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301 Commencement of Proceeding

37 CFR §2.101(a) *An opposition proceeding is commenced by the filing of an opposition in the Patent and Trademark Office.*

37 CFR §2.111(a) *A cancellation proceeding is commenced by the timely filing of a petition for cancellation, together with the required fee, in the Patent and Trademark Office.*

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 in the PTO. *See* 37 CFR §2.101(a). *See also* *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). *Cf.* FRCP 3. Similarly, a cancellation proceeding is commenced by the timely filing of a petition for cancellation, together with the required fee, in the PTO. *See* 37 CFR §2.111(a).

The notice of opposition, or the petition for cancellation, and the answer thereto correspond to the complaint and answer in a court proceeding. *See* 37 CFR §2.116(c). 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. *See* 37 CFR §2.116(b). *See also* *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988).

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. Similarly, a concurrent use proceeding commences when the Board mails a notice

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of the proceeding to each of the parties thereto, as described in 37 CFR §§2.99(c) and 2.99(d)(1). For further information concerning interference and concurrent use proceedings, *see* TBMP chapters 1000 and 1100, respectively.

302 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. *See* Sections 12(a), 13(a), and 24 of the Act, 15 U.S.C. §§1062(a), 1063(a), and 1092. *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. The opposition papers will be returned to the person who filed them, and 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. *See* Section 24 of the Act, 15 U.S.C. §1092.

303 Who May Oppose or Petition to Cancel

303.01 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 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 12 of this Act of the mark sought to be registered. ...

15 U.S.C. §1064 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 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 Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official

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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 this register he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Commissioner to cancel such registration. ...

15 U.S.C. §1127 *In the construction of this Act, 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.*

* * *

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

37 CFR §2.101(b) *Any entity which believes that it would be damaged by the registration of a mark on the Principal Register may oppose the same by filing an opposition, which should be addressed to the Trademark Trial and Appeal Board. ...*

37 CFR §2.111(b) *Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. ...*

303.02 Meaning of the Term "Person"

The term "person," as used in the Act, includes both natural and juristic persons. See Section 45 of the Act, 15 U.S.C. §1127. Cf. 37 CFR §2.2(b). A juristic person is a "firm, corporation, union, association, or other organization capable of suing and being sued in a court of law." See Section 45 of the Act, 15 U.S.C. §1127. See also *Opryland USA Inc. v. The Great American Music Show Inc.*, 970

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F.2d 847, 23 USPQ2d 1471 (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 (CCPA 1969) [commercial corporation, being a "person" within the meaning of Section 45 of the Act, can base opposition on Section 2(a) of the Act, 15 U.S.C. §1052(a)]; *Aruba v. Excelsior Inc.*, 5 USPQ2d 1685 (TTAB 1987) [Commonwealth of Aruba is a "person" within the meaning of Sections 13 and 45 of the Act]; *U.S. Navy v. United States Manufacturing Co.*, 2 USPQ2d 1254 (TTAB 1987) [U.S. Navy is a juristic person within the meaning of Section 45 of the Act]; *The Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408 (TTAB 1986) [Alabama Board of Trustees, a corporate body, may be considered either a "person" or an "institution" within the meaning of Section 2(a) of the Act]; *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752 (TTAB 1985) [corporations as well as individuals are "persons" for purposes of Section 2(a) of the Act]; and *In re Mohawk Air Services Inc.*, 196 USPQ 851 (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].

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. See *In re Cambridge Digital Systems*, 1 USPQ2d 1659 (TTAB 1986), and TMEP §1201.02(d). 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, the Board will make written inquiry as to whether the division is incorporated or is otherwise a legal entity which 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. Cf. *In re Cambridge Digital Systems*, *supra*, and TMEP §1201.02(d).

303.03 Meaning of the Term "Damage"

The term "damage," as used in Sections 13 and 14 of the Act, 15 U.S.C. §§1063 and 1064, relates only to a party's standing to file an opposition or a petition to cancel, respectively. 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 personal

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interest in the outcome of the proceeding beyond that of the general public. There is no requirement that actual damage be pleaded and proved in order to establish standing or to prevail in an opposition or cancellation proceeding. *See 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 & Co.*, 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 (CCPA 1976); *American Vitamin Products Inc. v. DowBrands 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); *Ipcor 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).

303.04 Federal Trade Commission

The proviso at the end of Section 14 of the Act, 15 U.S.C. §1064, specifically states that the Federal Trade Commission may apply to cancel, on the grounds specified in paragraphs (3) and (5) of the section, any mark registered on the Principal Register established by the Act. *See also Formica Corp. v. Lefkowitz*, 590 F.2d 915, 200 USPQ 641 (CCPA 1979), and *Federal Trade Commission v. Formica Corp.*, 200 USPQ 182 (TTAB 1978). For a listing of the grounds for cancellation specified in paragraphs (3) and (5) of Section 14 of the Act, *see* TBMP §308.01.

303.05 Opposition Filed During Extension of Time to Oppose

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37 CFR §2.102(b) The 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, but 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. 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. *See 37 CFR §2.102(b); TMEP §1503.04; SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707 (TTAB 1994); and *In re Cooper*, 209 USPQ 670 (Comm'r 1980). *Cf.* TBMP §206.02.

303.05(b) Opposition Filed by Privy

An opposition filed during an extension of time to oppose, by a party other than the party to which the extension was granted, will not be rejected on that ground if it is shown to the satisfaction of the Board that the differing party is in privity with the party granted the extension. *See 37 CFR §2.102(b); TMEP §1503.04; SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707 (TTAB 1994); and *In re Cooper*, 209 USPQ 670 (Comm'r 1980). *Cf.* TBMP §206.02.

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 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 which fails to make a satisfactory showing of privity.

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

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303.05(c) Misidentification

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. *See* 37 CFR §2.102(b), and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993). The phrase "misidentification by 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. *See Cass Logistics Inc. v. McKesson Corp.*, *supra*. *See also* TMEP §1503.04. *Cf. Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap*, 184 USPQ 505 (TTAB 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 TBMP §512.04. *Cf. also* TMEP §§802.06 and 802.07; *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991); *In re Atlanta Blue Print Co.*, 19 USPQ2d 1078 (Comm'r 1990); *In re Techsonic Industries, Inc.*, 216 USPQ 619 (TTAB 1982); *Argo & Co. v. Springer*, 198 USPQ 626 (TTAB 1978); *In re Eucryl, Ltd.*, 193 USPQ 377 (TTAB 1976); *Argo & Co. v. Springer*, 189 USPQ 581 (TTAB 1976); and *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613 (Comm'r 1974).

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 opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy.

304 Joint Opposers or Petitioners

An opposition, or a petition for cancellation, may be filed by two or more parties 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* 37 CFR §§2.101(d)(1) and 2.111(c)(1); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707 (TTAB 1994); and TBMP §§309 and 310.

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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. 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 therein, even though a ground for opposition or cancellation has been proved. *See Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139 (TTAB 1986).

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. *See Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625 (TTAB 1992).

305 Proceeding Against Multiple Class Application or Registration

When an opposition is filed with respect to an application which contains goods and/or services in multiple classes (*see* 37 CFR §2.86(b)), 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. *See* 37 CFR §§2.101(d) and 2.111(c), and TBMP §§309 and 310.

306 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) Petitions to cancel different registrations owned by the same party may be joined in a consolidated petition when appropriate, but the required

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fee must be included for each party joined as petitioner for each class sought to be cancelled in each registration against which the petition to cancel is filed.

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. *See* 37 CFR §2.104(b). When such a pleading is filed, the Board sets up a single opposition file, identified by a single opposition proceeding number, but bearing on its front, in the place where the number of the opposed application is written, the number of each application opposed in the consolidated notice of opposition.

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. *See* 37 CFR §2.112(b). When such a pleading is filed, the Board sets up a single cancellation file, identified by a single cancellation proceeding number, but bearing on its front the number of each registration sought to be cancelled in the consolidated petition to cancel.

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. *See Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237 (TTAB 1993). 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. *Cf.* 37 CFR §§2.104(b) and 2.112(b). When such a pleading (referred to as a "combined" opposition and petition to cancel) 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 papers relating to the combined proceedings. *Cf.* TBMP §511.

A consolidated notice of opposition, or petition to cancel, or 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. *See Nabisco Brands Inc. v. Keebler Co.*, 28

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USPQ2d 1237 (TTAB 1993). *Cf.* FRCP 42(a); TBMP §511; *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246 (TTAB 1975); and *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440 (TTAB 1973). *Cf. also* *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444, 1445 (TTAB 1987), and *Federated Department Stores, Inc. v. Gold Circle Insurance Co.*, 226 USPQ 262, 263 (TTAB 1985).

307 Time for Filing Opposition

307.01 In General

15 U.S.C. §1062(a) Upon the filing of an application for registration and payment of the prescribed fee, the Commissioner 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 1(d) of this Act, the Commissioner shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office....

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 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 12 of this Act 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 Commissioner for good cause when requested prior to the expiration of an extension. The Commissioner shall notify the applicant of each extension of the time for filing opposition. ...

37 CFR §2.101(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.

An opposition to the registration of a mark upon the Principal Register must be filed prior to the expiration of the thirty-day period after publication of the mark in the *Official Gazette* for opposition, or within an extension of time to oppose granted to the opposer or its privy. *See* Section 13(a) of the Act, 15 U.S.C.

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§1063(a); 37 CFR §§2.102(b) and (c); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707 (TTAB 1994); and *In re Cooper*, 209 USPQ 670 (Comm'r 1980). *Cf.* TBMP chapter 200.

The certificate of mailing by first-class mail procedure described in 37 CFR §1.8 and the certificate of "Express Mail" procedure described in 37 CFR §1.10 are both available for the filing of a notice of opposition; the certificate of transmission procedure described in 37 CFR §1.8 is not. *See* 37 CFR §§1.8(a) and 1.10(a).

307.02 Date of Publication of Mark

Normally, the date of publication of a mark is the cover date of the issue of the *Official Gazette* in which the mark is published, pursuant to Section 12(a) of the Act, 15 U.S.C. §1062(a), for purposes of opposition.

However, when an issue of the *Official Gazette* is mailed late (*see* TBMP §202.03), the date of publication of the marks published therein for opposition is considered by the Commissioner to be the date on which the *Official Gazette* was mailed, and the thirty-day opposition period is considered by the Commissioner to run from the *Official Gazette* mailing date, rather than from its cover date. Applicants and potential opposers are notified of the late mailing, and of the consequent change in both the publication date and the opposition period expiration date, by a Commissioner's Notice published in a subsequent issue of the *Official Gazette*. *Cf. In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375, at fn.1 (Comm'r 1988).

307.03 Premature Opposition

Section 13 of the Act, 15 U.S.C. §1063(a), requires that an opposition to the registration of a mark upon 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, in the *Official Register*, 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

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be instituted; rather, the opposition papers will be returned, and any submitted opposition fee will be refunded. *Cf.* TBMP §§119.03 and 202.04.

307.04 Late Opposition

Because the timeliness requirements of Section 13(a) of the Act, 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 Commissioner upon petition. *See In re Cooper*, 209 USPQ 670 (Comm'r 1980).

Accordingly, an opposition filed after the expiration of the would-be opposer's time for opposing must be rejected by the Board as late. No proceeding will be instituted; rather, the opposition papers will be returned, 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 Section 14 of the Act, 15 U.S.C. §1064, when and if a registration is issued.

307.05 Effect of Suspension of Extension Time

The Board sometimes suspends the running of an extension of time to oppose pending consideration by the Examining Attorney of an amendment to the applicant's subject application (*see* TBMP §212.04), or pending determination of a letter of protest filed by the potential opposer, with respect to applicant's subject application, during the thirty days after publication for opposition (*see* TBMP §215).

However, the suspension of the running of the extension in these situations is solely for the benefit of the potential opposer, that is, to preserve potential opposer's time for opposing until potential opposer has been notified of the disposition of the amendment, or letter of protest, and has had adequate time thereafter to file an opposition. *See* TBMP §212.04.

If, notwithstanding the Board's letter suspending the running of the extension, an opposition is filed prior to the expiration of the extension as originally set, the opposition will not be rejected by the Board as having been filed during the suspension. Rather, opposer will be deemed to have waived the suspension of the

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running of its extension, and the opposition will be deemed timely (except that if, prior to the filing of the opposition, the Commissioner restored jurisdiction over the subject application to the Examining Attorney, the opposition cannot be entertained by the Board--*see* TBMP §§213, 215, 307.06, and 307.07). If, after being informed of the outcome of the request to amend or letter of protest, opposer is no longer interested in opposing, opposer may request that the opposition not be instituted (or, if already instituted, that the institution be vacated), and that the opposition fee be refunded. *See* TBMP §212.04.

307.06 Effect of Restoration of Jurisdiction

When an Examining Attorney's request for jurisdiction is granted by the Commissioner during the thirty days after publication of the involved mark for opposition, or during an extension of time to oppose the involved application, the application is no longer subject to the filing of a new opposition, and the restoration of jurisdiction serves to stay the running of the potential opposer's extension of time for opposing.

Any opposition filed after the restoration of jurisdiction will be rejected by the Board. No proceeding will be instituted; the opposition papers will be returned to the opposer; and any submitted opposition fee will be refunded. *See* TBMP §213. However, in those cases where (1) jurisdiction is restored during the thirty days after publication of the mark for opposition, and (2) the Examining Attorney subsequently approves the application, the mark will be republished in order to afford potential opposers a full opposition period. In those cases where (1) jurisdiction is restored during an extension of time to oppose, (2) the Examining Attorney subsequently approves the application, and (3) the mark is not republished, the Board will reset potential opposer's time for filing an opposition. *See* TBMP §213.

Any opposition filed prior to the restoration of jurisdiction will be accepted by the Board, and the Board will suspend proceedings in the opposition pending completion of the ex parte examination. *See* 37 CFR §2.130.

307.07 Effect of Letter of Protest

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The filing of a letter of protest (*see* TMEP §1116; *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (Comm'r 1988); and *In re Pohn*, 3 USPQ2d 1700 (Comm'r 1987)) does not serve to stay the time for filing an opposition to the subject mark. *See* TBMP §215. If a letter of protest is filed after publication, and a potential opposer wishes to preserve its time to oppose pending determination of the letter of protest, it must obtain an extension (or extensions, as necessary) of its time to oppose. For information concerning the handling of requests for extension of time to oppose when there is a pending letter of protest, *see* TBMP §215.

An opposition may be filed while a letter of protest is pending. However, if a letter of protest is granted, and jurisdiction over the application is restored to the Examining Attorney, no opposition may be filed thereafter; the application is no longer subject to the filing of a new opposition. *See* TBMP §307.06. If an opposition is filed after restoration of jurisdiction, no proceeding will be instituted; the opposition papers will be returned to the opposer; and any submitted opposition fee will be refunded.

307.08 Effect of Petition to the Commissioner

If an applicant or potential opposer is dissatisfied with an action of the Board relating to a request for an extension of time to oppose, it may file a petition to the Commissioner for review of the action in question. *See* 37 CFR §2.146 and TBMP §211.02. However, the filing of a petition from the denial, or 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. *See* TBMP §211.02. *Cf.* 37 CFR §§2.89(g) and 2.146(g).

Any opposition, or request for a further extension of time to oppose, filed by the involved potential opposer during the pendency of the petition to the Commissioner, will be held by the Board for appropriate action after determination of the petition. If a petition from the granting of a request for an extension of time to oppose is granted, any opposition or request for further extension of time to oppose filed during or after the extension period in question will be rejected by the Board as untimely. *See* TBMP §211.02. No proceeding will be instituted; the opposition papers will be returned to the opposer; and any submitted opposition fee will be refunded.

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307.09 Effect of Republication

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. *See* TBMP §214. If the change reflected in the republication is one which might have an effect upon the opposition, the Board will notify opposer and applicant, in writing, 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 its opposition fee refunded, and the opposition not instituted.

However, once the Board learns that a mark which 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.

When a mark is republished solely by mistake, 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 be returned to the opposer; no proceeding will be instituted; and any submitted opposition fee will be refunded. *See* TBMP §214.

307.10 Effect of Inadvertent Issuance of Registration

Sometimes a registration is issued, inadvertently, from an application which, at the time of such issuance, is the subject of a timely opposition, or an unexpired extension of time to oppose. *See* TBMP §216.

The Board is without authority, within the context of an opposition proceeding, to cancel an inadvertently issued registration and restore it to application status.

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Rather, it is the Commissioner who has such authority, and the Commissioner exercises this authority with caution. *See In re Trademark Registration of Mc Lachlan Touch Inc.*, 6 USPQ2d 1395 (Comm'r 1987).

Accordingly, when it comes to the attention of the Board that a registration has issued inadvertently from an application which is the subject of a timely opposition, the Board will forward the registration file to the Commissioner for such action as the Commissioner deems appropriate. The Commissioner, in turn, may either cancel the registration as inadvertently issued, and restore it to application status, or decline to do so.

When a registration issues inadvertently during a timely opposition, the Commissioner 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.

For information concerning the inadvertent issuance of a registration during an unexpired extension of time to oppose, *see* TBMP §216.

307.11 Effect of Abandonment of Application

An application which 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 be returned by the Board to the opposer; no proceeding will be instituted; and any submitted opposition fee will be refunded. *See Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079 (TTAB 1992), and *In re First National Bank of Boston*, 199 USPQ 296 (TTAB 1978). *Cf.* TBMP §§218 and 602.01.

If it comes to the attention of the Board, after the filing of an opposition, that the opposed application was abandoned, prior to its publication for opposition, for failure of the applicant to respond to an Office action issued by the Trademark Examining Attorney, the Board will advise the parties that the application is not subject to opposition unless applicant files a petition to revive under 37 CFR §2.66, and the petition is granted. If a prior abandonment for failure to timely respond comes to the attention of the Board at a time reasonably contemporaneous

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with the filing of the opposition, and the application is not revived, the opposition will not be instituted; the opposition papers will be returned to the opposer; 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. *See Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079 (TTAB 1992).

After the commencement of an opposition, if applicant files an express abandonment of its application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. *See* 37 CFR §2.135. However, if an applicant files an abandonment after the commencement of an opposition, but before applicant has been notified thereof by the Board, 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 will be entered against applicant. *See In re First National Bank of Boston*, 199 USPQ 296 (TTAB 1978). *Cf.* TBMP §§218 and 602.01.

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; the opposition will be returned to the opposer; no proceeding will be instituted; and any submitted opposition fee will be refunded. *See In re First National Bank of Boston*, 199 USPQ 296 (TTAB 1978). *Cf.* TBMP §§218 and 307.11.

For further information concerning abandonment of an opposed application during the opposition, *see* TBMP §602.01.

308 Time for Filing Petition to Cancel

15 U.S.C. §1064 *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 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.*

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

(4) *At any time if the mark is registered under the Act of March 3, 1881, or the Act of February 20, 1905, and has not been published under the provisions of subsection (c) of section 12 of this Act.*

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

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

15 U.S.C. §1092 *Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by the registration of a mark on this register he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Commissioner to cancel such registration. The*

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Commissioner 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 Commissioner. 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(b) *Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. The petition need not be verified, and may be signed by the petitioner or the petitioner's attorney or other authorized representative. The petition 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(c) or (e) of the Act. In all other cases the petition 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.*

308.01 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, or a registration issued under the Act of 1881 or the Act of 1905 which has not been published under Section 12(c) of the Act of 1946, 15 U.S.C. §1062(c). *See* Sections 14 and 24 of the Act, 15 U.S.C. §§1064 and 1092, and 37 CFR §2.111(b).

In addition, a petition to cancel any registration may be filed at any time on any ground specified in Section 14(3) or 14(5) of the Act, 15 U.S.C. §1064(3) or 1064(5). *See* Sections 14 and 24 of the Act, 15 U.S.C. §§1064 and 1092, and 37 CFR §2.111(b). *See also Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990), and *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990).

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308.02 Petition That Must Be Filed Within Certain Time

308.02(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 Sections 14(3) or 14(5) of the Act, must be filed 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 Section 12(c) of the Act of 1946, on a ground not specified in Section 14(3) or 14(5) of the Act, must be filed within five years from the date of publication under Section 12(c). *See* Sections 14(1) and 14(2) of the Act, 15 U.S.C. §§1064(1) and 1064(2), and 37 CFR §2.111(b).

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 Section 14(3) or 14(5) of the Act, a petition to cancel filed prior to the expiration of the five-year period may be based upon any ground which could have prevented registration initially. *See Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990); *International Mobile Machines Corp. v. International Telephone and Telegraph Corp.*, 800 F.2d 1118, 231 USPQ 142 (Fed. Cir. 1986); *International Order of Job's Daughters v. Lindeburg and Co.*, 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984); and *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

The grounds for cancellation which are thus available in these cases for a petition filed within the five-year period, but not thereafter, include, for example (this list is exemplary, not exhaustive):

(1) Section 2(d) of the Act, 15 U.S.C. §1052(d) (i.e., that respondent's mark so resembles a mark registered in the PTO, 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 respondent, to cause confusion, or to cause mistake, or to deceive). *See Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Person's Co. v. Christman*, *supra*; *Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309 (TTAB 1990); and *Liberty Trouser Co. v. Liberty & Co.*, 222 USPQ 357 (TTAB 1983).

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(2) The grounds specified in Section 2(e) of the Act, 15 U.S.C. §1052(e) (i.e., that respondent's mark, when used on or in connection with the goods or services of the respondent, is merely descriptive or deceptively misdescriptive of them, or is primarily geographically descriptive of them, except as indications of regional origin may be registrable under Section 4 of the Act, 15 U.S.C. §1054, or is primarily geographically deceptively misdescriptive of them; and that respondent's mark is primarily merely a surname). *See Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390 (TTAB 1979); and *Food Specialty Co. v. Carnation Co.*, 170 USPQ 522 (TTAB 1971).

(3) That respondent's design does not function as a trademark, but rather is an essentially functional configuration. *See Shakespeare Co. v. Silstar Corp. of America Inc.*, 9 F.3d 1091, 28 USPQ2d 1765 (4th Cir. 1993), and *International Order of Job's Daughters v. Lindeburg and Co.*, 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984).

(4) That there was no bona fide use of respondent's mark in commerce prior to the filing of the application for its registration. *See International Mobile Machines Corp. v. International Telephone and Telegraph Corp.*, 800 F.2d 1118, 231 USPQ 142 (Fed. Cir. 1986); *Pennwalt Corp. v. Sentry Chemical Co.*, 219 USPQ 542 (TTAB 1983); and *Bonaventure Associates v. Westin Hotel Co.*, 218 USPQ 537 (TTAB 1983).

(5) That respondent's mark is a mere background design which does not function as a mark separate and apart from the words displayed thereon. *See General Foods Corp. v. Ito Yokado Co., Ltd.*, 219 USPQ 822 (TTAB 1983).

(6) That respondent is not (and was not, at the time of the filing of its application for registration) the rightful owner of the registered mark. *See Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318 (TTAB 1990), and *Kemin Industries, Inc. v. Watkins Products, Inc.*, 192 USPQ 327 (TTAB 1976).

(7) That respondent'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 respondent's goods. *See Kassnar Imports v. Plastilite Corp.*, 180 USPQ 156 (TTAB 1973), *aff'd*, 508 F.2d 824, 184 USPQ 348 (CCPA 1975).

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The five-year period specified in Section 14(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. *See Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309 (TTAB 1990). *Cf.* TMEP §§1603.03 and 1605.01. Similarly, the five-year period specified in Section 14(2) ("Within five years from the date of publication under section 12(c) hereof of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905"), includes the fifth anniversary date of the publication under Section 12(c). *Cf. Strang Corp. v. Stouffer Corp.*, *supra*, and TMEP §§1603.03 and 1605.01.

The certificate of mailing by "Express Mail" procedure described in 37 CFR §1.10 is available for the filing of a petition to cancel, but the certificate of mailing or transmission procedure described in 37 CFR §1.8 is not. *See* 37 CFR §§1.8(a) and 1.10(a).

308.02(b) Sec. 14 Limitation Is Independent of Sec. 15 Affidavit

The Section 14 limitation, after expiration of the five-year period, of the grounds upon which the specified types of Principal Register *registrations* may be attacked, "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)." (emphasis in original) *See Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990). *See also Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990), and *Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309 (TTAB 1990).

308.02(c) Factors Affecting the Five-Year Period

308.02(c)(1) Reliance on Registration By Plaintiff

Section 14 of the Act, 15 U.S.C. §1064, limits, after a five-year period, the grounds upon which a Principal Register registration issued under the Act of 1946, 15 U.S.C. §1051 et seq., or issued under certain prior acts and published under Section 12(c) of the Act of 1946, 15 U.S.C. §1062(c), may be cancelled. The five-year period runs from the date of the registration of the mark, for a registration issued on the Principal Register under the Act of 1946; and from the date of publication under Section 12(c) of the Act, for registrations issued on the Principal

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Register under the specified prior acts and published under Section 12(c) of the Act of 1946. *See* Section 14 of the Act.

However, if an opposer relies upon such 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 filed 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 opposition tolls, during the pendency of the proceeding, the running of the five-year period for purposes of determining the grounds upon which a counterclaim may be based. *See Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518 (CCPA 1966); *Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048 (TTAB 1982); *UMC Industries, Inc. v. UMC Electronics Co.*, 207 USPQ 861 (TTAB 1980); *Humble Oil & Refining Co. v. Sekisui Chemical Company Ltd. of Japan*, 165 USPQ 597 (TTAB 1970); and *Sunbeam Corp. v. Duro Metal Products Co.*, 106 USPQ 385 (Comm'r 1955). *See also* J. Thomas McCarthy, *Trademarks and Unfair Competition*, §20:17(C), at pages 1064-1065 (2d ed. 1984).

Similarly, the limitation would not apply to a counterclaim to cancel such a Principal Register registration relied upon 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.

308.02(c)(2) Amendment of Registration

Section 14 of the Act, 15 U.S.C. §1064, limits, after a specified five-year period, the grounds upon which a Principal Register registration issued under the Act of 1946, 15 U.S.C. §1051 et seq., or issued under certain prior acts and published under Section 12(c) of the Act of 1946, 15 U.S.C. §1062(c), may be cancelled. *See* Section 14 of the Act.

Ordinarily, the five-year period runs from the date of the registration of the mark, for a registration issued on the Principal Register under the Act of 1946; and from the date of publication under Section 12(c) of the Act, for registrations issued on the Principal Register under the specified prior acts and published under Section 12(c) of the Act of 1946. *See* Section 14 of the Act, 15 U.S.C. §1064.

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However, when such a Principal Register registration has been amended, the registration is subject to attack under Section 14 of the Act, 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 Section 14 five-year period following issuance of the registration, or publication under Section 12(c), may have expired, if a petition to cancel the registration is filed within the five years following the amendment of the registration, the petition is not limited to Section 14(3) or 14(5) grounds, to the extent that the amendment has in any way enlarged the registrant's rights. Rather, during the five years after the amendment, "the modified registration may be challenged in a cancellation proceeding as long as petitioner states grounds" (not limited to Section 14(3) or 14(5) grounds) "for the cancellation indicating how he believes he is or will be damaged by the modified registration." *See Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420, 423 (CCPA 1976). *See also Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822 (TTAB 1984).

308.03 Premature Petition to Cancel

Sections 14 and 24 of the Act, 15 U.S.C. §§1064 and 1092, provide for the filing of a petition to cancel "a registration of a mark." Until a registration actually issues, there is no registration.

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. No proceeding will be instituted; rather, the petition papers will be returned, 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.

308.04 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 Section 14(3) or 14(5) of the Act, must be filed 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

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the Act of 1905, and published under the provisions of Section 12(c) of the Act of 1946, on a ground not specified in Section 14(3) or 14(5) of the Act, must be filed within five years from the date of publication under Section 12(c). *See* Section 14 of the Act, 15 U.S.C. §1064, and 37 CFR §2.111(b).

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 Section 14(3) or 14(5) of the Act, the petition is late, and will be rejected by the Board. No proceeding will be instituted; rather, the petition papers will be returned, 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 Section 14(3) or 14(5).

309 Fee for Filing Opposition

309.01 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 may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office....

37 CFR §2.101(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(1)). If no fee, or a fee insufficient to pay for one person to oppose the registration of a mark in at least one class, is submitted within thirty days after publication of the mark to be opposed or within an extension of time for filing an opposition, the opposition will not be refused if the required fee(s) is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.

(2) If the fees submitted are sufficient to pay for one person to oppose registration in at least one class but are insufficient for an opposition against all of the classes in the application, and the particular class or classes against which the opposition is filed are not specified, the Office will issue a written notice allowing opposer until a set time in which to submit the required fee(s) or to specify the class or classes opposed. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the opposition will be presumed to be against the

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class or classes in ascending order, beginning with the lowest numbered class and including the number of classes in the application for which the fees submitted are sufficient to pay the fee due for each class.

(3) If persons are joined as party opposers, and 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 Office will issue a written notice allowing the named party opposers until a set time in which to submit the required fee(s) or to specify the opposer(s) to which the submitted fees apply. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the first named party will be presumed to be the party opposer and additional parties will be deemed to be party opposers 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 the registration of a mark in more than one class, the fees submitted are insufficient, and no specification of opposers and classes is made within the time set in the written notice issued by the Office, 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, and any excess will be applied on behalf of the second-named party to the opposition against the classes in the application in ascending order.

The rules governing opposition fees are specified in 37 CFR §§2.101(d)(1)-(d)(3). The amount of the required fee is specified in 37 CFR §2.6(a)(17). For information concerning how to pay fees, *see* 37 CFR §§1.22-1.25, and TBMP §118. For information concerning fee refunds, *see* 37 CFR §1.26, and TBMP §119.

309.02 Insufficient Fee

The required fee for filing an opposition should be submitted with the opposition. However, if no fee, or an insufficient fee, is submitted within thirty days after publication of the mark to be opposed, or within an extension of time to oppose, the defect may be cured as specified in 37 CFR §§2.101(d)(1)-(d)(3).

310 Fee for Filing Petition to Cancel

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310.01 In General

15 U.S.C. §1064 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 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 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 this register he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Commissioner to cancel such registration. ...

37 CFR §2.111(c)(1) The petition must be accompanied by the required fee for each class in the registration for which cancellation is sought (see §§2.6(1) and 2.85(e)). If the fees submitted are insufficient for a cancellation against all of the classes in the registration, and the particular class or classes against which the cancellation is filed are not specified, the Office will issue a written notice allowing petitioner until a set time in which to submit the required fee(s) (provided that the five-year period, if applicable, has not expired) or to specify the class or classes sought to be cancelled. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the cancellation will be presumed to be against the class or classes in ascending order, beginning with the lowest numbered class, and including the number of classes in the registration for which the fees submitted are sufficient to pay the fee due for each class.

(2) 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 insufficient for each named party petitioner, the Office will issue a written notice allowing the named party petitioners until a set time in which to submit the required fee(s) (provided that the five-year period, if applicable, has not expired) or to specify the petitioner(s) to which the submitted fees apply. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the first named party will be presumed to be the party petitioner and additional parties will be deemed to be party petitioners 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 registration sought to be cancelled in more than one class, the fees submitted are insufficient, and no specification of parties and

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classes is made within the time set in the written notice issued by the Office, 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, and any excess will be applied on behalf of the second-named party to the petition against the classes in the registration in ascending order.

(3) The filing date of the petition is the date of receipt in the Patent and Trademark Office of the petition together with the required fee. If the amount of the fee filed with the petition is sufficient to pay for at least one person to petition to cancel one class of goods or services but is less than the required amount because multiple party petitioners and/or multiple classes in the registration for which cancellation is sought are involved, and the required additional amount of the fee is filed within the time limit set in the notification of the defect by the Office, the filing date of the petition with respect to the additional party petitioners and/or classes is the date of receipt in the Patent and Trademark Office of the additional fees.

The rules governing cancellation fees are specified in 37 CFR §§2.111(c)(1)-(c)(3). 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 PTO of both the petition to cancel and the required fee. *See* 37 CFR §§2.111(a), 2.111(c)(1), and 2.111(c)(3); *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518 (CCPA 1966); and TBMP §310.04.

For information concerning how to pay fees, *see* 37 CFR §§1.22-1.25, and TBMP §118. For information concerning fee refunds, *see* 37 CFR §1.26, and TBMP §119.

310.02 Fee for Counterclaim

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. *See* 37 CFR §§2.106(b)(2)(iii) and 2.114(b)(2)(iii); *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518 (CCPA 1966); *Sunway*

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Fruit Products, Inc. v. Productos Caseros, S. A., 130 USPQ 33 (Comm'r 1960); *Jet-Pak, Inc. v. United States Plywood Corp.*, 125 USPQ 491 (Comm'r 1960); *Jet-Pak, Inc. v. United States Plywood Corp.*, 124 USPQ 385 (TTAB 1960); and *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16 (TTAB 1959).

310.03 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. *See* Section 14 of the Act, 15 U.S.C. §1064. *Cf.* TBMP §303.04.

310.04 Insufficient Fee

The required fee for a petition to cancel must be submitted with the petition. *See* 37 CFR §2.111(c)(1). The filing date of a petition to cancel is the date of receipt in the PTO of the petition and the required fee. *See* 37 CFR §2.111(c)(3), and *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518 (CCPA 1966). Moreover, Section 14 of the Act, 15 U.S.C. §1064, limits, after a specified five-year period, the grounds upon which a Principal Register registration issued under the Act of 1946, 15 U.S.C. §1051 *et seq.*, or issued under certain prior acts and published under Section 12(c) of the Act of 1946, 15 U.S.C. §1062(c), may be cancelled. *See* Section 14 of the Act, and TBMP §308.02(a). If a petition to cancel such a registration is submitted to the PTO prior to the expiration of the five-year period, but the required fee is not submitted until after the expiration thereof, the filing date of the petition is the date of receipt in the PTO of the required fee, and the petition can be entertained by the Board only to the extent that it pleads a ground for cancellation permitted after expiration of the five-year period. *See* Section 14 of the Act; *Williamson-Dickie Manufacturing Co. v. Mann Overall Company, supra*; and TBMP §308.04.

Except to the extent that the five-year period of Section 14 is applicable in a particular case, there is no time limit for the filing of a petition to cancel an issued registration. Thus, if no fee, or an insufficient fee, is submitted with a petition to cancel, the defect may be cured as specified in 37 CFR §§2.111(c)(1)-(c)(3), *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*

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period. The petition will not be rejected (except to the extent that it is barred by the five-year limit) if the required fee is submitted to the PTO within the time limit set in the Board's written notification of the defect.

The responsibility for filing proper documents and fees rests with the party filing them. Although the Board makes every effort to notify plaintiffs of insufficiencies in fees before the expiration of any applicable statutory deadline, so that the insufficiencies 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. *Cf. In re Holland America Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984), and *In re Application Papers Filed November 12, 1965*, 152 USPQ 194 (Comm'r 1966).

311 Scope of Opposition and Petition to Cancel

15 U.S.C. 1068 In such proceedings the Commissioner 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 hereunder may be established in the proceedings....

37 CFR §2.111(b) Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel 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 Trademark Trial and Appeal Board will allow the party time in which to file a request that the application or registration be amended to conform to the findings of the Trademark Trial and Appeal 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.

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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.

The Board is an administrative tribunal which 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. Thus, a plaintiff in a proceeding before the Board can attack only the defendant's right to register.

In an opposition, the registration sought by an applicant may be opposed in whole, or in part. In the latter case, the opposer may oppose registration only, for example, as to some of the goods or services listed in the application, or only in the absence of a particular restriction (described in sufficient detail to give the applicant fair notice thereof) to the goods or services. *See* Section 18 of the Act, 15 U.S.C. §1068; 37 CFR §2.133(b); *Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, Spezialfabrik Fur Reitbekleidung*, 34 USPQ2d 1266 (TTAB 1994), and *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040 (TTAB 1985). *Cf.* 37 CFR §2.111(b).

Similarly, a petitioner may seek to cancel a registration in whole, or in part. In the latter case, the petitioner may seek to cancel the registration only, for example, as to some of the goods or services listed therein, 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). *See* Section 18 of the Act, 15 U.S.C. §1068; 37 CFR §§2.111(b) and 2.133(b); and *Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, Spezialfabrik Fur Reitbekleidung*, 34 USPQ2d 1266 (TTAB 1994).

However, geographic limitations will be considered and determined by the Board only within the context of a concurrent use registration proceeding. *See* 37 CFR §§2.99(h) and 2.133(c), and *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815 (TTAB 1990).

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; any claim which is not pleaded in the complaint, as originally filed or as amended (or deemed amended) pursuant to FRCP 15(a) or 15(b), will not be entertained by the Board. *See Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, Spezialfabrik Fur Reitbekleidung*, 34 USPQ2d 1266

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(TTAB 1994), and *Reflange v. R-Con International*, 17 USPQ2d 1125 (TTAB 1990). See also TBMP §§312.03, 321, and 507.

312 Form of Opposition and Petition to Cancel

312.01 In General

37 CFR §2.101(b) *Any entity which believes that it would be damaged by the registration of a mark on the Principal Register may oppose the same by filing an opposition, which should be addressed to the Trademark Trial and Appeal Board. The opposition need not be verified, and may be signed by the opposer or the opposer's attorney or other authorized representative.*

37 CFR §2.111(b) *Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. The petition need not be verified, and may be signed by the petitioner or the petitioner's*

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.*

The notice of opposition, or petition to cancel, corresponds to the complaint in a court proceeding. See 37 CFR §2.116(c). For purposes of simplicity, the term "complaint" is often used hereafter to refer to a notice of opposition or a petition to cancel.

The complaint 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 or registration which is the subject of the complaint, the name of the proceeding (i.e., "ABC Corporation v. XYZ Company"), the wording "Opposition No. _____" or

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"Cancellation No. _____" (the Board will insert, in the blank space, the number assigned to the proceeding), and a title describing the nature of the paper (i.e., "Notice of Opposition" or "Petition to Cancel"). 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; a pleading of the substance (i.e., standing and grounds) of the complaint; a signature; and a description of the capacity in which the signing individual signs.

In addition, a petition to cancel should indicate, to the best of petitioner's knowledge, the name and address of the current owner of the registration. *See* 37 CFR §2.112(a). Petitioner may comply with this requirement simply by furnishing the Board with whatever information it has concerning the name and address of the current owner of the registration; a special investigation made solely for purposes of complying with the rule is not necessary. The purpose of the requirement is to provide the Board with whatever information petitioner may have concerning the name and address of the current owner of the registration, so that the Board can notify that party of the filing of the petition. *Cf.* TBMP §§315.01 and 315.02. If petitioner has no information concerning the name and address of the current owner of the registration, petitioner may simply use the name and address of registrant stated on the registration certificate.

The complaint need not be verified, and it may be signed by the plaintiff or by the plaintiff's attorney or other authorized representative. *See* 37 CFR §§2.101(b) and 2.111(b), and TBMP §106.02. 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 PTO within the time limit set in the Board's letter notifying plaintiff of this defect. *See* 37 CFR §2.119(e) and TBMP §106.02. However, Section 14 of the Act, 15 U.S.C. §1064, limits, after a specified five-year period, the grounds upon which certain Principal Register registrations may be cancelled. *See* Section 14 of the Act; 37 CFR §2.111(b); and

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TBMP §308.02(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. *Cf. Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518 (CCPA 1966); *Texas Instruments Inc. v. Conklin Instrument Corp.*, 161 USPQ 740 (TTAB 1969); TBMP section 310.04; and Saul Lefkowitz and Janet E. Rice, *Adversary Proceedings Before the Trademark Trial and Appeal Board*, 75 Trademark Rep. 323, 329 (1985). Although 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. *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984); *In re L.R. Sport Inc.*, 25 USPQ2d 1533 (Comm'r 1992); and *In re Application Papers Filed November 12, 1965*, 152 USPQ 194 (Comm'r 1966).

The complaint, and any exhibits thereto, must be filed in duplicate. *See* 37 CFR §§2.104(a) and 2.112(a). The complaint need not be served by the plaintiff upon the defendant. . Rather, the duplicate copy of the complaint, and any exhibits thereto, will be forwarded to the defendant by the Board itself. *See* 37 CFR §§2.105, 2.113, and 2.119(a).

While a complaint must be filed "in duplicate," there is no requirement that one of the duplicates filed be the original. The duplicates may consist either of the original and one copy, or of two copies. However, all copies must be legible, and on good quality paper. *See* TBMP §106.03.

The Board prefers that complaints be submitted in typewritten or printed form, double spaced. A complaint may be submitted on either legal or letter-size paper. However, letter-size paper (the size preferred by many Federal district courts) is recommended. *See* TBMP §106.03.

312.02 Suggested Formats for Complaints

The PTO has no printed form for use in filing a notice of opposition or petition for cancellation. However, as an aid to litigants, the PTO has prepared suggested

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formats for these complaints. A complaint need not follow the suggested format, as long as it includes the necessary information.

312.02(a) Suggested Format for Notice of Opposition

The suggested format for a notice of opposition is shown below:

Format for Notice of Opposition

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark application Serial No.....
Filed.....
For the mark.....
Published in the Official Gazette on.....
(Date)

.....
(Name of opposer)
v.

.....
(Name of applicant)

Opposition No.
(To be inserted by Patent & Trademark Office)

NOTICE OF OPPOSITION
(State opposer's name, address, and entity information)(1)

.....
(Name of individual as opposer, and business trade name, if any)

.....
(Business address)

OR.....
(Name of partnership as opposer)

.....
(Names of partners)

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(Business address of partnership)
OR.....
(Name of corporation as opposer)
.....
(State or country of incorporation)
.....
(Business address of corporation)

The above-identified opposer believes that it/he/she will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.(2)

The grounds for opposition are as follows:(3)

By.....
(Signature)(4)
.....
(Identification of person signing)(5)

FOOTNOTES

- (1) If opposer is an individual, state the opposer's name, business trade name, if any, and business address. If opposer is a partnership, state the name of the partnership, the names of the partners, and the business address of the partnership. If opposer is a corporation, state the name of the corporation, the state (or country, if opposer is a foreign corporation) of incorporation, and the business address of the corporation. If opposer is an association or other similar type of juristic entity, state the information required for a corporation, changing the term "corporation" throughout to an appropriate designation.
- (2) The required fee must be submitted for each party joined as opposer for each class opposed, and if fewer than the total number of classes in the application are opposed, the classes opposed should be specified.
- (3) Set forth a short and plain statement here showing why the opposer believes it/he/she would be damaged by the registration of the opposed mark, and state the grounds for opposing.
- (4) The opposition need not be verified, and may be signed by the opposer or by the opposer's attorney or other authorized representative. If an opposer signing for itself is a partnership, the signature must be made by a partner; if an opposer signing for itself is a corporation or similar juristic entity, the signature must be

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made by an officer of the corporation or other juristic entity who has authority to sign for the entity and whose title is given.

(5) State the capacity in which the signing individual signs, e.g., attorney for opposer, opposer (if opposer is an individual), partner of opposer (if opposer is a partnership), officer of opposer identified by title (if opposer is a corporation), etc.

REPRESENTATION INFORMATION

If the opposer is not domiciled in the United States, and is not represented by an attorney or other authorized representative located in the United States, a domestic representative must be designated.

If the opposer wishes to furnish a power of attorney, it may do so, but an attorney at law is not required to furnish a power.

312.02(b) Suggested Format for Petition to Cancel

The suggested format for a petition to cancel is shown below:

Format for Petition to Cancel

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark Registration No.....
For the mark.....
Date registered.....

.....
(Name of petitioner)

v.

.....
(Name of registrant)

Cancellation No.
(To be inserted by Patent & Trademark Office)

PETITION TO CANCEL

(State petitioner's name, address, and entity information)(1)

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.....
(Name of individual as petitioner, and business trade name, if any)

.....
(Business address)

OR.....

(Name of partnership as petitioner)

.....
(Names of partners)

.....
(Business address of partnership)

OR.....

(Name of corporation as petitioner)

.....
(State or country of incorporation)

.....
(Business address of corporation)

To the best of petitioner's knowledge, the name and address of the current owner of the registration are.....

.....
The above-identified petitioner believes that it/he/she will be damaged by the above-identified registration, and hereby petitions to cancel the same.(2)

The grounds for cancellation are as follows:(3)

By.....

(Signature)(4)

.....
(Identification of person signing)(5)

FOOTNOTES

(1) If petitioner is an individual, state the petitioner's name, business trade name, if any, and business address. If petitioner is a partnership, state the name of the partnership, the names of the partners, and the business address of the partnership. If petitioner is a corporation, state the name of the corporation, the state (or country, if petitioner is a foreign corporation) of incorporation, and the business address of the corporation. If petitioner is an association or other similar type of juristic entity, state the information required for a corporation, changing the term "corporation" throughout to an appropriate designation.

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(2) The required fee must be submitted for each party joined as petitioner for each class sought to be cancelled, and if cancellation is sought for fewer than the total number of classes in the registration, the classes sought to be cancelled should be specified.

(3) Set forth a short and plain statement here showing why the petitioner believes it/he/she would be damaged by the registration, and state the grounds for cancellation.

(4) The petition need not be verified, and may be signed by the petitioner or by the petitioner's attorney or other authorized representative. If a petitioner signing for itself is a partnership, the signature must be made by a partner; if a petitioner signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the corporation or other juristic entity who has authority to sign for the entity and whose title is given.

(5) State the capacity in which the signing individual signs, e.g., attorney for petitioner, petitioner (if petitioner is an individual), partner of petitioner (if petitioner is a partnership), officer of petitioner identified by title (if petitioner is a corporation), etc.

REPRESENTATION INFORMATION

If the petitioner is not domiciled in the United States, and is not represented by an attorney or other authorized representative located in the United States, a domestic representative must be designated.

If the petitioner wishes to furnish a power of attorney, it may do so, but an attorney at law is not required to furnish a power.

312.03 Pleading Substance of Complaint

37 CFR §2.104(a) The opposition must set forth a short and plain statement showing why the opposer believes it would be damaged by the registration of the opposed mark and state the grounds for opposition. ...

37 CFR §2.112(a) The petition to cancel must set forth a short and plain statement showing why the petitioner believes 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. ...

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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 (2) a short and plain statement of one or more grounds for opposition. *See* 37 CFR §2.104(a); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752 (TTAB 1985); and *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154 (TTAB 1985). *Cf.* FRCP 8(a). The grounds upon which an application for registration of a mark may be opposed include (but are not limited to) all of the grounds listed in TBMP §§308.01 and 308.02(a) as grounds for cancellation. For a further discussion of the grounds for opposition, *see* J. Thomas McCarthy, *Trademarks and Unfair Competition*, §§20.03-20.07 (3rd ed. 1994).

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 (2) a short and plain statement of one or more grounds for cancellation. *See* 37 CFR §2.112(a); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990); *International Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992); and *American Vitamin Products Inc. v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992). *Cf.* FRCP 8(a). For a discussion of the grounds upon which the registration of a mark may be cancelled, *see* TBMP §§308.01 and 308.02(a). *See also* J. Thomas McCarthy, *Trademarks and Unfair Competition*, §§20.14-20.15 (3rd ed. 1994).

The elements of a claim should be stated simply, concisely, and directly. *See* FRCP 8(e)(1). However, the pleading should include enough detail to give the defendant fair notice of the basis for each claim. *See McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45 (TTAB 1985). *See also Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988), and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

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. *See* FRCP 10(b), and *Isle of Aloe, Inc. v. Aloe Creme Laboratories, Inc.*, 180 USPQ 794 (TTAB 1974). Each claim founded upon a

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separate transaction or occurrence should be stated in a separate count whenever a separation would facilitate the clear presentation of the matters pleaded. *See* FRCP 10(b). 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. *See* FRCP 10(b) and (c).

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 alternately or hypothetically, either in one count or in separate counts. *See* FRCP 8(e)(2); *PacTel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994); *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696 (TTAB 1987); *Home Juice Co. v. Runmlin Cos.*, 231 USPQ 897 (TTAB 1986); *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154 (TTAB 1975); *John T. Clark Co. v. Colgate-Palmolive Co.*, 176 USPQ 93 (TTAB 1972); *Rimmel, Ltd. v. Romel Cosmetics, Inc.*, 172 USPQ 186 (TTAB 1971); and *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48 (TTAB 1971).

A plaintiff may plead likelihood of confusion hypothetically by asserting, 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 plaintiff will be damaged by the registration of defendant's mark (i.e., has standing to maintain the proceeding--*see* TBMP §303.03). *See Revco, D.S., Inc. v. Armour-Dial, Inc., supra*. 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 Section 2(d) of the Act, 15 U.S.C. §1052(d)); etc. Thus, a plaintiff wishing to plead likelihood of confusion hypothetically in a proceeding based upon Section 2(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.

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. *See* FRCP 8(e)(2).

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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. *See McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16 (TTAB 1959).

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. *See 37 CFR §2.116(a); FRCP 8(f); and Scotch Whiskey Ass'n v. United States Distilled Products Co.*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

313 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 two copies of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. ...*

A plaintiff or defendant may attach exhibits to its pleading if it so desires. However, with one exception, 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. *See 37 CFR §2.122(c); Republic Steel Co. v. M.P.H. Manufacturing Corp.*, 312 F.2d 940, 136 USPQ 447 (CCPA 1963); *Home Juice Co. v. Runmlin Companies Inc.*, 231 USPQ 897 (TTAB 1986); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154 (TTAB 1985); *Syosset Laboratories, Inc. v. TI Pharmaceuticals*, 216 USPQ 330 (TTAB 1982); *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978); *A-1-A Corp. v. The Gillette Co.*, 199 USPQ 118 (TTAB 1978); and *Permatex Co. v. California Tube Products, Inc.*, 175 USPQ 764 (TTAB 1972).

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The one exception to the foregoing rule is a current status and title copy, prepared by the Patent and Trademark Office, of a plaintiff's pleaded registration. When a plaintiff submits such a status and title copy 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. *See* 37 CFR §§2.122(c) and 2.122(d)(1), and TBMP §703.02(a).

314 FRCP 11 Applicable

Rule 11 of the Federal Rules of Civil Procedure provides, in part, as follows:

(b) Representations to Court.

By presenting to the court (whether by signing, filing, submitting, or later advocating) a pleading, written motion, or other paper, an attorney or unrepresented party is certifying 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 or to 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 the extension, modification, or reversal of existing law or the establishment of new law;

(3) 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

(4) 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) Sanctions.

If, after notice and a reasonable opportunity to respond, the court determines that subdivision (b) has been violated, the

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court may, subject to the conditions stated below, impose an appropriate sanction upon the attorneys, law firms, or parties that have violated subdivision (b) or are responsible for the violation.

The quoted provisions are applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board. See TBMP §529.01, and authorities cited therein.

For information concerning the imposition of FRCP 11 sanctions by the Board, see TBMP §529.01.

315 Notification of Proceeding

315.01 In General

37 CFR §2.105 Notification of opposition proceeding[s].

When an opposition in proper form has been filed and the correct fee(s) have been submitted, a notification shall be prepared by the Trademark Trial and Appeal Board, 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. A copy of the notification shall be forwarded to the attorney or other authorized representative of the opposer, if any, or to the opposer. The duplicate copy of the opposition and exhibits shall be forwarded with a copy of the notification to the attorney or other authorized representative of the applicant, if any, or to the applicant.

37 CFR §2.113 Notification of cancellation proceeding.

When a petition for cancellation has been filed in proper form (see §§2.111 and 2.112), a notification shall be prepared by the Trademark Trial and Appeal Board, which shall identify the title and number of the proceeding and the registration or registrations 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. A copy of the notification shall be forwarded to the attorney or other authorized representative of the petitioner, if any, or to the petitioner. The duplicate copy of the petition for cancellation and exhibits shall be forwarded with a copy of the notification to the respondent (see §2.118), who shall be the party shown by the

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records of the Patent and Trademark Office to be the current owner of the registration or registrations 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 or registrations. When the party identified by the petitioner, pursuant to §2.112(a), as the current owner of the registration or registrations is not the record owner thereof, a courtesy copy of the petition for cancellation shall be forwarded with a copy of the notification to the alleged current owner, which may file a motion to be joined or substituted as respondent. If the petition is found to be defective as to form, the party filing the petition shall be so advised and allowed a reasonable time for correcting the informality.

When a timely opposition in proper form has been filed, and the required fee has been submitted, the Board obtains the file of the opposed application and sets up an opposition proceeding file (*see* TBMP §120.01). *See* 37 CFR §2.105. The defendant in the opposition is the party shown by the records of the PTO to be the current owner of the opposed application, 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 application. *See* TBMP §512. *Cf.* 37 CFR §2.113.

When a timely petition to cancel in proper form, together with the required fee, has been filed (*see* §§2.111(a) and 2.113), the Board obtains the file of the registration sought to be cancelled and checks the assignment records of the PTO 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 file is set up. *See* TBMP §120.01. The defendant in the cancellation proceeding is the party shown by the records of the PTO 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. *See* 37 CFR §2.113, and *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109 (TTAB 1976). *Cf.* TBMP §512.

Next, the Board prepares a letter wherein it, *inter alia*, notifies the defendant of the filing of the complaint, and notifies both parties of the formal institution of the proceeding. The notification letter includes the identification information described in 37 CFR §2.105, for an opposition, or in 37 CFR §2.113, for a cancellation; states that proceedings in the case will be conducted in accordance with the Trademark Rules of Practice; and specifies the due date for the filing of defendant's answer to the complaint.

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One copy of the notification letter is mailed to the attorney or other authorized representative of the plaintiff, or, if the plaintiff is representing itself, to the plaintiff itself. In an opposition, a second copy of the letter is mailed, together with a copy of the notice of opposition and any exhibits thereto, to the attorney or other authorized representative of the applicant, or, if the applicant is representing itself, to the applicant itself. *See* 37 CFR §2.105, and *Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237 (TTAB 1993). In a cancellation, a second copy of the notification letter is mailed, together with a copy of the petition to cancel and any exhibits thereto, to the respondent itself (even if there is an attorney or other authorized representative of record in the registration). *See* 37 CFR §2.113.

The reason why the complaint and notification letter are sent to the defendant's attorney or other authorized representative, if any, in an opposition, but are 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 a registration file 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 has not taken any action on behalf of the registrant for some years, no longer represents registrant, does not know where registrant is currently located, is no longer in practice, etc. However, if the Board is unable to locate the registrant for purposes of serving a copy of the complaint and notification letter upon it, and there is of record in the registration an attorney or other authorized representative who 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. *See* the notice of final rulemaking published in the *Federal Register* on August 22, 1989 at 54 FR 34886, 34891, and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26, 30.

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

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is not the record owner thereof, the Board will send a courtesy copy of the notification letter, together with a copy of the petition to cancel and any exhibits thereto, to the alleged current owner. 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. *See* 37 CFR §2.113 and TBMP §512.

315.02 Defendant's Copy of Complaint Returned as Undeliverable

If the applicant in an opposition is not represented by an attorney or other authorized representative, and the applicant's copies of the notice of opposition and notification letter are returned to the Board as undeliverable, the Board will make all reasonable efforts to locate the applicant. However, it is the responsibility of an applicant representing itself to keep the PTO informed of its current address. If the applicant fails to do so, and the Board is unable to locate the applicant, the Board will continue to send correspondence relating to the opposition to applicant's last-known address, and when applicant fails to file an answer to the notice of opposition, the opposition may be decided as in case of default.

If, in a cancellation proceeding, the respondent's copies of the petition to cancel and notification letter are returned to the Board as undeliverable, the Board will send a letter to the petitioner asking the petitioner for information concerning respondent's current address. If the petitioner files a response indicating that the respondent is no longer in business, notice of the filing of the petition to cancel will be published in the *Official Gazette*, pursuant to 37 CFR §2.118. If the petitioner fails to file a response to the Board's letter, or files a response indicating that it is unable to furnish respondent's current address, the Board will make all reasonable efforts to locate the respondent. *See* the notice of final rulemaking published in the *Federal Register* on August 22, 1989 at 54 FR 34886, 34891, and in the *Official Gazette* of September 12, 1989 at 1106 TMOG 26, 30. If the Board is unable to locate the respondent after reasonable investigation, notice of the filing of the petition to cancel will be published in the *Official Gazette*. *See* 37 CFR §2.118.

When notice of the filing of a petition to cancel is published in the *Official Gazette*, the published notice allows the respondent thirty days from the

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publication date thereof in which to appear in the cancellation proceeding. If respondent fails to appear within the time allowed, default judgement may be entered against respondent.

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 §1105.

316 Time for Filing Answer

316.01 In General

Rules 2.105 and 2.113, 37 CFR §§2.105 and 2.113, provide, in part, that the Board's letter notifying a defendant 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 letter setting the time for filing an answer. *See Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237 (TTAB 1993). 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 letter in which to file its answer.

When a timely counterclaim for cancellation is filed, the time for filing an answer thereto is designated in a letter prepared by the Board. Rules 2.106(b)(2)(iii) and 2.114(b)(2)(iii), 37 CFR §§2.106(b)(2)(iii) and 2.114(b)(2)(iii), provide, in part, that the time allowed will be "not less than thirty days." It is the general practice of the Board to allow the counterclaim defendant 30 days from the mailing date of the Board's letter in which to file an answer to the counterclaim.

316.02 Rule 2.119(c) 5-Day Addition Not Applicable to Deadlines Set by Board

Rule 2.119(c), 37 CFR §2.119(c), provides, in part, that "[w]hen 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,

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"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 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 which must be taken by a party within a time set in a communication from the Board.

Thus, when a Board letter notifying a defendant of the filing of an opposition or petition to cancel allows the defendant 40 days from the mailing date of the notification letter 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 letter in which to file an answer to the counterclaim, the answer is due on or before the 30th day, not on the 35th day.

316.03 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 upon motion granted by the Board, or by order of the Board. *See* FRCP 6(b), and TBMP §509.

317 Default

317.01 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 no answer has been filed; enters notice of default under FRCP 55(a); and allows the defendant 20 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

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response to the notice, or files a response which does not show good cause, default judgment may be entered against it. *See* 37 CFR §§2.106(a) and 2.114(a); FRCP 55(a), 55(b) and 55(c); *Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899 (Comm'r 1990); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613 (TTAB 1991); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Identicon Corp. v. Williams*, 195 USPQ 447 (Comm'r 1977). *Cf.* TBMP §508.

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. 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 FRCP 55(c) standard, that is, whether the defendant has shown good cause why default judgment should not be entered against it. *See Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899 (Comm'r 1990), and *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556 (TTAB 1991).

When a defendant which 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 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 the copies of the complaint and 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.

317.02 Setting Aside Notice of Default

If a defendant which 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. *See* FRCP 55(c). 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.

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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.

The determination of whether default judgment should be entered against a party lies within the sound discretion of the Board. 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.

See Paolo's Associates Limited Partnership v. Paolo Bodo, 21 USPQ2d 1899 (Comm'r 1990); *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556 (TTAB 1991); *Thrifty Corp. v. Bomax Enterprises*, 228 USPQ 62 (TTAB 1985); *Amaturo Group, Inc. v. Greater Media, Inc.*, 201 USPQ 617 (Comm'r 1978); and *Identicon Corp. v. Williams*, 195 USPQ 447 (Comm'r 1977). *See also Grinnell Corp. v. Grinnell Concrete Pavingstones Inc.*, 14 USPQ2d 2065 (TTAB 1990). *Cf. Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); *Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341 (TTAB 1984); *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 216 USPQ 617 (TTAB 1982); and *Regent Baby Products Corp. v. Dundee Mills, Inc.*, 199 USPQ 571 (TTAB 1978).

317.03 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 upon a showing of good cause. *See* FRCP 55(c). However, once default judgment has actually been entered against a defendant pursuant to FRCP 55(b), the judgment may be set aside only in accordance with FRCP 60(b), which governs motions for relief from final judgment. *See* FRCP 55(c), and 6 *Moore's Federal Practice*, §55.10 (2d ed.

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1985). *See also* *Waiferson Ltd. Inc. v. Classic Music Vending*, 976 F.2d 290, 24 USPQ2d 1632 (6th Cir. 1992). For information concerning motions under FRCP 60(b) for relief from final judgment, *see* TBMP §545.

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 FRCP 55. Compare, for example, *Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899 (Comm'r 1990), and *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556 (TTAB 1991) (both of which involved the question whether default judgment should be entered against defendant), with *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 the question whether defendant should be granted relief from a default judgment). *See also* Wright, Miller & Kane, *Federal Practice and Procedure: Civil 2d* §2692 (1983), at pages 470-471, and *Waiferson Ltd. Inc. v. Classic Music Vending*, 976 F.2d 290, 24 USPQ2d 1632 (6th Cir. 1992).

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. *See* Wright, Miller & Kane, *Federal Practice and Procedure: Civil 2d* §2692 (1983), at pages 471-472, and *Waiferson Ltd. Inc. v. Classic Music Vending*, 976 F.2d 290, 24 USPQ2d 1632 (6th Cir. 1992).

Nevertheless, because default judgments for failure to timely answer the complaint are not favored by the law, a motion under FRCP 55(c) and 60(b) seeking relief from such a judgment is generally treated with more liberality by the Board than are other motions under FRCP 60(b) for relief from other types of judgments. Compare, for example, *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613 (TTAB 1991), and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) with *Syosset Laboratories, Inc. v. TI Pharmaceuticals*, 216 USPQ 330 (TTAB 1982); *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735 (TTAB 1976); and *Williams v. Five Platters, Inc.*, 181 USPQ 409 (TTAB 1974), *aff'd*, 510 F.2d 963, 184 USPQ 744 (CCPA 1975). *See also* Wright, Miller & Kane, *Federal Practice and Procedure: Civil 2d* §2693 (1983), at pages 480-485.

318 Form of Answer

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318.01 In General

An answer to a notice of opposition or petition to cancel corresponds to an answer to a complaint in a court proceeding. *See* 37 CFR §2.116(c).

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 (e.g., "ABC Corporation v. XYZ Company") of the proceeding, the proceeding number (e.g., "Opposition No. 56,789" or Cancellation No. 12,345"), and a title describing the nature of the paper (e.g., "ANSWER," "ANSWER AND COUNTERCLAIM," etc.).

An answer need not be verified, but it must be signed. The signature may be made by the defendant or by the defendant's attorney or other authorized representative. *See* 37 CFR §2.119(e), and TBMP §106.02. If a defendant signing for itself is an individual, the signature must be made by the individual. If a defendant signing for itself is a partnership, the signature must be made by a partner. If a defendant signing for itself is a corporation or association, 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 PTO within the time limit set in the Board's letter notifying the defendant of this defect. *See* 37 CFR §2.119(e), and TBMP §106.02.

The Board prefers that answers be submitted in typewritten or printed form, double spaced. An answer may be submitted on either legal or letter-sized paper. However, letter-size paper (the size preferred by many Federal district courts) is recommended. *See* TBMP §106.03.

One copy of the answer, and any exhibits thereto, must be filed in the PTO. Another copy of the answer, with any exhibits thereto, should be served by the defendant upon the plaintiff, and the answer should 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

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service was made) that such service has been made. See 37 CFR §2.119(a), and TBMP §113.

318.02 Pleading 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.*

(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*

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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 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.*

318.02(a) Admissions and Denials

In its answer, a defendant should admit or deny each of the allegations contained in the complaint. If the defendant is without knowledge or information sufficient to form a belief as to the truth of an allegation, it should so state, and this statement will have the effect of a denial. *See 37 CFR §§2.106(b)(1) and*

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2.114(b)(1); FRCP 8(b); *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); and *Thrifty Corp. v. Bomax Enterprises*, 228 USPQ 62 (TTAB 1985).

A denial of an allegation should fairly meet the substance of the allegation denied, and may take any of the forms described in FRCP 8(b). *See* 37 CFR §§2.106(b)(1) and 2.114(b)(1). 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, the defendant may do so by general denial, subject to the obligations set forth in FRCP 11 (for a discussion of FRCP 11 in relation to pleadings, *see* TBMP §314). 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.

In the absence of a general denial of some or all of the allegations in a complaint, admissions or denials should be made in numbered paragraphs corresponding to the numbered paragraphs in the complaint.

If any allegation in a complaint is not denied in the defendant's answer thereto, the allegation may be deemed admitted. *See* FRCP 8(d).

318.02(b) Defenses

An answer should include a short and plain statement of any defenses which the defendant may have to the claim or claims asserted by the plaintiff. *See* 37 CFR §§2.106(b)(1) and 2.114(b)(1), and FRCP 8(b). These defenses may include unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. *See* 37 CFR §§2.106(b)(1) and 2.114(b)(1). They 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); except that geographic restrictions will be considered and determined by the Board only in the context of a concurrent use registration proceeding. *Cf.* 37 CFR §§2.133(b) and 2.133(c); *Brunswick Corp. v. British Seagull Ltd.*, F.2d ,

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32 USPQ2d 1120 (Fed. Cir. 1994); *Personnel Data Systems Inc. v. Parameter Driven Software Inc.*, 20 USPQ2d 1863 (TTAB 1991); and *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970 (TTAB 1991). See also *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815 (TTAB 1990). Cf. TBMP §514. When one of the special matters listed in FRCP 9 (including, inter alia, capacity, fraud, and judgment) is pleaded, the provisions of FRCP 9 governing the pleading of that special matter should be followed. See 37 CFR §§2.106(b)(1) and 2.114(b)(1).

A defense which attacks the validity of a registration pleaded by a plaintiff will not be entertained unless the defendant timely files a counterclaim or a separate petition to cancel the registration. See 37 CFR §§2.106(b) and 2.114(b); *Food Specialty Co. v. Standard Products Co.*, 406 F.2d 1397, 161 USQP 46 (CCPA 1969); *Gillette Co. v. "42" Products Ltd., Inc.*, 396 F.2d 1001, 158 USPQ 101 (CCPA 1968); *Contour Chair-Lounge Co. v. Englander Co.*, 324 F.2d 186, 139 USPQ 285 (CCPA 1963); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986); *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). See also TBMP §319.

Although Rules 2.106(b)(2)(ii) and 2.114(b)(2)(ii), 37 CFR §§2.106(b)(2)(ii) and 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. See *Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989). 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.

A defendant's request 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. See 37 CFR §2.133(d). Geographic restrictions will be considered and determined by the Board only within the context of a concurrent use registration proceeding. See 37 CFR §§2.99(h) and 2.133(c). See also *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815 (TTAB 1990).

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

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unnecessary and redundant. *See Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); *Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822 (TTAB 1984); and *W. R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670 (Comm'r 1977).

The elements of a defense should be stated simply, concisely, and directly. *See* FRCP 8(e)(1). However, the pleading should include enough detail to give the plaintiff fair notice of the basis for the defense. *Cf. McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45 (TTAB 1985).

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. *See* FRCP 8(e)(2). *Cf. Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696 (TTAB 1987); *Home Juice Co. v. Runmlin Cos.*, 231 USPQ 897 (TTAB 1986); *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154 (TTAB 1975); *John T. Clark Co. v. Colgate-Palmolive Co.*, 176 USPQ 93 (TTAB 1972); *Rimmel, Ltd. v. Romel Cosmetics, Inc.*, 172 USPQ 186 (TTAB 1971); and *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48 (TTAB 1971).

For example, an applicant whose application for registration has been opposed under Section 2(d) of the Act, 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. *Cf. 37 CFR §2.133(b)*, 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. *See* FRCP 8(e)(2).

Evidentiary matters (such as, for example, lists of third-party registrations upon which defendant intends to rely) should not be pleaded in an answer. They are

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matters for proof, not for pleading. *See McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16 (TTAB 1959).

318.02(c) Other Affirmative Pleadings

An answer may include affirmative assertions which, 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. *See Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696 (TTAB 1987); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747 (TTAB 1986); *Textron, Inc. v. Gillette Co.*, 180 USPQ 152 (TTAB 1973); and *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16 (TTAB 1959). *Cf. Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988).

319 Counterclaims

319.01 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.

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(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 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.

An attack upon the validity of a registration pleaded by a plaintiff cannot be entertained by the Board unless the defendant timely files a counterclaim or a separate petition to cancel the registration. *See* 37 CFR §§2.106(b)(2)(ii) and 2.114(b)(2)(ii); *Food Specialty Co. v. Standard Products Co.*, 406 F.2d 1397, 161 USPQ 46 (CCPA 1969); *Gillette Co. v. "42" Products Ltd., Inc.*, 396 F.2d 1001, 158 USPQ 101 (CCPA 1968); *Contour Chair-Lounge Co. v. Englander Co.*, 324 F.2d 186, 139 USPQ 285 (CCPA 1963); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986); *Clorox Co. v. State Chemical Manufacturing*

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Co., 197 USPQ 840 (TTAB 1977); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Although Rules 2.106(b)(2)(ii) and 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. *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989). 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. Further, a defendant which 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. *See* TBMP §319.04, and cases cited therein.

The only type of counterclaim which may be entertained by the Board is a counterclaim for cancellation of a registration owned by an adverse party. *See Pyttronic Industries Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055 (TTAB 1990), and *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024 (TTAB 1983).

A counterclaim may seek to cancel a registration in whole, or in part. In the latter case, the counterclaimant may seek to cancel the registration only, for example, as to some of the goods or services listed therein, 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). *See* Section 18 of the Act, 15 U.S.C. §1068; 37 CFR §§2.111(b) and 2.133(b); and TBMP §311, and cases cited therein. However, geographic limitations will be considered and determined by the Board only within the context of a concurrent use registration proceeding. *See* 37 CFR §§2.99(h) and 2.133(c), and *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815 (TTAB 1990).

A counterclaim is the legal equivalent of a petition to cancel. Thus, the provisions of Rules 2.111 through 2.115, 37 CFR §§2.111 through 2.115, governing petitions to cancel, are applicable to counterclaims. *See* 37 CFR §§2.106(b)(2)(iii) and 2.114(b)(2)(iii).

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, testimony, briefs and/or oral argument will be reset or extended. A party which

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believes that such a resetting or extension is necessary should file a motion therefor with the Board. *See* 37 CFR §§2.106(b)(2)(iv) and 2.114(b)(2)(iv).

319.02 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.*

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. *See* 37 CFR §§2.106(b)(2)(iii) and 2.114(b)(2)(iii); *Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518 (CCPA 1966); *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742 (TTAB 1992), *summ. judgment granted, in part*, 26 USPQ2d 1926 (TTAB 1993); *Sunway Fruit Products, Inc. v. Productos Caseros, S. A.*, 130 USPQ 33 (Comm'r 1960); *Jet-Pak, Inc. v. United States Plywood Corp.*, 125 USPQ 491 (Comm'r 1960); *Jet-Pak, Inc. v. United States Plywood Corp.*, 124 USPQ 385 (TTAB 1960); and *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16 (TTAB 1959). That is, the required fee (*see* 37 CFR §2.6(l)) 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. *See* 37 CFR §§2.111(c) and 2.112(b). *Cf.* TBMP §310.

319.03 Form 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 §312). 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.

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Moreover, a plaintiff filing a separate petition to cancel must file the petition (and any exhibits thereto) in duplicate, and need not serve a copy thereof upon the defendant(s). *See* 37 CFR §§2.112(a) and 2.119(a), and TBMP §312.01. A counterclaimant, on the other hand, need file only one copy of its counterclaim (and any exhibits thereto) with the Board, but must serve a copy thereof (with any exhibits thereto) upon every other party to the proceeding, and must make proof of such service before the counterclaim will be considered by the Board. *See* 37 CFR §2.119(a).

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. *See Ariès Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926 (TTAB 1993); *Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 USPQ2d 1597 (TTAB 1990); *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879 (TTAB 1990); *Bankamerica Corp. v. Invest America*, 5 USPQ2d 1076 (TTAB 1987); *M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93 (TTAB 1984); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (TTAB 1981); and *General Mills, Inc. v. Nature's Way Products, Inc.*, 202 USPQ 840 (TTAB 1979). *Cf. Domino's Pizza Inc. v. Little Caesar Enterprises Inc.*, 7 USPQ2d 1359 (TTAB 1988), and *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857 (TTAB 1986).

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 which is not in the nature of a counterclaim. Section 14 of the Act, 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 upon 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 upon which a counterclaim may be based. *See Williamson-Dickie Manufacturing Co. v. Mann Overall Company*, 359 F.2d 450, 149 USPQ 518 (CCPA 1966); *Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048 (TTAB 1982); *UMC Industries, Inc. v. UMC Electronics Co.*, 207 USPQ 861 (TTAB 1980); *Humble Oil & Refining Co. v. Sekisui Chemical Company Ltd. of*

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Japan, 165 USPQ 597 (TTAB 1970); *Sunbeam Corp. v. Duro Metal Products Co.*, 106 USPQ 385 (Comm'r 1955); and TBMP §308.02(c)(1). *See also* J. Thomas McCarthy, *Trademarks and Unfair Competition*, §20:17[3] (3rd ed. 1994).

319.04 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.*

See Vitaline Corp. v. General Mills Inc., 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594 (TTAB 1992), *summ. judgment granted*, 24 USPQ2d 1376 (TTAB 1992); *See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ2d 1395 (TTAB 1989); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311 (TTAB 1989); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355 (TTAB 1989); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221 (TTAB 1987); *Consolidated Foods Corp. v. Big Red, Inc.*, 231 USPQ 744 (TTAB 1986); and *M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93 (TTAB 1984). *See also* FRCP 15(a); *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); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974); and Beth A. Chapman, *TIPS*

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FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991).

A defendant which 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, upon motion, on the ground that the substance of the petition constitutes a compulsory counterclaim in another proceeding, and that it was not timely asserted. See *Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989), and *Consolidated Foods Corp. v. Big Red, Inc.*, 231 USPQ 744 (TTAB 1986).

If a defendant confronted with a motion for summary judgment knows of grounds for a counterclaim which 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. See *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594 (TTAB 1992), *summ. judgment granted*, 24 USPQ2d 1376 (TTAB 1992).

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 upon 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 grounds for cancellation of a plaintiff's unpleaded registration are known to the defendant when the defendant files its answer, the defendant is under no compulsion to seek to cancel the registration unless and until the registration is pleaded by the plaintiff. See 37 CFR §§2.106(b)(2)(i) and 2.114(b)(2)(i), and *M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93 (TTAB 1984). See also Notice of Final Rulemaking published in the *Federal Register* of January 22, 1981 at 46 FR 6940.

319.05 Permissive Counterclaims

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A party may counterclaim to cancel a registration which 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. *See* FRCP 13(b). *Cf.* 37 CFR §§2.106(b)(2)(i) and 2.114(b)(2)(i).

319.06 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 the required cancellation fee) is filed, the Board prepares a letter acknowledging receipt thereof and allowing the plaintiff (defendant to the counterclaim) until a set time, not less than 30 days, in which to file an answer to the counterclaim. *See* 37 CFR §§2.106(b)(2)(iii) and 2.114(b)(2)(iii). In practice, the time allowed by the Board is usually 30 days. A copy of the letter is sent to each party to the proceeding, or to each party's attorney or other authorized representative.

If no answer to the counterclaim is filed during the time allowed therefor, the counterclaim may be decided as in case of default. *See* 37 CFR §§2.114(a) and 2.114(b)(2)(iii). For information concerning default, *see* TBMP §317.

An answer to a counterclaim should be in the same form as an answer to a complaint. For information concerning the proper form for an answer to a complaint, *see* TBMP §318.

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 in the counterclaim is a compulsory counterclaim if grounds for such counterclaim exist at the time when

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the plaintiff's answer to the defendant's counterclaim is filed. If grounds for a counterclaim are known to the plaintiff 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. *Cf.* 37 CFR §§2.106(b)(2)(i) and 2.114(b)(2)(i), and TBMP §319.04.

A plaintiff's counterclaim to cancel a registration owned by the defendant, but not pleaded in the defendant's counterclaim, is a permissive counterclaim. *Cf.* FRCP 13(b), and TBMP §319.05.

For information concerning the fee for a counterclaim, see 37 CFR §2.6(a)(16) and TBMP §310. For information concerning the form for a counterclaim, *see* TBMP §319.03.

320 Reply to Answer Should Not be Filed

Although Rules 2.106(b) and 2.114(b) require that an answer to a counterclaim be filed, within the time designated therefor by the Board, they specifically provide that a reply to an affirmative defense need not be filed. *See* 37 CFR §§2.106(b)(1) and (2)(iii), and 2.114(b)(1) and (2)(iii). Similarly, FRCP 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 "[n]o other pleading shall be 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.

321 Unpleaded Matters

An unpleaded claim cannot be relied upon by a plaintiff unless the plaintiff's pleading is amended (or deemed amended), pursuant to FRCP 15(a) or (b), to assert the matter. *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 (CCPA

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1978); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883 (TTAB 1993); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134 (TTAB 1992); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125 (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).

Similarly, except as provided in FRCP 12(b) and (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 FRCP 15(a) or 15(b), to assert the matter. *See* FRCP 8(b), 8(c), and 12(b); *Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991); *U.S. Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340 (TTAB 1984); *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).

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. *See* FRCP 15(a); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *Trans Union Corp. v. Trans Leasing International, Inc.*, 200 USPQ 748 (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 2.114(b)(2)(i).

A party may not obtain summary judgment on an unpleaded issue, nor may a party defend against a motion for summary judgment by asserting the existence of

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genuine issues of material fact as to an unpleaded claim or defense. However, a party which seeks to obtain, or to defend against, summary judgment on the basis of an unpleaded issue may move to amend its pleading to assert the issue. *See* TBMP §528.07, and cases cited therein.

322 Amendment of Pleadings

37 CFR §2.107 Amendment of pleadings in an opposition proceeding. Pleadings in an opposition proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court.

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.

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. *See* 37 CFR §§2.107 and 2.115. For further information concerning the amendment of pleadings, *see* FRCP 15, and TBMP §507. *See also* Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

323 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.

324 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 which is the subject of the opposition, *see* TBMP §219.