Chapter One

Inter Partes Matters
General Background and Prefiling Considerations

Erik M. Pelton

I. Strategic Considerations for TTAB-Contested Proceedings: A TTAB Proceeding versus a Court Action

A party considering whether to file a proceeding in the Trademark Trial and Appeal Board (the TTAB or Board) against an application or registration of a mark that is thought of as damaging has a number of factors to consider before commencing a proceeding. These proceedings can be powerful tools for brand owners to guard their brands and to keep the U.S. Patent and Trademark Office (USPTO) trademark register clear of potentially conflicting marks. Potential plaintiffs in trademark proceedings have a variety of decisions to make and procedures to consider regarding an action to protect their trademark(s).

A party that may be injured by a pending trademark application or registration might have, as an alternative to proceeding at the TTAB, the option to file an action in a federal district court against the use of the offending mark. In federal court, the complaint could include a request for relief in the form of an order requiring the defendant to abandon a pending

Chapter 1, for the first and second editions of this book, originally was authored by David J. Kera, formerly of Oblon, McClelland, Maier & Neustadt, LLP (now retired). His contributions to the earlier editions of this book are gratefully acknowledged.
application or an order cancelling an issued registration pursuant to the Trademark Act.¹

TTAB proceedings share many procedures and potential claims with trademark disputes in district court, but are before a body of administrative judges from the USPTO. The Supreme Court, in a 2015 trademark decision, B&B Hardware, Inc. v. Hargis Industries, Inc., noted that TTAB and district court proceedings have many similarities:

Opposition proceedings before the TTAB are in many ways “similar to a civil action in a federal district court.” These proceedings, for instance, are largely governed by the Federal Rules of Civil Procedure and Evidence.²

As discussed below, district court and TTAB proceedings may both involve disputes regarding a likelihood of confusion or other trademark issues, but there are significant procedural differences between the two types of proceedings, and the stakes may be quite different as well. While in many instances the plaintiff in a trademark proceeding may have a choice between bringing action in a district court or the TTAB, there are circumstances in which a district court action is inappropriate. If the offending mark is the subject of a pending application filed (1) on the basis of a bona fide intention to use the mark under Trademark Act § 1(b), 15 U.S.C. § 1051(b); (2) on the basis of a foreign application or registration under Trademark Act § 44(d) or (e), 15 U.S.C. § 1126(d) or (e); or (3) as a request for the extension of protection of a Madrid Protocol international registration to the United States under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), the applicant might not be using the mark in commerce in the United States. Under such circumstances, the plaintiff’s only option would be a proceeding before the TTAB.

A. Advantages of a TTAB Proceeding

Assuming that the offending mark is in use in the United States so that there would be a choice between litigation in a district court and a proceeding before the Trademark Trial and Appeal Board, the potential advantages of a proceeding before the TTAB include

- A TTAB proceeding is usually far less expensive than litigation in a district court, with more predictable expenses.
- A TTAB proceeding may require less time and effort by the parties compared to a district court action, particularly if the parties agree to use the new Accelerated Case Resolution procedure at the TTAB,

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which is discussed in chapter 9. On the other hand, some federal district courts have “rocket docket” procedures in which cases may be concluded in less than a year from filing to disposition.

- It is easier for a plaintiff to dismiss a TTAB proceeding than to dismiss a district court litigation because there are no monetary consequences to the dismissal—whether it is without the defendant’s consent and therefore with prejudice, or with the defendant’s consent and therefore without prejudice.
- Proceedings before the TTAB are decided by a panel of three Administrative Judges who are very experienced in the field of trademarks; there are no juries at the TTAB.
- TTAB decisions may be appealed to the Court of Appeals for the Federal Circuit (CAFC), or to a district court for a de novo review.
- The Supreme Court in 2015 held that a decision by the TTAB may be preclusive in later district court litigation, so long as other elements of issue preclusion are met and the “usages adjudicated by the TTAB are materially the same as those before the district court.” For example, the TTAB’s finding of a likelihood of confusion that includes consideration of how the marks are used in the marketplace could be preclusive in a later action for infringement in district court.

B. Advantages of a District Court Action

Reasons for proceeding initially with district court litigation, assuming that the court would have subject-matter jurisdiction and jurisdiction over the defendant, include the following:

- Relief before the Trademark Trial and Appeal Board is limited to a refusal of registration in an opposition proceeding or cancellation of a registration in a cancellation action. If a plaintiff wishes to stop the registration of a defendant’s mark and also seek an injunction against the use of that mark, it is possible to file an opposition at the Trademark Trial and Appeal Board and a complaint in federal district court, and request suspension of the TTAB proceeding pending the disposition of the federal litigation. If a proceeding before the Board involves issues in common with the issues in a civil action in a federal district court, the decision of the district court on those issues is almost always followed by the TTAB.¹

³. Id., 575 U.S. at ___
⁴. See Trademark Trial and Appeal Board Manual of Procedure § 510.02(a) (2014) [hereinafter TBMP].
• The district court has the power to order injunctive and financial relief, whereas the TTAB will not order the payment of any costs or expenses for litigation or as a sanction for the violation of any rule.
• A jury may be available in a district court action if monetary remedies are sought. TTAB proceedings are decided at final hearing by a panel of three administrative trademark judges. No jury is available.
• A district court proceeding may include live witnesses and testimony, while TTAB proceedings are conducted entirely on paper with all evidence submitted in document form to the administrative judges.
• The only counterclaims possible in a TTAB proceeding are for the cancellation or restriction\(^5\) of one or more of the plaintiff’s registrations, particularly pleaded registrations. In a district court proceeding, a counterclaim could be much more extensive and could be lodged not only against the plaintiff but also against other parties who could be pulled unwillingly into the litigation.
• The TTAB will not order the payment of any costs or expenses for litigation or as a sanction for the violation of any rule.
• It is not unusual in district court litigation to have the district judge refer the matter to a magistrate judge or a court-annexed mediator to resolve the conflict at an early stage. Before the TTAB, the parties may request that an interlocutory attorney or administrative trademark judge be involved in the initial discovery/settlement conference. However, the Board does not generally involve itself in the parties’ settlement discussions.
• In the federal district court system, the governing precedents are decisions from the court of appeals in which the district court is located and the district court itself. A district court may rely on decisions from courts of appeals and district courts of other circuits. Of course, at both the TTAB and federal district courts, decisions of the United States Supreme Court are controlling.

II. Statutory and Regulatory Authority

A. History, Establishment, and Organization of the TTAB
The federal statute that governs proceedings before the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office is the

Trademark Act, as amended, which was approved by the president on July 5, 1946, and went into effect on July 5, 1947. The act is codified as 15 U.S.C. §§ 1051 et seq. Before creation of the TTAB in 1958, the powers now exercised by the Board were exercised by the Assistant Commissioner for Trademarks (the current title of that position is Commissioner for Trademarks).

B. Board Members and Staff
The personnel constituting the Board includes the director and the deputy director of the U.S. Patent and Trademark Office, the commissioner for trademarks, the commissioner for patents, and administrative trademark judges, who are appointed by the secretary of commerce in consultation with the director. At the present time, there is a chief administrative trademark judge, a deputy chief judge, and 23 administrative trademark judges. There are also more than a dozen interlocutory attorneys, whose duties include ruling on nondispositive motions and drafting, for ultimate decision by panels of three administrative trademark judges, decisions denying or granting motions for summary judgment and other dispositive motions. The Board’s personnel roster also includes paralegals and other support staff, whose duties are to conduct the routine administrative work of the Board.

C. Statutory Authority for Board Proceedings

Statutory provisions pertaining to inter partes proceedings are in diverse sections of the Trademark Act pertaining to procedural matters and substantive issues. The authority to take specific action with respect to an application or registration is provided in Trademark Act § 18, 15 U.S.C. § 1068, which states that in proceedings the director may (1) refuse to register the opposed mark; (2) cancel a registration in whole or part; (3) modify an application or registration by limiting the goods or services; (4) otherwise restrict or rectify the registration of a registered mark; (5) refuse to register any or all of several interfering marks; or (6) register the mark or marks for the person or persons entitled thereto. The powers granted to the director are exercised by the Board.

The filing of oppositions and the obtaining of extensions of time to file oppositions are the subjects of Trademark Act § 13, 15 U.S.C. § 1063. Petitions to cancel registrations are the subject of Trademark Act § 14, 15 U.S.C. § 1064, which contains the five-year statute of limitations for
petitioning to cancel on specified grounds registrations issued on the Principal Register under the Act of 1946 and for marks that were issued under the Acts of 1881 or 1905 and have been republished pursuant to the Act of 1946. The exceptions are specified in Trademark Act § 14(3), 15 U.S.C. § 1064(3). These exceptions include genericness, functionality, abandonment, fraud, and registrations obtained contrary to the provisions of Trademark Act § 4, 15 U.S.C. § 1054, or Trademark Act § 2(a), (b), or (c), 15 U.S.C. § 1052(a), (b), or (c).

The five-year statute of limitations in Trademark Act § 14, 15 U.S.C. § 1064, is independent of the benefits of incontestability provided by Trademark Act § 15, 15 U.S.C. § 1065. The five-year statute of limitations operates automatically without any action by the registrant. The benefits of incontestability may be obtained only by the filing of a declaration after the fifth anniversary date of a registration and after the mark has been registered and used substantially, exclusively, and continuously for five consecutive years. However, note that the five-year statute of limitations is tolled for a counterclaimant when the opposer’s mark reaches its five-year status during the course of an opposition.

Another pertinent section of the statute is Trademark Act § 18, 15 U.S.C. § 1068, which gives the TTAB authority to restrict, by partial cancellation, goods or services when an applicant for registration of a mark files a petition for partial cancellation on the ground that the deletion of certain goods or services from a cited registration would obviate the likelihood of confusion between the mark of the cited registration and the mark of the application. There is no other statutory provision that deals with that situation.


The final sentence of Trademark Act § 18, 15 U.S.C. § 1068, states that no final judgment shall be entered in favor of an applicant under Trademark Act § 1(b), 15 U.S.C. § 1051(b), before the mark is registered if that applicant cannot prevail without establishing constructive use pursuant to Trademark Act § 7(c), 15 U.S.C. § 1057(c).

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6. The benefits of incontestability are of importance in civil actions for infringement but have no applicability in proceedings before the Board.

II. Statutory and Regulatory Authority

2. Substantive Grounds
Substantive grounds for oppositions and cancellation proceedings, other than dilution, are set forth in Trademark Act § 2, 15 U.S.C. § 1052. Subsections (a) through (e) of § 1052 specify the grounds upon which a trademark application may be refused in both ex parte prosecution and inter partes proceedings, and subsection (f) allows the registration of marks on the basis of proof of acquired distinctiveness and also prohibits the refusal in ex parte examination of an application on the ground that a mark is likely to cause dilution.

The substantive grounds for opposing an application or for petitioning to cancel a registration on the ground of dilution are contained in Trademark Act § 43(c), 15 U.S.C. § 1125(c). Cross-references to section 43(c) are in Trademark Act § 13(a), 15 U.S.C. § 1063(a), and Trademark Act § 14, 15 U.S.C. § 1064. Case law has established that an application may be opposed or a petition for cancellation filed on the ground that the application is void ab initio or that the targeted registration issued from an application that was void ab initio, or on the ground that the matter claimed to be a mark does not function as a mark and therefore does not fulfill the requirement of Trademark Act § 1, 15 U.S.C. § 1051; Trademark Act § 2, 15 U.S.C. § 1052; and Trademark Act § 45, 15 U.S.C. § 1127.

D. Governing Rules of Procedure
The regulations (Trademark Rules) for inter partes proceedings at the Trademark Trial and Appeal Board are contained in Title 37 of the Code of Federal Regulations, specifically in Part 2 of Title 37. The Board has published detailed guides to its practice in the Trademark Trial and Appeal Board Manual of Procedure (TBMP), which is generally updated annually by the Board to include recent case law. Both searchable and PDF versions of the TBMP can be found on the Board’s website.


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9. Cases are cited at Trademark Manual of Examining Procedure §§ 1202.03, 1301.01 (Jan. 2015).
§§ 2.91 to 2.98. Interferences will not be declared except upon petition to the director, and those petitions will be granted only upon a showing of extraordinary circumstances that would result in a party’s being unduly prejudiced without an interference. In ordinary circumstances, the availability of an opposition or cancellation proceeding will be deemed to remove any undue prejudice. Several decades have elapsed since the last interference was declared.

Applications that have been filed internationally under the Madrid Protocol are the subject of additional rules. Trademark Act §§ 60–74, 15 U.S.C. §§ 1141–1141n, implement the Madrid Protocol for the international registration of marks. Special attention should be paid to the regulations dealing specifically with extensions of time to oppose requests for the protection of Madrid Protocol international registrations and with oppositions against requests for the protection of Madrid Protocol international registrations in the USPTO.

Requests to extend the time for filing an opposition to an application filed under Trademark Act § 66(a), as well as oppositions to such applications, must be filed through the Electronic System for Trademark Trials and Appeals (ESTTA), which is the online electronic communication system between parties or their attorneys and the TTAB. Note that the Trademark Rules do not require that ESTTA be used for the filing of a petition for cancellation of a registration obtained through the Madrid Protocol.

Notably, Trademark Rule 2.107(b), 37 C.F.R. § 2.107(b), states that in an opposition filed against an application proceeding under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), an opposition may not be amended to add to the grounds for opposition or to add to the goods or services subject to the opposition. These restrictions do not apply to cancellation proceedings involving U.S. registrations received under the Madrid Protocol.

Trademark Rules 2.116 to 2.136, 37 C.F.R. §§ 2.116 to 2.136, apply to contested proceedings of all types, including (1) the incorporation, as appropriate, of the Federal Rules of Civil Procedure; (2) service and discovery, including discovery conferences and pretrial disclosures; (3) testimony periods; (4) matters in evidence, including notices of reliance; (5) trial testimony; (6) depositions on written questions; (7) filing and service of testimony; (8) form of submissions to the Board; (9) oral argument and reconsideration; (10) involuntary dismissal for failure to take testimony; (11) amendment of application or registration during proceedings; (12) surrender or voluntary cancellation of registrations and abandonment of application or mark; and (13) status of application upon termination of proceedings. Appealing to the CAFC or via a civil action for
III. Types of Inter Partes Proceedings before the Trademark Trial and Appeal Board

There are four types of proceedings before the Trademark Trial and Appeal Board: oppositions, cancellations, concurrent use proceedings, and interferences.

A. Opposition

An opposition is a proceeding in which the party seeks to prevent the registration of a pending trademark application. An application can be opposed within 30 days (or within a proper extension period) of its publication by the USPTO in the Official Gazette of Trademarks. For more on extensions of time to oppose, see section V on page 16. The most common grounds for opposition are likelihood of confusion with an earlier used trademark, dilution, descriptiveness, genericness, functionality, false suggestion of a connection, lack of a bona fide intent to use, and lack of use. Note that many other grounds exist as well. For more on grounds, see chapter 2, section II.C.

B. Cancellation

A cancellation proceeding is one in which a party is seeking to cancel an existing trademark registration that is owned by a defendant. The common grounds for cancellation are similar to those for opposition, with the addition of abandonment. Note that a registration that is more than five years old cannot be cancelled at the TTAB on grounds of likelihood of confusion. For more on grounds, see chapter 2, section II.C.

C. Concurrent Use Proceedings

Concurrent use proceedings are rare, but are permitted by Trademark Act § 2(d), 15 U.S.C. § 1052(d). Many, if not the majority of, concurrent use proceedings are ultimately settled by agreement between the parties.

delimiting their respective geographic territories. The only means of obtaining a registration in the USPTO for a territory that is less than the entire United States is a concurrent use proceeding.\footnote{15} 

The Board’s policy is that concurrent use proceedings are reserved for situations where proposed conditions and limitations for registration cannot be incorporated into the drawings of the involved marks or into the identifications of goods or services, and thus cannot be considered under the main clause of Trademark Act § 2(d), 15 U.S.C. § 1052(d). The only limitations that cannot be incorporated into the identification of goods or services of a registration are geographic ones.\footnote{16} 

The first portion of section 2(d) provides for the refusal of registration of a mark that so resembles the mark registered in the USPTO, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, to cause mistake, or to deceive.

The proviso states that if the director of the USPTO determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under the Trademark Act; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or the Act of February 20, 1905, and continuing in force and effect to the date of concurrent use application; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947.

Use prior to the filing date of any pending application or registration shall not be required when the owner of that application or registration consents to the grant of a concurrent registration. Concurrent registrations also may be issued when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce.

\textbf{D. Interferences}

The TTAB has not seen an interference proceeding in several decades. For more on procedures regarding interferences, see TBMP chapter 1000.


IV. Filing of Documents at the TTAB

A. Who May File Proceedings
Under the rules of the USPTO, the following individuals may represent parties before the Board:17

1. Any individual who is an attorney admitted in the United States may represent others before the USPTO in trademark cases.
2. A foreign attorney, not a resident of the United States, who is registered with or in good standing before the Patent or Trademark Office of the country in which the attorney resides and practices may be recognized for the limited purpose of representing parties located in that country before the USPTO, provided that the Patent or Trademark Office of the foreign country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the USPTO.
3. A company or association may be represented by any member or officer authorized to represent it, including in-house counsel. An individual may represent himself or herself pro se.

B. How to File Documents at the TTAB
Several methods exist for corresponding with the Board. By far, the means of transmission most favored by the Board is the Electronic System for Trademark Trials and Appeals (ESTTA).18

Filing through ESTTA requires converting one’s papers into JPG or PDF format, and submitting them through a series of ESTTA dialogue boxes. It is recommended that ESTTA be used for filing all oppositions, petitions for cancellation, and all other papers in the course of a contested proceeding. The ESTTA filing system can handle virtually all types of filings in all TTAB proceedings. Information on ESTTA, fees, new rules, and additional information is easily found on the USPTO’s TTAB webpage.19 The Board strongly encourages the use of the ESTTA system because documents filed electronically are routed directly into the electronic database in which the Board keeps all documents and obviates the necessity of the Board having to convert paper documents into the electronic format.

18. ESTTA is accessible through http://estta.uspto.gov.
Note that filings will generally not be accepted on CD-ROM, DVD, or flash drive, unless the correspondence includes video or other formats that cannot be submitted on paper or electronically via ESTTA.20

If sent by U.S. mail, documents should be addressed to:

Trademark Trial and Appeal Board
P. O. Box 1451
Alexandria, VA 22313-1451

Documents addressed to the Board also may be sent by any courier service and may be hand-delivered to:

Trademark Assistance Center
Madison East, Concourse Level Room C 55
600 Dulany St.
Alexandria, VA 22314

Documents also may be sent with a Certificate of Mailing or by express mail.21

The effect of a Certificate of Mailing is to make the correspondence timely filed if it is mailed within the time set for filing a document. The effect of express mail is to make the date of mailing the effective date of receipt of the correspondence in the USPTO.

Facsimile transmissions to the Board are not permitted in any inter partes case.22

C. Formal Requirements

1. Format

The form of submissions to the Board must follow detailed requirements for paper and electronic submissions, including type size, use of tabs or dividers, numbering of pages, and attachment of exhibits to electronic submissions.23

2. Page Limitations

There is a limitation of 25 pages for a brief on a motion and an answering brief on a motion.24 This limitation includes a table of contents, index of

21. Trademark Rule 2.197, 37 C.F.R. § 2.197 (Certificate of Mailing); Trademark Rule 2.198, 37 C.F.R. § 2.198 (express mail). These rules contain specific requirements and exceptions regarding the use of a Certificate of Mailing or an express mail mailing.
cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. The page limitation is strictly enforced and cannot be waived even by stipulation of the parties. A brief containing more than 25 pages will not be considered. A reply brief has a strictly enforced limitation of 10 pages in its entirety. Exhibits to a brief are not included in the page count.

At final hearing, the main brief and the answering brief are limited to 55 pages and must include an alphabetical index of cases. The table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary must be contained within the 55-page limitation. A reply brief cannot exceed 25 pages.

3. Captions
Sample captions for TTAB filings can be found in Attachment A to the TBMP.

4. Confidential Material
Confidential briefs, motions, transcripts, and exhibits must be marked confidential, preferably on each page, and must be marked with the case number and parties, at least on the first page of each part of a submission. Confidential material must be placed in an envelope with the prominent notation “CONFIDENTIAL” and case number and identification of the parties or filed via ESTTA as confidential. A redacted version, with the confidential parts omitted, of each confidential submission must also be submitted so that it may be included in the publicly accessible record.

5. Identification of Proceedings
When a pleading is received and a new proceeding is instituted by the TTAB, the proceeding is assigned a proceeding number. The first two numerals of an opposition number are “91” and the first two numerals of a cancellation proceeding are “92.”

It is important to identify every paper filed by the proper proceeding number; otherwise, the paper may not be associated with the proper file.

When a filing relates to multiple TTAB proceedings, a separate copy of each document must be filed in each proceeding to which the document to be filed in the proceeding before the Board must be furnished for each file to which the document pertains. However, when two or more proceedings that were filed separately have related issues, they may be consolidated into one proceeding upon motion by one or both of the parties, or sua sponte

26. Trademark Rule 2.128(b), 37 C.F.R. § 2.128(b).
27. Trademark Rule 2.126(c), 37 C.F.R. § 2.126(c).
by the TTAB. After consolidation, only one copy of a paper need be filed, identifying the number of the “parent” proceeding.28

D. Signature
Every pleading filed at the TTAB must bear the signature of a person entitled to represent the party in the proceeding. The original document from which the JPG or PDF is scanned should be retained as evidence of the signature if such evidence is later required.29

If an electronically transmitted signature filing is permitted or required, the person who signs the filing must place a symbol consisting of numbers and/or letters between two forward slash marks in the signature block on the electronic transmission or sign the verified statement using some other form of electronic signature specified by the director.30

The presentation to the USPTO, whether by signing, filing, submitting, or later advocating in support of any document filed by a party, whether by a practitioner or a nonpractitioner, constitutes a certification,31 and violations may result in the imposition of sanctions32 and disciplinary action (see further discussion in chapter 11 of this book).

E. Fees
An initial filing fee is paid to the USPTO in connection with an opposition or cancellation proceeding.33 Thereafter, no fee is payable for any action taken or paper filed by a party to the proceeding, except when a defendant or applicant files a counterclaim.

An opposition or a petition for cancellation may be filed against goods or services in fewer than all classes of a multiclass application or multi-class registration. The fees submitted in conjunction with the filing must be

28. For more on consolidations, see chapter 4, section III.A.
30. Trademark Rule 2.193(c), 37 C.F.R. § 2.193(c).
31. USPTO Ethical Rule 11.18(b), 37 C.F.R. § 11.18(b).
32. USPTO Ethical Rule 11.18(c), 37 C.F.R. § 11.18(c).
33. The authority for the charging of a fee for the filing of an opposition is Trademark Rule 2.101(d)(1), 37 C.F.R. § 2.101(d)(1). The equivalent authority for a petition for cancellation is Trademark Rule 2.111(c)(1), 37 C.F.R. § 2.111(c)(1). The amount of the fee in either type of proceeding is specified in Trademark Rule 2.6, 37 C.F.R. § 2.6. The filing fee charged is per class of goods or services in the application opposed or registration sought to be cancelled. The full fee is payable by each named plaintiff and must be paid as part of the filing of a notice of opposition or petition for cancellation. Trademark Rules 2.101(d)(1) and 2.111(c)(1), 37 C.F.R. §§ 2.101(d)(1) and 2.111(c)(1). The methods by which fees can be paid are in Trademark Rule 2.207, 37 C.F.R. § 2.207. If no fee is paid for at least one person to oppose the registration of a mark in at least one class, the opposition will be refused. Trademark Rule 2.101(b)(3)(i), 37 C.F.R. § 2.101(b)(3)(i). The corresponding provision for cancellation petitions is Trademark Rule 2.111(c)(3)(i), 37 C.F.R. § 2.111(c)(3)(i).
sufficient for all of the classes named in the complaint on behalf of all of the plaintiffs named in the complaint. If the fees are sufficient for at least one plaintiff against one class, the payment will be allocated on behalf of the first named plaintiff against the lowest numbered class in the complaint. Any remaining fees will then be allocated against the classes in ascending numerical order on behalf of the first named plaintiff, and if any money remains after payment of the fee for all of the named classes, it will be applied on behalf of the second named plaintiff in ascending numerical order of classes.34

Petitions to the director, while extremely rare in contested proceedings before the Board, require the payment of a fee for each petition.35

F. Service Requirements

Every paper filed at the Board, including notices of opposition and petitions for cancellation, must be accompanied by a Certificate of Service on every other party to the proceeding.36 The Certificate of Service must be signed by an attorney or other authorized representative, including a legal assistant or paralegal, and must state the date and method of service on the attorney or other authorized representative of each adverse party or, if there is no attorney or other authorized representative, on the party. Service may be made by mail, by courier, by personal delivery, or, if agreed upon by the parties, by e-mail.

If the parties agree to service of documents by e-mail, they cannot, even by stipulation, retain the additional five days afforded by Rule 2.119(c) for filing and/or service of documents by first-class mail.37

The service copy of a notice of opposition should be served on the attorney of record for the applicant or, if there is no attorney, on the applicant or applicant’s domestic representative.38 The service copy of a petition for cancellation should be served on the owner of record for the registration, on the owner’s domestic representative of record, if one has been appointed, or on the correspondence address of record in the USPTO.39

For notices of opposition and petitions for cancellation, the assignment records of the USPTO should be checked to obtain the appropriate address for service if there has been an assignment. The assignment records can

34. Trademark Rules 2.101(d)(3)(ii) and (iii), 2.111(c)(3)(ii) and (iii); 37 C.F.R. §§ 2.101(d)(3)(ii) and (iii), 2.111(c)(3)(ii) and (iii).
35. Trademark Rule 2.6(a)(15), 37 C.F.R. § 2.6(a)(15).
be accessed via the USPTO’s Trademark Status & Document Retrieval (TSDR) online system. If the service copy of a notice of opposition or petition for cancellation pleading is returned as being undeliverable, the plaintiff must notify the Board within 10 days of receipt of the returned copy.

V. Extensions of Time to Oppose an Application and Notices of Opposition

A. Proper Potential Opposer(s): Standing
The word “standing” means the right of a natural or juristic person to present a claim to the Board, either an opposition to the granting of a registration of a mark or a petition to cancel a registration of a mark, and to have it adjudicated. The concept of standing was explained by the Federal Circuit in *Ritchie v. Simpson*, which also discusses leading prior cases on the issue.

The requirement that a party allege and, if put to the proof, demonstrate standing is to prevent the presentation and prosecution of oppositions and cancellation proceedings by parties that have been described variously as gratuitous interlopers, intermeddlers, meddlesome parties, or self-appointed guardians of the purity of the Register. As held in *Ritchie*, any party who believes that damage would result from the prospective or continued registration of a mark on the Principal Register or believes that damage would result from the continued registration of the mark on the Supplemental Register, and whose belief of damage is reasonable, has standing to file and to prosecute an opposition or cancellation proceeding.

Standing may exist even though the plaintiff is a member of a substantial part, perhaps even a majority, of the general public, provided that the prospective or continued registration of a mark would be injurious to the plaintiff.

It is no longer correct to say that standing depends on a plaintiff’s showing that the plaintiff has an interest “beyond that of the general public.”

41. Trademark Rule 2.101(b), 37 C.F.R. § 2.101(b) (Notice of Opposition); Trademark Rule 2.111(b), 37 C.F.R. § 2.111(b) (Petition for Cancellation).
42. 170 F.3d 1092, 50 U.S.P.Q.2d 1023 (Fed. Cir. 1999).
The test is whether the plaintiff has a direct and personal stake in the outcome of the opposition or cancellation proceeding.

Standing is presumed when the plaintiff alleges that the defendant’s mark, as applied to the defendant’s goods or services, is likely to cause confusion or mistake or deception. Standing is also presumed when the complaint is that the defendant’s mark is likely to cause dilution, by blurring or tarnishment, of the plaintiff’s mark or trade name.

In those cases, where the complaining party is seeking to protect a mark, name, or reputation and therefore, on the face of the complaint, has an interest in the proceeding, standing will generally be found. Once the low threshold of showing a personal interest in the outcome of a case has been crossed, the plaintiff may rely on any ground that negates the defendant’s right to obtain or retain a registration.

In a concurrent use proceeding, which is started by the filing of an application to register a mark for a defined geographic territory with recognition of the rights of one or more other parties in the same or highly similar mark for the same or closely related goods or services in geographic territories other than that claimed in the concurrent use application, standing is self-evident because the applicant is claiming a right to register a mark for the defined territory.

Interferences are not declared today because the USPTO decided many years ago that the same purpose could be served by the successive examination and publication of applications, assuming the marks were otherwise registrable, in the order of the filing of the applications with the right of junior applicants but putative senior users to oppose the registration of an earlier filed and published mark.

When an applicant for registration of a mark petitions for the restriction or partial cancellation of a cited registration that is causing a refusal of the application, standing is apparent because the applicant by definition has an interest in the outcome and therefore has a reasonable basis for the belief that damage is being caused by the cited registration. The required reason for a petition to restrict the goods or services of a registration is that the restriction would avoid a likelihood of confusion between the mark of the registration and the mark of an application (filed by the restriction petitioner) that is blocked by the unrestricted registration.

46. For additional types of cases and the standing issues that result, see J. T. McCARTHY, McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 20:10–20:12 (4th ed. 2011).


B. Proper Defending Party or Parties

An applicant whose application has been opposed or a registrant whose registration is the subject of a petition for cancellation is, by definition, the proper party to defend against the opposition or petition for cancellation.

If there has been an assignment or other change in ownership of a mark and the application or registration, different rules apply depending on when the change of name or assignment has occurred in temporal relationship to the commencement of the proceeding.

When an application or registration involved in a proceeding is assigned or transferred to a different person or entity, it is always the better practice to record the assignment in the Assignment Branch of the USPTO. This is as true for a party in the position of plaintiff as it is for a party in the position of defendant. An assignment may result from a transfer of property rights from one person or entity to another person or entity or may result from a merger or some other form of corporate transaction.

For trademark matters, the documents submitted to establish ownership of a mark may be required to be recorded in the assignment records of the USPTO as a condition to permitting the assignee to take action in a matter pending before the USPTO.49

The assignee of a trademark application or registration may prosecute a trademark application, submit documents to maintain a trademark registration, or file papers against a third party in reliance on the assignee's trademark application or registration, to the exclusion of the original applicant or previous assignee,50 and the assignee must establish ownership in compliance with the appropriate USPTO rules.51

If an application or registration that is the object of an inter partes proceeding is assigned, the assignee may be joined as a party upon the filing at the TTAB of a copy of the assignment. When the assignment is recorded in the Assignment Branch of the USPTO, the assignee may be substituted as a party if:

1. The assignment occurred prior to the commencement of the proceeding,
2. The assignor is no longer in existence,
3. The plaintiff raises no objection to the substitution, or
4. The discovery and testimony periods have closed.

49. USPTO Rule 3.73(b)(1)(i), 37 C.F.R. § 3.73(b)(1)(i) requires such documents to be recorded pursuant to USPTO Rule 3.11, 37 C.F.R. § 3.11.
50. USPTO Rule 3.71(d), 37 C.F.R. § 3.71(d).
51. USPTO Rule 3.73, 37 C.F.R. § 3.73.
Otherwise, the assignee will be joined rather than substituted, to facilitate discovery. A number of cases are cited in that TBMP section.

If a mark pleaded by a plaintiff is assigned and a copy of the assignment is filed at the Board, the assignee will ordinarily be substituted if:

1. The assignment occurred prior to the commencement of the proceeding,
2. The discovery and testimony periods have closed,
3. The assignor is no longer in existence, or
4. The defendant raises no objection to substitution.

Otherwise, the assignee will be joined, rather than substituted, to facilitate the taking of discovery and the introduction of evidence.

The assignment of the plaintiff’s application or registration does not have to be recorded before substitution or joinder (whichever is appropriate) is ordered. Recordation of the assignment is advisable.

If the mark of an excepted common law user (that is not the owner of an involved application or registration) in a concurrent use proceeding is assigned, the assignee will be joined or substituted as party defendant upon notification to the Board of the assignment.

Alternatively, if there has been an assignment of a mark that is the subject of, or is relied upon in, a proceeding before the Board, and the Board does not order that the assignee be joined or substituted in the proceeding, the proceeding may be continued in the name of the assignor.

If the name of a party to an inter partes proceeding is changed, the title of the proceeding may be changed, upon motion or upon the Board’s own initiative, to reflect the change of name provided that appropriate evidence of the change is made of record in the proceeding. One form of appropriate evidence is a submission advising the Board of the number of the reel and frame where the change of name was recorded in the Assignment Branch. If no evidence of a change of name is made of record, the proceeding may be continued in the party’s former name.

Although a change of name document does not have to be recorded in order for the Board proceeding’s title to be changed to reflect the new name, recordation is advisable.

52. TBMP § 512.01.
53. Id.
54. Id.
55. TBMP § 512.02.
VI. Time Limits for Action

A. Statutory Action

The Trademark Act provides limitations on the time to file an opposition and on the time within which, following the issuance of a registration on the Principal Register, the petition for cancellation must be filed for certain causes of action. There is no statutory time limit for filing a petition to cancel a registration on the Supplemental Register. The time limits prescribed by the Trademark Act control the filing of notices of opposition and petitions for cancellation.

If the last day for taking any action in TTAB proceeding falls on a Saturday, Sunday, or federal holiday within the District of Columbia, the deadline for taking action is automatically moved forward to the next day that is not a Saturday, Sunday, or federal holiday within the District of Columbia.

If, because of some unscheduled event, such as adverse weather conditions, the USPTO is officially closed by Executive Order of the President or by the Office of Personnel Management for an entire day, that day will be regarded as a federal holiday within the District of Columbia. If the USPTO is closed for only part of a day between 8:30 AM and 5:00 PM, that day remains the deadline for taking the required action.

Trademark Act § 13 prescribes a period of 30 days after publication of an application in the Official Gazette to file a notice of opposition or to request an extension of time to file a notice of opposition. The counting begins on the day after the date of publication, which is always a Tuesday. One should take note that the period is counted in days. Therefore, care must be exercised in calculating the last day of a period that starts in a month having more or fewer than 30 days. Requests for extensions of time may be filed by paper or through ESTTA, except that requests for extensions of time to oppose Madrid Protocol–based applications must be filed through ESTTA.

An extension of time to file a notice of opposition may be obtained provided that the extension is requested before the expiration of the time for which an extension is desired. There are three time periods for which extensions may be requested. For an extension of 30 days of the

58. USPTO Rule 1.7(a), 37 C.F.R. § 1.7(a).
59. Trademark Rule 2.102, 37 C.F.R. § 2.102.
opposition period, no reason is required and it will be granted as a matter of right. A further extension of 60 days from the expiration of the first 30-day extension may be requested upon a showing of good cause. There is a relatively low standard for showing good cause. Examples are negotiations between the parties for a possible agreement to avoid an opposition, waiting for a response to a request for the abandonment of the application, efforts by the prospective opposer to retain counsel to file an opposition, needing time to conduct an investigation into the use of the mark of the application, or any other reasonable explanation for needing more time.

Instead of requesting a first extension of 30 days and a second extension of 60 days, a party may request a first extension of 90 days upon a showing of good cause, as explained above.

Before the end of the extended period of 120 days to file an opposition (the first 30 days following publication and 90 days of extension), a party may request one further extension of 60 days. This final extension of 60 days is available solely with the consent of the applicant, and it usually is requested when the parties are engaged in negotiations for a possible agreement and more time is needed for that purpose. No further extension will be granted after the final extension, which ends 180 days following the publication of the application. Before the end of the final extension of time, a notice of opposition must be filed or the opportunity to do so will be gone. If the opportunity to oppose expires, a party is not precluded filing a petition for cancellation after the mark becomes registered.

For cancellation actions, there is a time limit for petitions based on some claims and no time limits for petitions based on other claims when the mark is registered on the Principal Register. For registrations on the Supplemental Register, there is no statutory time limit.

Exceptions to the statute of limitations include petitions on the ground that the mark has become the generic name for the goods or services or a portion thereof; or the mark is functional; or the mark has been abandoned; or the registration was obtained fraudulently; or the registration was obtained contrary to the provisions of Trademark Act § 4, 15 U.S.C. § 1054; or the mark was obtained contrary to the provisions of Trademark Act § 2(a), (b), or (c), 15 U.S.C. § 1052(a), (b), or (c); or the mark is being used


by, or with permission of, the registrant so as to misrepresent the source of the goods or services for which the mark is used. The last provision is very rarely invoked.

If a mark was registered under the Act of 1881 or the Act of 1905 and has been republished under Trademark Act § 12, 15 U.S.C. § 1062, the statute of limitations of section 14 applies. If the registration that is the subject of a petition is against the mark that was registered under the Act of 1881 or the Act of 1905 and has not been republished under the 1946 Trademark Act, there is no statute of limitations.

There also is no statute of limitations if the cancellation action is against a certification mark and alleges any of the grounds specified in Trademark Act § 14(5), 15 U.S.C. § 1064(5).

The statute of limitations is tolled when a registration less than five years old is pleaded as a basis for an opposition alleging a likelihood of confusion. The tolling is effective even if a counterclaim for the cancellation of the pleaded registration is not filed until after the registration has passed its five-year anniversary.62

Notwithstanding the fact that a petition for cancellation may be filed prior to the expiration of the five-year statute of limitations, the registrant may still have a defense on the ground of laches.63

B. Regulatory

The Rules of Practice prescribe time limits for taking action in many situations. These include the time limits specified in the TTAB schedule shown on page 24, motions and responses, briefs, and responses to discovery. Except for statutorily mandated due dates, every date may be extended by stipulation of the parties or by an order of the Board.

For an unconsented extension, a request filed prior to the expiration of the time for taking action must show good cause,64 for which the standard is fairly lenient. For example, extensions have been granted because counsel was committed to other matters and needed more time, a witness was temporarily unavailable, evidence had to be located, a client was temporarily unable to instruct counsel, and a client or counsel was ill. A party must act in good faith and not have abused the privilege of obtaining more time.

If a motion for additional time is filed after the expiration of the time for the action, the standard is the far more rigorous requirement of showing excusable neglect, of which the most important factor is whether the delay was beyond the reasonable control of the party seeking the extension.

VII. Amendments to Applications during Extension Requests

An application may be amended without the consent of the potential opposer during the pendency of an extension of time obtained by a potential opposer. In fact, except for an issue related to a request for an extension of time, the Board has no jurisdiction over an application prior to the institution of an opposition. A request for an amendment in an application that is the subject of an extension of time but not yet the subject of an opposition should be sent to the examining attorney in the same form as any other amendment during the prosecution of an application. There is a dedicated Trademark Electronic Application System form for filing an amendment after an application has been published.

Any request for an amendment of an application prior to the institution of an opposition is referred to the examining attorney to determine whether the amendment will be permitted.

VIII. Sequence and Schedule of a TTAB Proceeding

The standard procedural sequence of a TTAB proceeding is shown in Table 1. Note again that this timeline is often extended or suspended at times by request of the parties, or delayed up the filing of a motion and the decision thereto, or altered by an agreement for accelerated case review approved by the Board. Note also that while the Board often issues the institution notice on the day the complaint is filed, that is not always the case, particularly when the complaint is filed on paper or the underlying application is a Madrid Protocol filing.

67. TBMP § 212.01.
68. Id.
69. Id.
# TABLE 1.1. Outline of a TTAB Schedule

<table>
<thead>
<tr>
<th>Preparation</th>
<th>Days from Institution Notice</th>
<th>Days from Previous Deadline</th>
<th>Action</th>
</tr>
</thead>
<tbody>
<tr>
<td>Plaintiff files complaint</td>
<td>–</td>
<td>–</td>
<td>Board issues institution notice</td>
</tr>
<tr>
<td>Plaintiff and defendant prepare initial disclosures</td>
<td>40</td>
<td>40</td>
<td>Answer due</td>
</tr>
<tr>
<td></td>
<td>50</td>
<td>10</td>
<td>If no answer, plaintiff moves for notice of default and suspension</td>
</tr>
<tr>
<td></td>
<td>60</td>
<td>20</td>
<td>Request for TTAB participation in conference</td>
</tr>
<tr>
<td></td>
<td>70</td>
<td>30</td>
<td>Discovery/Disclosure/Settlement conference</td>
</tr>
<tr>
<td></td>
<td>70</td>
<td>30</td>
<td>Discovery opens—must await initial disclosures</td>
</tr>
<tr>
<td></td>
<td>100</td>
<td>30</td>
<td>Initial disclosures due</td>
</tr>
<tr>
<td></td>
<td>220</td>
<td>150</td>
<td>Update initial disclosures</td>
</tr>
<tr>
<td></td>
<td>220</td>
<td>150</td>
<td>Disclosure expert testimony</td>
</tr>
<tr>
<td>Plaintiff prepares pretrial disclosures</td>
<td>250</td>
<td>180</td>
<td>Discovery closes</td>
</tr>
<tr>
<td></td>
<td>295</td>
<td>45</td>
<td>Plaintiff pretrial disclosures</td>
</tr>
<tr>
<td></td>
<td>310</td>
<td>15</td>
<td>Plaintiff testimony opens</td>
</tr>
<tr>
<td>Defendant prepares pretrial disclosures</td>
<td>340</td>
<td>30</td>
<td>Plaintiff testimony closes</td>
</tr>
<tr>
<td></td>
<td>355</td>
<td>15</td>
<td>Defendant pretrial disclosures</td>
</tr>
<tr>
<td></td>
<td>370</td>
<td>15</td>
<td>Defendant testimony opens</td>
</tr>
<tr>
<td>Plaintiff prepares rebuttal disclosures</td>
<td>400</td>
<td>30</td>
<td>Defendant testimony closes</td>
</tr>
<tr>
<td></td>
<td>415</td>
<td>15</td>
<td>Plaintiff rebuttal testimony disclosures</td>
</tr>
<tr>
<td></td>
<td>430</td>
<td>15</td>
<td>Plaintiff rebuttal testimony opens</td>
</tr>
<tr>
<td></td>
<td>445</td>
<td>15</td>
<td>Plaintiff rebuttal testimony closes</td>
</tr>
<tr>
<td></td>
<td>505</td>
<td>60</td>
<td>Plaintiff’s brief due</td>
</tr>
<tr>
<td></td>
<td>535</td>
<td>30</td>
<td>Defendant’s brief due</td>
</tr>
<tr>
<td></td>
<td>550</td>
<td>15</td>
<td>Plaintiff’s reply brief due</td>
</tr>
<tr>
<td></td>
<td>560</td>
<td>10</td>
<td>Request for an oral hearing, if desired, due</td>
</tr>
</tbody>
</table>
Briefing and oral hearing (if requested) follow the close of trial. The schedule may be used as a checklist for attending to the various procedural requirements.

IX. Online Resources from the Trademark Trial and Appeal Board

The USPTO and TTAB websites contain a variety of information and documents useful for practitioners and parties in TTAB proceedings.

- USPTO: http://www.uspto.gov/
- TBMP: http://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/tbmp-preface
- TTAB Hearing Schedules: http://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/ttab-hearing-schedules
- TTAB Video: https://www.youtube.com/watch?v=RIvngyjFFdY
- Electronic System for Trademark Trial and Appeals (ESTTA) online filing: http://estta.uspto.gov/
- Trademark Trial and Appeal Board Inquiry System (TTABVUE) for reviewing documents in current and past proceedings: http://ttabvue.uspto.gov/ttabvue/v
X. Checklist for Prefiling Considerations

Prior to filing an opposition against an application or a petition to cancel a registration, the following questions should be considered:

- Is the proposed action within the statutorily permitted time?
- Has the file history of the potential target mark and of the applicant or registrant been reviewed?
- Has an investigation been made to see whether, how, and approximately how extensively the target mark is being used, if at all?
- Who are the potential customers or users of the goods or services of the target mark?
- To what extent would the registration and use of the target mark cause economic or legal damage?
- Are there contemporaneous or past other matters between the potential plaintiff and the owner of the target mark?
- Are there other marks, registered or pending, owned by the same potential defendant that should be factored in?
- Which party has priority or superiority of right?
- Is evidence available and are there witnesses to prove the critical allegation of a notice of opposition or petition to cancel?
- Are the potential pleaded registrations or prior application of the potential plaintiff safe from a successful counterattack?
- Has the international trademark situation been considered?
- Have third-party registrations and use been evaluated?
- Would an agreement be possible before filing or while a proceeding is pending?
- Would confidential or trade secret data or information be subject to disclosure?
- Does the potential plaintiff possess sufficient financial resources to support the conduct of the proceeding?
- Are there strategic advantages to bringing an action in district court rather than the TTAB?
- Have the potential preclusive effects of a decision at the TTAB been considered?
- If the potential plaintiff wins, would it contest an appeal?
- If the potential plaintiff loses, would it file and argue an appeal?
- Is alternate dispute resolution a possibility?