Chapter One

Inter Partes Matters: General Background and Prefiling Considerations

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

Trademark Trial and Appeal Board (TTAB, or the Board) proceedings can be powerful tools for brand owners to guard their brands and to keep the U.S. Patent and Trademark Office (USPTO) trademark registers clear of potentially conflicting marks. But TTAB proceedings at best lead to refusals to register or maintain the registration of trademarks. As an executive branch adjudicator, the TTAB cannot provide injunctive relief or a damages award. Thus, a party potentially injured by a pending trademark application or registration might consider an action in a federal district court against the use of the offending mark. In federal court, relief may also include an order requiring the defendant to abandon a pending application or an order cancelling an issued registration pursuant to the Trademark Act.1 Potential plaintiffs in trademark proceedings therefore have a variety of decisions to make, and procedures and expenses to consider, regarding an action to protect their trademark(s).

TTAB proceedings share many procedures and potential claims with trademark disputes in district court, but they take place before a body of administrative judges from the USPTO. The U.S. 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.”

As discussed ahead, 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 section 1(b), 15 U.S.C. § 1051(b); (2) on the basis of a foreign application or registration under Trademark Act section 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 section 66(a), 15 U.S.C. § 1141f(a), the applicant might not be using the mark in commerce in the United States. Under any of these circumstances, the plaintiff’s only option is to challenge the application to register the trademark under consideration, which requires a proceeding before the TTAB.

**A. Advantages of a TTAB Proceeding**

Assuming a choice between litigation in a district court or before the Board, a TTAB proceeding has numerous possible advantages:

- 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. As discussed in Chapter 9, the parties may even agree to use the TTAB’s Accelerated Case Resolution procedure. 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 monetary payments usually

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are not associated with 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.3

• A TTAB decision may be preclusive in later district court litiga-
tion, 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.”4 For example, the TTAB’s finding of a
likelihood of confusion that considers how the marks are used in
the marketplace could have issue-preclusive effect in a later action
for infringement in district court.

B. Advantages of a District Court Action

On the other hand, district court litigation, assuming that the court would
have subject-matter jurisdiction and jurisdiction over the defendant, has
its own potential tactical advantages:

• The district court has the power to order injunctive relief and
monetary awards. Relief before the Board is limited to a refusal of
registration in an opposition proceeding or cancellation of a registra-
tion in a cancellation action. If a plaintiff wishes to stop the regis-
tration 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 Board
and a complaint in federal district court and request suspension of
the TTAB proceeding pending the disposition of the federal litiga-
tion. If a proceeding before the Board involves issues in common
with the issues in a civil action in a federal district court, the deci-
sion of the district court on those issues is almost always followed
by the TTAB.5

• A jury may be available in a district court action if monetary rem-
edies are sought. TTAB proceedings are decided at final hearing by
a panel of three administrative trademark judges, and no jury is
available.

3. A party may appeal to the CAFC or the district court, but not both. See Princeton
(W.D.N.C. 2019).

4. Id.; B&B Hardware, Inc., 135 S. Ct. at 1308.

5. See Trademark Trial and Appeal Board Manual of Procedure § 510.02(a) (2014)
[hereinafter TBMP].
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• 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 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 for the district judge to 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 U.S. Supreme Court, the circuit court of appeals where the district court sits, and the district court itself. A district court may rely on, refer to, or seek guidance from decisions from the circuit courts and district courts of other circuits. Of course, at the TTAB, decisions of the U.S. Supreme Court are controlling.

II. Statutory and Regulatory Authority

A. History, Establishment, and Organization of the TTAB

The federal statute governing proceedings before the TTAB is the Trademark Act, as amended, which was signed into law 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 now being the commissioner for trademarks).

B. Board Members and Staff

The Board's personnel include the director and the deputy director of the USPTO, 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. There is currently a chief administrative trademark judge, a deputy chief judge, and 27 administrative trademark judges. There are also more than a dozen interlocutory attorneys, whose duties include ruling on nondispositive motions, participation in discovery conferences (upon request), 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

I. Nonsubstantive Provisions

Statutory provisions pertaining to procedural matters and substantive issues of inter partes proceedings are in diverse sections of the Trademark Act. The authority to take specific action with respect to an application or registration is provided in Trademark Act section 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 section 13, 15 U.S.C. § 1063. Petitions to cancel registrations are the subject of Trademark Act section 14, 15 U.S.C. § 1064. Section 14 also contains a five-year statute of limitations for petitions to cancel on specified grounds. The exceptions are specified in Trademark Act section 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 section 4,7 or Trademark Act section 2(a), (b), or (c).8 The five-year statute of limitations operates automatically without any action by the registrant. This limitations

8. Id. § 1052(a), (b), or (c). These provisions include marks that are deceptive or suggest a false connection, marks that consist of a flag, coat of arms, or other government emblem, and marks that contain the name, likeness, or signature of a living person.
period is tolled for a counterclaimant when the opposer’s mark reaches its five-year status during the course of an opposition.\(^9\)

The five-year limitations period in Trademark Act section 14, 15 U.S.C. § 1064, is independent of the benefits of so-called “incontestability” provided by Trademark Act section 15, 15 U.S.C. § 1065. The benefits of incontestability may be obtained only by filing a declaration after the fifth anniversary of a registration averring that the mark has been continuously used for the preceding five years without a final judgment adverse to the registrant’s rights or a pending challenge to those rights.\(^{10}\)

The TTAB also has 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.\(^{11}\) There is no other statutory provision dealing with that situation.


The final sentence of Trademark Act section 18, 15 U.S.C. § 1068, states that no final judgment shall be entered in favor of an applicant under Trademark Act section 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 section 7(c), 15 U.S.C. § 1057(c).

2. Substantive Grounds

Substantive grounds for oppositions and cancellation proceedings, other than dilution, are set forth in Trademark Act section 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. Subsection (f) allows the registration of marks based on 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

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10. The benefits of incontestability are of importance in civil actions for infringement but have no applicability in proceedings before the Board.
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Trademark Act section 43(c), 15 U.S.C. § 1125(c). Case law has established additional grounds for opposition or cancellation. 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. An application may also be opposed or a petition for cancellation filed 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 section 1, 15 U.S.C. § 1051; Trademark Act section 2, 15 U.S.C. § 1052; and Trademark Act section 45, 15 U.S.C. § 1127. For example, the requirements are not fulfilled where the subject matter is merely ornamental or informational.

D. Governing Rules of Procedure

The TTAB regulations (Trademark Rules) for inter partes proceedings are set forth 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.


Applications filed internationally under the Madrid Protocol are subject to additional rules. Trademark Act sections 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 and with oppositions against requests for the protection of Madrid Protocol international registrations in the USPTO. For example, while the Board allows for requesting extensions of time to oppose or file an opposition in paper form in exceptional circumstances, such requests concerning an application filed under

15. Cases are cited at Trademark Manual of Examining Procedure § 1202.03.
17. The online version is available at https://tbmp.uspto.gov/RDMS/TBMP/current (last visited Apr. 16, 2020). The TBMP is also available in PDF format at http://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/tbmp-preface (last modified Sept. 6, 2019).
Trademark Act section 66(a) must be filed without exception through the Electronic System for Trademark Trials and Appeals (ESTTA), the online electronic communication system between parties or their attorneys and the TTAB.\(^\text{18}\) Perhaps most importantly, in an opposition filed against an application proceeding under Trademark Act section 66(a), 15 U.S.C. § 1141f(a), the notice of opposition may not be amended to add to the grounds for opposition or to add to the goods or services subject to the opposition.\(^\text{19}\) 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 de novo review of a decision by the Board are the subjects of Trademark Rule 2.145, 37 C.F.R. § 2.145.

III. Types of Inter Partes Proceedings before the TTAB

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

A. Opposition

An opposition is a proceeding in which a party seeks to prevent the registration of a pending trademark application.\(^\text{20}\) 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.\(^\text{21}\) For more


\(^{19}\) Trademark Rule 2.107(b), 37 C.F.R. § 2.107(b).


on extensions of time to oppose, see section V. 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. 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 seeks 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. A registration more than five years old cannot be cancelled at the TTAB on the ground of likelihood of confusion. For more on the permissible grounds for cancellation, see Chapter 2, section II.C.

C. Concurrent Use Proceedings

The Lanham Act also allows for the concurrent federal registration of marks for use in different geographic areas, so long as such use is not likely to cause consumer confusion. 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. Concurrent use proceedings are rare. Many, if not the majority of, concurrent use proceedings are ultimately settled by agreement between the parties defining their respective geographic territories.

The Board resorts to concurrent use proceedings when 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 section 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.

Under Section 2(d), an eligible applicant may request issuance of a registration based on rights acquired by use of its mark concurrently with

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use of the same mark by another owner. The director of the USPTO may issue a concurrent use registration if the director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used. An applicant is eligible to request concurrent use if the applicant’s date of first use in commerce is before the filing date of the pending applications or of any registrations issued under the Trademark Act of 1946. 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.

D. Interferences
Although the Lanham Act also provides for a proceeding called an interference, several decades have elapsed since the last interference was declared. The rules for interferences were eliminated in 2018. An interference may still be declared pursuant to a petition to the director. 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:

1. Any individual who is an attorney admitted in the United States.
2. A foreign attorney who is registered with or in good standing before the patent or trademark office of the country in which the attorney resides and practices, provided that the foreign country grants substantially reciprocal privileges to those permitted to practice in trademark cases before the USPTO. Currently, only Canadian attorneys may qualify under this provision.

27. 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 in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947, the applicant is eligible to request a concurrent use registration if its date of first use is earlier than July 5, 1947.
3. Any member or officer authorized to represent a company or association, including in-house counsel.
4. An individual appearing pro se.

B. How to File Documents at the TTAB

In all but exceptional circumstances, filings must be transmitted through ESTTA.\footnote{31} ESTTA must 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. 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 an electronic format. The Board will generally not accept filings 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.\footnote{32}

In exceptional circumstances, documents may still be filed on paper, and mailed where ESTTA is unavailable due to technical problems or other extraordinary circumstances prevent an electronic filing.\footnote{33} All submissions in paper form, except for extensions of time to file a notice of opposition, the notice of opposition, the petition to cancel, or answers thereto, must include a written explanation of such technical problems or extraordinary circumstances. Extensions of time to file a notice of opposition, notices of opposition, petitions to cancel, or answers thereto must be accompanied by a petition to the director under § 2.146, with the required petition fee, as well as a showing that ESTTA was unavailable due to technical problems, or that extraordinary circumstances were present.\footnote{34}

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

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

\footnote{31} Trademark Rule 2.126, 37 C.F.R. § 2.126. ESTTA is accessible through https://estta.uspto.gov (last visited Apr. 16, 2020).
\footnote{32} Trademark Rule 2.126(b); Hunter Indus., Inc. v. Toro Co., 110 U.S.P.Q.2d 1651 (T.T.A.B. 2014).
\footnote{33} Trademark Rule 2.126, 37 C.F.R. § 2.126.
\footnote{34} See 37 C.F.R. §§ 2.101(b)(2), 2.102(a)(2), 2.106(b)(1), 2.111(c)(2), and 2.114(b)(1).
Documents also may be sent with a certificate of mailing or by express mail. 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.

Information on ESTTA, fees, new rules, and additional information is easily found on the USPTO’s TTAB web page.

C. Formal Requirements

1. Format

Electronic submissions to the Board have relatively few format requirements. There are no font requirements, but text must be in at least 11-point size and be double-spaced. Exhibits must be attached and must be clear and legible. Paper submissions must follow detailed requirements, including type size, use of tabs or dividers, numbering of pages, and attachment of exhibits to electronic submissions.

2. Page Limitations

There is a limit of 25 pages for a brief on a motion and an answering brief on a motion. This limit includes a table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. The page limit 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 limit of ten pages in its entirety. Exhibits to a brief are not included in the page limit.

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. Evidentiary objections may be raised in an appendix or by way of a separate statement of objections that is not included in the page limit.  

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 submitted using the “Confidential” selection available in ESTTA or, where appropriate, under a separate paper cover. Submissions should be marked with the prominent notation “CONFIDENTIAL” and the case number and identification of the parties. A redacted version of each confidential submission, with the confidential parts omitted, 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.”

When a filing relates to multiple TTAB proceedings, a separate copy of each document must be filed in each proceeding 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 by the TTAB. After consolidation, only one copy of a document need be filed. The file should be submitted in the “parent” proceeding.

D. Signature

Every pleading filed at the TTAB must bear the signature of a person entitled to represent the party in the proceeding. Documents may be signed

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42. Id.
43. Trademark Rule 2.126(c), 37 C.F.R. § 2.126(c).
45. For more on consolidations, see Chapter 4, section III.A.
by either a handwritten signature or an electronic signature. If signed by hand, 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.\footnote{Trademark Rule 2.193(b), 37 C.F.R. § 2.193(b).} If signed electronically, the signatory must place a symbol consisting of numbers and/or letters between two forward slash marks ("/") in the signature block of the document or sign the verified statement using some other form of electronic signature specified by the director.\footnote{Trademark Rule 2.193(c), 37 C.F.R. § 2.193(c).}

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.\footnote{USPTO Ethical Rule 11.18(b), 37 C.F.R. § 11.18(b).} Violations may result in the imposition of sanctions\footnote{USPTO Ethical Rule 11.18(c), 37 C.F.R. § 11.18(c).} and disciplinary action (see further discussion in Chapter 11 of this book).

### E. Fees

Filing an opposition or cancellation proceeding requires submission of an initial filing fee.\footnote{The authority for the charging of a fee for the filing of an opposition is Trademark Rule 2.101(d), 37 C.F.R. § 2.101(d). The equivalent authority for a petition for cancellation is Trademark Rule 2.111(d), 37 C.F.R. § 2.111(d). 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) and 2.111(d), 37 C.F.R. §§ 2.101(d) and 2.111(d). 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(c), 37 C.F.R. § 2.101(c). The corresponding provision for cancellation petitions is Trademark Rule 2.111(d), 37 C.F.R. § 2.111(d).} Thereafter, no other action taken or filing by a party to the proceeding, except when a defendant or applicant files a counterclaim, requires a fee.

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

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

**F. Service Requirements**

Papers filed at the Board must generally be accompanied by a certificate of service reflecting service on every other party to the proceeding. No certificate of service is needed for a notice of opposition or petition to cancel, because service is completed by the Board. 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 must be made by e-mail, unless otherwise stipulated.

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

**A. Proper Potential Opposer(s): Standing**

Standing is 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 in a Board proceeding was explained by the CAFC in *Ritchie v. Simpson*, which also discusses leading prior cases on the issue.

Standing is a threshold issue. The requirement that a party allege and, if put to the proof, demonstrate standing is to prevent the filing of oppositions and cancellation proceedings by parties that have been described variously as gratuitous interlopers, intermeddlers, meddlesome parties, or

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51. 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).
52. Trademark Rule 2.6(a)(15), 37 C.F.R. § 2.6(a)(15).
54. Trademark Rule 2.119(a), 37 C.F.R. § 2.119(a); Trademark Rules 2.105(c), 2.113(c), 37 C.F.R. §§ 2.105(c), 2.113(c).
55. The parties may agree that service may be made by mail, by courier, or by personal delivery. The date of mailing or of delivery to the overnight courier will be considered the date of service.
self-appointed guardians of the purity of the Register.\textsuperscript{57} Per the Lanham Act, and as held in \textit{Ritchie}, any party who believes that damage would result from the prospective or continued registration of a mark on the Principal Register\textsuperscript{58} or believes that damage would result from the continued registration of the mark on the Supplemental Register,\textsuperscript{59} and whose belief of damage is reasonable, has standing to file and to prosecute an opposition or cancellation proceeding.

Proof of standing in a Board proceeding is a low threshold.\textsuperscript{60} Standing may exist even though the plaintiff is a member of the general public, provided that the prospective or continued registration of a mark would be injurious to the plaintiff.\textsuperscript{61} There is no requirement that the plaintiff have a relevant commercial interest or even represent a substantial part of the general public.

The test is whether the plaintiff has a direct and personal stake in the outcome of the opposition or cancellation proceeding.\textsuperscript{62}

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. But the facts regarding standing are a part of a plaintiff’s case and must be affirmatively proved.\textsuperscript{63}

Standing is apparent 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 because the applicant has a clear interest in the outcome and a self-evident 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.\textsuperscript{64}

\textsuperscript{57} See, e.g., 3 J. Thomas McCarthy, \textit{McCarthy on Trademarks and Unfair Competition} § 20.07 (5th ed. 2017).
\textsuperscript{62} \textit{Id}.
\textsuperscript{63} Lipton Indus., Inc. v. Ralston Purina Co., 670 F.2d 1024, 1028, 213 U.S.P.Q. 185, 189 (C.C.P.A. 1982).
Standing is self-evident in a concurrent use proceeding because the applicant is claiming a right to register a mark for the defined territory with recognition of the rights of one or more other parties.

**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 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 owner, it is always the better practice to record the assignment in the Assignment Branch of the USPTO. This is true for both plaintiff and defendant.

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. An assignee may act to the exclusion of the original applicant or previous assignee. 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. The assignee must establish ownership in compliance with the appropriate USPTO rules.

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.

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65. 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.
66. USPTO Rule 3.71(d), 37 C.F.R. § 3.71(d).
67. USPTO Rule 3.73, 37 C.F.R. § 3.73.
Otherwise, the assignee will be joined rather than substituted, to facilitate discovery.68

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. But recordation is advisable.69

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.70

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.71 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.

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68. TBMP, supra note 5, § 512.01 and cases cited within.
69. Id.
70. Id.
71. Id. § 512.02.
VI. Time Limits for Action

A. Statutory Action

The Trademark Act provides limitations on the time to file an opposition and to petition for cancellation of a registration on the Principal Register for certain causes of action. 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 a 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 a.m. and 5:00 p.m., that day remains the deadline for taking the required action. These shifts do not change subsequent deadlines.

There is no statutory time limit for filing a petition to cancel a registration on the Supplemental Register.

Trademark Act section 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. Because the period is counted in days, a potential opposer must exercise care in calculating the last day of a period that starts in a month having more or fewer than 30 days.

Extensions of time to oppose are available if the extension is requested before the expiration of the current deadline. Extensions of time must be filed through ESTTA, with limited exceptions. An initial extension may be requested for either 30 or 90 days. For an extension of 30 days of the 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

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74. USPTO Rule 1.7(a), 37 C.F.R. § 1.7(a).
75. TBMP, supra note 5, § 112.
76. Trademark Rule 2.102, 37 C.F.R. § 2.102.
is a relatively low standard for showing good cause. Examples include 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 subject mark, or any other reasonable explanation for needing more time. If a party requests a first extension of 90 days, a showing of good cause, as explained above, is required.

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. 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.

Some cancellation actions have time limits. Cancellation actions against registrations on the Principal Register alleging a likelihood of confusion or dilution by blurring or dilution by tarnishment may only be brought within five years of registration.

Many cancellation actions, however, have no time limit. There is no statute of limitations to petition that a mark has become the generic name for the goods or services or a portion thereof; a mark is functional; a mark has been abandoned; a registration was obtained fraudulently; a registration was obtained contrary to the provisions of Trademark Act section 4, 15 U.S.C. § 1054; a mark was obtained contrary to the provisions of Trademark Act section 2(a), (b), or (c), 15 U.S.C. § 1052(a), (b), or (c); or a 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. There is no statutory time limit for registrations on the Supplemental Register.

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 section 14(5), 15 U.S.C. § 1064(5).

VI. Time Limits for Action

The statute of limitations of section 14 applies if a mark was registered under the Act of 1881 or the Act of 1905 and has been republished under Trademark Act section 12, 15 U.S.C. § 1062. 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.

The statute of limitations is tolled for purposes of a counterclaim 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.\(^7\)

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.\(^8\)

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 in Table 1.1, and for 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,\(^9\) 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,\(^10\) of which the most important factor is whether the delay was beyond the reasonable control of the party seeking the extension.\(^11\)


\(^10\) Id. 6(b)(1)(B).

VII. Amendments to Applications during Extension Requests

An application may be amended without the consent of the potential opposer even after a potential opposer obtains an extension of time.84 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.85 If an application is the subject of an extension of time but not yet the subject of an opposition, requests for amendment 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.86

VIII. Sequence and Schedule of a TTAB Proceeding

The standard procedural sequence of a TTAB proceeding is shown in Table 1.1. This timeline is often extended or suspended at times by request of the parties, or delayed by the filing of a motion, or altered by an agreement for accelerated case review approved by the Board. While the Board often issues the institution notice on the day the complaint is filed, that is not always the case, particularly when the underlying application is a Madrid Protocol filing.

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 TTAB

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

- USPTO: https://www.uspto.gov/

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84. TBMP, supra note 5, § 212.01.
85. Id.
86. 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>Deadline to serve discovery requests</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 from opening of discovery</td>
<td>Discovery closes</td>
</tr>
<tr>
<td></td>
<td>294</td>
<td>44</td>
<td>Deadline to file motion to compel discovery responses or motion for summary judgment</td>
</tr>
<tr>
<td></td>
<td>295</td>
<td>180 from close of discovery</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>
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<td>Plaintiff rebuttal testimony disclosures</td>
</tr>
<tr>
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<td>15</td>
<td>Plaintiff rebuttal testimony opens</td>
</tr>
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<td>15</td>
<td>Plaintiff rebuttal testimony closes</td>
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<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>
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<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>
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 targeted mark and of the applicant or registrant been reviewed?
- Has an investigation been made to see whether, how, and approximately how extensively the targeted mark is being used, if at all?
- Who are the potential customers or users of the goods or services of the targeted mark?
- To what extent would the registration and use of the targeted mark cause economic or legal damage?
- Are there contemporaneous or past other matters between the potential plaintiff and the owner of the targeted 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?