To institute proceedings
- To decide motions
- To suspend proceedings
- To hear oral arguments
- To issue final decisions
- To terminate proceedings



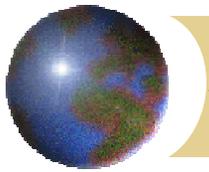
Suspension

- ❁ Suspension conserves the Board's limited resources by allowing the parties, or the court, to resolve the issues.
 - ❁ for settlement negotiations between the parties (The Board encourages settlement talks, and will suspend its proceedings for such talks almost indefinitely.)
 - ❁ when a complaint that may have a bearing on the Board decision is filed in a court by one of the parties against the other.



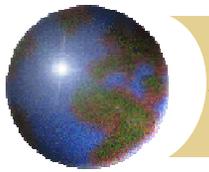
Efficiencies

- ❖ There were over 6000 oppositions/cancellations filed last year
- ❖ with only 162 final decisions by a three-judge panel issued.
- ❖ This is because the majority of the disputes are settled by agreement of the parties or loss of interest in the case by one of the parties.



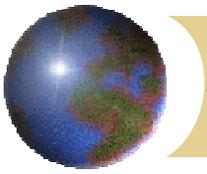
Responsibility of the Parties

- ❖ Cooperation with other side
- ❖ The parties must attempt to resolve differences first before involving the Board.
- ❖ Motions—if a party is entitled to relief from non-cooperation of the other party, a motion may be filed with the Board for relief.



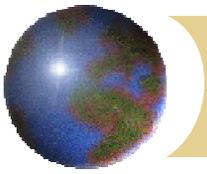
Motions practice— not exhaustive list

- ✿ for default judgment
- ✿ to dismiss for failure to state a claim upon which relief can be granted
- ✿ to compel
- ✿ to have the admissions deemed admitted
- ✿ to quash the notice of deposition if the notice is untimely, or if it constitutes harassment.
- ✿ to extend/suspend
- ✿ for summary judgment



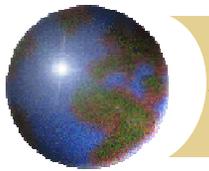
Mandatory Initial Disclosure

- ❖ The Board recently added a procedure requiring parties, during the early stage of the proceeding, to disclose claims and defenses that they will rely on.
- ❖ This should streamline Board practice even further since it forces the parties to investigate their case early in the proceeding, which may lead to earlier settlement or resolution.



Conclusion

- ❖ Proceedings at the Board are less expensive than court proceedings.
- ❖ All documents can be filed and viewed on-line.
- ❖ The parties are encourage to settle the dispute or, if that is not possible, to proceed with as little intervention by the Board as possible.



Thank you

Nancy Omelko

Office of Intellectual Property Policy and
Enforcement

nancy.omelko@uspto.gov

571-272-9300