ABA-IPL Trademark Day:

Getting to Know the USPTO:
Topics & Tips for New and Experienced Practitioners + Live TTAB Hearing

Wednesday, September 18, 2019
USPTO Campus
Alexandria, VA
# 7th Annual ABA-IPL Trademark Day with the USPTO

Getting to Know the USPTO: Topics & Tips for New and Experienced Practitioners +
Live TTAB Hearing

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<tr>
<td>Christina D. Frangiosa, Eckert Seamans, Cherin, &amp; Mellott, LLC, Philadelphia, PA</td>
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<tr>
<td>Josh Gerben, Gerben Law Firm PLLC, Washington, DC</td>
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<td><strong>Experienced Practitioner Track: The Far Reaches of Trademarks: Non-Traditional Marks at the USPTO</strong></td>
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# 7th Annual ABA-IPL Trademark Day with the USPTO

*Getting to Know the USPTO: Topics & Tips for New and Experienced Practitioners + Live TTAB Hearing*

**Wednesday, September 18, 2019**

8:30 am - 6:00 pm

**USPTO Headquarters**

Clara Barton Auditorium
(formerly Madison Auditorium)
Alexandria, VA

## Schedule

<table>
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<tr>
<td>8:30 am – 8:50 am</td>
<td>REGISTRATION &amp; COFFEE</td>
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| 8:50 am – 9:00 am | Welcome  
Rick Biagi, ABA-IPL Trademarks Division Chair, Neal & McDevitt LLC |
| 9:00 am – 9:30 am | State of the Trademark Office  
Commissioner for Trademarks, Mary Boney Denison, USPTO |
| 9:30 am – 10:00 am | State of the TTAB Board  
Chief Administrative Trademark Judge, Gerard F. Rogers, Trademark Trial and Appeal Board, USPTO |
| 10:00 am – 11:00 am | TTAB Panel: Expedited Cancellation Proceedings, Best Practices for Pleadings and Evidence  
TTAB Judge Michael Adlin, Interlocutory Attorneys Catherine Faint and Elizabeth Winter will discuss hot topics at the Board including Expedited Cancellation Proceedings, the Standard Protective Order, Best Practices for Pleadings, recent limits on the number of Discovery Requests, and recent developments at the Board. |
| 11:00 am – 11:15 am | BREAK |
| 11:15 am – 12:15 pm | TTAB hearing/Q & A  
Preview of the Hearing at 11:15 am: Hon. Frances Wolfson, TTAB, USPTO  
Hearing: starts promptly at 11:30 am. |
<p>| 12:15 pm – 1:15 pm | NETWORKING LUNCH: ATRIUM AREA |</p>
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<tr>
<th>Time</th>
<th>New Practitioner Track</th>
<th>Experienced Practitioner Track</th>
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<tr>
<td>1:30 pm – 2:30 pm</td>
<td><strong>Intro to TTAB Practice</strong>&lt;br&gt;Hear from TTAB interlocutory attorneys on the basics of filing, litigating and preparing for trial in cases brought in this venue. Learn the difference in procedure between federal court and this administrative tribunal.&lt;br&gt;&lt;br&gt;<strong>Speakers:</strong>&lt;br&gt;Interlocutory Attorneys Andrew Baxley &amp; Katie McKnight, USPTO</td>
<td><strong>Making Effective Arguments to the TTAB</strong>&lt;br&gt;Hear from TTAB judges and interlocutory attorneys on advanced topics for ex parte and inter partes proceedings including how to create powerful and persuasive arguments in motions, final briefs, and oral arguments, and how to effectively build the record during the testimony period through depositions, declarations, Notice of Reliances, and more.&lt;br&gt;&lt;br&gt;<strong>Speakers:</strong>&lt;br&gt;Hon. Jonathan Hudis, TTAB, USPTO&lt;br&gt;Hon. Thomas Wellington, TTAB, USPTO</td>
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<tr>
<td>2:30 pm – 3:30 pm</td>
<td><strong>Trademark Bootcamp</strong>&lt;br&gt; <em>New to the process? Join the USPTO for an interactive “bootcamp” for those new to the field (or that just need a refresher.) USPTO will share information on trademark basics such as navigating the e-filing system, responding to common Office Action refusals, and the nuts and bolts of how the USPTO searches for ‘confusingly similar’ trademarks.</em>&lt;br&gt;&lt;br&gt;<strong>Speaker:</strong>&lt;br&gt;Jennifer Williston, Managing Attorney, USPTO</td>
<td><strong>Obtaining Foreign Registration in the United States</strong>&lt;br&gt;Get insider tips on prosecuting trademarks before the USPTO based on Lanham Act Sections 44 and 66(a). Learn how to help your international clients obtain and maintain trademark registrations in the United States, the common pitfalls encountered with Sections 44 and 66(a), and how to overcome them.&lt;br&gt;&lt;br&gt;<strong>Speaker:</strong>&lt;br&gt;Jennifer Chicoski, Administrator for Trademark Policy, Procedure, and Practice, USPTO</td>
</tr>
<tr>
<td>3:30 pm – 4:30 pm</td>
<td><strong>Best Practices in Trademark Searching, Prosecution &amp; Maintenance</strong>&lt;br&gt;Hear from experienced trademark practitioners on “best practices” in U.S. federal trademark searching, prosecution and maintenance, including pre-filing best practices, tips and considerations in overcoming substantive refusals and helpful insight in post-registration</td>
<td><strong>The Far Reaches of Trademarks: Non-Traditional Marks at the USPTO</strong>&lt;br&gt;Hear from the USPTO about “non-traditional” trademarks and learn what to consider when applying for federal registration of these marks.&lt;br&gt;&lt;br&gt;<strong>Speaker:</strong>&lt;br&gt;Susan Hayash, Managing Attorney, USPTO</td>
</tr>
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maintenance.

**Panelists:**
Tracy L. Deutmeyer, Fredrikson & Byron, P.A., Des Moines, Iowa
Christina D. Frangiosa, Eckert Seamans Cherin & Mellott, LLC, Philadelphia, PA
Josh Gerben, Gerben Law Firm PLLC, Washington, D.C.

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<tr>
<td>4:30 pm - 6:00 pm</td>
<td>NETWORKING RECEPTION: National Inventors Hall of Fame and Museum</td>
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State of the Trademark office

Commissioner for Trademarks
Mary Boney Denison

September 18, 2019

Images used in this presentation are for educational purposes only.
Trademarks organization staffing

- 953 Trademarks employees (approximately 7% of USPTO)
- 639 examining attorneys (67% of Trademarks)
- 83% of examining attorneys telework
- Hired 61 new examining attorneys in FY 2018; hired 83 in FY 2019. Anticipate hiring approximately 40 in FY 2020
New application filing projections

- FY 2016: 530,270 classes filed
- FY 2017: 594,107 classes filed
- FY 2018: 638,847 classes filed
- FY 2019 projection: 646,000 classes filed (~1.0 % increase from FY 2018)
Pendency initiative

FY19 TM Pendency Initiative

FINAL RESULTS

709,498 BDs

As of 4/1/2019

655,920 BDs
Total number of BDs needed by March 31, 2019
## Trademarks performance: Pendency

<table>
<thead>
<tr>
<th>FY 2019 Trademarks performance measures</th>
<th>FY 2019 targets</th>
<th>FY 2019 May results</th>
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</thead>
<tbody>
<tr>
<td><strong>First action pendency</strong></td>
<td></td>
<td></td>
</tr>
<tr>
<td>First action pendency from date of filing to the first office action in months</td>
<td>2.5 – 3.5</td>
<td>2.3</td>
</tr>
<tr>
<td><strong>Disposal pendency</strong></td>
<td></td>
<td></td>
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<tr>
<td>Disposal pendency from date of filing to issuance of a notice of allowance, registration, or abandonment – excluding suspended and <em>inter partes</em> proceedings.</td>
<td>12.0</td>
<td>9.9</td>
</tr>
</tbody>
</table>
# Trademarks performance: Quality

<table>
<thead>
<tr>
<th>FY 2019 Trademarks performance measures</th>
<th>FY 2019 targets</th>
<th>FY 2019 May results</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>First action compliance</strong></td>
<td></td>
<td></td>
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<tr>
<td>In-process review evaluation of the statutory bases for which the USPTO raises issues and/or refuses marks for registration based on the first office action</td>
<td>95.5%</td>
<td>96.4%</td>
</tr>
<tr>
<td><strong>Final action compliance</strong></td>
<td></td>
<td></td>
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<tr>
<td>In-process review evaluation of the statutory bases for which the USPTO raises issues and/or refuses marks for registration based on the examining attorney’s approval or denial of the application</td>
<td>97.0%</td>
<td>97.0%</td>
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<tr>
<td><strong>Exceptional office action</strong></td>
<td></td>
<td></td>
</tr>
<tr>
<td>Measure indicating the comprehensive quality of the first office action search, evidence, writing, and decision making</td>
<td>46.0%</td>
<td>55.2%</td>
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Letter of protest and petition pendency

As of June 24, 2019:

- 436 letters of protest, pendency is 1.75 months
- 607 Petitions to the Director, pendency is approximately 6.5 months

• Two examining attorneys began six-month details to assist with the backlog in May 2019, and we hired two full-time petitions attorneys in June 2019
# Letters of protest

<table>
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<th>FY2018 Pre Publication</th>
<th>FY2018 Post Publication</th>
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<tr>
<td>Percentage of LOPs filed pre publication that were granted:</td>
<td>Percentage of LOPs filed post publication that were granted:</td>
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<tr>
<td>75.30%</td>
<td>5%</td>
</tr>
<tr>
<td>Average percentage of LOPs granted in which Examining Attorney issued an Office action:</td>
<td>Percentage of post-publication LoPs granted in which Examining Attorney issued an Office action:</td>
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<tr>
<td>44.9%</td>
<td>100%</td>
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Quality and training

• Opportunity for ABA-IPL members to quality review examining attorney office actions
  – Assist in identifying training needs
  – Suggest improvements to form paragraphs and office action templates
• Interested? Let us know how many office actions to send.
E-government statistics

- Original goal was to have all applications submitted electronically; currently, we are at 99.9%.
- The goal shifted from all applications submitted electronically to two-way electronic communication throughout the entire registration process.
- We will continue to encourage end-to-end electronic processing by users.
- We are planning to implement mandatory electronic filing in FY 2019.
LAW AND POLICY
Rulemaking

U.S. counsel requirement

• New rule requires foreign-domiciled trademark applicants and registrants to be represented by a U.S.-licensed attorney to file trademark documents with the USPTO
• Rule would:
  – Ensure effective use of available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements
  – Increase confidence that registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims
  – Aid our efforts to improve accuracy of the U.S. Trademark Register
• Final rule published in Federal Register on July 2, 2019, effective as of August 3, 2019
Rulemaking

U.S. counsel requirement – impact on U.S. licensed attorneys

• Bar membership information and status as active member in good standing required
• Owner address required
• Beware of foreign solicitations – persons located internationally offering to pay to use your bar information to circumvent the rule
Rulemaking

Mandatory electronic filing

- Notice of final rulemaking drafted
  - Publication and implementation this year.
  - Rule will make using TEAS mandatory for all trademark filings and require communication with the USPTO via email
  - Exceptions:
    - International agreements requiring acceptance of paper submissions from certain countries
    - Specimens for scent, flavor, or other non-traditional marks
    - Petition process for requesting acceptance of paper submissions under limited circumstances
    - Postal service interruptions or emergencies

- uspto.gov/trademark/laws-regulations/mandatory-electronic-filing
Rulemaking

Mandatory electronic filing – petitions to accept paper

• 2.147(a) – petitions to accept paper when TEAS is unavailable on the date of a filing deadline
• 2.147(b) – petitions to accept certain papers timely filed before the date of a filing deadline
• 2.147(c) – petitions under Rule 2.146
Proposal to withdraw statements of use

• Legal policy attorney drafting a Notice of Proposed Rulemaking

• Reviewing an earlier draft of a similar proposed change
Marijuana-related trademarks

• New exam guide released May 2, 2019
• Discusses possible implications of various federal laws on whether commerce involving cannabis (“CBD”) and cannabis-related goods and services is lawful
• 2018 Farm Bill and corresponding amendments to the Controlled Substances Act (“CSA”) remove “hemp” (defined as cannabis containing less than .3% THC) as a controlled substance
• Even if the CSA does not apply, many marks for CBD and hemp products are not lawful as they may still violate other laws.
• Factors relevant to determining how marks for CBD and CBD-derived goods and related services are handled by the USPTO include:
  – Is the filing date of the application before or after the December 20, 2018 effective date of the Farm Bill?
  – Are the goods in fact derived from “hemp” and identified accordingly in the identification of goods/services?
  – Do the Food Drug and Cosmetic Act (FDCA) or other federal laws apply?
Marijuana-related trademarks

• Cannabis marks are examined by a specialized group of examining attorneys.

• Recently increased the number of examiners handling the marks from 10 to 14
Section 2(a)

• The Supreme Court issued Brunetti decision on June 24, 2019 holding the immoral or scandalous provision of Section 2(a) unconstitutional.
• Examination Guide to be issued Summer 2019
INITIATIVES
Improper behavior

- Submitting fake or altered specimens
- Submitting false claims of use in U.S. commerce
- Using unauthorized practitioners
- Making unauthorized address changes
- Misleading Solicitations
- Trying to circumvent U.S. counsel rule
Addressing bad behavior

**Proof of use audit program**
The USPTO began a pilot program in 2012 and made it permanent in 2017, giving the USPTO the authority to cancel audited registrations with unsubstantiated use claims or to delete unsupported goods and services.

**Excluded unauthorized foreign practitioners**
The commissioner has excluded specific foreign practitioners from appearing before the USPTO.

**Proof of actual use in examination**
Examiners have been trained about the issues posed by mocked-up and fake specimens and to use the 37 CFR §2.61(b) request for information authority to request proof of actual use when refusing registration because the specimen does not show use of the mark in commerce.
Addressing bad behavior

**Improved readability of declaration** The declaration was reformatted to make it more readable and to make the signer acknowledge the required statements by checking a box next to each one, thereby increasing the likelihood that the signer will read the declaration and appreciate the significance of swearing to use for each and every good or service listed.

**Expedited cancellation pilot for non-use or abandonment claims**
Implemented TTAB pilot program for cases raising non-use or abandonment claims to identify the types of procedures needed to accelerate disposition of those claims; considering whether to make permanent.

**Issued U.S. counsel final rulemaking**
The USPTO issued a final rule requiring all foreign-domiciled trademark applicants and registrants to be represented before the USPTO by a lawyer licensed to practice law in the U.S.

1. **Specimen database:** Developing specimen database to enable examining attorneys to see highly similar specimens used by multiple applicants

2. **Login:** To prevent unauthorized changes, USPTO will be implementing a login system requirement for all filings
Decluttering initiative: Proof-of-use audit program

• Permanent program launched November 1, 2017
• The program improves the integrity of the Trademark Register.
  – Allows us to cancel audited registrations with unsubstantiated use claims or remove unsupported goods and services from others
• Your registration may be audited if you meet both requirements:
  – You filed a Section 8 or 71 declaration of use.
  – Your registration includes at least one class with four or more goods or services, or at least two classes with two or more goods or services.
• If audited, we will require submission of proof of use for additional goods/services in registration to ensure that register accurately reflects marks that are in use in the United States for all goods/services identified in registrations.
• [uspto.gov/trademarks-maintaining-trademark-registration/post-registration-audit-program](http://uspto.gov/trademarks-maintaining-trademark-registration/post-registration-audit-program)
Proof-of-use audit program results so far
November 2017 – May 31, 2019

• 4,091 first actions issued by examiners on project
• 2,538 responses received
• 50.4 percent of registrations with response deleted at least some goods or services
• 79 percent of respondents represented by an attorney
• 21 percent of respondents pro se
Unauthorized changes

- Unauthorized parties have filed forms through TEAS making changes to trademark records.
- These instances affect a very small number of total applications and registrations.
- We created a webpage where customers can get information on steps to take, if impacted by an unauthorized change (search “unauthorized changes” on uspto.gov).
Action plan

Short-term solutions
• Assigned full-time staff to monitor this issue and contact affected customers
• Created a [webpage](search “unauthorized changes” on www.uspto.gov) (search “unauthorized changes” on www.uspto.gov)

Long-term solutions
• TEAS log in with authentication and authorization (customized COTS product)
Phase 1 – Fall 2019

• Use an existing uspto.gov account or sign up for a new one at [http://my.uspto.gov](http://my.uspto.gov)

• Log in through [http://my.uspto.gov](http://my.uspto.gov) or click on the TEAS form you want to use and you will be prompted to log in

• Once logged in, file as usual through TEAS
Phase 1 – Fall 2019

MyUSPTO has three ways to provide two-step authentication:

1. Email
   - A six-digit code will be sent to the primary email address associated with your uspto.gov account.
   - If the code is not used within 20 minutes, it will no longer be active and a new code will need to be requested.

2. Authentication app
   - A six-digit code will be generated by a RFC 6238-compliant authenticator app.
   - In order to be used, the application will need to be installed and configured on your device.

3. Phone call
   - A six-digit code will be generated and a phone call made to the verified number on your account. You must verify and enable the number through your account page.
Phase 2 – Winter 2019/2020

- Current and new uspto.gov account holders will verify their identity.
- Identity proofing prevents “impostor” accounts.
Phase 3 – Spring 2020

• Customers will be able to create roles and delegate authority to other accounts.
  – Attorneys may authorize multiple staff accounts to access and edit filings.
  – Customers may restrict any unauthorized users from making changes to an application or registration.
Misleading solicitations

**Collaboration:** We’re collaborating with stakeholders to find solutions.
- Informal interagency working group on combatting fraudulent solicitations
- 2017 roundtable with TPAC and numerous bar groups and government agencies
- TM5 project co-led by the European Union Intellectual Property Office (EUIPO) and the USPTO

**Education:** We’re warning applicants and registrants at key stages.
- Warnings on application filing receipts, office action cover emails, and paper notices mailed with each trademark registrations
- Examples of notices and video explanation on our webpage “Caution: Misleading notices”

**Prosecution:** We’re working with DOJ on criminal prosecutions.
- 2017: Two men pled guilty to stealing $1.66 million from U.S. trademark applicants and registrants; the third man was convicted.
- 2018: We sent two attorneys to DOJ to work on criminal prosecutions.
- 2019: We extended the attorneys’ work with DOJ USPTO on criminal prosecutions.
Specimen issues

• Mocked-up or fake specimens are a problem.
• Issues are much more sophisticated.
• Applicants are pasting their marks on products or services of others to show use in commerce.
• We are doing our best to refuse the fraudulent specimens.
• We started an internal pilot program using digital forensic services to help us.
Mock-ups and digitally altered specimens

• Fake specimens present several issues:
  – Fail to show mark as used in commerce
  – Fraud on the USPTO
  – Discipline by the Office of Enrollment and Discipline (OED)
  – Impact on validity of registration
Specimen protest pilot program
Specimen protest pilot program
Specimen protest pilot program

• Streamlined process for public to report improper specimens
• Email submissions should include either:
  – Objective evidence of third party use of images identical to the specimen of record.
  – Registration or serial numbers showing identical specimens bearing different marks.
• Additional submission guidelines and details on the process are on our website under “Recent postings.”
• Specimens mailbox email address: TMSpecimenProtest@uspto.gov
Specimen rule revision

• Proposed revision to Rule 2.56 with the new mandatory electronic filing rule
• Updated language codifies current specimen requirements in case law and the TMEP. For example:
  – Requires URL and access or print date for webpage specimens
  – Requires that specimens show use of the mark placed on the goods, on containers or packaging for the goods, or on labels/tags affixed to the goods
Additional rule proposals

• Section 7 deletion fee waiver
  • Fee waiver for Section 7 amendments that request deletion of goods and services from a registration that is not under audit or involved in a TTAB proceeding

• Section 7 correction fee for deletions during audit
  • Fee charged for deleting goods and services from audited registrations
  • Registration cancelled if fee not paid
Additional rule proposals

• Affirmations of use in initial disclosures in TTAB proceedings
  • Require affirmative statements in mandatory initial disclosures from parties in TTAB proceedings that registered marks or marks in use-based applications are in use with all goods/services in registration/application
  • Require affirmative statements from attorneys and pro se owners attesting that they took action to confirm use with all goods/services in applications/registrations as of filing date

• Fees
  • Charge additional fees for more than a set number of goods/services in a class
Special task force

• Developed in response to the significant increase in unauthorized and improper activities in connection with trademark filings
• Goals include:
  – Developing and implementing policies, procedures, and technology solutions to effectively address fake/altered specimens, false claims, unauthorized TEAS submissions, and other efforts to circumvent the Rules of Practice in Trademark Cases
• The task force will reach out to other federal agencies for best practices and feedback on available technical solutions for privacy and fraud detection.
Anti-counterfeiting efforts

- New Trademark Information Network (TMIN) video
- 2018 video contest
- June 6 anti-counterfeiting event with The McCarthy Institute
- Nationwide campaign in the works
Efforts to enhance customer experience

• FY 2018-2019 focus areas include:
  – Implementing four customer touchpoint surveys on:
    • Trademark Assistance Center
    • Website content
    • MyUSPTO
    • Application prosecution
  – Dramatically improving our website so customers can find, understand, and use the information they need
    • This includes improving the organization of materials and adding information on advanced topics such as petitions’ decisions.
  – Improved TESS guidance includes:
    • “Get ready to search – classification and design search codes”
    • “Using the Trademark Electronic Search System”
INTERNATIONAL
TM5

• Comprised of the 5 largest trademark offices:
  – China National Intellectual Property Administration (CNIPA)
  – European Union Intellectual Property Office (EUIPO)
  – Japan Patent Office (JPO)
  – Korean Intellectual Property Office (KIPO)
  – USPTO

• Focuses on exchange of information and collaboration and harmonization projects regarding trademark matters to benefit users

• Projects include, among others:
  – Combatting Bad Faith Filings
  – Common Status Descriptors
  – ID List
  – Non-traditional Marks
  – Image searching
  – Anti-Counterfeiting
  – Misleading (Fraudulent) Solicitations
2019 TM5 Events

• The 2019 TM5 Midterm Meeting was conducted on May 18 in Boston where the Partners provided progress reports and mapped future plans of each of the 15 common projects and several new proposed projects.

• On May 19, TM5 held its user session during the INTA Annual Meeting in Boston, which included updates and presentations on TM5 and the projects.

• TM5 and INTA cohosted a workshop during the INTA Annual Meeting in Boston on combatting bad faith filings. This popular session brought together users and IP offices from all over the world to discuss how they are handling bad faith trademark applications and the way forward.

• 2019 TM5 Annual Meeting in Tokyo, Japan, December 9-11, hosted by JPO with an invited user session on December 11 and a special TM5 (closed) session on quality management December 9.
TM5 ID list

- TM5 ID list search tool posted on the TM5 website: http://tmfive.org/
- As of June 5, 2019, the TM5 ID list contained 19,732 pre-approved terms that are acceptable to all partner offices.
IP Attaché's Around the World
CHINA
Focus on China

• Influx of Chinese filings
• Specimen issues
• Counterfeiting
• Bad faith filings
U.S. filings by applicants in China

![Bar chart showing U.S. filings by applicants from China from 2013 to 2019. The chart displays the number of filings per year, with a clear increase over time. The data is broken down by different filing types, with the years and corresponding numbers as follows:

- 2013: 4,704
- 2014: 6,287
- 2015: 13,616
- 2016: 28,763
- 2017: 51,018
- 2018: 58,131
- 2019: 39,674]
IT RESOURCES
My.USPTO.gov

• Trademark docket
  – Share collections in dockets with other MyUSPTO users

• Trademark form finder widget
  – Widget identifies forms using plain language rather than current form names
  – Includes a search box to search the form names

• Next widget: Trademark Electronic Application System (TEAS) Plus Short Form
  – Initial scope: Intent-to-use (ITU) word marks, TEAS Plus fee basis
USPTO TM Status App

- Available on Apple App Store and Google Play
- Search application and registration numbers
- Notifications of selected status changes
- Reflects updated status changes within minutes
- Share, bookmark, or create notebooks for saving information
- No account necessary
Stay informed

Sign up to receive updates and announcements on upcoming Trademarks system changes, events and roundtables, rule changes, and other Trademarks Operations matters.
Hot Topics at TTAB: Expedited Cancellation Proceedings, the Standard Protective Order, Best Practices for Pleadings, Limits on Discovery Requests and Recent Developments

Administrative Trademark Judge Michael Adlin, Interlocutory Attorneys Elizabeth Winter and Catherine Faint
7th Annual ABA—IPL Day with the USPTO
September 18 2019
Overview

- Pilot Expedited Cancellation proceedings and ACR
- Standard Protective Order changes
- Best practices for pleadings and evidence
- Recent limits on the number of Discovery Requests
- Other recent developments
Teleconferences

• “Whenever it appears to the Trademark Trial and Appeal Board that a stipulation or motion filed in an inter partes proceeding is of such nature that a telephone conference would be beneficial, the Board may, upon its own initiative or upon request made by one or both of the parties, schedule a telephone conference.” (37 CFR § 2.120(j)(1))

• Matters include:
  – Discovery conferences, motions to compel, motions to quash notice of deposition, extensions, suspensions, provide progress report on status of settlement negotiations, or to resolve complex procedural issues

• To request a teleconference call the Board attorney assigned to the proceeding. TBMP § 502.06(a)
Pilot Expedited Cancellation Proceeding
Pilot Expedited Cancellation proceeding

• Instead of drafting a proposed rule on separate “streamlined” proceeding, TTAB has commenced a pilot program focusing on use of existing ACR tools in an “expedited” cancellation proceeding.

• See “News and Notices” section on TTAB section of USPTO webpage, with link to background, how it works, how to participate and program goals and expected duration
Pilot program objectives

- Identify abandonment and non-use cancellation cases most suitable for some sort of “expedited” proceeding
- Discuss with parties application of ACR procedures that could be used most effectively in such proceedings
- Involve Board attorneys and judges participating in discovery conferences in cases that Board identifies as suitable candidates
Pilot program – early results

• More than 80 cases found eligible to date
• Nearly 50 conferences held to date, and orders for conferences have been issued in multiple cases
• 12 sets of parties agreed to use of some form of ACR and a number of others agreed to consider ACR as the case progressed, or to discuss the possible use of ACR with the assigned interlocutory attorney at a later conference
• TV Azteca, S.A.B. de C.V. v. Martin, 128 USPQ2d 1786 (TTAB 2018)
Pilot program – early findings

• Cases involving no or limited discovery are better candidates for inclusion in pilot.

• Some parties are comfortable agreeing to cross-motions for summary judgment type of ACR; but retaining right to take some discovery.
Pilot program – future uses?

- Identify (1) possible changes to Trademark Rules to support a separate new expedited cancellation proceeding, (2) possible expansion of early intervention pilot into cases involving other issues, and (3) possible adaptation of current ACR procedures.
Accelerated Case Resolution ("ACR")
ACR

- Parties seeking a final determination of their opposition or cancellation proceeding quickly and without the time and expense of a full trial should consider the TTAB’s “Accelerated Case Resolution” (ACR) procedure. See TBMP § 702.04.
- ACR is a procedure akin to summary judgment in which parties can receive a determination of the claims and defenses in their case promptly, but without the uncertainty of result and delay typically presented by standard summary judgment practice.
ACR - background

- When either party to a Board case concludes that resolution of the opposition or cancellation proceeding without extensive discovery or trial periods may be desired, the party should notify the interlocutory attorney.
- Preferably such notice would be provided during the required settlement and discovery conference to be held within 30 days of the pleadings closing. Then, the possible use of ACR can be discussed during the conference.
- Parties may discuss telephone conference with interlocutory attorney to discuss use of ACR.
ACR – procedure to elect

• Even if the ACR option is not chosen during the discovery conference, the parties may agree to pursue ACR after some disclosures and discovery.

• In such cases, the interlocutory attorney should be notified no later than two months from the opening of the original discovery period.

• The further the parties proceed into discovery, the less likely it is that will resort to ACR, and will realize savings of time and resources.
ACR – typical case

• A typical ACR case is anticipated to be one in which the parties are able to stipulate to many facts, or in which each party expects to rely on the testimony of only one or two witnesses and the overall record is not extensive.

• Clearly worded stipulations are vital.
ACR – procedure of case

• In order to take advantage of ACR, the parties must stipulate that, in lieu of trial, the Board can resolve any issues of material fact.
• The parties may include evidence with their briefs, including written disclosures and disclosed documents, and stipulate to facts for the Board to consider. After the briefs are filed, the Board will issue a decision on the merits within fifty days, which will be judicially reviewable as set out in 37 CFR § 2.145.
• If the parties have already filed cross-motions for summary judgment, they may also stipulate that the Board may resolve any issues of material fact and consider the parties’ cross-motions as the parties’ final briefs in the case in lieu of a full trial.
Declaration testimony

• Under TTAB rules a party can elect to present testimony by affidavit or declaration, in lieu of testimony deposition. Adverse party can elect to cross-examine declarant. 37 CFR § 2.123(a)(1)

• Only evidence admissible under Rules of Evidence may be presented by affidavit or declaration; inadmissibility is a valid ground for objection. 37 CFR 2.122(a) and 2.123(l).
Declaration testimony

• Party electing to cross declarant bears expense of travel and court reporter. TBMP 703.01(b); *RPost Communication, supra*; and *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1166-67 (TTAB 2017).

• **ATJ Tip:** parties often choose not to cross-examine declarants, but TTAB judges may find the cross helpful in fleshing out the issues.

• *See* TBMP § 703.01(d) and (e) for timing, procedures.

• Proffering party obligated to produce declarant. TBMP § 703.01(b).
ACR – typical stipulations

- Parties, however, may stipulate to ACR-type efficiencies at any stage of a proceeding in order to expedite the remainder of the trial schedule.
- Parties seeking to avail themselves of such efficiencies may stipulate to, for example:
  - abbreviating the length of the testimony period;
  - limiting the subject matter for testimony;
  - agreeing to limit the number of witnesses; or
  - agreeing to streamline the method of introduction of evidence, for example, by stipulating to facts and introduction of evidence by affidavit or declaration.
TTAB - Standard Protective Order
TTAB - Standard Protective Order

TTAB Standard Protective Order (last revision June 24, 2016)
- Automatically imposed in *inter partes* proceedings
  - Applies to all pending and new cases
  - Exceptions apply
- Parties may modify by stipulation subject to Board approval
- Covers:
  - Discovery including disclosures (required and supplemental)
  - Testimony by declaration/affidavit as well as deposition
  - 2 tiers of designations:
    - Confidential
    - Confidential- attorneys eyes Only (‘AEO’) (trade secret/commercially sensitive, personal health, medical and financial information)
TTAB - Standard Protective Order, cont’d

Features include:

• Clawback provision for inadvertent disclosure
• Limitations on shielding information:
  – Parties, including “in-house” counsel, do NOT have access to documents designated as “AEO,” even if the document does not entirely contain “AEO” information.
  – The “AEO” designation should be limited to information that “can be used in the operation of a business or other enterprise and that is sufficiently valuable and secret to afford an actual or potential economic advantage over others.” United States Polo Ass’n v. David McLane Enterprises, Inc., 2019 USPQ2d 108442 (TTAB 2019).
  – Demonstration of “good cause” for “AEO” designation required. See id. The party seeking to limit information bears the burden of demonstrating that its confidentiality designations are appropriate, and “must show that disclosure would cause a clearly defined serious injury to its business such as harm to its competitive and financial position” and that fear of harm is not speculative. Id.; see also TBMP § 412.01.
  – When a party chooses to rely on the testimony of a witness at trial, the party has waived the protection provided to trade secret/commercially sensitive information, and can no longer shield the identity of the witness. Hunter Indus., Inc. v. The Toro Co., 110 USPQ2d 1651, 1656 (TTAB 2014).
TTAB - Standard Protective Order, cont’d

Expanded call for input on SPO:
• Comment period closed June 30, 2019
• Six questions/subjects for comment
  – Access to attorneys’ eyes only (trade secret or commercially sensitive) information/material?
  – Three tiers or two, of confidentiality?
• Comments received to date are split
  – Overall, no clear consensus for changes on in-house access to AEO or on the number of tiers of confidentiality
  – Comments representing customer groups or companies
  – 2 votes for, 2 against, 1 compromise suggestion on in-house access to AEO
  – 4 votes for keeping two tier designations
Pleading Your Case
Pleading your case

• Notice pleading, not a time to prove your case
• **ATJ tip:**
  – *Always* attach proof of pleaded registration. *Hewlett-Packard Co. v. Olympus Corp.*, 18 USPQ2d 1710 (Fed. Cir. 1991) ("The Trademark Rules provide a means for implementing this proof of a *prima facie* case. ... These rules are simple and clear, but Hewlett did not follow them."); *Gillette Canada Co. v. Robin Research Lab., Inc.* (Opposition No. 91124984; April 12, 2005) at 17 TTABVUE, Reconsideration denied at 21 TTABVUE.)
Pleading your case

• When facing MTD under FRCP 12(b)(6), consider amendment as matter of course – it’s just business.
• As the defendant, think about mandatory counterclaims.
• ATJ tip: As defendant do not include arguments regarding 2(d) elements as affirmative defenses, or open-ended reservation of rights.
• ATJ quip: Motions to strike just don’t matter.
  – They can cause delay.
Pleading your case

• As defendant also think about permissive counterclaims and appropriate defenses.

• Would resort to Section 18 be helpful? See *Embarcadero Tech. Inc. v. RStudio Inc.*, 105 USPQ2d 1825 (TTAB 2013).

• Interlocutory attorneys will strike matter when they need to review pleadings; helps avoid discovery disputes. May convene phone conference to handle pleading motions.
Pleading problems impact discovery

- Insufficient or inapplicable claims
- Blanket defenses without supporting facts
- Assert proper/mandatory counterclaims or they may be waived.
Review your pleading, often

• **Tip from the Chief Judge:**
  – Consider amendments after receipt of disclosures or discovery; prior to filing MSJ; as part of pre-trial planning.
  – Avoid reliance on issue having been tried by implied consent; and risk of having issue found not tried by implied consent. *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921 (TTAB 2011).
  – Don’t wait until briefing to articulate a new basis for your case. *Id.* (petitioner raised family of marks issue for first time in brief).
Discovery Rules
TTAB Rules: Discovery

• TTAB Rules expressly require proportionality in process and procedure - 37 CFR § 2.120(a)(1)
• Initial disclosure and expert disclosure deadlines remain the same
• Must serve discovery early enough so that responses (including production or inspection) will be due no later than the close of discovery - 37 CFR § 2.120(a)(3)
Discovery deadlines

- **Trans-High Corp. v. JFC Tobacco Corp., 127 USPQ2d 1175 (TTAB 2018)**
  - The timing to serve discovery requests is bounded by the specified time period for the close of discovery. Thus, where the close of discovery has not yet passed, the time for serving requests is effectively reset under the good cause standard and the excusable neglect standard is inapplicable.

  - Discovery requests must be served with at least thirty-one days remaining in the discovery period, regardless if day of service falls on a weekend or holiday.
Discovery conference

• The parties have a shared burden to arrange and conduct the discovery conference, regardless of whether the Board will be participating. Promgirl Inc. v. JPC Co., 94 USPQ2d 1759 (TTAB 2009); Influance, Inc. v. Elaina Zuker, 88 USPQ2d 1859 (TTAB 2008).

• Board may upon request or sua sponte schedule discovery conference with Board participation. 37 CFR § 2.120(a)2(i)

• No recording of conference permitted 37 CFR § 2.120(j)(3)
TTAB Rules: Limits on Discovery Requests

• Limits on discovery requests
  – 75 Interrogatories, 75 Requests for Admission, and 75 Requests for Production
    o 37 CFR §§ 2.120(d), (e) & (i)
  – May move for good cause to exceed limits
    o 37 CFR §§ 2.120(d), (e) & (i)
  – One comprehensive RFA to authenticate specific documents produced by adverse party
    o 37 CFR § 2.120(i)

• Discoverable items include ESI as well as documents and tangible things - 37 CFR §§ 2.120(e) & (f)
TTAB Rules: Discovery response times

• Response Times
  – Additional 5 days for acting within prescribed period no longer allowed - 37 CFR § 2.119(c)
  – All 15-day response and reply deadlines for briefing a motion are amended to 20 days - 37 CFR § 2.127(a)
  – Summary judgment motions: time for response or filing of motion under Fed. R. Civ. P. 56(d) remains at 30 days; reply is amended to 20 days - 37 CFR § 2.127(e)(1)
  – Responses to written discovery: remain 30 days in accordance with Fed. R. Civ. P. 33, 34 & 36 - 37 CFR § 2.120(a)(3)
Discovery extensions

• No per se “cap” on number of extensions of discovery period
• But extensions should be limited
• If too many extensions are requested, Board may condition further extensions upon a required showing, or may deny further extensions entirely – Cf. 37 CFR § 2.117(c)
• Expert disclosure deadline must always be scheduled prior to the close of discovery - 37 CFR § 2.120(a)(2)(iv)
Discovery motion deadlines

• Motion for sanctions for failure to cooperate in scheduling discovery conference due prior to the deadline for initial disclosures. 37 CFR § 2.120(h)(1)
• Motion to compel initial disclosures due 30 days after deadline for initial disclosures - 37 CFR § 2.120(f)(1)
• Motion to compel discovery or to test sufficiency of responses to RFAs must be filed before the day of the deadline for the first pretrial disclosure - 37 CFR §§ 2.120(f)(1) & (i)(1)
  – Once deadline passes, any subsequent resetting of first pretrial disclosure deadline will not reset the time to file a motion to compel
Dispositive motions

• Filing motion that is potentially dispositive of any aspect of a proceeding automatically suspends case - 37 CFR § 2.127(d)

• Motions for summary judgment must be filed before the day of the deadline for plaintiff to make pretrial disclosures - 37 CFR § 2.127(e)(1)
  – Once deadline passes, any subsequent resetting of first pretrial disclosure deadline will not reset the time to file a motion for summary judgment
  – Parties may stipulate to an abbreviated trial

• These changes intended to avoid surprises on the eve of trial
U.S. Counsel Rule
U.S. Counsel Required for Foreign-domiciled Applicants August 3, 2019

• Foreign-domiciled trademark applicants, registrants, and parties to Trademark Trial and Appeal Board proceedings, including Canadian trademark filers, must be represented at the United States Patent and Trademark Office (USPTO) by an attorney who is licensed to practice law in the United States. 37 CFR § 11.14

• U.S.-licensed attorneys representing trademark filers must provide all of the following:
  – Their name, postal address, and email address
  – Information concerning their bar membership (state, number if applicable, and year of admission).
Goals of the rule

The rule is intended to:

• Increase USPTO customer compliance with U.S. trademark law and USPTO regulations
• Improve the accuracy of trademark submissions to the USPTO
• Safeguard the integrity of the U.S. trademark register
Who is considered foreign-domiciled?

• An individual with a permanent legal residence outside the United States or its territories
• An entity with its principal place of business (headquarters) outside the United States or its territories
U.S. licensed attorneys

- Paper and electronic trademark submissions made after the effective date of this rule will require U.S.-licensed attorneys representing applicants, registrants, or parties in matters before Trademarks and TTAB to provide all of the following:
  - Their name, postal address, and email address.
  - Information concerning their bar membership (state, number if applicable, and year of admission).

- Electronic submissions are filed online through TEAS.
  - Attorney bar information will not be made publicly available when submitted to Trademarks through the TEAS forms.
  - Until an ESTTA form is available, in order not to make attorney bar information publicly available, the information may be submitted by selecting "confidential" in the ESTTA filing.
Beware of foreign solicitations asking to use your information

- USPTO discovered that U.S.-licensed attorneys are receiving emails offering to pay to use their attorney identification information in trademark filings. These solicitations appear to be an attempt to circumvent the rule requiring U.S. counsel representation at the USPTO.

- Agreeing to such arrangements would likely be aiding the unauthorized practice of law and would violate our rules, including the Rules of Professional Conduct, 37 C.F.R. Part 11. Under our rules, attorneys must:
  - Conduct a reasonable inquiry, before submitting any filing, to determine that the filing is not being presented for any improper purpose and that the facts have evidentiary support
  - Personally sign filings and correspondence.

- Sanctions for violating these rules could include striking the filing, terminating the proceedings, and referring the attorney to the USPTO’s Office of Enrollment and Discipline (OED) for appropriate action. In addition, attorneys could be disciplined for such violations, including exclusion or suspension from practice before the USPTO, reprimand, censure, or probation. Attorneys disciplined by the USPTO also may be disciplined by their state bar.

- If you receive solicitations asking to use your attorney identification information, please forward them to TMFeedback@uspto.gov.

- See the new exam guide: Requirement of U.S.-Licensed Attorney for Foreign Trademark Applicants and Registrants
Questions?
Introduction to the hearing case: *In re QVC, Inc.*

Frances Wolfson
Administrative Judge, Trademark Trial and Appeal Board (TTAB)
September 18, 2019 - 7th Annual ABA IPL Trademark Day
In re QVC, Inc.  Serial No. 86670074

DENIM & CO.

PSEUDO MARK:
DENIM AND COMPANY

“The mark is in standard characters, without claim to any particular font style, size or color”
Claim of ownership – Applicant is the owner of U.S. Registration No. 1982121

- **DENIM & CO**
- Register: Principal
- Disclaimer: "DENIM"
- Goods: Women's clothing made in whole or significant part of denim, namely jeans, pants, shirts, jackets, skirts, leggings, and T-shirts
Trademark Day Page 110

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 1,982,121
Registered June 25, 1996

TRADEMARK
PRINCIPAL REGISTER

DENIM & CO

QVC, INC. (DELAWARE CORPORATION)
1365 ENTERPRISE DRIVE
WEST CHESTER, PA 19380

FOR: WOMEN'S CLOTHING MADE IN
WHOLE OR SIGNIFICANT PART OF DENIM,
NAMELY JEANS, PANTS, SHIRTS, JACKETS,
SKIRTS, LEGGINGS AND T-SHIRTS, IN CLASS
25 (U.S. CLS. 22 AND 39).

FIRST USE 1-9-1994; IN COMMERCE

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "DENIM", APART FROM THE
MARK AS SHOWN.

SER. NO. 74-621,125, FILED 1-12-1995.

JERI J. FICKES, EXAMINING ATTORNEY
DENIM & CO.

“WOMEN’S CLOTHING,
NAMELY, SHIRTS, DRESSES, SKIRTS, TOPS, BOTTOMS, SWEATERS, SHORTS, PANTS, JACKETS,
LEGGINGS, T-SHIRTS MADE IN WHOLE OR SUBSTANTIAL PART OF DENIM;

AND MADE OF MATERIALS OTHER THAN DENIM

ALL SOLD THROUGH INTERACTIVE TELEVISION AND INTERACTIVE ONLINE MEDIA
WHEREIN THE CLOTHING PRODUCTS OFFERED FOR SALE ARE MODELED
AND WHEREBY DETAILED INFORMATION REGARDING SUCH CLOTHING PRODUCTS IS
PROVIDED INCLUDING INFORMATION AS TO THE FABRICS AND MATERIALS FROM WHICH
SUCH CLOTHING PRODUCTS ARE MADE”
Disclaimer of “DENIM”

• FOR

– "WOMEN'S CLOTHING, NAMELY, SHIRTS, DRESSES, SHIRTS, TOPS, BOTTOMS, SWEATERS, SHORTS, PANTS, JACKETS, LEGGINGS, T-SHIRTS MADE IN WHOLE OR SUBSTANTIAL PART OF DENIM"
Deceptiveness refusal – against the goods not made of denim


“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises...deceptive...matter”
Deceptively misdescriptiveness refusal – against the goods *not made of denim*


  “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

  (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them... .”
Three-part test for deceptiveness

• Does the applied-for mark consist of or contain a term that misdescribes the goods?

• Will prospective buyers believe that the misdescription actually describes the goods?

• Is the misdescription likely to affect a significant portion of the relevant consumers’ decision to purchase the goods?

  • In re Spirits Int’l, N.V., 563 F.3d 1347, 90 USPQ2d 1589 (Fed. Cir. 2009); In re White Jasmine LLC, 106 USPQ2d 1385, 1392 (TTAB 2013).
Two-part test for deceptive misdescriptiveness

• The first two prongs of the deceptiveness test
  – Does the applied-for mark consist of or contain a term that misdescribes the goods?
  – Will prospective buyers believe that the misdescription actually describes the goods?

Issues for goods not made of denim

• Is “denim” misdescriptive?
  – If yes, register mark with disclaimer
  – Trademark Act §§ 2(e)(1) and 6(a), 15 U.S.C. §§1052(e)(1), 1056(a)

• Is “denim” deceptive?
  – If yes, mark cannot be registered at all
  – Trademark Act § 2(a), 15 U.S.C. §§1052(a)
Supplemental Register – against the goods *not made of denim*


> “All marks capable of distinguishing applicant’s goods or services and not registrable on the principal register herein provided, except those declared to be unregistrable under subsections (a)...of section 1052 of this title...may be registered on the supplemental register”
Denim fabric dyed with indigo and black dyes and made into a shirt.

Skinny jeans made from red denim

A mini-skirt made from purple denim

Jeans made from light grey denim

FALL DENIM GUIDE
See which must-have styles made the cut.

SHOP NOW »
Examine attorney’s evidence

- First prong – that “DENIM” misdescribes Applicant’s clothing

noun  den·im  \'de-nəm\n
1 a: a firm durable twilled usually cotton fabric woven with colored warp and white filling threads
b: a similar fabric woven in colored stripes
From French: “serge de Nimes” (fabric of Nimes)

1853 – Levi Strauss makes denim clothes for gold rush miners

1864 – First appearance of DENIM in Webster’s dictionary
Examining attorney’s evidence

• Second prong – that consumers would believe the misdescription

  • Websites to show that clothing is commonly made from denim
  • Third-party registrations
Examining attorney’s evidence

• Third-party registrations on Supplemental Register with disclaimers to “DENIM”

• Third-party registrations on Principal Register with a claim of acquired distinctiveness as to the entire mark and a disclaimer of the term “DENIM”
Examining attorney’s evidence

• Third prong –

• That applicant’s use of “DENIM” was a material factor affecting a consumer’s purchasing decision
Examining attorney’s evidence

• Article in Men’s Health – “The Truth About High-End Denim” – why spend $300 for a pair of jeans

• “Strong” “Durable”
Examining attorney’s evidence - @ www.bustle.com

8 Reasons Why Jeans Are Better Than All The Other Pants You’ve Ever Owned

1. BECAUSE THE OPTIONS ARE ENDLESS
2. BECAUSE THEY LAST LONGER THAN OTHER PANTS
3. BECAUSE THEY HAVE VERSATILITY
4. BECAUSE YOUR BUTT HAS NEVER LOOKED BETTER
5. BECAUSE THEY ARE SUPER EASY TO STYLE
6. BECAUSE THEY FEEL WORTH THE INVESTMENT
7. BECAUSE THEY ARE DURABLE
8. BECAUSE THEY HIDE STAINS SO WELL
Applicant’s evidence

– Declaration of applicant’s vice president
  • Applicant’s mark DENIM & CO. is one of applicant’s oldest and most famous casual lines of apparel and accessories.
  • Sales of its DENIM & CO. casual line of apparel are in the billions of dollars and the line has consistently included both denim and non-denim clothing.
Applicant’s evidence

- Is DENIM as much a lifestyle or statement as to one’s casual nature as it is a fabric?
Applicant’s evidence

ELWOOD DENIMS COMPANY USA-MADE
Prin. Register Reg. No. 2212847
"jeans, pants, shorts, T-shirts, sweatshirts, sweaters, jackets, belts, button down shirts, baseball hats, wool beanies."
Disclaimer: "DENIMS COMPANY" and "USAMADE"

LIFE AFTER DENIM
Prin. Register Reg. No. 3606501
"Clothing, namely, shirts, tops, tank tops, cotton woven shirts, knit shirts, polo shirts, t-shirts, sweatshirts, sweaters, vests, cardigans, pants, slacks, shorts, sweatpants, coats, jackets, blazers, rain coats, overcoats, top coats, sports coats, leather coats, leather jackets, neckties"

DENIM OF VIRTUE
Prin. Register Reg. No. 4252650
"Clothing, namely, pants, trousers, shorts, skirts, shirts, tops, sweaters, jackets, dresses; belts, headwear, footwear"
Disclaimer: "DENIM"
Applicant’s evidence

• “ALL SOLD THROUGH INTERACTIVE TELEVISION AND INTERACTIVE ONLINE MEDIA
• WHEREIN THE CLOTHING PRODUCTS OFFERED FOR SALE ARE MODELED
• AND WHEREBY DETAILED INFORMATION REGARDING SUCH CLOTHING PRODUCTS IS PROVIDED INCLUDING INFORMATION AS TO THE FABRICS AND MATERIALS FROM WHICH SUCH CLOTHING PRODUCTS ARE MADE”
Applicant’s evidence

Denim & Co. Gingham Check Button Front Shirt

Denim & Co. Embroidered Gauze Dress

Denim & Co. Active French Terry 3/4 Sleeve Dress
WORD OF THE DAY

**cotton**

to begin to like or understand
Introduction to the TTAB

Andrew P. Baxley and Katie W. McKnight, Interlocutory Attorneys

September 18, 2019 – 7th Annual ABA-IPL Day with the USPTO
Board personnel

- Chief administrative trademark judge
- Deputy chief administrative trademark judge
- Senior counsel for policy and procedure
- Administrative trademark judges (24)
- Managing interlocutory attorney
- Interlocutory attorneys (16)
- Chief clerk
- Supervisory and lead paralegals and paralegals (9)
- Additional administrative and technical staff
Administrative trademark judges

- Preside at oral hearings and issue final decisions on merits of:
  - Appeals from trademark examining attorney refusals
  - Oppositions; cancellations
- Consult with interlocutory attorneys on dispositive motions, such as:
  - Motions for summary judgment
  - Motions to dismiss
  - Motions for sanctions (judgment)
Interlocutory attorneys

• Inter partes cases only
• Draft and issue orders
  – Contested dispositive motions – “signed” by judges
  – Contested non-dispositive motions – “signed” by attorney
    • Discovery motions (e.g., to compel)
    • Contested scheduling motions
  – May conduct phone conference on contested motion
• Participate in discovery conferences
Paralegals

• Draft and issue orders in inter partes cases on consented and uncontested motions
  – Extensions of discovery and trial dates; stipulated dispositions:
    • Consented withdrawals
    • Abandonments
  – Notices of default; default judgments
  – Orders for interlocutory attorney’s signature
    • Motions to amend
    • Motions to join/substitute parties
• Draft and issue orders in ex parte cases
• Extensions of time to oppose
Types of proceedings

- **Appeal**: Appeal from trademark examining attorney’s refusal to register
- **Opposition**: Challenge by any party believing it would be damaged by registration of pending application
- **Cancellation**: Challenge by any party believing it would be damaged by existing registration
- **Concurrent use**: Request for a geographically limited registration
Expedited Cancellation Pilot Program

- On-going TTAB pilot program focusing on use of existing Accelerated Case Resolution (ACR) tools in an “expedited” cancellation proceeding
- The goal is to improve accuracy of the use-based register in response to stakeholder requests for an option to clear deadwood, consistent with parties’ due process rights
Expedited Cancellation Pilot Prgm. - cont’d

• Identify abandonment and non-use cancellation cases suitable for an “expedited” proceeding
• Discuss with parties application of ACR procedures that could be used most effectively in such proceedings
• Involves TTAB interlocutory attorney and judge participating in discovery conferences for cases identified as suitable candidates
Reasons to register

• A Principal Register registration is prima facie evidence of:
  – The validity of the registered mark and of its registration;
  – The validity of the owner’s ownership of the mark; and
  – The owner’s exclusive right to use the registered mark for the identified goods or services.
More trials than appeals filed

New cases commenced

- Appeals
- Oppositions
- Cancellations
More appeals than trials decided

Cases decided on merits

- Appeals
- Oppositions
- Cancellations
Why the TTAB is not like district court

- What may the TTAB decide?
- What should you focus on?
TTAB jurisdiction

• Jurisdiction limited to determining right to obtain/maintain registration
  - No injunctions
  - No damages
  - No attorney fees
  - No punitive damages
Limited issues

• Not the right to use – but Board decision may have preclusive effect in later litigation

• Most cases involve questions of likelihood of confusion

• Board looks only at marks and goods or services in application(s) and registration(s), not marketplace realities
Remedies

- Affirm/reverse trademark examining attorney’s refusal
- Sustain/dismiss opposition
- Grant/deny petition to cancel
  - Board cannot grant damages or issue injunctions, and does not award attorney fees
  - But TTAB proceedings are faster and less expensive
TTAB does not consider:

- Use of house mark

Images used in this presentation are for educational purposes only.
TTAB does not consider:

- Use of fonts or colors or displays when considering standard character marks

PLATINO
TTAB does not consider:

• That actual goods or services are narrower than identification
  - “boats” in International Class 12
TTAB does not consider:

• That class of consumers or channels of trade may in fact be limited

“[W]here the goods in a cited registration are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers.” In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).
TTAB does not consider:

- Expensive nature of goods/services, unless so limited
- “automobiles” in International Class 12
TTAB assumes:

• Registered mark is in use and used for all items within the scope of identification

• “clothing, for women, men and children, namely, shirts, long-sleeved shirts, T-shirts, under shirts, night shirts, rugby shirts, polo shirts, cardigans, jerseys, uniforms, scrubs not for medical purposes, smocks, dress shirts, pants, trousers, slacks, jeans, culottes, cargo pants, stretch pants, denim jeans, overalls, coveralls, jumpers, jump suits, shorts, boxer shorts, tops, stretch tops, tube tops, crop tops, tank tops, tankinis, halter tops, sweat shirts, hooded sweat shirts, sweat jackets, sweat shorts, sweat pants, wraps, warm-up suits, jogging suits, track suits, play suits, blouses, skirts, dresses, gowns, sweaters, vests, fleece vests, pullovers, snow suits, parkas, capes, anoraks, ponchos, cloaks, shrugs, shawls, pashminas, jackets, dinner jackets, reversible jackets, wind-resistant jackets, shell jackets, sports jackets, golf and ski jackets, jean jackets, coats, heavy coats, over coats, top coats, petticoats, blazers, suits, tuxedos, cummerbunds, cuffs, collars, removable collars, collar protectors, turtlenecks, cloth ski bibs, swimwear, beachwear, tennis wear, surf wear, ski wear, layettes, infant wear, infants sleepers, booties, baby bibs not of paper, caps, swim caps, berets, beanies, hats, visors, headbands, wrist bands, sweat bands, headwear, ear muffs, aprons, scarves, bandanas, belts, suspenders, neckwear, ties, neckerchiefs, pocket squares, ascots, underwear, briefs, swim and bathing trunks, bras, sports bras, panties, thongs, G-strings, socks, loungewear, robes, underclothes, pajamas, sleepwear, night gowns, nighties, lingerie, camisoles, negligees, chemises, chemisettes, slips, sarongs, leg warmers, hosiery, pantyhose, body stockings, knee highs, leggings, tights, leotards, body suits, unitards, body shapers, gloves, mittens, rain slickers, rainwear, footwear, shoes, mules, sneakers, boots, galoshes, sandals, flip-flops, and slippers, sports wear [sic], namely, T-shirts, shorts, sweaters, hats, pants, skirts, jackets, sneakers, sports bras” in International Class 25
Strange results sometimes?

• Opposer challenging use-based application may have stronger case at Board than in court (easier to stop registration than infringement?)

• Applicant arguing against refusal may have a weaker case than it would as defendant in infringement case (easier to justify use than to register?)
What should you focus on at TTAB

- Ex parte appeals
  - Submission of evidence

- Trial cases
  - Pleadings
  - Building a good record
Ex parte appeals: Evidence

• New evidence often submitted with appeal brief – Don’t do it!

• Evidence not submitted must come in through remand to examiner
Ex parte appeals: Evidence (cont’d)

• Listing of third party registrations
  • Board does not take judicial notice of them
  • Submission of list, chart or summary insufficient
  • Examining attorney must object to listing, chart or summary when problem can be cured
  • If not, TTAB will deem any objection waived
Ex parte oral hearing

• Argument heard by a panel of three judges
• Trademark examining attorney will appear to represent the Office
• Judges, examining attorneys, or applicants may attend remotely
• Oral argument limited to:
  – 20 minutes for applicant
  – 10 minutes for examining attorney
  – Applicant may reserve time for rebuttal
Trial cases

• Who may oppose/petition to cancel?
  – Any person who believes they would be damaged by the registration of another’s mark
  – Injury must be real or potential, but not necessarily economic
Pleadings define the issues in the case

- **Complaint** – “short and plain”
  - Notice of Opposition
  - Petition for Cancellation
- **Answer** – response to complaint
  - Affirmative defenses may be allowed
- **Counterclaim** – to cancel plaintiff’s pleaded registration(s)
  - Plaintiff allowed time to answer counterclaim
Trial cases: Pleading (cont’d)

- Reassess and amend along the way.
- Do not “win ugly” by having Board find issue tried by implied consent.
- Do not lose because adversary not on notice of claim or issue you thought was obviously being tried.
Trial cases: Disclosures and discovery timeline –180 days

• Discovery conference
  – No later than opening of discovery period
  – Consider claims/defenses and make discovery plan
  – Either party can request that interlocutory attorney attend

• Initial disclosures
  – Due one month into discovery period
  – Identify witnesses, and produce or describe relevant documents and their location

• Expert disclosures
  – Due one month before end of discovery period
  – Identify experts, if any, and produce written report or summary
Trial

During trial period, each party may present evidence to the Board to prove its case.

Unlike court trials, TTAB trials are presented on a written record, which may include:

- Transcripts of oral trial testimony depositions and exhibits
- Declarations or affidavits, with the right to cross-examination
- Certain documents under a Notice of Reliance
  - Registrations
  - Printed publications and official records
  - Some discovery responses and depositions (officers/30(b)(6) witnesses)
  - Internet materials for what they show on their face
Trial timeline

- Pretrial disclosures – 15 days before each party’s trial period opens
- Trial periods – 30 days for each party
  - Testimony – by deposition or affidavit
  - Evidence – as exhibit to testimony or by Notice of Reliance
- Plaintiff’s rebuttal period – 15 days
  - Can only respond to defendant’s evidence
Build a good record

- Consider stipulations of fact; they help focus.
- Take only appropriate discovery and introduce only what you really need.
- Use notice of reliance when appropriate.
- Use testimony by declaration; cross examination available when necessary.
Build a good record (cont’d)

• Focus testimony on determinative factual issues, not legal opinions.

• Submit all exhibits electronically and be sure they are clear and legible.

• Explanatory testimony and representative documents are more useful than large collections of documents.
Trial cases: Briefs

• Following trial
• Briefs embody the parties’ written legal arguments based on the evidence and testimony of record
• No new evidence may be presented; judicial notice may be requested
  • Show cause order if plaintiff does not file brief
  • Reply brief allowed for plaintiff
Trial cases: Briefing timeline

- **Plaintiff’s brief**
  - 60 days after close of plaintiff’s rebuttal trial period
  - 55 pages maximum length

- **Defendant’s brief**
  - 30 days after due date of plaintiff’s brief
  - 55 pages maximum length

- **Plaintiff’s reply brief**
  - 15 days after due date of defendant’s brief
  - 25 pages maximum length
Trial cases: Oral hearing

• On request of either party, Board will hold an oral hearing before a three-judge panel
• Purpose is summation of the case; hybrid trial-appellate argument
• No new evidence or testimony may be presented
• Not recorded or made part of the record
  – But may assist judges in organizing the evidence and understanding complex factual situations or multiple issues
Trial cases: Oral hearing timeline

• Must request within 10 days from last reply brief due date
• Attendance not required
• May arrange to attend oral hearing remotely
Final decision

• Panel of three Administrative trademark judges
• One panel judge is assigned by the chief judge to author
• Requires consideration of all relevant evidence and arguments
Appeals from TTAB decisions

• Must be taken within 63 days
• Two options:
  – Federal Circuit – appeal on record
    • Further appeal to Supreme Court
  – U.S. District Court – trial de novo
    • PTO attorney fees may be awarded in appeals of ex parte decisions to district court
    • Further appeal to regional Circuit Courts of Appeal
• U.S. Supreme Court
  – Discretionary review
Know our rules, precedents

• Federal rules (civil procedure and evidence) and Trademark rules apply, depending on circumstances – know which and when; rely on TBMP
• Bound by Federal Circuit precedent and prior TTAB precedents; cite to USPQ
• In briefs, cite to TSDR, TTABVUE
• Be timely; stay within page limits
Introducing Effective Evidence and Making Persuasive Arguments before the Trademark Trial and Appeal Board

The 7th Annual ABA-IPL Day with the USPTO
September 18, 2019
Jonathan Hudis  
Administrative Trademark Judge  
Trademark Trial and Appeal Board  

Thomas Wellington  
Administrative Trademark Judge  
Trademark Trial and Appeal Board  

Special thanks to Matthew Gehring and Tim Rivenburg for their assistance in the creation of this presentation.
TTAB Best Practices for Pleading and Proving Your Case

• Topics for Discussion
  – Pleadings
  – Disclosures and Discovery Conference
  – Discovery
  – Summary Judgment Motions
  – Pre-Trial Disclosures
  – Trial and ACR
  – Briefing
  – Oral argument
  – Sample Cases for Discussion
Pleadings

TTAB PRACTICE
Pleadings

• Party(ies) seeking extensions of time to oppose vs. the opposer(s)
  – Privity or misidentification by mistake
• Allegations made through ESTTA vs. asserted in complaint
• Making your registration(s) of record
• The downside of asserting too many registrations
  – Subject to counterclaims
  – Subject to increased discovery obligations
Pleadings (cont’d)

• Issues with asserting dilution or false suggestion of a connection

• Asserting the elements of a claim without supporting facts may be insufficient

• Asserting blanket defenses without supporting facts is a mistake

• Asserting proper/mandatory counterclaims
Priority

• A plaintiff must plead (and later prove) priority of use
• In order to properly assert priority, a plaintiff must allege facts showing proprietary rights in its pleaded mark that are prior to defendant’s rights in the challenged mark
• Such rights may be shown by, for example, ownership of an application with a filing date (or a registration with an underlying application filing date) prior to any date of first use on which defendant can rely
  – properly introduced registration unchallenged by counterclaim
  – prior trademark or service mark use
  – or prior use analogous to trademark or service mark use
• Provide evidence of first use, such as proof of a sales, advertising, or invoices
• A plaintiff may be permitted to assert the proprietary rights or registration(s) of a third-party as a basis for a Trademark Act § 2(d), 15 U.S.C. § 1052(d) ground if plaintiff can show a legitimate interest in preventing confusion between the pleaded mark(s) and the defendant’s mark
Likelihood of Confusion

• The evidentiary factors the Board considers in determining likelihood of confusion are set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). These factors include the similarity of the marks, the relatedness of the goods and/or services, the channels of trade and classes of purchasers for the goods and/or services, the number and nature of similar marks in use on similar goods, the nature and extent of any actual confusion.
  – No need to recite in final briefs.
• Can be direct or hypothetical Likelihood of Confusion
• Reverse Confusion
• Trademark Act § 2(d), 15 U.S.C. § 1052(d)
Merely Descriptive

• No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them . . . .

• Matter that "merely describes" the goods or services on or in connection with which it is used is not registrable on the Principal Register. As noted in In re Abcor Dev. Corp., 588 F.2d 811, 813, 200 USPQ 215, 217 (CCPA 1978):
  – The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.
  – Trademark Act § 2(e), 15 U.S.C. § 1052(e)
Affirmative Defenses

Except as provided in Fed. R. Civ. P. 12(b) and 12(h)(2), an unpleaded defense cannot be relied upon by the defendant unless the defendant’s pleading is amended.

- Laches
- Estoppel
- Failure to state a claim
Laches

• The legal doctrine that a legal right or claim will not be enforced or allowed if a long delay in asserting the right or claim has prejudiced the adverse party
• Before making a claim of laches, learn when the “period of delay” begins to toll
• When a claim of Laches is possible:
  – equitable defenses may not be available against certain grounds for opposition or cancellation or under certain circumstances
  – the defenses of laches may not be available against claims such as genericness, descriptiveness, fraud, abandonment and functionality, and further, may not apply in a case of likelihood of confusion if it is determined that confusion is inevitable
Estoppel

• A bar that prevents one from asserting a claim or right that contradicts what one has said or done before, or what has been legally established as true
Failure to state a claim

• A defense asserting that even if all the factual allegations in a complaint are true, they are insufficient to establish a cause of action
• Federal Rule of Civil Procedure 12(b)(6)
• Without a follow-up motion, this is a useless defense
Electronic filing and pleadings

• *DFC Expo LLC v. Coyle*, 121 USPQ2d 1903 (TTAB 2017)
  • Filing via ESTTA is mandatory for all filings and a Petition to the Director is required for certain submissions filed in paper form

• *Destileria Serralles, Inc. v. Kabushiki Kaisha Donq*, 125 USPQ2d 1463 (TTAB 2017)
  • Oppositions to applications filed under Section 66(a) of the Act are limited to the goods, services and grounds set forth in the ESTTA cover sheet, per Trademark Rule 2.104(c), which codifies past practice
Pleading problems impact discovery

• Insufficient or inapplicable claims
• Blanket defenses without supporting facts
• Assert proper/mandatory counterclaims or they may be waived
Discovery and Disclosures.

TTAB PRACTICE
Initial meeting of the parties: Discovery Conference

Topics include
• Standard Protective order: modify?
• Claims, defenses, discovery
• Settlement and methods-of-discovery should be discussed
• Accelerated Case Resolution (ACR)
• Seeking board participation
  – How and when to ask
  – When appropriate to ask
Initial Mandatory Disclosures

- **What disclosures (before the board) must contain**
  - Witnesses & documents having discoverable information that may be used to support claims or defenses
  - For identified witnesses: names, addresses, phone numbers
  - For identified documents: categories

- **Documents**
- **Relationship to discovery**
- **Relationship to proofs allowed at trial**
- **Amending disclosures**
Discovery

• Request what is truly relevant!
  – To claims and defenses
  – Proportional to needs of case
• Consequences of failure to timely respond
• The special case of Requests for Admissions
  • No response to admission deemed admitted, Fed. R. Civ. P. 36(a)(3)
  • Move to test sufficiency
    – Inadequate/incomplete response
    – Objections
• Counting Interrogatories, Document Requests and Requests for Admission before the Board
• Deadlines for propounding/taking discovery before the board
• **Limits on discovery requests**
  – 75 Interrogatories, 75 Requests for Admission, and 75 Requests for Production
    • 37 CFR §§ 2.120(d), (e) & (i)
  – May move for good cause to exceed limits
    • 37 CFR §§ 2.120(d), (e) & (i)
  – One comprehensive RFA to authenticate specific documents produced by adverse party
    • 37 CFR § 2.120(i)
• **Discoverable items include ESI as well as documents and tangible things** - 37 CFR §§ 2.120(e) & (f)
Discovery (cont’d)

• Proportionality in process and procedure expressly adopted - 37 CFR § 2.120(a)(1)
• Must serve discovery early enough so that responses (including production or inspection) will be due no later than the close of discovery - 37 CFR § 2.120(a)(3)
Motions for summary judgment - timeliness

- Motions for summary judgment cannot be filed prior to service of initial disclosures – 37 CFR § 2.127(e) unless
  - Based on issue or claim preclusion
  - Based on lack of jurisdiction by the Board
- Motions for summary judgment must be filed by the day before deadline for plaintiff’s pretrial disclosures - 37 CFR § 2.127(e)(1).
  - Once deadline passes, any subsequent resetting of first pretrial disclosure deadline will not reset the time to file a motion for summary judgment
  - Parties may stipulate to an abbreviated trial
- Motions for summary judgment, or responses thereto, exceeding the page limit will not be considered by the Board.
  - See 37 C.F.R. § 2.127(a)
Pretrial Disclosures and Trial

TTAB PRACTICE
Pre-Trial disclosures

• Due 15 days prior to opening of each testimony period
• Served on opposing party, not filed with the Board
• Content
  – Disclosure of witnesses who may testify and subject matter of testimony or statement that have no plans to submit witness testimony
  – Need not disclose documents that may rely on at trial
Pre-Trial Disclosures (cont’d)

• Witness and document disclosures
• Relationship to Initial Disclosures, discovery responses and declarations attached to motions
• Motions to strike Pretrial Disclosures
Pre-Trial Disclosures (cont’d)

If witness not included in pretrial disclosures

– Move to quash notice of testimony deposition
– Move to strike if testimony presented by affidavit/declaration (37 CFR § 2.121(e))
– Motions to strike pretrial disclosures address whether failure to disclose was substantially justified or harmless. *Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098 (TTAB 2018)
– See also *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327 (TTAB 2011)
Pre-Trial Disclosures (cont’d.)

- *Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098 (TTAB 2018)
- Supplemented initial disclosures that previously-disclosed third party use documents would be introduced into evidence through the declaration of the authenticating witness was sufficient, and motion to strike pretrial disclosures identifying authenticating witness denied. Applicant’s failure to disclose in the supplemented initial disclosures the identity of additional declarants identified in pretrial disclosures who would be testifying as to the disclosed subject of third party use is both substantially justified and harmless, and motion to strike pretrial disclosures identifying third party witnesses denied.
Expert disclosures

• Deadline 30 days before close of discovery
• Board should be notified (unlike other disclosures)
• Trademark Rule 2.120(a)(2)(iii) provides the Board wide latitude in managing a proceeding following any party’s disclosure of plans to use expert testimony, including but not limited to, suspending proceedings if necessary to allow for discovery of the expert. Monster Energy Co. v. Martin, 125 USPQ2d 1774 (TTAB 2018)
ACR vs. Trial

• Do the parties want a full-blown trial?
• Can efficiencies be achieved through accelerated case resolution?
• Appropriate for expedited cancellation proceeding?
• Making one’s registration(s) properly of record
• Tight and concise testimony depositions
  – Direct examination – laying foundations
  – Objections and cross-examination
Trial

- Testimony by deposition
- Testimony by affidavit or declaration
  - 37 CFR §§ 2.123(a)
  - Subject to right of adverse party to take cross-exam
- Deposition transcripts must be submitted one page per sheet and with a word index
  - 37 CFR §§ 2.123(g)(1) and (3)
  - TTAB judges and attorneys do read the submissions
- Standardized requirements for notices of reliance, including Internet evidence
  - 37 CFR § 2.122(g)
Trial (cont’d)

• File of subject application or registration
  – Is of record without any action by the parties - 37 CFR § 2.122(b)(1)
  – Date of use is not evidence unless established by competent evidence and specimen is not evidence unless identified and introduced in evidence during testimony period 37 CFR § 2.122(b)(2)
  – Statements in affidavits or declarations in file history record are not testimony - 37 CFR § 2.122(b)(2)

• Exhibits to pleadings
  – Except for a current status and title copy of a plaintiff’s pleaded registration, or a database equivalent, an exhibit to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached, and must be introduced in evidence as an exhibit during testimony period - 37 CFR § 2.122(c) and (d)(1)
Trial (cont’d)

• **Notice of Reliance**
  – Internet materials (37 CFR § 2.122(e)(2))
  – Printed publications and official records (37 CFR 2.122(e)(1)-(2))
    • Includes information from USPTO databases (TSDR/TESS)
      – Plead registration
      – Registrations (pleaded or unpleaded) owned by any party (37 CFR § 2.122(d)(2))
      – Pending applications (37 CFR § 2.122(e))
        – See Safer, Inc. v. OMS Investments, Inc., 94 USPQ2d 1031 (TTAB 2010)
  
• **Indicate generally the relevance and associate with one or more issues** (37 CFR § 2.122(g))
  – Be strategic in what is submitted
  – Procedural vs. Substantive Objections
Trial (cont’d)

• Notice of Reliance
  – “When evidence has been made of record by one party in accordance with the Trademark Rules, it may be referred to by any party for the purpose permitted by the Federal Rules of Evidence”
  • See also WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc., 126 USPQ2d 1034 (TTAB 2018)
Trial (cont’d)

• Use of discovery deposition transcripts and written discovery responses - 37 CFR § 2.120(k)
  – Of the adverse party (a FRCP 30(b)(1) or 30(b)(6) deposition): may be introduced by notice of reliance: 37 CFR § 2.120(k)(1)
  – Must file a motion with pretrial disclosures if
    • A party’s own witness
    • Or a third-party witness
    • Under specific circumstances (e.g., unavailability of witness)
    • 37 CFR § 2.120(k)(2)
Trial (cont’d)

• Bell’s Brewery, Inc. v. Innovation Brewing, 125 USPQ2d 1340 (TTAB 2017)

    Because the respondent produced documents in responding to the petitioner’s interrogatories and admitted in responses to requests for admissions that the documents it produced were true and correct copies of authentic documents, the documents were admissible by notice of reliance per Trademark Rule 2.120(k)(3)(ii) (which codifies prior practice)

• Azalea Health Innovations, Inc. v. Rural Health Care, Inc., 125 USPQ2d 1236 (TTAB 2017)

    Trademark Rule 2.123(a) does not permit non-party witnesses’ discovery depositions to be used for impeachment absent (i) a motion at the time of its pretrial disclosures seeking Board approval of its use of the discovery depositions; or (ii) a motion claiming exceptional circumstances exist after circumstances claimed to justify the use of the depositions became known.
Trial (cont’d)

• **Barclays Capital Inc. v. Tiger Lily Ventures Ltd.,** 124 USPQ2d 1160 (TTAB 2017)

To meet the requirements of Trademark Rule 2.122(g), if the propounding party introduces a group of documents to support more than one element of a claim or defense, or more than one relevant fact, it should indicate the specific element or fact supported by each document in the group. Party need not elect oral cross-examination in order to lodge a substantive objection to declaration testimony, but may raise objection by a motion to strike which is maintained in the brief, or raised in the brief for the first time. Amended Trademark Rule 2.123(j) explicitly provides that “[o]bjections to the competency of a witness or to the competency, relevancy, or materiality of testimony ... may not be considered until final hearing”

• **United States Postal Service v. RPost Communication Limited,** 124 USPQ2d 1045 (TTAB 2017)

Oral cross-examination of declarants submitted in the form of an affidavit or declaration under the amended rules is conducted like cross-examination of witnesses providing testimony by deposition, except the cross-examination does not immediately follow an oral examination as it would in a deposition, but follows a notice of election of cross-examination and is to be completed within thirty days of the notice of election. Trademark Rule 2.123(c). A reasonable place for cross-examination of a testimonial declarant is where the witness lives and works, and not where the party seeking cross-examination is located.
Trial (cont’d)

  
  Trademark Rule 2.122(g) amended to make clear that any failure of a notice of reliance to identify the relevance of the evidence, or associate it with issues in the proceeding, with sufficient specificity will be considered a curable procedural defect

- **Luxco, Inc. v. Consejo Regulador del Tequila, A.C., 121 USPQ2d 1477 (TTAB 2017)**
  
  Trademark Rule 2.122(e) is amended to include the holding in *Safer* permitting Internet evidence to be introduced through a notice of reliance, and Trademark Rules 2.123(a)(1) and (2) are amended to permit testimony in the form of an affidavit or declaration subject to the right of cross examination
Trial briefs

• Evidentiary objections may be made in an appendix or by way of a separate statement of objections, neither of which is included in the page limit

• Briefs exceeding the page limit may not be considered by the Board

• See 37 CFR § 2.128(b)
Briefing tips; Oral argument

TTAB PRACTICE
Briefing

• Create a roadmap
• Keep it “concise”
• Do not discuss factors not at issue in the case
• Evidentiary objections may be a separate document
• Place a short summary of arguments up front
• Do not attach materials to brief
• Citations to Fed. Cir. and TTAB decisions; infringement decisions not as relevant
Oral Argument

- Rarely changes the ultimate result
- Good practice in factually complicated cases
- May be helpful to bring sample of product
- Demonstrative evidence should be of record
- Limited to record
- Where factually or legally complex
Sample Cases for Discussion

TTAB PRACTICE
Recent TTAB Precedential Decisions

• *TPI Holdings, Inc. v. TrailerTrader.com, LLC and Trailer Central LLC*, 126 USPQ2d 1409 (TTAB 2018)


• *Hewlett Packard Enter. Dev. LP v. Arroware Indus., Inc.*, 2019 USPQ2d 158663 (TTAB 2019)

• *M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd. and Global Technology & Trade Marks Limited*, LEXIS 35818 (N.D.CA. 2017)

• *Grote Industries v. Truck-Lite Co., LLC f/k/a/ Truck-Lite Co., Inc.*, 126 USPQ2d 1197 (TTAB 2018)
**TPI Holdings v. TrailerTrader.com, LLC and Trailer Central LLC**

- **Issues**
  - ACR case
  - Supplemental Reg. v Principal Reg.
  - Laches (unreasonable delay/ reliance/ prejudice)
  - Inevitable confusion
  - Pleading and proving ‘family’ of marks
A&H Sportswear Co. v. Yedor

- MIRACLE ON 35th STREET for printed materials and various clothing items

- Summary Judgment (SJ) granted to Opposer

- Applicant lacked bona fide intent to use (bfitu) the mark at the time of filing Section 1(b) application

- Good discussion of burdens on SJ with regard to BFITU
Hewlett Packard Enter. Dev. LP v. Arroware Indus.

- Use of a blanket interrogatory or document request to discover information or documents that form the factual bases for a responding party’s answer to each request for admission is impermissible.
- If a party believes that the number of interrogatories served upon it exceeds 75, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number.
- Merit-based objections to discovery request must be specifically stated.
- Requirements for responding to an interrogatory by specifying its business records from which the information may be derived or ascertained.
Evidentiary point:

Applicant successfully moved to strike the declaration of Opposer’s CEO because the declaration was not properly sworn.

- The declaration was signed in India but failed to state that the declarant would be bound by United States law in compliance with Trademark Rule 2.123(a)(1)
- “When a person executes a document outside the United States, a recitation that it is made under penalty of perjury without reference to which country’s perjury laws will be applied provides no assurance of truthfulness because the penalty of perjury may be non-existent or trivial in the place where the person signed the document.” (quoting Jack v. Trans World Airlines, 854 F. Supp. 654, 658 n.3 (N.D. Cal. 1994))
Grote Industries v. Truck-Lite Co., LLC f/k/a/ Truck-Lite Co., Inc., 126 USPQ2d 1197 (TTAB 2018)

Registration

lighting products for vehicles, namely, a combined stop-turn-tail lamp

Application

electric lighting fixtures, namely, lights for vehicles
**Grote Industries v. Truck-Lite Co., LLC f/k/a/ Truck-Lite Co., Inc.**

**Description of registered mark**

- The mark consists of the configuration of a stop/turn/tail light, which consists of a circular base and a circular cover portion. The circular cover portion of the stop/turn/tail light consists of an arrangement of circular patterns integrally formed within the cover. The circular patterns form individual lens portions arranged above light emitting diode (LED) lights located within the interior of the stop/turn/tail light. There are six lenses and six corresponding LED’s. A center lens portion, which has a pentagonal perimeter, is located in the center of the cover. Each of the five additional lens portions are arranged around the pentagonal perimeter of the center lens portion. A corresponding LED is positioned below each lens portion. When illuminated, the light emitted from the six LED’s shines through the corresponding lens portions and the aforementioned pattern of the LED’s and lens portions is visible.

**Description of mark in application**

- The mark consists of an arrangement of six light emitting diodes (LED’s) with one LED located in the center of a pentagonal pattern as applied to a circuit board sold as an integral component of a vehicle light. Additional structure is shown in broken lines to give context, but does not form any part of the mark.
Both registration and application are based on a claim of acquired distinctiveness under Trademark Act Section 2(f): “nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce”

The Board finds that “the essence of the claimed marks depicted in the two drawings comprises the same Penta-Star Pattern design”
Grote Industries v. Truck-Lite Co., LLC f/k/a/ Truck-Lite Co., Inc.

Same Claims Against Registration and Application (cancellation and opposition consolidated)

- Mark is functional under Trademark Act Section 2(e)(5) and therefore incapable of serving as a trademark
- Mark lacks acquired distinctiveness under Trademark Act Section 2(f)
Grote Industries v. Truck-Lite Co., LLC f/k/a/ Truck-Lite Co., Inc.

Inwood: "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article"

Morton-Norwich:
(1) the existence of a utility patent disclosing the utilitarian advantages of the design;
(2) advertising materials in which the originator of the design touts the design's utilitarian advantages;
(3) the availability to competitors of functionally equivalent designs; and
(4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product.

Legal test for acquired distinctiveness

A mark has acquired distinctiveness "if it has developed secondary meaning, which occurs when, 'in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself'"
The Board’s assessment of relevant evidence on utilitarian functionality:

- **While Defendant owns a utility patent for truck lights, “patent does not show that the Penta-Star Pattern is essential to the use or purpose of the article.”** Utilitarian advantages not disclosed, and although preferred embodiment, any number of diodes could be used.
- **Defendant's advertising does not promote utilitarian advantages arising from the Penta-Star Pattern.**
- **There appear to be alternative designs that satisfy federal regulations.**
- **There is no clear benefit as to either cost or ease of manufacture attributable to the pattern.**

Accordingly, on the basis of the totality of the evidence in this case, we find the design to be non-functional.
Grote Industries v. Truck-Lite Co., LLC f/k/a/ Truck-Lite Co., Inc.

Because the configuration is a product design, it is not inherently distinctive, and can be registered as a mark only on a showing of acquired distinctiveness

• stop/turn/tail lights serve crucial non-source-identifying purposes, including increasing visibility and showing when a vehicle is stopping or turning.
• numerous third parties make the same type of goods serving the same purpose with various LED patterns, including a design very similar to the Penta-Star Pattern offered by a third party
• declarations from two Defendant executives and two third parties have little persuasive value
• sales success alone is not probative of purchaser recognition of a configuration as an indication of source, because, without more, it may simply indicate popularity of the product itself
• no “look for” advertising

There is insufficient evidence in the record as a whole to show that the design by itself indicates source, or that consumers recognize it as such
Grote Industries v. Truck-Lite Co., LLC f/k/a/ Truck-Lite Co., Inc.

Decision

• The petition to cancel is granted, and the opposition is sustained
• Considering the record evidence as a whole, we conclude, based on the preponderance of the evidence, that Truck-Lite's product configuration is not functional, but Truck-Lite has not established that its configuration has acquired distinctiveness and therefore serves as an indicator of source
Questions?
Thank You.
Trademark boot camp

Jennifer Williston
September 2019
Discussion topics

• What is a trademark and what is the benefit of federal registration
• Filing considerations
• After you file: common refusals and requirements issued by the examining attorney
• Tips and recap of helpful USPTO resources
What is a trademark?

• Any word, slogan, symbol, design, or combination of these that:
  – Identifies the source of your goods or services
  – Distinguishes your goods and services from those of another party
Types of trademarks – trade dress

• “Trade dress” encompasses the design and appearance of the product or its packaging
• Examples of product design drawings

U.S. Reg. No. 1927046 – Candy
U.S. Reg. No. 4677237 – Cleaning Sponges
Types of trademarks – trade dress

• Examples of product packaging

Examples of packaging as trade dress
U.S. Reg. No. 1057884 (Soda bottle)
U.S. Reg. No.  2140630 (Soda bottle)
U.S. Reg. No. 4707902 (Wine bottle)
U.S. Reg. No. 1138877 (Syrup bottle)
U.S. Reg. No. 4266924 (Lotion bottle)
Other types of trade dress

• Uniforms and costumes

• Sounds

• Colors

• Store layouts
Trademark notification symbols

• Trademark “TM” is used to provide notice that a word or design is a source identifier for goods.
• Service mark “SM” is used to provide notice that a word or design is a source identifier for services.
• The registration symbol ® may only be used upon registration of the mark by the USPTO.
## Distinction between common law and federal trademarks

<table>
<thead>
<tr>
<th>Common law trademark</th>
<th>Federal trademark registration</th>
</tr>
</thead>
<tbody>
<tr>
<td>• Trademark used in commerce in connection with specified goods and services</td>
<td>• Trademark used in interstate commerce in connection with specified goods and services and registered with the USPTO</td>
</tr>
<tr>
<td>• Rights are limited to a particular geographic area</td>
<td>• Rights are granted throughout the United States and its territories</td>
</tr>
<tr>
<td>• Rights begin with first use of Trademark</td>
<td></td>
</tr>
</tbody>
</table>

Trademark Day Page 245
Why seek federal registration?

- Legal presumption of ownership and right to use the mark
- Provides public notice because mark is listed in the USPTO database
- Legal right to enforce the mark through legal action in federal court
- Means of preventing importation of infringing products through recordation with U.S. Customs and Border Protection
- Can use registration as a basis for foreign filing
- Rights granted throughout the United States and its territories
Filing considerations

• Minimum filing requirements
• Selection of mark (drawing)
• Identification of goods and services
• Filing basis
  – Intent to use
  – Use in commerce (specimen considerations)
  – Foreign application
• Method of filing
Minimum filing requirements

• Trademark Rule CFR 2.21 (TMEP § 202)
• Application must include the following to receive a filing date:
  – Name of applicant
  – Address (applicant or filing correspondent)
  – Drawing of the mark
  – Identification of goods and/or services
  – Filing fee (one class required)
Name and address of applicant

- **Name** – Provide the true and correct name of the owner(s) of the mark.
  - Filing an application in the wrong name can void your application.
  - Once filed, a voided application cannot be corrected and the filing fee will not be refunded.

- **Address** – Provide the applicant(s) mailing address for correspondence with the USPTO.
  - Foreign-domiciled applicants must have a U.S.-licensed attorney.
Drawing of the mark

Unacceptable drawing  Acceptable drawing
Types of trademark drawings

• Standard character marks
  – COCA-COLA

• Non-visual marks
  – Sound, motion, scent

• Special form marks

Composite mark
Design mark
Factors to consider when selecting a mark

• Mark selection and filing strategy is a business decision.
  – Not every mark that registers is enforceable.

• Research the proposed trademark before you file.
  – Search the internet for information on the potential perception of your proposed mark in the marketplace.
    • Look for meaning in English and foreign languages.
  – Use USPTO’s Trademark Electronic Search System (TESS) or third-party search tools to search for potentially conflicting marks.
  – Review Trademark Status and Document Retrieval System (TSDR) to see how the USPTO has treated marks with similar issues.
Identification of goods and services

• Application must include a list of goods and/or services that the mark is used with.
• Use the ID manual found at http://idm-tmng.uspto.gov to draft an acceptable identification.
• Goods and services are divided into 45 classes.
  – Goods: Class 1 - Class 34
  – Services: Class 35 - Class 45.
Identification of goods and services

• “Specific, definite, clear, accurate, and concise” TMEP § 1402.01(a)
• Understandable in English
• No broad terms – think “including,” “such as,” “products,” “accessories,” “etc.”
• No proprietary names or trademarks
• No class headings
• Classifiable in only one class
Filing basis

- Section 1(a): use in commerce
- Section 1(b): intent to use
- Based on foreign application or registration
- Section 44 – discussed in advanced topics
- Section 66(a) – discussed in advanced topics
Section 1(a): use in commerce

• Specimen (evidence of use) for each class
  – Goods: tags, labels, photos of mark on goods or packaging, point of sale displays
  – Services: promotional material, brochures, signs, photos of mark in rendering or advertisements of services

• Dates of use

• First use anywhere and in commerce

• Declaration
Section 1(b): intent to use

• Initial application includes allegation that applicant has a “bona fide intent to use the mark and is entitled to use the mark with the identified goods or services.”

• Allegation of use is a prerequisite to registration
  – Pre-publication
    • $100 per class for Amendment to Allege Use
  – Post-publication
    • Notice of Allowance (NOA) issues approximately three months after publication
    • Six months from date of NOA to file Statement of Use or request for extension of time (successive six-month periods)
    • Three years from date of NOA to submit Statement of Use
## Method of filing

<table>
<thead>
<tr>
<th></th>
<th>TEAS Plus</th>
<th>TEAS RF</th>
<th>TEAS Regular</th>
<th>Paper</th>
</tr>
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<tbody>
<tr>
<td>Filing fee per class</td>
<td>$225</td>
<td>$275</td>
<td>$400</td>
<td>$600*</td>
</tr>
<tr>
<td>Email address &amp; correspond by email</td>
<td></td>
<td>X</td>
<td></td>
<td>X</td>
</tr>
<tr>
<td>File documents online</td>
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<td></td>
<td>X</td>
</tr>
<tr>
<td>Select goods &amp; services from the Identification Manual</td>
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<td>X</td>
<td></td>
<td>X</td>
</tr>
<tr>
<td>Additional statements</td>
<td>X</td>
<td>X</td>
<td></td>
<td>X</td>
</tr>
</tbody>
</table>

*Paper applications eliminated with Mandatory Electronic Filing Rule*
Recommended inclusions in application

- Standard character claim
- Appropriate disclaimers
- *Fees for all classes*
- Clear specimens (explain, if necessary)
- *Consent for names or portraits of living individuals*
- Translations and transliterations
- Descriptions of marks
- *Filing date and serial no. of foreign registration*
- /signed declaration/

TEAS Plus requirements are *italicized.*
Trademark examination process

1. Review application.
2. Conduct likelihood of confusion search.
3. Research applicant’s mark, goods and services, and issues identified in review of application.
4. Address any procedural or substantive issues identified during review in an office action, examiner’s amendment, or priority office action.

• Resolution by phone or email is encouraged.
Internal deadlines

• New application: seven days (from assignment of the case to examining attorney) to take initial action
• Response to office action: 21 days (from date case hits their docket) to take action
• About an hour to review an application and take action on a file
Common substantive refusal: Section 2(d) likelihood of confusion

- Two-part test for a likelihood of confusion
  - Are the marks similar in:
    - Sound?
    - Meaning?
    - Appearance?
    - Commercial impression?
  - Are the goods and/or services legally related?
    - Consumers will mistakenly believe that the goods/services come from the same source.

Similarity in any one is sufficient.
Common substantive refusal: Section 2(e)(1) merely descriptive

- Strength of mark determines registrability and protectability
  - Strong marks
    - Fanciful/arbitrary
    - Suggestive
  - Weak marks
    - Descriptive
    - Generic

- Strong marks – unique identifiers of source; distinguish goods/services of one source from another
  - High probability of being registrable
  - More easy to protect against third party infringement

- Weak marks – more commonly used by others to describe a characteristic or quality about the good/services itself, not its source
  - Low to zero probability of being registrable and/or protectable
Examples of strong marks

• Fanciful – invented words
  - xerox
  - Microsoft
  - cisco

• Arbitrary – actual words but don’t convey any association with the goods/services
  - Apple
  - GAP
  - BlackBerry

• Suggestive – suggest a quality of an intended/desired effect of the goods/services
  - COPPERTONE for suntan lotion
  - DRI-FOOT for deodorant for feet
  - EVERREADY for batteries
Examples of weak marks

Descriptive

• Words or designs describing the goods or services:
  – URBANHOUZING for real estate service
  – APPLIE PIE for potpourri
• Much harder to protect than fanciful or arbitrary marks

Generic

• Common everyday names for goods or services
• Incapable of being source identifiers and are never registrable
Other common substantive refusals

- Section 2(e)(4) primarily merely a surname
  - MILLER LAW GROUP primarily merely a surname for legal services
- Section 2(e)(2) primarily geographically descriptive
  - DENVER WESTERNNS for western-style shirts originating in Denver
- Section 2(c) name, portrait, or signature of a living individual or deceased U.S. president without consent
- Section 2(a)
  - False suggestion of a connection
  - Deceptive
Common procedural requirements

• Drawing issues
  – Mark description, color claim

• Translation and transliteration

• Entity type and citizenship

• Identification
  – Indefinite wording, overly broad language, incorrect class
During the examination process

- Know your deadlines.
- Have six months to file a Response to Office Action.
- Have six months to file an Appeal to the Trademark Trial and Appeal Board (TTAB).
- Applicant may file one or more Requests for Reconsideration prior to appeal and Request for Remand during appeal.
- Know when suspension is appropriate. TMEP § 716.02
- USPTO cannot grant requests to extend deadlines for responding.
Key response tips

• All emails are part of the record. TMEP § 709.04
• Don’t send us confidential documents. They become part of the record.
• Advance prosecution of applications with procedural issues by authorizing an examiner’s amendment.
• Put your most important arguments up front.
• Be prepared to educate the examining attorney on the nature and channels of trade of the applicant’s goods and services.
Key response tips

• Check the status of any marks cited against your application in a 2(d) refusal.
• Check TESS and TSDR for treatment of similar applications.
• Argue the facts and evidence.
• Consider submitting more than one specimen and offering an explanation of how the specimen is used.
• Resolve identification and classification issues (especially if sole issue) prior to appealing to the TTAB.
Intent to use extension tip

• To maximize your time:

1. File an extension request on the last day of the existing extension period.
2. Next day (the first day of the next extension period) file the statement of use (SOU).
3. If SOU deficient, you may file one further “insurance” extension before the end of that six-month extension period in which the SOU is filed.

• Following this practice has the effect of providing almost one year to make use of the mark and correct any deficiencies in the SOU.

Key response tips: Petition to Revive

• Application is abandoned for failure to respond.
• File a Petition to Revive within two months of the abandonment date, along with $100 fee and a statement that the abandonment was unintentional.
• If office action was not received, ask USPTO to resend.
• If you received the office action, you must submit a response to the office action with the petition.
My.USPTO.gov

- Trademark docket
  - Share collections in dockets with other MyUSPTO users

- Trademark form finder widget
  - Identifies forms using plain language rather than current form names
  - Includes a search box to search the form names

- New widget: Trademark Electronic Application System (TEAS) Plus Short Form
  - Initial scope: intent to use word marks, TEAS Plus fee basis
Trademark application filing process

• What if I need additional information?
  – Watch the TEAS Nuts & Bolts videos
  – How-to video series for the initial application forms
Helpful resources

• TESS – Trademark Electronic Search System:
  – Search online for registrations/pending applications.

• TEAS – Trademark Electronic Application System:
  – Apply online and file other forms and responses.

• TSDR – Trademark Status and Document Retrieval System:
  – Check the status of applications and registrations, and view or download copies of documents in their electronic files.

• TMEP – Trademark Manual of Examining Procedure:
  – Research the rules and procedures that govern the examination process.

• TMIN – Trademark Information Network videos:
  – View online instructional videos.
Questions?
Obtaining registration in the U.S.: Section 44 and Madrid Protocol

Jennifer Chicoski
September 18, 2019
Topics covered

• Section 44 of the Lanham Act
• Request for extensions of protection (REP) under Section 66(a)
• Ex officio examination
• Maintenance affidavits and renewals
• Practice pointers
Section 44 (15 U.S.C. § 1126): International conventions; register of marks
Section 44 – Eligibility

Two necessary elements—the applicant’s country of origin and the country where the applicant filed the application or obtained registration—are parties to a treaty or agreement with the United States. See Trademark Manual of Examining Procedure (TMEP) §1002.02.

Trademark Day Page 282
Section 44 – Entitlement

• Establishing entitlement under a treaty (TMEP §1002.03)

• Appendix B of the TMEP
  – Paris Convention
  – Buenos Aires Convention
  – Inter-American Convention
  – WTO
Section 44 – Country of origin

• Three options (TMEP §1002.04):
  – Real and effective industrial or commercial establishment
  – Domicile
    • Principle place of business or permanent legal residence
  – National
Section 44(d) – Filing basis

Section 44(d) is filing basis only

– Registration basis in order to be approved for publication (TMEP §1003.03)
  • Section 1(a) based on use
  • Section 1(b) based on bona fide intent
  • Section 44(e) based on foreign registration

– First filed requirement (TMEP §1003.01)
– Filed within six months (TMEP §1003.02)
Section 44 – Multiple filing bases

• When §§1(a) or 1(b) bases are claimed, may elect to retain §44(d) priority filing date and not perfect §44(e) basis. (TMEP §1003.04(b))

• Claim of priority under §44(d) without another basis will result in suspension until foreign registration is provided. (TMEP §1003.04)
Section 44 – Multiple supporting applications/registrations

• May claim §44(d)/§44(e) based on one or more foreign applications or registrations for the same mark for different goods or services.

• Must specify which goods/services are covered by which application/registration. (TMEP §§1003.07 and 1004.02)
Section 44 – Ownership

- Applicant must be the owner of the foreign application or registration on the filing date of the U.S. application. (TMEP §1005)
- Assignees do not have to be the owner of underlying foreign application/registration, but must meet eligibility. (TMEP §1006)
Section 44 – Mark requirements

• Mark in U.S. application must be a substantially exact representation of mark in foreign filing. (TMEP §1011.01)

• U.S. application may claim only one mark:
  – If foreign filing covers a series of distinct marks, U.S. application may shown only one.
  – Separate U.S. applications for each mark are required. (TMEP §1011.02)
Section 44 – Filing requirements

• Bona fide intention to use the mark in commerce (TMEP §1008)
  – Lawfulness of goods/services is necessary at time of filing for intention to be valid.
  – If goods/services not lawful, refusal will issue for lack of bona fide intent to use in lawful commerce. (TMEP §907)

• U.S. Counsel must take action for applicants not domiciled in United States.
  – New rule 37 C.F.R. §2.11
Section 44 – Options

• If mark is found to be non-distinctive:
  – Supplemental Register – Section 23
  – Acquired distinctiveness – Section 2(f)

• If foreign mark reproduction shows more than one image, may petition to the director to waive U.S. rule (TMEP §1011.04)
Section 44 – Options

• Division of U.S. application is permitted.

• International class assigned in foreign registration is not binding on the U.S. Patent and Trademark Office (USPTO).

• U.S. application may list more specific goods/services, but cannot exceed scope of foreign filing.
  – May assert a different basis for goods/services not covered within scope of foreign filing.
Requests for extension of protection (REP) under the Madrid Protocol and Lanham Act Section 66(a)
International registration

• The International Bureau (IB) of the World Intellectual Property Organization (WIPO) “issues” international registrations (IRs) under Madrid Agreement & Protocol.

• Once “issued,” notices are sent to designated countries or intergovernmental organizations requesting protection of mark in such jurisdictions.

• Notification to office marks the start of refusal period.
Provisional refusal period

• Terms of Madrid Protocol give a 12-month refusal period.
• A member country may elect an 18-month refusal period; the U.S. has done so.
• Members may provide for refusals based on opposition after the 18-month time limit.
• Refusal periods are strictly enforced by WIPO.
Designation of United States

• International Bureau (IB) forwards request for extension of protection (REP) to the USPTO electronically.
• REP becomes an application under Trademark Act Section 66(a) and is assigned a U.S. serial number in the 79-series code.
• REPs are referred to as “Madrid applications,” “66(a) applications” or “79 applications.”
Receipt of REP by USPTO

• International registration (IR) date listed as “filing date” in USPTO records
  — Paris Convention priority – such date is used to determine “effective” filing date for purposes of examination
  — Subsequent designation – date received by IB or date filed in a local office (if forwarded to IB on time)

• Filing dates of REPs often older than oldest applications in new case inventory
Receipt of REP

USPTO display of application data in TSDR
Section 66 – Multiple supporting applications/registrations

• IR may be based on one or more foreign applications or registrations for the same mark for different goods/services.

• REP lists goods/services covered by different priority claims.
Section 66 – Options

• Division of U.S. REP application is permitted.
• U.S. REP application may include limitation of more specific goods/services, but cannot exceed scope of IR basic goods/services.
  – May not assert a different basis for goods/services not covered within scope of foreign filing (unlike §44).
Examination of §66(a) by the USPTO

• All USPTO examining attorneys are trained to examine REPs.
• REPs are examined the same as nationally filed applications.
  • Relative (likelihood of confusion) and absolute grounds apply; “common law” marks are not a basis for refusal.
  • Most of the same regulatory requirements apply.
Examination of §66(a) by the USPTO

• All marks must be eligible for registration on Principal Register.
  – Must be inherently distinctive or prove acquired distinctiveness (secondary meaning); no amendment to Supplemental Register.

• No examination of the declaration of bona fide intent to use the mark in U.S.
  – Use WIPO form MM18.
  – WIPO receives and reviews, but does not forward to USPTO.
Examination of §66(a) by the USPTO

- International class assigned by the IB may not be changed.
  - Classes may not be added.
- Indication (identification) of goods and services must conform to USPTO practice.
- Description required for all marks not claiming standard characters
Examination of §66(a) by the USPTO

If approved for publication:

- Interim status notification is sent to IB indicating date of opposition period
- Mark is published in the Trademark Official Gazette
  - Opposition period of 30 days begins
  - Extendable to 180 days
- If no opposition is filed, mark will register and a grant of protection is sent to IB.
- If opposition is filed by a third party, the USPTO will notify IB.
Examination common to both §§ 44 and 66(a)
Use in commerce considerations

• No proof of use is required before registration.
• Proof of use is required to maintain a resulting registration.
  – Sections 8 and 71 affidavit of continued use
  – Filed between fifth and sixth anniversary, ninth and 10th anniversary, and every 10 years thereafter
Grounds for refusal – substantive

• Trademark Act, Section 2
  – Deceptiveness; false suggestion of a connection; geographic indication used in connection with wine or spirits not originating in geographic area
  – Flag or coat of arms or other national insignia
  – Name or portrait of a living individual except by written consent
Grounds for refusal – substantive

• Trademark Act, Section 2
  – Likely to cause confusion
  – Descriptive or misdescriptive
  – Geographically descriptive
  – Geographically deceptively misdescriptive
  – Surname
  – Functional matter
Grounds for refusal – substantive

• Trademark Act, Sections 1, 2, 3, and 45
  – Failure to function refusals, but only when clearly apparent without use
  – Ornamentation (TMEP §1202.03(e))
  – Trade dress (TMEP §1202.02(e))
    • Product design
    • Product packaging
  – Informational matter (TMEP §1202.04)
Grounds for refusal – substantive

• Trademark Act sections 1, 2, 3, and 45
  – Other refusals when evidence exists to establish prima facie case
    • Goods in trade
    • Title of single work
    • Varietal and cultivar name
    • Non-traditional marks (sound, scent, motion, repeating pattern)
Grounds for refusal – procedural

• Identification/classification of goods/services
• Vast majority of foreign-based U.S. applications receive a requirement for more specific identification of goods/services.
  – In §66(a) applications, IB controls international class assigned
  – In §44 applications, international class has no legal effect
• The USPTO does not accept:
  – International class headings – goods and services must fall within the “ordinary meaning” of the words in the heading.
  – Brackets [ ] – wording must be incorporated or removed.
Grounds for refusal – procedural

Legal entity and place of organization
  • This is the second most common requirement made of §66(a) applicants.
  • U.S. Rules of Practice require this information of all applicants.
  • Not required by treaty regulations, but may include in international application
  • If not provided in the REP, the USPTO examining attorney will require in provisional refusal.
Grounds for refusal – procedural

Reproduction of the mark

• §44 – Drawing must be substantially exact representation of mark registered in foreign office.

• §66(a) – “Mark” may not be amended, but must comply with USPTO drawing rules.
Marks in color

• Marks in color must claim colors featured and describe where colors appear.
  – When IR or foreign registration mark is in color and color is claimed, color must be claimed as part of the mark in the U.S..
  – When IR or foreign registration mark is in color, but color is not claimed, applicant has option to amend to black and white drawing.
Grounds for refusal – procedural

§66(a) marks claiming color vs no claim

<table>
<thead>
<tr>
<th>MARK SECTION</th>
<th>IMAGE</th>
<th>COLLECTIVE, CERTIFICATE OR GUARANTEE MARK</th>
<th>MARK IN STANDARD CHARACTERS</th>
<th>MARK IN SYMBOL</th>
<th>COLOR CLAIMED FOR MARK</th>
<th>THREE DIMENSIONAL MARK</th>
<th>SOUND MARK</th>
<th>THE WORDS CONTAINED IN THE MARK HAVE NO MEANING (AND THEREFORE CANNOT BE TRANSLATED)</th>
<th>TM IMAGE: COLOR</th>
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</thead>
<tbody>
<tr>
<td>IMAGE</td>
<td>NO</td>
<td>NO</td>
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<td>NO</td>
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<td>NO</td>
<td>NO</td>
<td>YES</td>
</tr>
<tr>
<td>MARK IN SYMBOL</td>
<td>YES</td>
<td>NO</td>
<td>NO</td>
<td>NO</td>
<td>Dark blue, orange and white.</td>
<td>NO</td>
<td>NO</td>
<td>NO</td>
<td>YES</td>
</tr>
</tbody>
</table>

NO – cannot amend as colors are claimed

YES – can amend because no color claim

Some countries permit color drawing without having to claim color
Grounds for refusal – procedural

Marks consisting of sound only

• Many countries use pictures or musical staff notations to depict sound

• The USPTO requires the following:
  – Reproduction of the sound itself
  – Detailed description of the sound comprising the mark
Grounds for refusal – procedural

Other requirements

- Description of mark – 37 C.F.R. § 2.52(b)(5)
- Mark significance/translation/transliteration
- Disclaimer of not registrable matter
  - Distinctiveness of matter is a question of national law.
  - A disclaimer in a foreign registration does not necessarily result in the USPTO making the same requirement.
Maintenance of registrations issued under Sections 44 or 66
Affidavits or declarations of continued use under Sections 8 and 71
Affidavit of use or excusable nonuse

- Maintenance affidavits regardless of basis for registration
- Section 8, 15 U.S.C. §1058
- Section 71, 15 U.S.C. §1141k
- Equivalent regulatory requirements
  - 37 C.F.R. §§2.160–2.166
  - 37 C.F.R. §§7.36–7.40
Affidavit of use or excusable nonuse

• Deadlines for filing:
  – Between fifth and sixth year after U.S. registration
  – Between ninth and 10th year
  – Within one year before 20th, 30th, and so on
• Statute provides for six-month grace period after each deadline
  – Grace period filings require surcharge
Section 44 – Maintenance affidavit

• File online using Trademark Electronic Application System (TEAS).
• Must be filed by owner of registration (TMEP §1604.07(a))
• Attests to use of mark in commerce or asserts excusable non-use (TMEP §1604.10)
• Goods/services not in use must be deleted. (TMEP §1604.09(b))
Section 44 – Maintenance affidavit

• One specimen of use for each renewed class
• Specimens must comply with Rule 2.56.
• Specimens may be refused for not establishing use of the mark as a mark in commerce.
  – Model number
  – Solely a trade name
  – Ornamental matter
Section 66 – Maintenance affidavit

• Same requirements for §71 affidavits as those for §8 affidavits
• If refused, holder/owner may respond to correct deficiencies
• Petition to the director to review refusal per 37 C.F.R. §7.40
Section 66 – Maintenance affidavit

• Affidavits must be submitted directly to the USPTO.

• Maintenance filing due date is calculated from date of issuance of U.S. registration, not from the IR date.

• Failure to maintain will result in USPTO notification of invalidation to IB.
All maintenance affidavits

- Most deficiencies may be corrected.
- The USPTO identifies deficiencies in an office action with a six-month response period.
- If, after response, affidavit is not accepted, owner may petition for review of denial.
  - 37 C.F.R. §2.165
  - Decision on petition necessary before filing an appeal or commencing civil action
Excusable nonuse

• Sections 8 and 71 both require “a showing” that any nonuse is due to “special circumstances.”

• Sufficient facts demonstrate clearly that nonuse is due to a special circumstance beyond the owner’s control or "forced by outside causes."
Excusable nonuse

• Must state when use in commerce stopped and give the approximate date that use is expected to resume. (37 C.F.R. §2.161(f)(2))
• Examples of special circumstances and those deemed not are found in TMEP §§1604.11 and 1613.11.
Excusable nonuse

If owner was unable to commence use due to special circumstances beyond the owner’s control that excuse nonuse, state that the mark was never in use in commerce and give the approximate date on which use is expected to begin. (TMEP §§1604.11 and 1613.11)
Excusable nonuse

• If the USPTO determines that facts do not support excusable nonuse, owner/holder may file supplementary evidence or explanation.
• If there is time remaining in statutory filing period, owner/holder may submit a new affidavit with a claim of current use.
Renewals
Section 44 – Renewals

• Applications for renewal are governed by Section 9, 15 U.S.C. §1059.
  – U.S. registration is valid for a period of 10 years.
  – Applications for renewal may be filed between ninth and 10th anniversaries, and every subsequent 10-year period thereafter.
  – There is a grace period of six months after each 10-year deadline, with payment of surcharge.
Section 66 – Renewals

- Applications for renewal are governed by Article 7 of Madrid Protocol
  - IR is valid for a period of 10 years.
  - Applications for renewal may be filed within six months of the 10th anniversary of IR date, and every subsequent 10-year period thereafter.
  - There is a grace period of six months after each 10-year deadline, with payment of surcharge.
Section 66 – Renewals

• Renewals must be filed with IB at WIPO
  – Centralized maintenance of all designated countries
  – Madrid e-Renewal Service on WIPO website
  – No changes to IR permitted when renewing
  – Any request to renew filed through USPTO will not be processed (37 C.F.R. §7.41)
Affidavits or declarations of incontestability under Sections 15 and 73
Section 15 – Incontestability

• Owner may file an affidavit stating mark has been in continuous use in commerce for a period of five years after the date of registration. (TMEP §1605, et. seq.)
• The USPTO “acknowledges” affidavits that comply with statute and rules.
• Applies only to Principal Register.
Section 15 – Incontestability

- Must specify goods/services to which claim applies.
- Fee due for each class in claim.
- Mark must be in use in commerce regulated by U.S. Congress.
- No adverse decision or pending proceeding involving rights in mark.
- TMEP §1605.04
Section 73 – Incontestability

• If holder files an affidavit that meets the requirements of §15, the USPTO will acknowledge affidavit and update records.
• May rely on use of the same mark for the same goods/services if holder owns a prior U.S. registration issued before §66(a) REP. (TMEP 1904.11)
Practice pointers
Overly broad goods/services

• The No.1 pitfall in prosecution? Listing goods and services that are too broad for the USPTO’s requirements

• Broadly written goods/services lead to more substantive refusals
  – Likelihood of confusion
  – Descriptiveness
Specify goods and services

• Save your client time and money:
  – Narrow the goods/services in a §44 application in accordance with the USPTO Trademark ID Manual
  – Use the limitation in an international application or subsequent designation

• Examining attorney has discretion to require proof of bona fide intent for any of the goods/services identified.
Avoiding office actions/provisional refusals

**Voluntary Amendment Not in Response to USPTO Office Action/Letter Form**

**GENERAL FORM INFORMATION:**
- **60 MINUTE TIME LIMIT:** The form “times-out” 60 minutes after accessing the page unless you **do not** click the “Continue” button when the time-out warning appears on screen. To avoid time-out, please have all information ready before starting your session.
- **DO NOT USE YOUR BROWSER BACK/FORWARD BUTTONS:** Use only the navigation buttons at the bottom of each page.
- **REQUIRED FIELDS:** All have an **asterisk (*)**, and the form will not validate if these fields are not filled out.

**FOLLOW THE 4 STEPS TO ACCESS THE AMENDMENT FORM:**

**STEP 1:** To use this form, you must wait approximately 3-10 days after your original submission. Please first ensure that all of the original application data has been fully loaded into the USPTO’s TSS system before attempting to use this form.

**WARNING:** While you may successfully submit a Voluntary Amendment, the filing will NOT result in any information being automatically uploaded into the USPTO’s database. An examining attorney must review the amendment to determine whether the proposed change(s) is acceptable. Also, you may submit a Voluntary Amendment for an application filed under the Malawi Protocol (Title 35 U.S.C. 4), but be limited to: [details]

If you are submitting additional information as part of the record for a registration where no change is applied, the Trademark Office will examine your act as a separate submission. Otherwise, if you wish to correct errors or omissions in the registration certificate, do not use this form, instead, you must file a Section 8 Request for Amendment or Correction of Registration Certificate.

**STEP 2:** ENTER APPLICATION SERIAL NUMBER/REGISTRATION NUMBER BELOW OR ACCESS PREVIOUSLY FILLED-OUT/AVED FORM.

To access previously saved data, use the “Browse/Choose File” button to access the file from your local drive, and then click the “Continue” button at Step 4. You cannot change your answers to the form-related questions at Step 3; however, you can change data within an existing submission of a saved form. To introduce a completely new tab, you must start a new form. For further instructions for retrieving your saved data, click [here].

You must follow these instructions to ensure that you can view your data in the expected tabular format.

**NOTE:** The button should not be used to attempt to upload or attach any files, for example, a specimen image or a foreign registration certificate. For those or any other types of attachments, after answering “Yes” to the appropriate related question(s), you can then attach the file within the specific form relating to that issue.

**USPTO Voluntary Amendment Form**

Trademark Day Page 342
Maintenance requirements

• First time submitting specimens? Ensure they comply with Rule 2.56.
  – Advertising does not support goods.
  – Specimens must be in actual use, not created for submission with affidavit.

• Review goods/services with client and delete those not in use.
Proof of use audit program

- Eligible for audit when registration has at least one class with four items or at least two classes with two or more items.
- USPTO requires evidence of use on randomly selected items other than those provided.
- https://www.uspto.gov/trademarks-maintaining-trademark-registration/post-registration-audit-program
Maintenance information

• Notice of requirements is provided on the back of every registration certificate.

• Trademark status and document retrieval (TSDR) system includes maintenance information on separate tab.
TS热烈零售商维护标签 – §44(e)

Trademark Status & Document Retrieval (TSDR)

Status: §44(e) - Renewal Granted
§9 (10 year) - Accepted

Declaration of Incontestability: §15 - Acknowledged

§8 Declaration and §9 Application for Renewal Due Dates:

Earliest date §§8 & 9 can be filed: Jun. 14, 2024
Latest date §§8 & 9 can be filed without paying an additional fee: Jun. 16, 2025
Latest date §§8 & 9 can be filed by paying an additional fee: Dec. 15, 2025

If you are the applicant or the applicant’s attorney and have questions about this file, please contact the Trademark Assistance Center
Trademark Status & Document Retrieval (TSDR)

§71 (6 year) Declaration Due Dates:

- Earliest date §71 (6 year) can be filed: May 21, 2024
- Latest date §71 (6 year) can be filed without paying additional fee: May 21, 2025
- Latest date §71 (6 year) can be filed by paying an additional fee: Nov 21, 2025

Download Adobe Reader

If you are the applicant or the applicant’s attorney and have questions about this file, please contact the Trademark Assistance Center.
Trademark Clearance Searches

Josh Gerben, Gerben Law Firm
Best Practices When Searching

- When conducting a trademark search:
  - Use a professional grade software / search provider.

- Do not forget to conduct state and common law searches.
  - Advise client of limitations of your trademark search.

- Free trademark searches are many times not adequate.
  - Be ready for clients who believe trademark searches can be done quickly and online.
Vendor/Technology Options

- USPTO’s TESS

- Entrenched large companies
  - Corsearch
  - Thompson West
  - Compumark

- New AI players
  - TrademarkNow
  - Marify
  - Others...

Trademark Day Page 352
Types of Advice to Give to Your Client

- Provide practical along with technical legal advice.
  - Clearance for “use” of a trademark.
  - Clearance for “registration of a trademark”

- Consider possibility of cancellation against blocking marks.

- Prepare client for the length of the prosecution process and possible outcomes. You are the guide through the forest.
Pre-Filing Best Practices

Tracy L. Deutmeyer, Fredrikson & Byron, P.A.
Who is the Applicant?

- An application must be filed by the owner of the mark or, in the case of an intent-to-use application, by the person who is entitled to use the mark in commerce. Normally the owner of a mark is the person who applies the mark to goods that he or she produces, or uses the mark in the sale or advertising of services that he or she performs. T.M.E.P. § 803.01

- If an applicant is not the owner of (or entitled to use) the mark at the time the application is filed, the application is void and cannot be amended to specify the correct party as the applicant, because the applicant did not have a right that could be assigned. 37 C.F.R. §2.71(d). T.M.E.P. § 803.01
Who is the Owner?

- In an application under §1, an applicant may base its claim of ownership on:
  1) its own exclusive use of the mark;
  2) use of the mark solely by a related company whose use inures to the applicant’s benefit; or
  3) use of the mark both by the applicant and by a related company whose use inures to the applicant’s benefit. Where the mark is used by a related company, the owner is the party who controls the nature & quality of goods sold or services rendered under the mark.

*T.M.E.P. § 1201.01*
Who is the Owner?
<table>
<thead>
<tr>
<th>DESCRIPTION OF THE MARK</th>
<th>The mark consists of letters &quot;TB&quot; in stylized font at the top interspersed with the number &quot;12&quot; in stylized font at the bottom, with the top bar of the &quot;T&quot; also forming the top of the &quot;B,&quot; the bottom half of the &quot;T&quot; forming the top half of the &quot;1,&quot; and the bottom half of the &quot;B&quot; forming the top of the &quot;2.&quot;</th>
</tr>
</thead>
<tbody>
<tr>
<td>PIXEL COUNT ACCEPTABLE</td>
<td>NO</td>
</tr>
<tr>
<td>PIXEL COUNT</td>
<td>322 x 224</td>
</tr>
<tr>
<td>REGISTER</td>
<td>Principal</td>
</tr>
<tr>
<td>APPLICANT INFORMATION</td>
<td></td>
</tr>
<tr>
<td>OWNER OF MARK</td>
<td>Yee &amp; Dubin Sports LLC</td>
</tr>
<tr>
<td>STREET</td>
<td>725 S. Figueroa Street, Suite 3085</td>
</tr>
<tr>
<td>CITY</td>
<td>Los Angeles</td>
</tr>
<tr>
<td>STATE</td>
<td>California</td>
</tr>
<tr>
<td>COUNTRY</td>
<td>United States</td>
</tr>
<tr>
<td>ZIP/POSTAL CODE (Required for U.S. applicants)</td>
<td>90017</td>
</tr>
<tr>
<td>LEGAL ENTITY INFORMATION</td>
<td></td>
</tr>
<tr>
<td>TYPE</td>
<td>Limited liability company</td>
</tr>
<tr>
<td>STATE/COUNTRY</td>
<td></td>
</tr>
</tbody>
</table>
WHO ARE WE?
Yee & Dubin Sports is a sports management and consulting firm located in downtown Los Angeles. The firm represents athletes, coaches and broadcasters in contract negotiations and career management and also serves as a consultant... Read More

WHY CHOOSE US?
We have a long track record of providing sophisticated advice and career guidance to our clients. We adhere to strict ethical standards in providing our services, and we are direct in our communication about what we can or cannot do... Read More

WHAT MAKES US UNIQUE?
Yee & Dubin provides each client an effective blend of business acumen, experience, sophistication and judgment. We take pride in our work ethic, which has yielded a proven history of success in a variety of ventures... Read More
## Assignment abstract of title for application serial no.: 87234118, registration no.: 5284247

**Marks/Registrant**
TB12
Yee & Dublin Sports LLC

**Serial**
87234118
Nov 11, 2016

**Registration**
5284247
May 15, 2018

### Assignments (1 total)

#### Assignment 1

<table>
<thead>
<tr>
<th>Reel/Frame</th>
<th>Execution date</th>
<th>Date recorded</th>
<th>Properties</th>
<th>Pages</th>
</tr>
</thead>
<tbody>
<tr>
<td>0286/0296</td>
<td>Sep 18, 2017</td>
<td>Mar 7, 2018</td>
<td>14</td>
<td>7</td>
</tr>
</tbody>
</table>

**Conveyance:**
ASSIGNMENT OF TRADEMARKS

**Assignor:**
YEE & DUBIN SPORTS LLC

**Entity type/citizenship:**
LIMITED LIABILITY COMPANY/CALIFORNIA

**Correspondent:**
LATHAM & WATKINS LLP
650 TOWN CENTER DRIVE, 20TH FLOOR
COSTA MESA, CA 92626

**Assignee:**
TER CAPITAL MANAGEMENT, INC.
C/O SCS FINANCIAL SERVICES
ONE WINDROP SQUARE
BOSTON, MA 02109

**Entity type/citizenship:**
CORPORATION/MASSACHUSETTS
Can the Applicant be Changed?

- While an application can be amended to correct an inadvertent error in the manner in which an applicant’s name is set forth (see TMEP §1201.02(c)), an application cannot be amended to substitute another entity as the applicant. *T.M.E.P. § 803.06*
What Errors are Correctable?

- **T.M.E.P. § 1201.02(c)** provides list of **correctable and non-correctable errors**.

- **Examples of correctable errors**: Trade name set forth as applicant; change of name pre-filing; non-existent entity at time of filing.

- **Examples of non-correctable errors**: predecessor in interest; president of corp. files as individual when corp. owns the mark; joint venturer files when joint venture owns mark.
Who is the Applicant? Practice Tips

- Check Secretary of State or foreign corporate database for citizenship, entity type, exact name.
- **Foreign applicant? Inquire first about application or registration in home country.** If applicant claims §44 as filing basis in the original U.S. application, or if applicant subsequently claims §44 as basis, applicant must be the owner of foreign application or registration on the filing date of the U.S. application. *T.M.E.P. § 1003.03*
Practice Tips - What Mark to Apply to Register?

For new brand names, first priority is application for standard characters, unless trying to distinguish from prior mark. Registrations in standard character format are “federal mark registrations that make no claim to any particular font style, color, or size of display and, thus, are not limited to any particular presentation.”

_Citigroup Inc. v. Capital City Bank Group Inc.,_ 637 F.3d 1344, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011).
Practice Tips - What Mark to Apply to Register?

☐ Apply for smallest portion of composite “mark” that makes separate commercial impression, unless trying to distinguish from prior mark. (Reg. No. 4727792 (GERBEN).)
Practice Tips - What Mark to Apply to Register?

- Ask client how it intends to use mark – view mock-up if available to determine what mark to apply to register.
- Foreign wording? **Best practice is to transliterate/translate before filing, search the English translation, too, and advise client of possible translation requirement.**
- If mark includes an individual’s name or portrait, either provide: (1) a statement that identifies the living individual whose name or likeness the mark comprises, and written consent of the individual; or (2) a statement that the name or portrait does not identify a living individual. Remember consent must include consent to use and registration.
Which Filing Basis?

There are 5 filing bases:

1) use of a mark in commerce under §1(a);
2) bona fide intention to use a mark in commerce under §1(b);
3) a claim of priority, based on an earlier-filed foreign application under §44(d);
4) ownership of a registration of the mark in the applicant’s country of origin under §44(e) of the Act; and
5) extension of protection of an international registration to the United States, under §66(a) of the Act.

T.M.E.P. §806
Which Filing Basis?

NOTE: The 4 BUTTONS below identify the choices of filing basis to be assigned to the items listed in the table, above. For an explanation of each basis, click here. Because assignment of the correct basis to each item is critical, please read the explanations if you have any questions as to which basis(es) to select, before clicking the button(s), below, to begin the assignment of the basis(es). Since assignment of a filing basis is not a requirement within this version of the form, you can by-pass this step by clicking on the Continue button, below, if necessary.

WARNING: Registration Subject to Cancellation for Fraudulent Statements
You must ensure that statements made in filings to the USPTO are accurate, as inaccuracies may result in the cancellation of a trademark registration. The lack of a bona fide intention to use the mark with all goods/services included in an application, or the lack of use on all goods/services for which you claim use, could jeopardize the validity of the registration and result in its cancellation.

<table>
<thead>
<tr>
<th>Section 1(a)</th>
<th>Section 1(b)</th>
<th>Section 44(d)</th>
<th>Section 44(e)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Actually using mark in commerce now</td>
<td>No use of mark yet, intending to use</td>
<td>Foreign application exists for same goods/services</td>
<td>Foreign registration exists for same goods/services</td>
</tr>
</tbody>
</table>

Section 44(d): Prior basis based on foreign filing. The applicant has a bona fide intention, and is entitled, to use the mark in commerce on or in connection with the identified goods/services, and asserts a claim of priority based upon an earlier filed foreign application.

<table>
<thead>
<tr>
<th>Country of Foreign Filing</th>
<th>Select Country *</th>
</tr>
</thead>
<tbody>
<tr>
<td>Foreign Application Number</td>
<td>Not the USTPO database can only store 10 characters for the field. You should adjust your entry if possible, eliminating any unnecessary letters to or country abbreviations, for example.</td>
</tr>
<tr>
<td>Date of Foreign Filing</td>
<td>[DD/MM/YYYY]</td>
</tr>
</tbody>
</table>

NOTE: Section 44(d) provides a basis for filing and a priority date, but not a basis for registration.

9. If this is the applicant's only basis per Section 44(d), the examiners' may suspend the application to await the submission of the foreign registration. If ultimately the applicant does not rely on Section 44(d) as a basis for registration, a valid claim of priority may be retained.

At this time, the applicant has another basis for registration (Section 1(a) or Section 44(e)) and does NOT intend to rely on Section 44(d) as the basis for registration, but to only asserting a valid claim of priority. The application should not be suspended to await the submission of the foreign registration.

<table>
<thead>
<tr>
<th>Section 1(a)</th>
<th>Section 1(b)</th>
<th>Section 44(d)</th>
<th>Section 44(e)</th>
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</tr>
</tbody>
</table>

7th Annual ABA-IPL Trademark Day with the USPTO 20 9/18/2019
Section 44(d) Practice Tips

- **Foreign applicant? First inquire about pending application or registration in home country.**
- **Confirm with client what other basis to select.**
- **If have Section 44(d) basis, best practice is to select another basis at time of filing.** Section 44(d) of the Act provides a basis for receipt of a priority filing date, but not a basis for publication or registration. Before the application can be approved for publication, or for registration on the Supplemental Register, the applicant must establish a basis under §1(a), §1(b), or §44(e) of the Act. 37 C.F.R. §2.34(a)(4)(iii); *T.M.E.P.* §1003.03.
Sections 1(a) and 1(b) Practice Tips

- It is possible to claim use in commerce for some goods in a class, and an intention to use the mark for other goods in that same class.

  (Based on intent to use) Vanilla essence; vanilla pods; vanilla flavourings for food or beverages
  (based on use in commerce) vanilla extract; vanilla sugar; vanilla beans; vanilla syrup; vanilla powder; vanilla paste (App. No. 88235787)

- Ask client for current specimen of use for each good identified, even though the USPTO only requires one acceptable specimen per class.
Section 44(e) Practice Tips

- Proofread foreign Certificate of Registration to ensure owners match, and goods/services in U.S. application fall within the scope of the identification in the foreign registration.

- Standard character mark? Check out Appx. E to TMEP, “Countries That Have Standard Character Marks or the Equivalent”.
Identification of Goods Practice Tips


2) If niche industry or otherwise necessary, check identifications in recently published applications for same or similar goods/services identifications.

3) For conceptually weak mark, ensure that mark does not appear in I.D.
What is a Registerable Service?

1) a service must be a real activity;
2) a service must be performed to the order of, or for the benefit of, someone other than the applicant; and
3) the activity performed must be qualitatively different from anything necessarily done in connection with the sale of the applicant’s goods or the performance of another service.

*T.M.E.P. § 1301.01(a)*
Identification Practice Tips

- Inquire further when a goods manufacturer or producer asks to include advertising, billing, design or development services in app.
- Inquire further when a service provider asks to include goods in the application.
Declaration for Initial Application

Filing basis

No one else can use the mark in commerce

Facts alleged have evidentiary support

Declares truth, having been warned re willful false statements

– 18 USC 1001
Declaration for Initial Application

Read the following statements before signing. Acknowledge the statements by checking the boxes and signing below.

☐ Basis:
If the applicant is filing the application based on use in commerce under 15 U.S.C. § 1051(a):

☐ The signatory believes that the applicant is the owner of the trademark/service mark sought to be registered;
☐ The signatory is the owner of the trademark/service mark sought to be registered;
☐ To the best of the signatory’s knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive.

☐ To the best of the signatory’s knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.
☐ The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

☐ To the best of the signatory’s knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.
☐ The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.
Increased Solemnity of Declarations

- **Subject to Criminal Penalties**
  - Pursuant to 18 U.S.C. § 1001
  - “Knowingly and willfully”
  - Fines, Imprisonment (less than 5 years)
  - Title 18 houses the U.S. criminal code

- **Advise Clients of Importance of Declaration**
  - Note each element shown in checkboxes
  - Signatory can only sign if he/she can say these things based on knowledge of the relevant facts
Signature Requirements
Signed by a Proper Person – Factual Knowledge

- 37 C.F.R. § 2.193(e) – Proper Person Must Sign
  - Signed by owner OR a person “properly authorized” to verify facts on behalf of the owner
    - Legal authority to bind (corporate officer or general partner of partnership); OR
    - Person with first-hand knowledge AND actual/implied authority to act on behalf of owner; OR
    - An attorney (§ 11.1) with actual POA
  - Key: PERSONAL knowledge of the facts
  - Must educate our clients about the importance of THEIR signatures
Signatory Must Sign Own Name

- **37 C.F.R.:**
  - § 1.4(d)(2): S-signatures:
    - “and the person signing the correspondence *must insert his or her own* S–signature”
  - §§ 2.193(a)(1), (c)(1):
    - (a)(1): If electronic, must be “*personally entered* by the person named as the signatory”
    - (c)(1): “*Personally enter* any combination of letters, numbers . . . he or she has adopted as a signature”
  - § 11.18:
    - “each piece of correspondence filed by a practitioner must bear a signature, *personally signed or inserted* by such practitioner . . .”

- “Another person (e.g., paralegal, legal assistant, or secretary) may not sign the name of a qualified practitioner or other authorized signatory.” TMEP § 611.01(c).
  - “Rules do not provide authority for an attorney to sign another person’s declaration.” *In re Dermahose*, 82 USPQ2d 1793, 1796 (TTAB 2007); TMEP § 804.04.

- Violation of the Rule could jeopardize client’s registration or pending application
OED Opinions – Signature Rule Violations

- Monthly Recent Opinions (published in OG and on eFOIA)
  - Reyner Meile – issued 3/22/19
    - President of paralegal outsourcing company, Virtual Legal Services
    - Paralegals entered keystrokes of client’s signatures – said had consent
    - Result: Public reprimand, notify clients, complete mandatory CLE
  - Travis Crabtree – issued 4/25/19
    - Ran Trademark Engine – he’s the only licensed attorney with the company
    - Paralegals entered client’s names in signature blocks & provided legal advice
    - Paralegals filed express abandonment without client’s knowledge or consent
    - Collected fees without escrow accounts
    - Result: Exclusion from practice

Source: https://foiadocuments.uspto.gov/oed
OED Opinions – Signature Rule Violations

- **Heather Sapp – issued 5/15/19**
  - Former Trademark Examining Attorney – 14 years of experience
  - With Legal Force, but was not a supervisory attorney
  - “Allowed” paralegals to sign trademark filings rather than named signatory
  - Once she learned re “impermissible signature practice” did not advise clients
  - Result: Public reprimand, one year probation

- **Deborah Sweeny – issued 6/19/19**
  - Pres. of MyCorporation Business Services – had 20 years of experience
  - Apps prepared, signed and filed through “electronic workflow”
  - Clients never saw final documents for signing
  - Result: Public reprimand
Common Themes

- **Concern: Unauthorized Practice of Law**
  - 37 C.F.R. § 2.17 – “Only an individual qualified to practice under § 11.14 . . . may represent an applicant, registrant or party to a proceeding before the Office in a trademark case.”
  - “Practitioners” – 37 C.F.R. § 11.1
    - Attorney or lawyer: “active member in good standing of the bar of the highest court” of a U.S. state may represent others before the Office in any trademark and other non-patent matters. (37 C.F.R. § 11.14)
    - Note Mandatory U.S. Counsel Rule
  - Problem: Non-attorneys providing legal advice
  - Misrepresentation to the client and the USPTO about who signed form

Risks of Attorney Signing Declarations

- Lack of actual knowledge
  - Date of first use
  - *Bona fide* intent to use (vs overbroad claim)
  - How the mark has been/is being used
  - Use on every good/service in each class

- Cancellation/Opposition Proceeding
  - Opposing Party entitled to inquire as to the factual basis supporting use
  - Attorney could become witness – requiring different attorney/firm to handle dispute
  - Entire registration could be cancelled
Statement of Use Declaration

[X] The signatory believes that the applicant is the owner of the mark sought to be registered.

For a trademark or service mark application, the mark is in use in commerce on or in connection with all the goods/services in the application or notice of allowance, or as subsequently modified.

For a collective trademark, collective service mark, collective membership mark application, the applicant is exercising legitimate control over the use of the mark in commerce by members on or in connection with all the goods/services/collective membership organization in the application or notice of allowance, or as subsequently modified.

For a certification mark application, the applicant is exercising legitimate control over the use of the mark in commerce by authorized users on or in connection with the all goods/services in the application or notice of allowance, or as subsequently modified, and the applicant is not engaged in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

[X] The specimen(s) shows the mark as used on or in connection with the goods/services/collective membership organization in commerce.

[X] To the best of the signatory's knowledge and belief, no other persons, except, if applicable, authorized users, members, and/or concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services/collective membership organization of such other persons, to cause confusion or mistake, or to deceive.

[X] To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.

[X] The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made by his/her own knowledge are true and all statements made on information and belief are believed to be true.

7th Annual ABA-IPL Trademark Day with the USPTO

Trademark Day Page 386
Section 8 – Declaration of Continuing Use

Read the following statements before signing. Acknowledge the statements by checking the boxes and signing below.

☐ Unless the owner has specifically claimed excusable nonuse, the mark is in use in commerce on or in connection with the goods/services or to indicate membership in the collective membership organization identified above, as evidenced by the attached specimen(s).

☐ Unless the owner has specifically claimed excusable nonuse, the specimen(s) shows the mark as currently used in commerce on or in connection with the goods/services/collective membership organization.

☐ To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.

☐ The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of this submission and the registration, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

- Pay close attention to this declaration – may precede a notice of a random audit
- Use in connection with ALL goods/services
- Delete any not in use before submitting
Tips on Responding to Office Actions
Ways to Overcome Section 2(d) Refusals

1) File an argument, and/or

2) Narrow the identification of goods or services in the application to distinguish the goods/services from cited mark.

3) Successfully petition to cancel the cited registration, or part of the registration. Action on pending application should be suspended pending the outcome of a cancellation proceeding.

4) Obtain the written consent to use and registration of the mark by registrant, indicating—in the consent—why no confusion is likely in the marketplace.

5) Purchase the cited registration, and file proof of that assignment with the USPTO.
Consent Agreements

- An applicant may submit a consent agreement in an attempt to overcome a refusal of registration under §2(d) of the Act, or in anticipation of a refusal to register.

- A consent agreement may take a number of different forms and arise under a variety of circumstances, but, when present, it is "but one factor to be taken into account with all of the other relevant circumstances bearing on the likelihood of confusion referred to in §2(d)." TMEP § 1207.01(d)(viii). In re N.A.D. Inc., 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985); see also In re Bay State Brewing Co., 117 USPQ2d 1958, 1963 (TTAB 2016) ("[T]here is no per se rule that a consent, whatever its terms, will always tip the balance to finding no likelihood of confusion, and it therefore follows that the content of each agreement must be examined.").

- "Naked" consent agreements (i.e., agreements that contain little more than a prior registrant’s consent to registration of an applied-for mark and possibly a mere statement that source confusion is believed to be unlikely) are typically considered to be less persuasive than agreements that detail the particular reasons why the relevant parties believe no likelihood of confusion exists and specify the arrangements undertaken by the parties to avoid confusing the public." TMEP §1207.01(d)(viii).
Practice Tips on Avoiding “Naked” Consent Agreement

- List reasons why parties believe no confusion is likely. *Recitals of agreement is a good place to enumerate reasons.*

- If consent agreement makes representations about both parties’ beliefs regarding likelihood of confusion and/or indicates that both parties have agreed to undertake certain actions to avoid confusion, then it should be signed by both parties. *T.M.E.P. § 1207.01(d)(viii).*

- If arrangement includes confidential information (such as payment by one party to another), have a main agreement, and then attach as an exhibit to main agreement the consent agreement to be filed with the USPTO.
Reminders on Submission of Evidence

- Web site evidence: To introduce Internet materials into the record, an applicant must provide (1) an image file or printout of the downloaded webpage, (2) the date the evidence was downloaded or accessed from the Internet, and (3) the complete URL address of the webpage.  
  TBMP §1208.03; see TMEP §710.01(b) (citing Safer Inc. v. OMS Invs. Inc., 94 USPQ2d 1031, 1039 (TTAB 2010)).

- Helpful programs for capturing “printer friendly” evidence with date and URL address include Snagit, PageVault and FireShot.
Reminders on Submission of Third Party Registrations

- Active third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *T.M.E.P. § 1207.01(d)(iii).*

- Third-party registrations that are not based on use in commerce, such as those registered under §66 of the Trademark Act, or those registered solely under §44 of the Trademark Act, and for which no §8 or §71 affidavits or declarations of continuing use have been filed, *have very little, if any, persuasive value.* *T.M.E.P. § 1207.01(d)(iii).*

- To make registrations of record, copies of the registrations or the complete electronic equivalent (i.e., complete printouts taken from the USPTO’s Trademark database) must be submitted. *T.M.E.P. § 710.03.*
Descriptive Refusals – § 2(e)

- Refusal based on descriptiveness
  - Merely descriptive of “ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services.” TMEP §1209.01(b)
  - Laudatory terms, phone numbers, foreign equivalents . . .

- Potential Responses
  - Submit argument challenging determination (suggestiveness, particular distinctive features)
  - Acquired distinctiveness under § 2(f) – long-standing use
  - Amend to the Supplemental Register (some limitations)
Merely Ornamental Use

- “Merely a decorative feature” – “does not function as a trademark” TMEP § 1202.03
- Some ornamental use can be registered – must serve as a source identifier
- Size/placement of design will matter – but will not be dispositive
Merely Ornamental Use, continued

- Ser. No. 86/705,287 – refused even after *ex parte* appeal
- Ser. No. 77/525,450 – refused after *ex parte* appeal
General Tips – Responding to Refusals

- Review the relevant section of TMEP (tmep.uspto.gov)
- Review cases that seem to support your position
  - Confirm they are really “on point”
- Review any cases seeming to argue against your position
- Confirm the strategy you intend to pursue with your client
  - May actually be the opposite of a position they may be taking in a different forum
General Tips – Responding to Refusals (contin.)

- **Persuasion techniques**
  - The person you are trying to persuade is a gatekeeper, not opposing third party.

- **Read the Office Actions closely**
  - Many times examiners will telegraph the point / problem you need to overcome. Focus on that issue in your response. Provide as much evidence and caselaw as possible.

- **Avoid templated arguments**
  - Examiners see a lot of templated arguments and similar case citations. It is fine to go through the motions, but it is typically only a case on point that you find, or, evidence that you can put into the record unique to your matter that will overcome a refusal to register.
Specimens

What qualifies as an appropriate specimen?
- ‘Goods’ vs. ‘Services’ specimen
  - Goods – a photograph of the product or packaging displaying the trademark
  - Services – a screenshot of a website or advertisement

Qualities of a bad specimen
- Digitally altered image
- Items not in the marketplace
USPTO is carefully reviewing specimens in renewal filings.

To ensure your client's registration can survive an audit it is a “best practice” to obtain a specimen for every product and/or service to be left in the registration.

Clients may push back on providing all this information.

Consider having talking points and information available for clients on the seriousness of the USPTO’s audit program.
Best Practices – Post-Registration Declarations

Christina D. Frangiosa, Eckert Seamans Cherin & Mellott, LLC
Section 8 – Declaration of Continuing Use (again)

- Registrant must declare use in connection with ALL goods/services
- Delete any not in use before submitting
- Registrant (not attorney) should sign these – personal knowledge of use
Continued Use Declarations (8/71)

- Best practices – following registration
  - Remind clients of their obligation to maintain good evidence of use for EACH good
  - Foreign registrants – first time evidencing use with this Declaration
- Perhaps even request that the client provide to you proof of use for Section 8/71 Declaration before filing
  - Consider submitting evidence of each good/service with the filing
  - Could help avoid a random audit if proof of use were already on file
  - Especially important to advise foreign clients about the use requirement
Random Audits
Registrations Audited

- Commissioner Denison will provide details for the number of registrations audited & process for auditing
  - First Post-Reg Office action – requests proof of use on two goods
  - Deleting one of those goods from the Reg. in response will trigger a second Office action, which will request proof of use on all g/s
    - This is why it's helpful to have that proof of use on hand
    - Think ahead and start asking clients to collect this evidence and provide to you in anticipation
  - General sense is that more than half require deletion of goods/services in response to the audit request
Random Audit Declaration

The following statement and declaration under 37 C.F.R. §2.20 can be used to verify the use of the mark as evidenced by the item(s) submitted as proof of use, if properly signed and dated:

The owner was using the mark in commerce on or in connection with the goods and/or services identified in the registration for which use of the mark in commerce is claimed, as evidenced by the submitted proof of use and specimen(s), during the relevant period for filing the affidavit of use.

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of this submission, declares that the facts set forth above are true; all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

____________________________________
Signature of Authorized Person

____________________________________
Type or Print Name

____________________________________
Date

WARNING: If your response to this Office action does not meet the requirements of the audit, or includes a request to delete the goods identified for the audit, and goods remain in the registration without acceptable proof of use, a second Office action will issue requiring proof of use for all remaining goods for which proof of use is not of record. See 37 C.F.R. §§2.161(h), 7.37(h). Therefore, the owner or holder/owner should delete all goods for which proof of use cannot be provided.
Random Audit Declaration

- **Text is different**

- The owner was using the mark in commerce on or in connection with the goods and/or services identified in the registration for which use of the mark in commerce is claimed, as evidenced by the submitted proof of use and specimen(s), during the relevant period for filing the affidavit of use.

- The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of this submission, declares that the facts set forth above are true; all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

See https://www.uspto.gov/trademarks-maintaining-trademark-registration/post-registration-audit-program.
Questions?
The far reaches of trademarks considerations for non-traditional marks
Susan C Hayash, managing attorney
September 18, 2019
Non-traditional marks defined

Lanham Act definition:

“Any word, name, symbol, or device, or any combination thereof ...”

15 U.S.C. §1127
Non-traditional marks defined

• The Supreme Court recognized “...since human beings might use a ‘symbol’ or ‘device’ almost anything at all is capable of carrying meaning, this language, read literally, is not restrictive.”
Most commonly seen marks

• Trade dress:
  – Product shape or configuration
  – Product packaging (product dressing)
Most commonly seen marks

• Repeating patterns
Most commonly seen marks

• Back to trade dress: color as a mark
  – Single color
Most commonly seen marks

• Back to trade dress: color as a mark
  – multiple colors
Most commonly seen marks

• Sensory marks:
  – These marks consist of sound, smell, touch, and taste.
Less common

- Tactile
- Multimedia
- Hologram
- Taste
- Light
Filing considerations
Filing considerations

• Minimum filing requirements:
  – Despite being called a “non-traditional” mark, all filing requirements are still required, and all depend on the type of filing (Trademark Electronic Application System (TEAS) Plus, TEAS Reduced Fee, Madrid) used.
  – However, there are some special issues to consider for filing
Special filing considerations: drawings

• For visual marks:
  – Clear as to the fidelity of the mark and what is being claimed
  – Line drawings preferred
  – Incapable matter must be indicated by broken lines
  – Provides notice to the public of the nature of the mark
Special filing considerations: drawings

• For visual marks:
  – Three dimensional marks must be shown in a single rendition.
    • Submitting multiple renditions will result in a requirement for a single rendition.
    • If the applicant feels that the mark cannot be adequately depicted in a single rendition, a petition to the director must be filed requesting a waiver.
Special filing considerations: drawings

• For visual marks:
  – Color marks:
    • Must show how the color is used on the goods or services, per Trademark Manual of Examining Procedure (TMEP) §1202.05(d)(ii).
    • The commercial impression of a color mark depends on the context in which it is used.
Special filing considerations: drawings

• For visual marks:
  – Color marks:
    • Drawing can be used on multiple goods if the goods the color is being applied to are similar in form or function, e.g. if the mark is the color purple used on refrigerators and freezers, a drawing of a purple freezer shown in broken lines (with a description of the mark claiming the color purple and indicating that it is used on the freezer).
Special filing considerations: drawings

• For non-visual marks:
  – Scent, sound, and other olfactory marks aren’t capable of being depicted in a drawing.
  – TMEP §807.09: If the applicant is submitting a TEAS application for a scent mark (or sound), the applicant should indicate that the mark type is "Standard Character" and should type "Scent Mark" (or “Sound Mark”) in the "Standard Character" field. The USPTO will enter the proper mark drawing code when the application is processed.
Special filing considerations: descriptions

• Descriptions are critical and must be complete with non-traditional marks (TMEP 807.02):
  – They must precisely list all features claimed in the mark.
  – Three-dimensional marks must contain the wording “three-dimensional” or “configuration” in the description.
Special filing considerations: descriptions

• Non-visual marks rely upon the description:
  – Scent: Describe the scent of the mark, e.g. “The mark is a scent of a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough.”
Special filing considerations: descriptions

• Non-visual marks rely upon the description:
  – Sound marks: The applicant should generally submit the musical score sheet music to supplement or clarify the description. TMEP §807.09; 37 C.F.R. §2.61(b).
Special filing considerations: consistency between mark and identification of goods/services

• An applicant may not register trade dress for goods or services that cannot take the shape of the mark depicted in the reproduction of the mark in the application.
Special filing considerations: acquired distinctiveness

• Nearly all non-traditional marks are not inherently distinctive, thus applicant should be prepared to demonstrate acquired distinctiveness.
Common refusals
Common refusals: functionality

• A mark is functional if as a matter of law it is “essential to the use or purpose of the article or it affects the cost or quality of the article.”
Common refusals: functionality

• Understanding how the applicant’s mark operates is key:
  – Does the applicant own utility patents? Or, are there third-party utility patents that claim features of the product design?
  – Are there other similar products or marks within the industry?
Common refusals: functionality

• Understanding how the applicant’s mark operates is key:
  – Does the applicant’s literature claim that there is improvement on the goods?
  – How easy is the applicant’s product to manufacture?
Common refusals: functionality — color, scent, taste, sound

• Functionality applies to all additional non-traditional marks in the same way as shapes and other non-traditional marks.
Common refusals: functionality

• Functionality is a complete bar to registration.
Common refusals: functionality in only a part of the mark

- If not all portions of the mark are functional, then the functional portions must be set aside through the drawing and mark description drafting that leaves them as features “not claimed as a part of the mark.”
Common refusals: distinctiveness

• The majority of non-traditional marks are nearly always never inherently distinctive.
• Examples of never inherently distinctive:
  – Product design trade dress
  – Color, sound, scent, flavor
Common refusals: distinctiveness

• Product packaging trade dress may be inherently distinctive, depending on if it is:
  – Common basic shape or design (not inherently distinctive);
  – Unique or unusual in a particular field (possibly);
  – A mere refinement of a commonly adopted and well known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods (probably not); or
  – Capable of creating a commercial impression distinct from any wording (most likely yes)
Common refusals: ornamentation

• Ornamentation:
  – Merely a decorative feature of the mark that does not function
  – Typically a specimen based refusal, however, the refusal can be issued based upon the description of the mark or the drawing
Common refusals: ornamentation

• Ornamentation in non-traditional marks
  – Typically secondary source doesn’t apply
  – Generally must be capable of acquiring distinctiveness
  – Could never be capable of registration
Common refusals and requirements: acquired distinctiveness

• Section 2(f) acquired distinctiveness will overcome a nondistinctiveness refusal.

• Claims:
  – Prior registrations
  – Five years’ use
  – Evidence based
Common refusals and requirements: acquired distinctiveness

• Prior registration:
  – Claim of ownership of at least one prior active registration on the Principal Register for the same mark for goods/services sufficiently similar to those in the application.

• Use based 2(f) claims:
  – Minimum of five years substantially exclusive and continuous use in U.S. commerce prior to filing the application
  – Declaration required to support
Common refusals and requirements: acquired distinctiveness

• Direct evidence:
  – Declarations from consumers
    • Form declarations aren’t as persuasive.
    • Declarations from applicant’s employees and representatives are often seen as self serving and biased.
    • Declarations that identify specific features are more persuasive.
Common refusals and requirements: acquired distinctiveness

• Direct evidence:
  – Surveys, market research, and consumer studies can be used but are often expensive.
    • Applicant must establish the procedural and statistical accuracy and carefully frame the questions.
    • Must include information about the survey and how it was conducted, number surveyed, and scope.
Common refusals and requirements: acquired distinctiveness

• Direct evidence:
  – “Look for” advertising:
    • Some of the best evidence
    • Shows that the applicant is educating the public to recognize the mark and associate it with the goods or services
Common refusals and requirements: acquired distinctiveness

• Direct evidence:
  – Sales and market data:
    • Can be helpful if put in context
    • What percentage of advertising budget was put towards promoting the mark and the sales as a result
    • Make it easy for the examining attorney to understand
Common refusals and requirements: supplemental register

• Many non-traditional trademarks are capable of registration on the Supplemental Register, which will allow the registrant to defend its mark in federal court.

• Allows time for developing acquired distinctiveness as well.
Thank You!

Susan Hayash
Managing Attorney, LO 123

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571-272-9362
www.uspto.gov
What’s new at the USPTO-TTAB?

Chief Trademark Judge
Gerard Rogers
7th Annual ABA-IPL Day with the USPTO
September 18, 2019
FY 2019 TTAB staffing

<table>
<thead>
<tr>
<th>FY 2018 EOY results</th>
<th>FY 2019 actual, target or projected</th>
<th>As of August 31, 2019</th>
<th>Variance</th>
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<td><strong>JUDGES and ATTORNEYS</strong></td>
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<td>Notices of Appeal</td>
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<td>Extensions of Time to Oppose</td>
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<td>Notices of Opposition</td>
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## Trends in new filings

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<th>Type of filing</th>
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<th>FY17 (% +/- FY16)</th>
<th>FY18 (% +/- FY17)</th>
<th>By Quarters in FY19</th>
<th>Year to date as of August 31, 2019 (% +/- FY18)</th>
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<td>3,158 (+1.2%)</td>
<td>3,223 (+2%)</td>
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<td>4,672; 4,673; 5,564</td>
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<td>2,101 (+13.7%)</td>
<td>2,253 (+7.2%)</td>
<td>565; 599; 609</td>
<td>2,199 (+6.5%)</td>
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<td>FY 2018 EOY results</td>
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<td>Variance</td>
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### FY 2019 TTAB performance measures

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<thead>
<tr>
<th>FY 2019 TTAB performance measures</th>
<th>FY 2018 EOY Results</th>
<th>FY 2019 Actual, Target or Projected</th>
<th>As of July 1, 2019</th>
<th>Variance</th>
</tr>
</thead>
<tbody>
<tr>
<td>PENDENCY – Contested motions</td>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>(1) Measured from ready-for decision until mailing; average of orders on contested motions, excluding precedents, issued during reporting period</td>
<td>9.4 weeks</td>
<td>(targets)</td>
<td>11 weeks</td>
<td>above target</td>
</tr>
<tr>
<td>(2) Age of single oldest contested motion ready for decision at end of reporting period</td>
<td>11.9 weeks</td>
<td>8-9 weeks (avg.)</td>
<td>23.3 weeks</td>
<td>above goal</td>
</tr>
<tr>
<td>INVENTORY – Contested motions ready for decision</td>
<td>165</td>
<td>Cases with motions 150-190 (target)</td>
<td>234</td>
<td>above target range</td>
</tr>
<tr>
<td>FY 2019 TTAB performance measures</td>
<td>FY 2018 EOY results</td>
<td>FY 2019 actual, target or projected</td>
<td>As of July 1, 2019</td>
<td>Variance</td>
</tr>
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</tr>
<tr>
<td><strong>PENDENCY – Final decisions</strong> (cancellations, oppositions, ex parte appeals)</td>
<td>8.6 weeks</td>
<td>10-12 weeks (target)</td>
<td>12.9 weeks</td>
<td>above target range</td>
</tr>
<tr>
<td>Measured from ready for decision date until mailing for final decisions, excluding precedents, in appeals and trial cases during reporting period</td>
<td></td>
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</tr>
</tbody>
</table>
| **INVENTORY – Cases ready for final decision** | Ex parte appeals 74  
Oppositions 33  
Cancellations 21  
Concurrent Use 2  
Total: 130 | Total case inventory 130-170 (target) | Ex parte appeals 158  
Oppositions 74  
Cancellations 34  
Concurrent Use 1  
Total: 267 | above target range |
<table>
<thead>
<tr>
<th>Final decisions on merits appeals and trial cases</th>
<th>FY16 (% +/- FY15)</th>
<th>FY17 (% +/- FY16)</th>
<th>FY18 (% +/- FY17)</th>
<th>By Quarters in FY19</th>
<th>Year to date as of July 1, 2019 (% +/- FY18)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Maturing to RFD (ready for decision) (appeals/trials)</td>
<td>687 (+11.3%) (529/158)</td>
<td>679 (-1.2 %) (517/162)</td>
<td>650 (-4.3%) (473/177)</td>
<td>191; 185; 201 (128/63); (126/59); (132/69)</td>
<td>577 (+18.4%) (386/191)</td>
</tr>
<tr>
<td>Awaiting decision at end of period (appeals/trials)</td>
<td>83 (-25.9%) (56/27)</td>
<td>93 (+12%) (65/28)</td>
<td>130 (+39.8%) (74/56)</td>
<td>197; 213 (131/66); (129/84); (158/109)</td>
<td>267 (+105.4%) (158/109)</td>
</tr>
<tr>
<td>FY 2019 TTAB performance measures</td>
<td>FY 2018 EOY results</td>
<td>FY 2019 actual, target or projected</td>
<td>As of July 1, 2019</td>
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<tr>
<td>TOTAL PENDENCY</td>
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<td></td>
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<tr>
<td>Average total pendency, commencement to completion, excluding precedents</td>
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<tr>
<td>Appeals</td>
<td>35.8 weeks</td>
<td>40 weeks</td>
<td>+11.7%</td>
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<tr>
<td>(441 decided FY18; 286 to date in FY19)</td>
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<tr>
<td>Trial cases</td>
<td>140.3 weeks</td>
<td>148 weeks</td>
<td>+5.5%</td>
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<td></td>
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<tr>
<td>(144 decided FY18; 138 in FY19)</td>
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</tr>
<tr>
<td>ACR trial cases</td>
<td>106.3 weeks</td>
<td>125.6 weeks</td>
<td>+18.2%</td>
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</tr>
<tr>
<td>(19 decided FY18; 19 decided in FY19 and 9 pending at end of June)</td>
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</tbody>
</table>